

PAPER A1 - 2008 - EXAMINER'S COMMENTS

Thirty-two candidates sat Paper A1. The most successful candidates demonstrated a good knowledge of patent law and practice and gained marks in the 70s.

The candidates gaining less than 50% appeared to have a base of relevant knowledge, but with significant gaps and a shortage of detail.

Many candidates appeared not to have read any of the leading decisions on which much of Question 4 was based.

Question 1

This question was designed to test candidates' knowledge of the deadlines and filing requirements for patent applications. Only a few showed near complete knowledge of the requirements.

Some candidates were unaware that applications cannot be filed on days when IPONZ is closed. Frequently overlooked requirements were (a) the fee and (b) the certified priority document and translation for a Convention application.

Question 2

Question 2 was intended to test candidates' knowledge of the provisions in the Patents Act for postdating, conversion of complete specifications to provisional specifications and extension of time for filing complete specifications.

A number of candidates scored highly on this question – but others made wrong calls. Most avoided postdating the application to a date after the first disclosure. But others believed that the publication in trade journals provides a six month grace period for filing. Others incorrectly believed that delaying acceptance would delay the expiry date of the patent and that the patent term was 20 years from grant.

Question 3

Question 3 raised the problem of what can be done to protect a modification of the invention not covered by the existing patent application. This question was generally reasonably well done.

Question 4

This question with 9 parts was designed to test candidate's knowledge of some of the best known patent cases. Most of the parts were fact situations that resembled those of such patent cases. Two less well-known cases, *Hickman v Andrews (Workmate)* and *Toyo Soda* were included to test the stronger candidates. No case was unknown to all candidates.

Fifteen candidates scored half marks or more for the question. For those with a good knowledge of case law, this was relatively easy. But it seemed that most candidates were not familiar with most of the cases. A number did not refer to a single case, let alone recognise any similarity with a decided case.

Question 5

Question 5 was about the options of opposition under section 21 and revocation under sections 41 and 42. Most candidates were well aware of the options and deadlines – and had an understanding of the advantages and disadvantages. Answers on the appropriate ground of attack varied.

Question 6

This question was intended to test candidates' knowledge of divisional applications. It was generally not well done. Many did not appear to be familiar with Regulation 23. Many believed that the way forward was to file a new application, without considering that the PCT application was likely to have been published and would be prior art.

The option of resisting the examiner's objection and arguing that there was sufficient basis in the existing specification was often not considered.

Some candidates incorrectly stated that there was a 12 month deadline for filing a divisional.

Question 7

Question 7 was intended to test whether candidates could recognise the possibility of a filing an application for a selection invention. Many did not. Many preferred to try to restrict the existing application to a range that was neither disclosed in the original patent specification nor supported by any example.

Question 8

Question 8 was concerned with post acceptance amendments except for the final section relating to compulsory licensing. Candidates were generally aware of the need not to delay making post-acceptance amendments, but description of the procedure was weaker.