

## **Examiner's comments 2016 – Paper E**

This year's examination paper was slightly different from previous years. It had a reasonably detailed fact situation involving a number of different parties including individuals as well as companies associated with those individuals.

Those candidates who took the time to understand the relationships between the parties and to recognise that the commercialisation agreement was between the individuals and not their companies, as well as setting out a timeline, seemed to do better in their answers. They had a better understanding of the inter-relationship between the parties and what had occurred between them in the ZORB business.

Candidates can usually assume that if the question provides information as to the existence or otherwise of agreements or IP applications/registrations, they will be relevant to your answers. The lapsing of the registered design for the ZORB II product was a classic example given the significant workaround to copyright infringement that creates in relation to the ZORB II product, as was the statement that the ORB was essentially identical to the ZORB I and ZORB II.

Like most years, the most significant issues were:

1. a failure to identify and discuss the key claim construction issues
2. the obviousness analysis, including discussing the dependent claims. Only five claims required analysis in this year's exam so there was no reason for candidates not to discuss all of the claims, both from an infringement and validity point of view. The prior art was relatively straightforward and two of the prior art documents could almost immediately be dismissed as irrelevant.

Again, those candidates who took the time to prepare claim charts with both an infringement and validity analysis seemed to do better. It certainly seems to pay off timewise in the end because a candidate can refer to the table in their analysis and focus on the key points in their discussion, rather than providing a lengthy and detailed narrative of every point they want to make.

Not every feature of the claims needed to be construed in detail yet a large number of candidates did just that. You should, after reading all of the materials (and that is what the reading time is for) identify the key construction/infringement/validity issues and then focus on those.

In relation to the patent infringement/validity issues, the examiner was looking for detailed analysis and reasoning rather than the correctness of the answer itself – because sometimes the answer is not always clear – in many cases it will be a matter of evidence from suitably qualified experts against the background of the relevant common general knowledge. Those candidates who did well identified and analysed the issues in appropriate detail giving reasons for (and sometimes reasons against) their answer.

As in previous years, a number of candidates just stated that a dependent claim was novel and inventive because the independent claim was or that a dependent claim wasn't infringed because the independent claim wasn't infringed, without any analysis of the dependent claims. Each claim must be analysed and discussed.

This year there were a significant number of marks for identifying/answering issues outside of the core infringement/validity analysis including:

1. whether co-owners can infringe;

2. whether a co-owner can grant a valid license or not; and
3. who could pursue a challenge to the New Zealand patent and the available grounds for doing so.

There were also a significant number of marks available for identifying what other investigations could be made, actions taken or other advice you would provide your client in question 3. Like other years, it was clear that many candidates didn't manage their time well and missed getting to, or having sufficient time to adequately answer, question 3. A number of candidates who were clearly on track based on their answers to questions 1 and 2 missed out because they didn't have enough time to provide sufficient answers to question 3.

This year's paper, possibly more so than other years, was designed to test the breadth of candidates' knowledge of the type of practical issues you are likely to encounter in everyday practice as a patent attorney. Possible misuse of confidential information, breach of contract, possible trade mark advice, the interplay between designs and copyright, and a good working knowledge of the Patents Act, were all tested.

Simply being able to deal with infringement/validity analysis is not enough for this subject.

Candidates should understand the issues that can be examined in this paper, and ask experienced practitioners for guidance and to review candidates' answers to practice papers, to assist in identifying relevant issues, and then analysing and answering them from a practical point of view. Candidates should also do practice papers in exam conditions - sitting practice papers in 4 hours will help with time management during the actual examination.