

Paper E - Examiner's Comments

Candidates generally provided reasonably well structured answers although the level of detail was often lacking.

Consideration of infringement was generally better than validity. For claim 1, candidates were expected to focus on the effect of the limitation of the compartment being "for receiving" the listed items (in distinction to claim 2 which required an item to be provided in the compartment), and which if any of the client's embodiments included feet. Here it was necessary to contrast with "foot", making reference to the embodiments described in the patent. At least the embodiments including a rim extending downwardly from the base and having cut-outs were considered to infringe although it was arguable that any embodiment able to stand would infringe.

With regards validity, many candidates missed the disclosure in D1 of a cavity (many seemed to base their analysis solely on the figures of D1) and failed to consider the different orientation of the head in this document when in the standing position. Many candidates also missed that D2 was not a valid prior publication. Of these, only a few raised the issue of possible subsequent use or re-publication of the D2 toothbrush.

For D3, discussion of "compartment" was required, noting the fact that a closable compartment was not required in claim 1, referring to claim 3 as first introducing a cover. For D4, candidates were expected to note that the Air NZ toothbrush constituted prior use. Discussion of evidential requirements was required (ie what, where, when, whether use has continued to present day etc) as well as the implications on the client's ownership of IP and their freedom to use their designs.

D1 provided the strongest challenge for prior publication of claim 1 but there were also arguable challenges based on D3 and D4. D2 was not considered to disclose all of the features of claim 1 and was not therefore considered a strong basis for attack, even if there had been subsequent use or publication in New Zealand.

A number of candidates also failed to address dependant claims in any detail under both infringement and validity.

There were various options for amending the patent, including deleting reference to sundry products, more tightly defining the orientation of the toothbrush in the standing position and/or the feet, the preferred manners of forming the compartment, and any significance of the combination of vents and drainage holes. Comments on the implications of the proposed amendments on infringement were required.

Candidates were expected to consider alternative strategies for the client with the date of the conference in mind, comparing the benefits of a belated opposition before the Commissioner with a revocation before the courts (identifying available grounds, most likely grounds and significant differences between the two actions), as well as other options, such as seeking a declaration as to non-infringement, if applicable.

Despite the signposts, few recognised and advised on contributory infringement and the possible impact of switching to a Chinese-based manufacturer of the heads.