

2019

PATENT ATTORNEYS

EXAMINATION

PAPER C

Foreign Patent Law

Regulation 158 (1) (c)

Duration: 3 hours (plus 10 minutes for reading)

Question 1**(6 marks total)**

Your client has a pending PCT application filed on 11 February 2018 which claims priority from a New Zealand patent application filed on 13 February 2017. Your client wishes to enter the PCT application into the national or regional phase in Canada, China, the European Patent Office, Japan, Singapore and Taiwan.

- (a) Excluding any extension of time, what is the due date for filing each national or regional phase application?

(3 marks)

- (b) Including any extension of time, what is the final date on which each national or regional phase application could be filed?

(3 marks)**Question 2****(9 marks total)**

Your client has received an Office Action for its US patent application. The Office Action is marked 'Final'. Explain what this means and the options available to keep patent protection pending in the US without any loss of rights. Include any time limits, with any available extensions, that your client has to meet.

Question 3**(5 marks total)**

Your New Zealand based client plans to secure patent protection in Hong Kong based upon either a pending European patent application designating the United Kingdom or a Chinese patent application. Advise your client on what is involved in securing patent protection in Hong Kong and outline any issues with registering the European patent application or the Chinese patent application.

Question 4**(17 marks total)**

Your European associate has advised that she has received a Communication under Rule 71(3) indicating that your client's European patent application designating the United Kingdom, France, Germany and Italy is acceptable with several amendments made by the examiner to the text intended for grant. The Communication was issued by the European Patent Office dated 1 June 2019 and the specification contains 15 claims and 35 pages. The European patent application was filed on 27 July 2015 and claims priority from a New Zealand patent application filed on 30 July 2014.

- (a) Advise your client on the options for responding to the Communication together with associated deadlines and costs.

(8.5 marks)

- (b) Your client wishes to delay the grant of the accepted European patent application for as long as possible in the hope of taking advantage of the unitary patent system. Explain the mechanisms by which it is possible to delay grant of the European patent as well as any associated costs and deadlines.

(8.5 marks)

Question 5**(16 marks total)**

You are a New Zealand based patent attorney and have been approached by a visiting Australian tourist who has asked you to assist him with protecting his invention internationally.

(a) Advise your client on possible filing strategies, including where patent applications could be filed.

(5.5 marks)

(b) Your client decides that he wants a PCT application to be filed this week since he will be disclosing the invention to potential investors early next week. However, he does not currently have the funds available. What implications does this have for the PCT application?

(3 marks)

(c) Explain to your client the PCT process post filing and any key deadlines. Do not explain procedures post national phase entry.

(7.5 marks)**Question 6****(8 marks total)**

Your client, a large Japanese corporation, has recently learned of the possibility that an Australian competitor might be about to launch an allegedly infringing product in Australia. The Japanese corporation has a pending Australian patent application that has not yet been examined and has sought your advice on what options are available to it to obtain a granted patent in Australia. Discuss the advantages and disadvantages of each of the options that are available to your client before IP Australia.

Question 7**(5 marks total)**

Your client recently purchased an unexamined Australian standard patent application, a granted Australian innovation patent and a granted US patent. All three have the same filing date, namely, 20 July 2016. The Australian innovation patent was granted on 4 August 2016 and the US patent was granted on 14 March 2017.

(a) For each patent or patent application, advise your client of the final due dates for payment of the renewal/maintenance fees (without incurring a late fee for any available extension) for the maximum, unextended term of each patent or patent application.

(3.5 marks)

(b) For each patent or patent application, advise your client of the final due date for payment of the next renewal/maintenance fee including any available extension. Assume that any renewal/maintenance fees due to date have been paid.

(1.5 marks)

Question 8**(8 marks total)**

You forwarded your client (MyBad Ltd) examination reports for its Australian and United States patent applications. However, despite email reminders and a telephone call to the secretary of MyBad Ltd, your client does not give you instructions and both applications are marked-off as abandoned. In the telephone call you learnt that the secretary had received your email reminders but believed they were a scam as she had received scam renewal reminders in the past. Your telephone call with the secretary was not acted upon because it happened on the day before she got married and she forgot to mention it to her boss.

You report the abandonment of the applications to your client who is horrified by the events and asks if the applications can be revived.

- (a) What options are available to revive each application and what additional information will you need from your client?

(4 marks)

- (b) It's a year later and MyBad Ltd has again failed to provide instructions, this time for a response due, last month, to an extended European search report for a European patent application. What are your client's options and what further information, if any, will you require?

(4 marks)**Question 9****(20 marks total)**

Your client (company A) is a New Zealand motor manufacturer which works with another New Zealand motor manufacturer (company B) on joint projects. Company B filed a PCT application for a motor which was published last week by WIPO. Company A considers that the motor claimed by the PCT application lacks novelty and is obvious over prior art. Company A wants to prevent company B from obtaining a patent for the motor claimed in the PCT application but "wishes to do so anonymously" as it does not wish to jeopardise its relationship with company B.

- (a) Advise company A on its options, if any, regarding the PCT application during the international phase.

(2 marks)

- (b) The relationship has broken down and company A no longer needs to be anonymous. The PCT application has entered the national or regional phase in Australia, Brazil, Canada, China, the European Patent Office, India, Japan, Korea, Singapore, and the United States. For each country or region, state what mechanisms exist to challenge the patent application in the relevant Patent Office before and after grant.

(10 marks)

- (c) Your client is particularly concerned about the possibility of a patent for the motor being granted in Australia. You check and find that an Australian application for the motor was published at acceptance on 6 May 2019. Advise your client on the grounds available to challenge it and the basic steps involved in an opposition.

(8 marks)

Question 10

(6 marks total)

Your client is interested in requesting the re-examination of a granted Australian standard patent.

(a) Explain to your client who can request re-examination in Australia and the grounds of re-examination.

(4 marks)

(b) During the re-examination, the patentee wishes to make amendments to the specification. Explain to your client the requirements and process for making the amendments and how this compares with the law in New Zealand.

(2 marks)