

2016 A1 examiner's comments

General

A number of people had clearly not read questions correctly. If there are multiple parts to a question answer these separately, do not combine parts. Marks are not awarded for off topic points, however correct they may be.

Question 1

Generally satisfactorily answered although a number of people did not know what the requirement for conciseness actually meant. Candidates were expected to refer to *Bancroft*.

Question 2

Not many people noted that a Convention application must be in English at filing. Part (c)(ii) required information about restoration of the right of priority and part (c)(iii) was about late entry into national phase.

Question 3

Although a few candidates answered this question very well, a number did not gain many marks. This question required knowledge of the 2013 Act provisions of infringement including the definition of infringement (s140 to 142) and the exceptions (s 143 to 146). Only one candidate noted that there is a presumption that a product is produced by infringing a patented process (s 142) and less than half of the candidates discussed the contributory infringement provision (s 141).

Question 4

Third party assertions can only be made before acceptance, so were not available in this scenario. In addition, the complete specification filing date was 30 October 2014, so this was a 2013 Act application. The priority date is irrelevant for determining this. Many candidates locked onto prior use without noting that the priority date was not known. This question required a discussion of the options under the Act and a recommendation for proceeding.

Question 5

Some candidates did not read the question properly. Candidates were told the patent was in force and that there were no grounds to challenge the validity of the patent. Candidates were expected to discuss compulsory licences, particularly the grounds, process and timing therefor. Note that the application is to the Court, not IPONZ.

Question 6

Many candidates did not read this question correctly and answered on the basis that the priority document (the German patent application) was the citation (which was simply stated to be “a patent document”). Part (a) required a discussion of the criteria from s 8(2)(a) to (c). Only one candidate actually set out these criteria. The citation is relevant for novelty only (see s 8(2)). A surprising number of candidates did not know the corresponding 1953 Act provision (s 14 prior claiming). Most candidates missed the point of part (c), which was that the further embodiments may affect the priority date of the NZ application and possibly make the citation relevant under s (8)(1).

Question 7

This question was generally well answered. Note that methods of diagnosis are only excluded if practiced on a human (part (a)). Only three candidates mentioned that a recombinant / genetically modified plant may be patentable (part (c)). Many candidates missed the lack of utility in the invention described in (g). Very few candidates mentioned morality as possibly excluding the invention in (i).

Question 8

Again – read the question. Steve filed the application and so the discussion in part (b) should have been about the disclosure in the magazine (which would have been relevant for both novelty and inventive step if published before the priority date) being disregarded if there had been a breach of confidence (s 9). Part (c) was generally answered well. This is a possible public disclosure with potential for the reasonable trial grace period. In addition, there was a question over whether the disclosure was enabling.

Question 9

It was apparent from this question that the answer to parts (a) and (b) required reference to the 1953 Act provisions. A number of candidates suggested filing a divisional application – this is not possible after acceptance. Part (c) required recognition that the transitional provisions apply and therefore so do the corresponding 2013 Act provisions for the amendment.