

2017

PATENT ATTORNEYS

EXAMINATION

PAPER A1

**The New Zealand Law and Practice
relating to Patents and Designs**

Regulation 158(1)(a)

Duration: 3 hours (plus 10 minutes for reading)

Question 1 (8 marks)

Discuss the requirements and any practice considerations, including any deadlines, for establishing an earlier filing date than the actual filing date for divisional applications under the Patents Act 1953 and Patents Act 2013. **(8 marks)**

Question 2 (10 marks)

Your client Randall is the managing director of Appliware Incorporated, a company that holds a granted patent for a process for manufacturing eyeglass lenses. The patent was granted under the Patents Act 2013 in September 2016 and has 18 years of its term left. Randall comes to you to discuss a new development in the manufacturing process. He tells you that they have made a modification to the process that improves the finish on the manufactured lens. Randall tells you that he can't believe they didn't think of the modification earlier as it is an obvious improvement to the patented process. Randall wants to know if there is any way to protect the modification. Advise Randall of the options, requirements and the term of protection that could be obtained, explaining the advantages and disadvantages of each. **(10 marks)**

Question 3 (10 marks)

You receive a first examination report in which the examiner objects that the invention as claimed does not involve an inventive step, being obvious to a person skilled in the art having regard to a single document.

- (a) Discuss what “inventive step” means with reference to the Patents Act 2013 and relevant case law. **(5 marks)**
- (b) After responding to the first examination report, a second examination report issues. In the second examination report, the examiner states that the invention of at least claim 1 lacks novelty and/or an inventive step over a combination of two documents. Discuss the objections and how they may be overcome. **(5 marks)**

Question 4 (10 marks)

You act for McMurtle Enterprises, a company that manufactures capsules for coffee machines. McMurtle Enterprises holds many patents for various capsules and manufacturing methods. Its record keeping is not the best, and the owner Sue McMurtle has come to you in distress as she has just realised that their New Zealand patent no. NZ123456 for a method of manufacturing a capsule has lapsed because the last renewal fee due was not paid. Sue intended to pay the fee, but the renewals reminder got lost in the company’s records.

- (a) Advise Sue of any action that she can take with respect to this situation. Note any further information you may need and explain the process to be followed. **(4 marks)**
- (b) Sue now tells you that she has become aware that Caffeine Turtle, a competitor company, adapted some of its production machinery based on the disclosure of NZ123456 and that the capsules produced by Caffeine Turtle are identical to those described in NZ123456 as resulting from the claimed process. Sue wants to know if anything can be done to stop Caffeine Turtle selling the competing capsules. Assume that the approach taken in (a) was successful. **(6 marks)**

Question 5 (12 marks)

Your client, Richie Parrott, meets with you to discuss his latest development, a new car jack. He informs you that he is in the process of setting up a production line and wants to obtain protection for his product. You conduct a search and identify NZ patent application 654321 in the name of Car Jack Limited which was filed on 4 September 2016 and has a priority date of 9 September 2015. The claims of NZ654321 currently on file read on Richie's product and you inform him of this. You also inform Richie of PCT publication no. WO2014/98760 (D1) which was published before the priority date of NZ654321 but which did not enter the national phase in New Zealand. D1 discloses all features claimed in NZ654321 except a preferred mechanism that may be included to ease lowering of the jack.

Richie goes away to review D1 and NZ654321 and returns a few days later. Richie informs you that, from his own investigations, car jacks according to NZ654321 were sold in Australia about 6 months after the priority date of D1. Further, the car jacks that were sold included a lowering mechanism similar to that described and claimed in NZ654321. Richie accepts that he will not be able to obtain patent protection for his car jack but in view of the investment to date in his production line, he wants to be able to sell his car jacks, if possible.

Propose a strategy for Richie that will provide him with freedom to market his car jacks, comparing alternative options, the pros and cons of each and outline the process for your preferred approach. Ideally, Richie would prefer to include the improved lowering mechanism. **(12 marks)**

Question 6 (10 marks)

You receive an enquiry from a Chinese patent attorney regarding filing of patent applications in New Zealand.

- (a) The attorney asks you about deadlines and filing requirements for a Chinese-language PCT application that is to enter the national phase in New Zealand. The PCT application has a priority date of 14 April 2015. Advise the agent. **(3 marks)**
- (b) The attorney asks you about deadlines and filing requirements to file a patent application in New Zealand claiming priority to a Chinese application which was filed on 10 July 2016. Provide the requested information. **(4 marks)**
- (c) After receiving your response to part (b), the attorney asks about the next steps once a Convention application has been filed. Inform the agent of the steps between filing and acceptance including any relevant deadlines. **(3 marks)**

Question 7 (15 marks)

Provide a brief discussion of each of the following:

- (a) Who is entitled to be granted a patent under the Patents Act 2013, when do details of entitlement need to be provided and what are the consequences (if any) of not providing this information. **(3 marks)**
- (b) What is a lack of unity of invention objection and what are the options and deadlines for addressing such an objection? **(3 marks)**
- (c) Discuss selection inventions with reference to relevant case law. **(5 marks)**
- (d) Who may bring patent infringement proceedings and when can they do so? **(4 marks)**

Question 8 (11 marks)

- (a) You are handling a New Zealand patent application that is a national phase entry of a PCT application claiming priority from a US patent application. The US attorney who instructed the filing informs you that it has just been discovered that two inventors were inadvertently omitted from the PCT application. No changes have been recorded during the international stage but the additional inventors were named for the US priority application and corresponding standard US application. The US attorney sends you a copy of the documents filed for the US applications and wants to know if the additional inventors can be added for the New Zealand application. Advise the US attorney including information about the requirements and process before the Intellectual Property Office of New Zealand. Identify if you need any additional information or documents. **(5 marks)**
- (b) The US attorney contacts you about another New Zealand patent application you are handling for her. The application is proceeding under the Patents Act 2013 and examination has not yet been requested. She says that there are several errors in the complete specification that was filed in New Zealand. One of the drawings was missing completely and some of the references in the drawings do not correspond to the references in the description. Advise the US attorney what can be done to remedy the situation. **(4 marks)**
- (c) How would your answer to (b) change if the patent had been accepted? **(2 marks)**

Question 9 (14 marks)

Brothers Bob and Steve Smith come to you regarding NZ patent 545671. The patent was granted 2 years ago and has 15 years of its term remaining, assuming all renewal fees are paid. Bob and Steve are named as owners and inventors of the patent.

Bob and Steve inform you that Mark Brown, Bob and Steve's brother-in-law, is also named as an inventor and owner of the patent but comment that marketing of the invention described and claimed in the patent has been difficult in recent times following Mark's separation from Bob and Steve's sister.

Bob and Steve are eager to establish a production line to make articles according to the invention. Mark is aware of this and has threatened Bob and Steve saying that if Bob and Steve proceed, he will obtain an injunction and close down their factory. He further says he will seek monetary compensation.

Bob and Steve have approached Mark with a view to buying him out of the patent but Mark's demands are completely unrealistic.

Bob and Steve have also considered selling the patent to a third party and while one company was interested and put forward a reasonable offer in Bob and Steve's view, Mark would not agree to the sale.

During further discussions with Bob, it becomes apparent that Mark may in fact have been incorrectly listed as an inventor. Bob mentions that he and Steve developed the core concepts and sought help from Mark to fund the patent application process and help take a product to market. At the time of filing the application, Bob says that the patent attorney they used just assumed all three of Bob, Steve and Mark were inventors and that this did not become apparent until after the application was filed. While Bob noticed the error, he said that he assumed it would be of little consequence and he did not want to upset Mark in fear of funding being cut.

Advise Bob and Steve of their rights and Mark's rights in the patent and what, if any, action can be taken to improve the situation. Also advise on any concerns around the inventorship issue and what can be done to remedy it. **(14 marks)**