

2016

PATENT ATTORNEYS

EXAMINATION

PAPER A2

The New Zealand Law and Practice relating to Patents and
Designs

Regulation 158 (1) (a)

Duration: 3 hours (plus 10 minutes for reading)

1. Outline with reference to the relevant parts of the Patents Act 2013 (“the 2013 Act”) and the Patents Regulations 2014 (“the 2014 Regulations”):
 - a. The extensions of time that are available in ‘proceedings’ before the Commissioner (“proceedings”) under the 2013 Act. In particular outline what deadlines may and may not be extendible, the length of any extension that might be available, and the circumstances in which any available extension may be granted. **(5 marks)**
 - b. The provisions for halting a proceeding under the 2013 Act. **(2 marks)**
 - c. The provisions regarding hearings before the Commissioner under the 2013 Act. **(2 Marks)**
 - d. The provisions regarding how the Commissioner may give directions in proceedings including what the Commissioner may direct a party to do, on whose initiative a direction may be given, whether a party has to comply with such a direction, and what the effect of non-compliance might be. **(4 Marks)**

(13 marks)

2. You receive an enquiry from an overseas patent attorney enclosing documents relating to a new chocolate bar product which is being manufactured and tested in France. The overseas patent attorney encloses the following:
- i. One page of hand sketched drawings of the product, as per Attachment A; and
 - ii. One page of CAD type drawings of the product, as per Attachment B.

The overseas patent attorney has a number of questions about protecting the appearance of the product in New Zealand. Please answer each question, providing reasons and referring to case law and/or legislation where appropriate:

- a. What protection is available for the appearance of the product in New Zealand? **(2 marks)**
- b. Whilst the primary product is a chocolate bar, we would like to cover other food products that might have the same or a similar appearance. Is this possible? Why/why not? **(2 marks)**
- c. Please draft a statement of novelty for our review. **(2 marks)**
- d. Are the enclosed drawings suitable for filing in New Zealand? Are there any particular considerations or issues that we should bear in mind with the hand sketched drawings and the CAD drawings supplied? **(5 marks)**
- e. Please explain what drawings you recommend filing, and why, and advise whether any additional drawings are required and why. **(3 marks)**
- f. Please outline any other issues or concerns you might have in respect of protecting the product via the registered design system in New Zealand. **(3 marks)**

(17 marks)

3. On 1 January 2015 your client filed a patent application accompanied by a provisional specification ("first provisional") in New Zealand for a widget made of aluminium. Ten months later on 1 October 2015 your client filed a further patent application accompanied by a provisional specification ("second provisional") in New Zealand with disclosure to a widget made of any metal, and to a widget made specifically of steel. The first and second provisional applications were cognated and a single complete specification was filed on 1 December 2015 containing all of the disclosure of the first and second provisional applications, claims to the widget made of aluminium, and further claims to the widget made of steel. During examination of the complete specification a non-unity of invention objection was raised and the claims were amended to be directed solely to the widget made of aluminium. These claims have been granted.

When responding to the examination report, a divisional application was also filed. The divisional application included all of the subject matter of the complete specification of the parent application.

Your client would like to pursue claims in the divisional application to:

- (a) the widget made of steel; and
- (b) the widget made of any metal.

Advise your client on whether it is possible to protect claim sets (a) and (b) in the divisional application. In particular, comment on what priority date each of claim sets (a) and (b) would be entitled to under the 2013 Act, and whether each of claim sets (a) and (b) would be considered novel under the 2013 Act. Assume that no prior art has been cited by IPONZ during examination.

(5 marks)

4. Outline with reference to the relevant parts of the Patents Act 1953 (“the 1953 Act”), the Patents Act 2013 (“the 2013 Act”), the Patents Regulations 1954 (“the 1954 Regulations”) and the Patents Regulations 2014 (“the 2014 Regulations”), and relevant case law:

- a) How ‘fair basis’ of claims is determined under the 1953 Act. **(3 marks)**
- b) The requirements for the contents of a complete specification under the 2013 Act. **(2 marks)**
- c) How a complete specification of a patent application or patent should ‘support’ the claims under the 2013 Act. **(3 marks)**
- d) What is the purpose of the claims in a complete specification? **(2 marks)**
- e) What are the formal requirements for patent claims in New Zealand? What sorts of objections can an examiner raise against a claim set? (There are no marks available for discussing patentability/excluded subject matter type issues). **(3 marks)**

(13 marks)

5. Advise whether the following can be protected under the New Zealand Designs Act 1953 and also whether the following would be subject to copyright protection under the New Zealand Copyright Act 1994:
- a. A bumper for a motor vehicle. **(2.5 marks)**
 - b. The home page of a website. **(4 marks)**
 - c. A drink bottle with ribs on its side surfaces that help prevent the bottle from collapsing or being crushed. **(2.5 marks)**
 - d. A distinctive image of an animal intended to be used on clothing. **(3.5 marks)**
 - e. A fence post with a z-shaped profile that improves the strength of the post. **(2.5 marks)**

(15 marks)

6. Your client writes to you saying that she has devised what she believes is a new and clever way of locking and unlocking storage units electronically, using a smartphone app she has devised. Your client explains that, as you would expect, the security of her facility is very important, and that she has devised a complex set of control algorithms used by the app and a server with which the app communicates to remotely lock and unlock one or more storage units as required.

Your client says that she has read a lot of articles in the press which state that computer programs are not patentable. However, before she launches her new system she thought she would seek some advice.

Please answer the following questions that your client has:

- a) Are computer programs excluded inventions under the Patents Act 2013? **(3 marks)**
- b) Is any patent protection available for her electronic locking system? Assume that your client is the sole inventor, and that the system is new. **(4 marks)**
- c) IPONZ applies five 'signposts' in assessing computer program inventions under section 11 of the Patents Act 2013. What are these five signposts? **(5 marks)**

Your client tells you she is also working on a system for storing electronic data files on a bank of memory servers that she uses. One of her customers mentioned that it would be useful to them to have an independently run system for them to store important electronic files remote from their own IT system. Consequently she is proposing to rent out electronic memory space on her servers, with access to those servers being gained using a similar app which uses similar control algorithms.

Please answer the following further question that your client has:

- d) Do you think she can obtain patent protection for this electronic storage system? Why/why not? **(3 marks)**

(15 marks)

7. You receive an enquiry from a Japanese associate regarding registered design protection in New Zealand as follows:

“Dear Sirs. We have, five months ago, filed a registered design application in Japan relating to a new train carriage. The Japanese application has not yet been published. The Japanese application includes seven different designs, each relating to a particular feature of the new train carriage. Our client would like to file a design application in New Zealand. Before we instruct you we have the following questions:

- a) When will a registered design application in New Zealand ordinarily be published? **(3 Marks)**
- b) Some of the designs include perspective views which show the appearance of the entire carriage for reference. Because of the length of time taken to launch this type of product, it is not uncommon for the design to change before launch, in which case we might not want the appearance of the entire carriage to be publically available. If we delete some of the representations during examination, will the originally filed representations be published? **(2 Marks)**
- c) Does a certified copy of the Japanese application need to be filed, and if so, when? Will the contents of that Japanese application (which will of course include the reference views of the entire carriage as above) also be published? **(2 Marks)**
- d) Any changes that might be made to the appearance of the entire carriage as above are likely to be relatively minor. If such changes are made, would we have to abandon any existing application and/or file a new application? **(3 Marks)**
- e) Is it possible to include more than one design in a single design application in New Zealand? What filing deadline(s) will apply? **(4 Marks)**

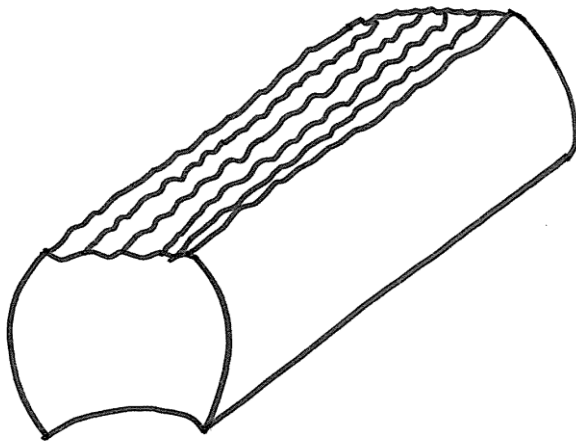
(14 Marks)

8.

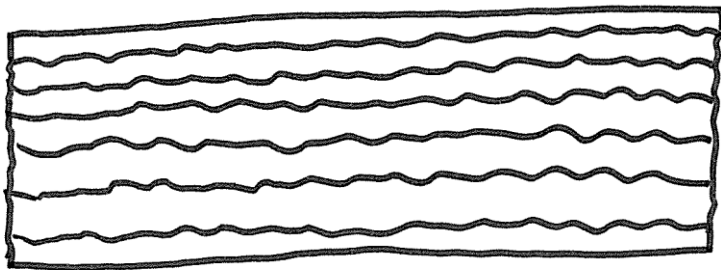
- a. Outline the provisions for restoration of a lapsed patent under the Patents Act 2013. Include details of any applicable time limits, reasons required, and the main procedural steps and their deadlines. **(3 marks)**
- b. Outline the provisions for protection of persons who avail themselves of an invention if the Commissioner restores a lapsed patent which protects that invention. **(3 marks)**
- c. Outline the provisions for restoration of a lapsed design under the Designs Act 1953. Include details of any applicable time limits, reasons required, and the main procedural steps and their deadlines. **(2 marks)**

(8 Marks)

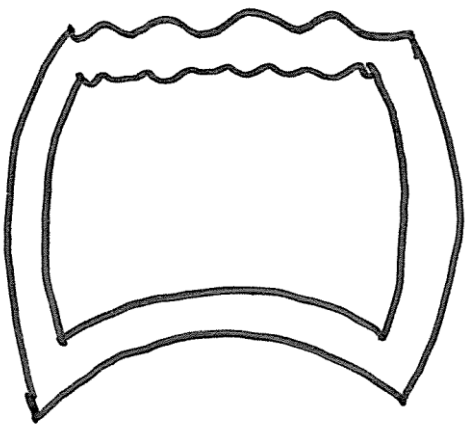
Attachment A



Perspective View



Plan View



Transverse Sectional View

Attachment B

