

PATENT ATTORNEY EXAMS 2007
Paper A2

Examiner's Comments on Candidates' Answers

General comments

- a. The general standard of the answers was reasonably good. Most candidates showed that they had a reasonable idea of what they were talking about. The result was a pleasing higher than average pass rate.
- b. However, even candidates who passed showed significant deficiencies in some areas. Passing the exam is a necessary step on the way to becoming a registered patent attorney but even successful candidates still have much to learn.
- c. As usual, problems of poor exam technique were evident to a greater or lesser extent, depending on the candidate. For example, not doing or not finishing questions or parts of questions, and using a shotgun approach to answering questions rather than getting directly to the point.

Common deficiencies on some particular questions

The following comments are not so much intended to give answers to the questions as to identify some of the problems experienced by various candidates. Where there is no comment given for any part of a question, this means that that part was generally well answered.

- 1(a)
 - Some didn't seem to know that s.7(1) allows the applicant to be the inventor alone or the inventor together with any other person.
 - Some ignored the possibility of the professor being a co-inventor or saw him as a co-inventor only if Sparky has obligations to the university.
 - Sparky's use of university facilities isn't enough by itself to give the university rights in the invention.
 - Unknowns are the nature of the professor's contract with the university and the nature of any contract Sparky might have with the university.
 - Even if Sparky made the invention in the course of employment by the supermarket, that doesn't make Will a co-inventor.
- 1(b)
 - Sometimes the answers were inconsistent with the answers given for part 1(a).
 - You can add an inventor and/or applicant before grant, but not under s.23 (mention of inventor in patent).
 - Some said that if the professor was found to be entitled, Sparky could assign a share to him – but that wouldn't be necessary.

2. This question was testing candidates' knowledge about savings as to anticipation for both patents and designs. A number did not address designs at all or addressed them only in part.
- 2(a) - Many didn't consider that the tines mightn't have been visible anyway.
- No reasonable trial period for designs.
- 2(b) - Generally there was no recognition that Frieda might have understood the disclosure to be confidential anyway.
- Some considered this part in terms of prior use, even commercial use, and not in terms of publication.
- 2(e) - There is no requirement for filing an application within 6 months or within a year after disclosure to a government department.
- 2(f) - Some considered that the publication in the Waikato Times destroyed novelty!
- 3(a) - Some didn't recognise this as being a s.25(5) issue.
- Someone saw it as a US foreign filing licence issue – maybe in part!
- 3(b) - Someone said that the initial application in the US would be void!
- 3(c) - An employment agreement might give legal title to an invention in some countries but in NZ it gives the employer only an equitable or beneficial interest in the invention. An assignment is still needed to transfer the legal title. Which law should prevail when the inventor and employer are both overseas?
- Some noted the provisions of s.7(1) but this is a s.7(2) convention case.
- Someone said there is no bar in NZ to assignment of future property rights. For inventions this would assign only an equitable or beneficial interest in the future invention.
- 3(d) - Some said that you could assign after the application is made and they were not referring to a confirmatory assignment (if such was appropriate).
- Since the basic application is a US application, Ajax is not the basic applicant.
- 4(c) - One reason for delaying grant is to allow time to record an assignment so that the patent issues in the name of the assignee. Some gave the reason as being because amendments after grant are more limited. But so are they after acceptance.
- 5(a) - Ms Chance can be named as inventor by importation but not as author (of the design) by importation.
- Ms Chance will not have to name the "true" inventor.
- For copyright, copying from a lapsed patent or design is only excused where it is a lapsed NZ patent or design.

- 5(b) - Some didn't consider the possibility of existing protection in NZ by others, or the possibility of others still getting protection in NZ and prevailing because of earlier priority.
- Getting a patent won't protect Ms Chance from copyright infringement if she does copy too closely.
 - Many considered that the German owner would succeed in opposing on the ground of obtaining. If so, that would always defeat invention by importation.
 - Many considered a NZ patent and design search, but not searching for any basic applications in, say, Germany or Europe, to see if convention applications might still be filed in NZ.
- 6(a) - Can an examiner request EPO search reports? What if the European application designates the UK? What if it doesn't?
- Many said that the examiner can request any prior art cited by any foreign Patent Office.
 - Some didn't distinguish between standard patent applications and PCT national phase filings.
 - Not all recognised this question as relating to a provision in the Patents Act (s.15).
- 6(b) - Some said the prior art must be brought to the attention of the examiner.
- Some suggested that amendment must be before acceptance because the amendment (referring to amendment by disclaimer) might not be allowed after acceptance. No mention of *PDL v Jackson* was made by these candidates.
 - Some suggested amending claim 1 by adding the subject matter of claims 2-4. But just adding the subject matter of claim 4 would be enough to avoid novelty and obviousness problems.
- 7(a) - The definition of "article" uses the words "made and sold separately" and not "made or sold separately".
- Some referred to "used" instead of to "made" in the definition they gave.
 - Some didn't give the s.2 definition at all.
- 7(b)(i) - Some said that a shape design dictated solely by function is registrable if the design has eye appeal.
- 7(b)(ii) - Most candidates had some idea of what a statement of novelty is.
- 7(c) - Someone ruled out the possibility of a s.8 design of addition, saying that required the design to be applied to a different article.
- 8(a) - Not all knew the definition of a "set of articles" or at least a synopsis of it.
- 8(b) - Very few identified that registration of a group of articles as a set could not be challenged on the ground that the articles did not truly qualify as a set.

- 8(c) - Very few identified the possibility that in a set, the invalidity of the design applied to one of the articles might mean the invalidity of the whole registration.
- Someone argued that if one of a set is infringed it may be harder to prove the whole registration is infringed!
- 9(a) - Some said that a correction was allowed but not an amendment. Regulation 81 permits amendments at the discretion of the Commissioner.
- 9(b) - Generally well answered but some said you couldn't add a perspective view ever.
- 9(c) - Some saw adding a disclaimer as narrowing the scope of a design.
- Some said the amendment would be advertised for opposition purposes.
- 10 This question was based on sections 15 and 28 of the Designs Act and, in general, was reasonably well answered.
- 11(a) - Some thought this question related to s.8 designs of addition.
- Many had issues with "new and original", considering the parts of the design rather than the whole of it.
 - Many had issues with "sets of article" and what would and would not qualify. For example, would a set of caps be intended to be sold together as a set? Does it matter? What if they are at least offered for sale as a set even if they do not have to be bought as a set? Are caps, tee-shirts and windbreakers articles of the same general character?
- 11(b) - Registered design protection cannot protect the logos *per se*. Copyright can.