

## Examiner's Comments – Paper A2 2009

### Question 1

1a) While most candidates seemed to have a reasonable understanding of the definition of an article, few candidates mentioned that the article must serve a purpose other than simply carrying the design.

1b) The majority of candidates applied patent law provisions to the infringement scenario. The exclusive rights given by registration are set out in s11(1) of the Designs Act. "Use" is not one of those rights, irrespective of whether the use has some commercial aspect to it (e.g. use of a product on business premises). To be an infringement, the act must be one of the types specified in s11(1).

Unauthorised manufacture and importation are not infringing acts, unless the manufacture or importation are for sale or for the use in trade or business. Therefore, in the fact scenario, the manufacturer of the item referred to in the question could have infringed the design, provided the item was manufactured for sale.

### Question 2

2a) The set of articles question was generally answered well. A benefit that most candidates considered was that a set can be filed with a single filing fee instead of the multiple fees that would be required for separate applications. Another possible benefit in filing a set is that you are effectively asserting that the differences between the knife, fork and spoon are immaterial, which could result in the designs being construed more broadly in relation to any alleged infringements than separate design registrations may be. Candidates should have referred to a "set" in their chosen title for the application.

2b) Many candidates correctly commented that you could file on one article, use a generic name for the article (e.g. "a utensil" or "a cutlery item"), disclaim the portion of the article other than the handle, and obtain protection for all three items through the one registration. However, several candidates incorrectly selected "a handle" or similar for the title for the application. The title should name the article that the design is applied to. A cutlery handle does not qualify as an article under the Designs Act, as it is not made and sold separately from the remainder of the cutlery item.

2c) Provided the carving knife has sufficient visual similarity, and the title chosen for the design application is sufficiently broad to cover a carving knife rather than a table knife, the carving knife would be captured by the registration. Several candidates incorrectly thought that a design registration extends to cover ANY article.

2d) Candidates were expected to consider that there could possibly be sufficient novelty in separate design applications for the knife and fork, even if the prior publication of the spoon invalidates the spoon application. It is possible that if the heads of the knife and fork are standard, that wouldn't be the case, but the question did not state that the heads were standard. Candidates were also expected to realise that there are no provisions for partial validity of a set design registration, and the spoon would likely invalidate the entire set application.

2e) This question tested candidates' knowledge of the specific provision in s2(3) of the Designs Act that the Commissioner's decision regarding a set of articles is final, so the registration cannot be attacked on the ground that the articles do not properly qualify as a set.

### **Question 3**

3a) There were many different answers given on the minimum filing requirements. Some candidates failed to mention that they would file at least one representation or sample with their documents to obtain a filing date. Candidates were expected to comment that a statement of novelty is not required for a textile design application.

3c) Many candidates knew of the provision of s10(1)(c) of the Designs Act that preclude the acceptance of a first confidential order for textile goods from invalidating a design application. This provision only applies to textile designs. Also, for this provision to apply, there has to be an intention to register the design at the time of accepting the order.

3d) Candidates were expected to be aware of s30(2) of the Designs Act and regulation 60(2) that precludes textile designs from being published for 3 years from the date of registration.

### **Question 4**

Candidates were expected to be aware of the ability to apply for cancellation via the Commissioner under s15(2) and rectification by the Court under s28(1).

### **Question 5**

This question tested candidates' knowledge of the section 8 ("design of addition") provisions.

5(i) Candidates were expected to be aware that while the application for product A was not published, when it is registered it will be prior art as of its filing date, so would invalidate a subsequently-filed standard application for registration. Some candidates incorrectly thought that applying an identical design to a new article would provide the new article with novelty.

While in the fact scenario given the earlier application had not been registered, in practice it is possible to file an application for a design of addition while the earlier application is pending, and for the second application to be registered after registration of the first application. Alternatively, the second application could be filed as a standard application while the first application is still pending, and after the first application has been registered the second application could be converted to an application for a design of addition.

5(ii) Some candidates incorrectly believed that a design registration covers the design applied to any article.

5(iii) Candidates were expected to be aware that a design is registered as of its filing date or, in the case of a convention application, its priority date. Candidates were also expected to be aware that both s7(5) and s21(2) state that no proceeding shall be taken in relation to any infringement that occurs before the certificate of registration issues. Several candidates incorrectly stated that damages can be backdated to the filing or priority date. However, that is in conflict with the

wording of the above sections of the Designs Act, and would not be in the public interest as the proprietor would be claiming damages for a period when the design had not been published.

### **Question 6**

6a) Candidates were expected to be aware of the possibility of amending a provisional specification using the s88 correction of error provisions. Several candidates suggested that the matter could just be excluded when filing the complete specification to keep the information confidential. However, when the complete specification is published and accepted, the provisional specification will also be published.

6b) Many candidates were not aware of s40(2) that states once the amendment has been allowed by the Commissioner, the amendment cannot subsequently be called into question other than on the ground of fraud.

6d) Some candidates incorrectly thought that using the 3 month extension (to 15 months) for filing a NZ complete-after-provisional specification would affect the validity of filing a convention application 12 months after the provisional application was filed.

### **Question 7**

This question was generally answered well.

### **Question 8**

Candidates were expected to be aware of the provisions and requirements for a late national phase entry as per the 1999 IPONZ Information for Clients, and for a late convention application requested under section s93A. Candidates' answers should also have outlined the additional considerations around due diligence and prudence that are considered under s93A.

### **Question 9**

Candidates appreciated that there was an issue that needed addressed, and were aware of possible consequences such as obtaining, false suggestion, and right to apply. Most candidates acknowledged that an assignment was required from the third inventor. A number of different approaches were suggested for addressing the issue via correction of error. It was not clear from several of the answers whether candidates were proposing to add the inventor to the application just as an inventor, as a co-applicant, or both.

### **Question 10**

10(a) Some candidates said your client could possibly apply for a patent application but not be named as inventor. However, that person is inventor by virtue of being true and first importer. Most candidates realised that there are unlikely to be importer application rights for designs – Aerospeed/Eveready v Gillette.

10(b) Most candidates realised there could be a copyright issue. Several candidates didn't realise there may be a convention design or patent filing that could capture your client, and that you should set up a watch for that.