

**2015**

**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 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”):
  - a. How a third party can attack a patent granted under the 2013 Act. Your answer should list the possible grounds for attack and explain when such attacks may be filed. **(9 marks)**
  - b. The patent opposition processes under the 1953 and 2013 Acts. Your answer should explain the nature and timing of key steps, any extensions of time that may be available, and when a halt in proceedings can be obtained. You do not need to list the grounds of opposition. **(10 marks)**

2. You receive an enquiry from an overseas agent enclosing European Community Registered Design No. 123456 filed 1 February 2015. The registered design relates to a car and has drawings which show the following new aspects:
- i. Front view of headlight;
  - ii. Front and perspective views of bumper;
  - iii. Side view of an alloy wheel;
  - iv. Front and perspective views of the forward part of the car (ie front bumper, bonnet, front wheel and windscreen);
  - v. Side view of a front door with window frame; and
  - vi. Seven views (the maximum allowed in Europe) of an entire car some (but not all) of which are CAD (computer aided design) type drawings including rendering/shading. The remainder are line drawings.

The overseas agent has a number of enquiries about design law in New Zealand. Please answer each enquiry, providing reasons and referring to case law and/or legislation where appropriate:

- a. Would any of the above aspects of the car potentially be excluded from registered design protection in New Zealand? **(2 marks)**
- b. Our client wants to protect all of the aspects shown in the drawings. Our client would like a cost effective strategy, but does not need to delay costs. Advise on how you would protect each of the aspects (i) to (vi) above. **(5 marks)**
- c. European Community Registered Design No. 123456 has not yet been published. Our client is keen to ensure that details of the design be kept confidential for as long as possible. Please advise whether and, if so, how we can achieve this in New Zealand and for how long. **(2 marks)**
- d. What are the general requirements for representations suitable for filing in New Zealand? Are there any particular considerations that we should bear in mind with the CAD representations supplied? **(3 marks)**
- e. Our client is concerned that there may have been a public disclosure of parts of the car in question on 15 January 2015. How does this affect our client's position in New Zealand? **(4 marks)**
- f. Our client has become aware of a competitor in New Zealand who is offering a vehicle alloy wheel on Trade Me that looks very similar to the alloy wheel included in its European Community Registered Design No. 123456. Please advise whether it can take action against the competitor, when it can write to the competitor and on what basis, what liability the competitor has to our client, and what risks to our client there may be in writing to the competitor. **(8 marks)**

3. You are approached by a Japanese company which has filed a Japanese Patent Application on 1 June 2015. The Patent Application relates to a commercial wind turbine having a potentially novel and inventive blade design. The blade is designed to withstand very high peak wind speed, and to withstand very strong gusts of wind, whilst also providing good efficiency in low winds. The wind turbine is of the commercial type comprising a tower at least 30m tall and is not suitable for micro-generation on a domestic house or the like.

As part of their instructions, the Japanese company mentions that their wind turbine was tested on 1 March 2015. The testing took place at a site in Japan which could be viewed from nearby roads and which was often subject to relatively high peak wind speed.

The Japanese company would like to seek patent protection in New Zealand.

Please prepare a note of advice to the Japanese company advising whether a valid patent can be obtained in New Zealand, the options for doing so, and any issues that may arise from the above fact scenario. Refer to relevant case law and/or legislation where appropriate. **(11 marks)**

4. Your client approaches you concerning a granted patent she has, New Zealand Letters Patent No. 123456, which entered national phase on 20 September 2012 from a PCT application with an International filing date of 23 March 2011. The patent was granted in New Zealand on 30 September 2014 with claims directed to a stapler with a handle mechanism that exerts a greater force on the staple than prior art staplers.

Your client has become aware that a local supermarket is selling a handle mechanism that is the same as the one described in her patent. The handle mechanism is being sold as an accessory to third party staplers to improve their operation. On investigation it appears that the handle mechanism has been on sale for 9 months. Your client is quite upset about this, as she has not yet put her stapler into production and had planned to launch it in New Zealand in a few weeks' time.

Your client has heard about a change in patent law that took place last year which may give her extra rights and wonders how this might affect her position since she is keen to do something about the rival handle mechanism.

Advise your client as follows:

- a) how the infringement provisions of the 2013 Act and/or the 1953 Act apply; **(2 marks)**
- b) compare and contrast what rights she has under each Act; **(4 marks)**
- c) whether the 2013 Act does indeed give her more rights than the 1953 Act and, if so, how; **(1 mark)** and
- d) on any risks there may be in alleging patent infringement now. **(2 marks)**

- 5.
- a. Advise whether the following can be protected under the New Zealand Designs Act 1953 and, if so, how:
    - i. An icon to be presented on the GUI (Graphic User Interface) of a smartphone; **(2 marks)**
    - ii. A new on/off switch for a chainsaw; **(2 marks)**
    - iii. A computer tablet having a screen which has a different size and proportions to known tablets; **(2 marks)**
    - iv. A replacement exhaust silencer for a motorbike. **(2 marks)**
  - b. On what grounds may a registered design in New Zealand be attacked? Briefly summarise the procedure for doing so before IPONZ referring to legislation where appropriate. **(3 marks)**

6. You receive instructions from an overseas agent to file a registered design application in New Zealand claiming priority from a US design patent application filed 1 February 2015.

The US design patent application is for a vase and includes the following views:

- front view;
- right hand side view;
- top view; and
- a perspective view from the front, one side and below.

The front view includes a logo of a flower which appears to be part of the wall of the vase. All of the views are computer rendered showing shading and contours.

The instructions mention that the vase has been sold in the USA from May 2015. The overseas agent asks you to obtain the broadest possible protection for the vase in New Zealand and asks you **not** to include the logo of the flower if possible.

- a) Advise how to obtain the earliest and broadest possible protection for the vase in New Zealand and any issues that may arise through not including the logo of the flower; **(13 marks)**
- b) Prepare a draft statement of novelty assuming that, regardless of your advice in question 6(a), the agent does not wish to include the flower logo; **(2 marks)**
- c) Assume a design application is filed and registered for the vase but is subsequently held to be invalid. Advise the agent what (if any) other rights its client may have in the vase design in New Zealand and any limitations on those rights. **(3 marks)**

7. Advise whether the following acts would be an infringement of a granted patent in New Zealand under the 2013 Act, and the main factors to consider in each case:
- a. Use of an invention after the earliest possible priority date of the claims of a patent by someone who had also used the invention before the earliest possible priority date; **(3 marks)**
  - b. Supplying only 'B' where there are claims for a product limited to features 'A', 'B' and 'C'; **(2 marks)**
  - c. Use of a patented invention on an aircraft at Auckland airport; **(1 mark)**
  - d. Selling a product that could be made by a process claimed in the patent; **(1 mark)**
  - e. Use of a patented invention where the registered proprietor has failed to pay the renewal fee but applied for an extension to pay. **(1 mark)**

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