

## Patent attorney examination syllabus for 2013

### Regulation 158(1)(a)

### The New Zealand law and practice relating to patents and designs

The subject requires the candidate to have a good understanding of the patent and design laws of New Zealand and the practice associated with the implementation and interpretation of the law by the Intellectual Property Office of New Zealand. In the main, the law is codified in the New Zealand Patents, Designs and Copyright Acts and associated Regulations.

Candidates should be familiar with the following Acts and Regulations:

- Patents Act 1953
- Patents Regulations 1954
- Patents (Patent Cooperation Treaty) Regulations 1992
- Designs Act 1953
- Designs Regulations 1954
- Patents, Designs and Trade Marks Convention Order 2012
- Copyright Act 1994
- All amendments of each of the above in force at the date of the examinations.

The inclusion of the Copyright Act is in respect of its interrelationship with the patent and design laws of New Zealand. A candidate should also have a basic understanding of the law in New Zealand relating to confidential information.

Examination questions will test a combination of a candidate's knowledge of relevant legislation and case law, and the types of problems which a practising patent attorney would expect to encounter in dealing with clients and the Intellectual Property Office of New Zealand.

### Source material

- The Acts and Regulations listed above
- The information on our website, particularly Practice Notes and Guidelines issued by the Commissioner of [Patents](#) and [Designs](#)

### Reference books

- British Patent Office Manual of Office Practice (Patents) (1949 Act)
- Patent Law of the United Kingdom by the Chartered Institute of Patent Agents (1949 Act) – Sweet & Maxwell 1975 (with 5th cumulative supplement)
- Terrell on the Law of Patents
- Patents for Inventions – T A Blanco-White
- The Law of Intellectual Property in New Zealand – Brown and Grant
- PCT Applicants Guide – WIPO
- Russell-Clarke on Copyright in Industrial Designs – Michael Fysh
- Design: The Modern Law and Practice – Morris and West
- The Modern Law of Copyright and Designs – Laddie, Prescott & Vitoria
- Copinger & Skone James on Copyright
- The Law of Intellectual Property – Ricketson
- Fair Trading in New Zealand – Hill and Jones
- Passing Off – David Young
- Misrepresentation and the Fair Trading Act – Trotman
- The Law of Trade Secrets – Dean
- Industrial Design Law in Australia and New Zealand – Puri

- Intellectual Property in New Zealand – Frankel and McLay, 2002
- CIPA Guide to the Patents Act
- The Laws of New Zealand – Confidential Information – Katz
- James & Wells Intellectual Property Law In New Zealand – Ian Finch
- Intellectual Property Law – Principles in Practice - Paul Sumpter

## **Regulation 158(1)(b)**

### **The New Zealand law and practice relating to trade marks**

The subject requires a good understanding of New Zealand trade mark law and the practice associated with the implementation and interpretation of the law by the Intellectual Property Office of New Zealand.

Candidates should be familiar with the following Acts and Regulations:

- Trade Marks Act 2002
- Trade Marks Regulations 2003
- Patents, Designs and Trade Marks Convention Order 2012
- Fair Trading Act 1986
- Flags, Emblems and Names Protection Act 1981
- Plant Variety Rights Act 1987 (s.22)
- Copyright Act 1994
- Geographical Indications (Wine and Spirits) Registration Act 2006
- Major Events Management Act 2007
- All amendments of each of the above in force at the date of the examinations

Candidates should also be aware of the nature and protection of common law trade marks particularly as far as these may conflict or co-exist with registered trade marks and The Madrid Protocol in so far as it affects trade mark practice in New Zealand.

The inclusion of the Fair Trading Act and the Copyright Act is in respect of its effect on the trade mark law of New Zealand.

Examination questions will test a combination of a candidate's knowledge of relevant legislation and case law and the types of problems which a practising patent attorney would expect to encounter in dealing with clients and the Intellectual Property Office of New Zealand.

### **Source material**

- The Acts and Regulations listed above
- The information on our website, particularly Practice Guidelines issued by the Commissioner of [Trade Marks](#)
- The [WIPO website](#)

### **Reference books**

- Trade Marks in Practice – Paul Sumpter
- Kerly's Law of Trade Marks and Trade Names, 14th edition, 2005
- The Law of Intellectual Property in New Zealand – Brown and Grant
- Service Marks: A Guide to the New Law – Morcom
- Misrepresentation and the Fair Trading Act – Trotman
- Passing Off: Law and Practice – Drysdale and Silverleaf
- Fair Trading in New Zealand – Hill and Jones
- The Law of Trade and Merchandise Marks – Venkataswaran
- Elements of Trade Mark Law and Practice – Faulkner
- Trade Mark Cases (Volumes 1 and 2) – P Narayanan
- The Law of Passing Off – C Wadlow

- Passing Off – David Young
- Australian Law of Trade Marks and Passing Off – Shanahan, 3rd edition, 2003
- A Practical Guide to Trade Mark Law – Amanda Michaels, London, Sweet & Maxwell, 2002
- Intellectual Property in New Zealand – Frankel and McLay, 2002
- James & Wells Intellectual Property Law In New Zealand – Ian Finch
- Intellectual Property Law – Principles in Practice - Paul Sumpter

## **Regulation 158(1)(c)**

### **Foreign patent law**

The subject requires a knowledge of patent law and practice in, or pursuant to, the following countries, Treaty and Conventions:

Australia

Great Britain

Canada

Japan

United States of America

People's Republic of China

Taiwan

Hong Kong

Republic of Korea

India

Brazil

Singapore

European Patent Convention

Paris Convention

Patent Cooperation Treaty (PCT)

For each country, Treaty and Convention, the candidate should have a thorough knowledge of:

1. Kinds of patents available.
2. Novelty and inventive step provisions governing the right to obtain patent protection.
3. Who may apply for a patent.
4. The general form of the specification, and any required format of the claims.
5. Any international arrangement under which patent applications may be filed.
6. A general outline of examination procedures.
7. A general outline of any pre- or post- grant opposition procedures that may be available, including third party observations and re-examination.
8. Date or dates of publication of documents relating to the application.
9. The operation of the Treaty and Conventions in relation to the countries listed above and France, Germany and Italy.
10. The operation of the Treaty and Convention.

Examination questions will test a combination of a candidate's knowledge of the above matters and the types of problems which a practising patent attorney would expect to encounter in dealing with clients and the relevant Patent Offices.

A detailed knowledge of forms and fees is not required.

Candidates will be required to demonstrate a detailed knowledge of the law and practice of Australia and the manner in which it is distinguished from the law and practice of New Zealand.

Candidates should be able to prepare claims which will be acceptable in the countries concerned or pursuant to the Treaty or Convention but will not be called upon to draft specifications. A candidate may however be required to discuss the actual form of the specification in so far as it differs from a New Zealand specification.

Candidates should be aware of any other international arrangements which could have a bearing upon where a New Zealand applicant should file overseas applications.

Candidates will be expected to answer questions showing a knowledge of recent amendments to USA and Australia legislation, including any applicable transitional provisions.

## Source Material

- The Acts and Regulations of the specified countries
- The Treaty and Conventions (EPC, PCT, Paris Convention)

## Reference Books

- World Patent Law and Practice – Baxter
- Manual for the handling of applications for Patents, Designs and Trade Marks throughout the world – Octrooibureau Los en Stigter - now available from Kluwer Law International and available online at [www.kluwermanualip.com](http://www.kluwermanualip.com)
- Patents Throughout the World – Jacobs
- Manual on Industrial Property all over the World – Katzarov
- PCT Applicants Guide – WIPO
- Patent Trademark and Copyright Laws – Samuels
- Canadian Patent Act Annotated – Barrigar
- European Patents Handbook – CIPA
- CIPA Guide to the Patents Acts
- Intellectual Property: The New Law – Flint
- Encyclopedia of United Kingdom and European Patent Law
- Japanese Patent Law – Tanabe and Wegner, 1979 AIPPI
- Australian Industrial and Intellectual Property – CCH
- Intellectual Property in Australia, Patents, Designs and Trade Marks Law – Butterworths

## Regulation 158(1)(d)

### The preparation of specifications for New Zealand Patents

**Note:** To be eligible the candidate must have already passed "The New Zealand Law and Practice relating to Patents and Designs".

The candidate will be required to prepare a complete patent specification based upon full technical details of the invention and a statement of the prior art.

The examination question will test the knowledge of the candidate as to the form and function of the complete specification and to demonstrate a competence in understanding technical information both in the form of a written description and drawings.

## Reference Books

- Terrell on the Law of Patents
- Patents for Inventions – T A Blanco-White
- Patent Claim Drafting and Interpretation – Kemp
- Fundamentals of Patent Drafting - Cole
- Patent Law of the United Kingdom by the Chartered Institute of Patent Agents (1949 Act) – Sweet & Maxwell 1975 (with 5th cumulative supplement)
- CIPA Guide to the Patents Act

## **Regulation 158(1)(e)**

### **Patent attorney practice in New Zealand**

**Note:** To be eligible the candidate must have already passed “The New Zealand Law and Practice Relating to Patents and Designs”.

The subject is intended to be the final test of a candidate’s ability to practice before the public and a good understanding of all aspects of New Zealand patent attorney practice is the primary requirement.

Candidates should be familiar with the following Acts and Regulations:

- Patents Act 1953
- Patents Regulations 1954
- Patents (Patent Cooperation Treaty) Regulations 1992
- Designs Act 1953
- Designs Regulations 1954
- Copyright Act 1994
- Fair Trading Act 1986
- Trade Marks Act 2002
- Trade Marks Regulations 2003
- Patents, Designs and Trade Marks Convention Order 2012
- Commerce Act 1986
- Flags, Emblems and Names Protection Act 1981
- Plant Variety Rights Act 1987
- Layout Designs Act 1994
- Geographical Indications (Wine and Spirits) Registration Act 2006
- Major Events Management Act 2007
- All amendments of each of the above in force at the date of the examinations

The Copyright, Fair Trading, Commerce, Plant Variety Rights and Layout Design Acts are included only in respect of their interface with intellectual property commonly handled by a New Zealand patent attorney.

Candidates should also be aware of any common law rights which may be relevant, particularly in the area of passing-off and confidential information.

The examination questions will test a combination of a candidate’s knowledge of the relevant legislation and the types of problems which a practising patent attorney would expect to encounter in dealing with clients and the Intellectual Property Office of New Zealand. The questions will however be directed primarily to the interpretation and criticism of patent specifications. In their answers candidates must also be able to demonstrate their knowledge of matters relating to:

- Practice before the Intellectual Property Office of New Zealand and the Courts in respect of patent applications and patents;
- The validity and infringement of patents; and
- The application of the various Acts and Regulations set out above.

### **Reference Books and Source Material**

- As specified in respect of papers (a), (b) and (d)
- Strategy in the Use of Intellectual Property – Momberg & Ashton