

PAPER A2 - 2008 - EXAMINER'S COMMENTS

Thirty one candidates sat Paper A2. Thirteen candidates showed a good knowledge of patent, copyright, and design law and practice and gained marks in the high 60s or above. Many candidates that achieved lower marks had a good understanding of some aspects, but a lesser understanding of others.

Many of the questions were designed as practical “real world” type questions, and were answered quite well given that candidates often find that type of question more difficult than brief fact-based questions.

Question 1

Part a tested candidates' knowledge of the definition of a design. While most candidates referred to shape, configuration, pattern, ornament, very few candidates mentioned that the shape/configuration features are generally 3d features and the pattern/ornament features are generally 2d features.

Part b tested candidates' knowledge of the section 8 design (design of addition). Most candidates understood that a design of addition can be used to protect the main design applied to a different article, but very few mentioned that a design of addition can also be used to protect a substantially similar design applied to the same or a different article.

Question 2

Question 2 tested candidates' knowledge of sets of articles. Most candidates understood the basic requirements for a set of articles.

In part b, it was necessary for candidates to determine whether the buckets qualify as a set of articles. Many candidates incorrectly made an assumption (one way or the other) whether the buckets would be ordinarily on sale or intended to be used together; often in the negative. That is a question of fact. Only a few candidates mentioned they would check whether their client intends to sell the buckets together.

For part c, it needed to be clear from the statement of novelty that the article is a set of buckets, not a set of bucket handles. As the bucket handles are permanently attached to the buckets, the handles do not qualify as articles under the Designs Act as they are not made and sold separately.

For part d, some candidates did not appreciate that it would be possible to file a single design application showing one of the buckets and disclaiming the bucket body, as the two handles are the same. Again it should have been clear from the statement of novelty that the article is a bucket rather than a bucket handle, but for this answer novelty should have been claimed only for the bucket handle.

In their answers for part e, several candidates assumed that the bucket was a work of artistic craftsmanship. However, there was nothing in the question to suggest that is so. Another important point is that most countries do not offer unregistered protection

for industrially applied designs. This is an important point to raise when advising on the benefits/limitations of copyright vs registered designs.

Question 3

Question 3 tested candidates' knowledge of the criteria for protecting parts of articles. The important issue is whether the spoiler will be made and sold separately from the boot lid. The question stated that the client provides aftermarket parts, so it is safe to assume that the boot lid will be made and sold separately from the car.

Some candidates decided that the design of the spoiler could not be registered as the sole purpose of the spoiler is to carry the design. The examiner is of the view that this is taking that point too far. If that argument was valid, it would not be possible to obtain a registration for an ornament for example. Additionally, the question states that the spoiler does not give any performance benefit, but does not state that the spoiler serves no purpose whatsoever. For example, a boot lid spoiler would typically provide a surface for a user to grasp to while opening and closing the boot lid.

Under part c, a number of candidates changed the article to a car, rather than a boot lid. That is too narrow, as the question states the client manufactures aftermarket car parts. The article should have been a boot lid, as that is what the client will sell.

Question 4

Question 4 covered various aspects of New Zealand patent infringement.

Part a required the candidates to outline the actions that amount to infringement of a New Zealand patent. Several candidates answered that use has to be commercial or trade use in order to infringe a patent. That is incorrect – private use infringes a patent. A small number of candidates misinterpreted the question and outlined the infringement test.

Part b tested candidates' knowledge of infringement of a process claim when the process is carried out overseas and the product of the process is imported. That is an infringement under the Saccharin doctrine. Several candidates thought infringement only occurred if the imported product was the only product that could have been manufactured by the process, or if the process was the only process that could provide the product. Neither is correct, but those considerations could well affect how easy or difficult it is to prove infringement. Some candidates also misinterpreted the effect of section 68A which simply changes the onus of proof if the product of the process is new.

Many candidates incorrectly thought an imported product would not infringe a process claim but would infringe a product-by-process claim.

Part c required the candidates to outline the steps of the Improver test. Correctly outlining the steps of the Catnic test was also acceptable.

Part d required an understanding of innocent infringement provisions and marking requirements, and was generally answered well.

Question 5

Question 5 tested candidates' knowledge of registrability requirements for designs. For part a, many candidates did not realise that a building in portable or kitset form is an "article" and is therefore registrable.

For part b, many candidates had the incorrect reasoning for a painting not being registrable. Regulation 33 has an exclusion for printed matter. However, a painting is not printed matter. Rather, a painting is not applied to an "article" as the canvas serves no purpose other than carrying the design. Some candidates correctly answered this.

For part c, candidates should have appreciated that the shape and configuration of a design that is wholly functional cannot be registered, unless the design also has eye appeal. Some candidates did appreciate this, and mentioned that they would check whether the designer had aesthetic considerations in mind when designing the switch.

Most candidates were aware of the exclusion for sculptures under regulation 33.

Question 6

Question 6 tested candidates' knowledge of the term and renewal timing for registered designs. For part a, many candidates simply answered that the term of copyright in a registered design is "15 years". However, it should have been clear from the answers that the term runs from the filing date of the application, or from the priority date for a convention application.

Under part b, some candidates did not mention that the 5 and 10 year renewal terms run from the filing or priority date (as above). Many candidates did not mention the six month extension that is available for paying renewals.

Under part c, candidates were expected to be aware that a 6 month extension is available from the initial renewal deadline, but after that the registration will lapse and there are currently no specific provisions for restoring a lapsed design.

Under part e, candidates were expected to be aware of the provisions of section 75 of the Copyright Act that states it is not a copyright infringement to make a 3d object, if it is more than 16 years from when the related artistic work was industrially applied (or more than 25 years in the case of a work of artistic craftsmanship).

Question 7

Question 7a(i) tested candidates' knowledge of inventor by importation provisions. Some candidates answered that the client could apply for a patent but could not be listed as inventor. However, that person is able to be listed as inventor by virtue of being the true and first importer.

Under question 7(a)(ii), a number of candidates did not realise that there are unlikely to be importer application rights for designs – *Aerospeed/Eveready v Gillette*.

For question 7(b) most candidates realised there could be a copyright issue. Several candidates did not mention that a convention design or patent filing could capture your client's product, and that a watch should be set up for that.

Question 8

Most of Question 8 tested candidates' knowledge of convention priority/patent validity issues. The question was answered well by many candidates. For question 8b, a few candidates incorrectly believed you can simply specify to IPONZ which claims you are claiming priority for and which you are not, when they are all fairly based on document A and some are also based on document P.

Many candidates correctly suggested deleting the claims with a priority issue or withdrawing the convention priority claim. Only a small number of candidates thought of filing a divisional application to separate the claims with a convention priority issue (to be the subject of a non-convention application) from the claims without a convention priority issue (to be the subject of a convention application).

Candidates were expected to know that a patent granted on a false claim to convention priority is invalid and cannot be fixed, as granted on a false suggestion – Gumbel's Patent (1958) RPC 1.

For part c, candidates were expected to recite the steps of the Mond Nickel test.

Question 9

Question 9 tested candidates' knowledge of requirements for patentability.

For question 9a, very few candidates mentioned that method of treating a non-human mammal would be allowable, even though the question did not specify that the device is for human use. Some candidates thought that dental methods are allowable generally. However, a 2005 IPONZ Information for Clients states that a method of removing plaque is not patentable. A method of reducing dental decay is also very unlikely to be patentable. Most candidates realised that a tooth whitening method is likely to be patentable, provided the cosmetic method does not have a therapeutic effect.

For 9c, several candidates knew of the British practice note relating to the patentability of board games, and the requirements for patentability. However, few candidates realised or stated that the required features must be claimed, not just disclosed in the specification. Additionally, there could be a novel and inventive game apparatus that would not need to be limited in the way outlined in the British practice note to be patentable.

For 9d, again most candidates overlooked that the method of treating a non-human mammal would be patentable.

Question 10

Question 10 tested candidates' knowledge of ownership/right to file issues for patents and designs. For question 10(a) some candidates incorrectly thought there is a commissioning provision for patents that gives the commissioning party the right to apply for a patent application. A few candidates realised that the commissioning party could possibly have an equitable ownership claim but not legal ownership of the invention, but overlooked that the designer was not commissioned to invent – he was simply commissioned to draw what the company director had invented. That would raise doubt over the equitable ownership position. In any case, that would still not transfer the right to apply for a patent application to the commissioning party, although might enable the commissioning party to challenge the ownership position through the Court.

Most candidates realised that there is a commissioning provision in the Designs Act that gives the commissioning party the right to file a design application.

For question 10(a)(iii), some candidates thought it would be sufficient to list the designer as a co-inventor, but did not realise that it would also be necessary for the designer to be listed as a co-applicant as there has been no assignment.

For question 10(b) many candidates realised that under section 63 of the Patents Act, co-owners have an equal undivided share in the invention. Most candidates failed to point out that the co-ownership position is subject to any agreement to the contrary.