

Examiner's Comments – Paper A1 2009

Question 1

(a) Many candidates had trouble articulating the requirements under s10. A number of candidates mentioned s17, but only a few specifically noted it was not relevant to the question. A few candidates referred to formality requirements, which the question specifically said was not necessary.

(b) Many candidates recognised that the compounds could be considered a selection invention and correctly identified supporting case law. However, only a few candidates could outline all the criteria necessary for a selection. In addition, many candidates did not point out that the objection may be overcome in other ways; for example, arguing the document was not valid prior art (dates, availability in NZ etc), compounds do not anticipate, or amend the claims.

Question 2

(a) Well answered by most.

(b) A well answered question, with most candidates getting full marks.

(c) A generally well answered question. A number of candidates did not read the question properly and thus suggested strategies that were not appropriate. Many candidates failed to question whether Barry's product fell within ProdCat's granted claims. A number of candidates correctly mentioned the main points: s74 (possible groundless threat and available remedies), s68 (possible innocent infringer and remedies), prior use which could be used to challenge under s41 (or perhaps s42 as noted by some candidates). Some candidates also suggested further practical strategies including suggesting a licence be taken if appropriate, defences, bring prior use to ProdCat's attention etc.

Question 3

(a) Overall, poorly answered. Many candidates did not make any distinction between methods of treatment and diagnostic methods. Many did not mention Swiss-style claims as an option. Very few mentioned recent IPONZ decisions relevant to these issues (particularly diagnosis and Swiss-style claims). A number of candidates said s17 was relevant to patentability of methods of treatment - overlooking more recent case law which established it is a question under s2.

(b) Generally well answered. However, many candidates did not refer to exceptions to secret use as outlined in s41(2).

(c) Generally well answered. Those that did not score well typically did not fully articulate what constitutes a "mere collocation" and what types of combinations might be patentable.

(d) Reasonably well answered. Many candidates simply mentioned a particular case and that for software to be patentable it must provide a commercially useful effect, but failed to explain how the case law defines a "commercially useful effect". Only one candidate mentioned the recent IPONZ decision (Microsoft NZ535067) relating to patentability of underlying data structures.

Question 4

(a) Very well answered. Everyone had a good understanding of basic rights.

(b) Very poorly answered. Many candidates listed exceptions to patentability, or issues related to remedies available to patentees, and non-statutory exceptions to patent infringement. Very few correctly identified s68B. A number referred to s55-58 - non-infringement in case of crown use. Some candidates also mentioned compulsory licensing.

(c) Very poorly answered. The question relates to crown use. Many candidates confused crown use and compulsory licensing by the Court under s46. No one was able to clearly articulate the circumstances under which the Crown could use the invention (under s55 generally and s58 specifically). While many recognised the patentee would be compensated, only one person mentioned that the Crown's right to use is non-exclusive. Few candidates mentioned that the Crown must take reasonable steps to get patentee's consent (unless in case of state of emergency).

(d) Generally poorly answered. Many candidates recognised s68A should be discussed. However, they often did not make it clear that this section only applies where the method relates to production of a "new" product. The question specifies that the product is not new. A number of candidates referred to "groundless threats" provisions. However, the question asked candidates to advise their client of the consequences if he was to actually initiate infringement proceedings.

(e) A reasonably well answered question. Most candidates recognised that importing a product made by a patented process can constitute infringement of a method claim in New Zealand. However, the question notes that the product imported into NZ is not the drug *per se*, but a formulation containing it. Only one candidate made note of this and discussed possible consequences.

Question 5

(a) This question was not as well answered as expected. Many candidates identified that the client could not view the contents of the Electric Company's provisional specification and would only know what was going on once the complete specification was published. However, only a few candidates mentioned when the complete specification would be published. Similarly, only a few candidates discussed the possibility of The Electric Company having filed overseas which might mean an earlier publication date. Many candidates suggested setting up a watching service. Some also suggested filing a request for information at IPONZ.

(b) A generally well answered question. However, a number of candidates did not mention the option of relying on the provisions of s22.

(c) A number of candidates failed to mention the option of obtaining files related to corresponding overseas patent applications and applying to IPONZ for information under s91. However, many candidates mentioned attempting to identify prior use. Some also suggested doing internet and market searches, and talking with people in industry to identify what was known.

(d) This question was generally well answered. Candidates who recognised that the document was published between the provisional and CAP filings and discussed priority dates/fair basis scored very well. A number of candidates suggested the document might have been available/published prior to the earliest priority date, even though the question specified that it was published after the priority date.

Question 6

- (a) A well answered question. Those candidates who fell short of full marks typically did not mention that the use must not be secret use or that it is necessary to establish what was used.
- (b) Surprisingly few candidates recognised that this statement could lead to inutility issues. Those that did recognise this typically provided satisfactory suggestions to amend to minimise risks associated with the statement. Many candidates interpreted the statement as a claim and then discussed insufficiency issues. The question clearly said this was a "statement in the specification", rather than a "claim". Others said that this sort of statement highlights the prior art and may raise novelty/obviousness issues.
- (c) A generally well answered question with candidates outlining factors to be considered and making reference to relevant case law. Very few candidates mentioned s65 provisions relating to the Commissioner being able to consider disputes between employee/employer.
- (d) Reasonably well answered. Candidates who did not score well appeared not to have read the question properly and hence did not answer the two separate parts to it. Those that scored well clearly outlined the discretionary principles applied by the court/Commissioner in considering whether or not to allow an amendment.
- (e) Many candidates did not distinguish between complete specifications in the first instance and CAPs and convention applications, simply saying the declaration must be filed with all applications, with a complete specification, or that it was only required when the applicant was not the inventor.
- (f) A generally well answered question. Candidates could typically refer to most of the relevant provisions under s63. Many also pointed out the provisions of s64. However, most candidates failed to state that the provisions of s63 only apply if there is no agreement in place to the contrary and as a result did not consider whether Bill and Ben may have such an agreement in place.

Question 7

- (a) Average answers. A number of candidates identified the main strategies of filing a supplementary provisional application to ensure an early priority date for the modification and then cognating it with the earlier application when it is completed, or to add details of the modified fan to a CAP when filed. Another option considered was to file a stand alone application. However, many candidates said filing a new application was only an option if the modified fan was novel/inventive over the original application (however, the original application had not been published). Many candidates also said the client should file an application for a patent of addition. However, an applications for a patent of addition can not be filed until after an earlier complete is filed and only a couple of candidates mentioned this.
- (b) A reasonably well answered question. Candidates needed to discuss two possible priority dates and fair basis issues to get full marks.
- (c) Not as well answered as (b). Many candidates identified the option of filing an application for a patent of addition, outlining the pros and cons of this option. Many also identified the option of filing a stand alone application and the pros and cons of this. An option which was not recognised by any of the candidates was to file a stand alone application in the first instance (benefit of having full 20 year term) and then convert to a patent of addition if obviousness issues (over

invention in original application) were raised later. Many candidates seem to think a patent of addition retains the priority date of the original application. A few also said that the invention in the patent of addition did not need to be novel over the invention in the original application.

Question 8

(a) An extremely poorly answered question. Few candidates properly addressed Sara's strategy of refiling and most simply said she should file a PCT application (despite the fact the question said she did not have funds to file a PCT application). Candidates typically did not appear to understand, or at least did not discuss, that to ensure a valid claim to priority, the priority application must be the "first filing in a convention country" nor did they outline the provisions necessary to ensure this was the case where refiling (i.e. s7(2A) - withdraw/abandon first application before filing second, no rights outstanding in first, first not to have been used to establish priority, new application must be filed in the same country and by the same applicant). As a result they did not recognise that the issue of Sara setting up the company and possibly refiling in its name and/or overseas could affect a claim to priority.

(b) Generally well answered.

(c) Generally well answered.