

2005

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 (10 marks)

A new client has a patent in New Zealand and the US for her invention. She also has a patent application in New Zealand and the US covering an improvement to the invention. She has asked you to check her portfolio because a competitor has just launched a competing product in New Zealand and she wishes to sue. She is anxious for you to write immediately to the competitor requesting that it ceases immediately or else proceedings for patent infringement will be commenced.

She provides you with a copy of all the files. The patents in New Zealand and the US were both granted on applications filed in 1999. You note that the scope of the broadest claim in the US is narrower than that of the broadest claim in New Zealand.

The New Zealand patent was granted in late 2004 with two claims (a broad claim 1 and a subsidiary claim 2), both of which cover the competing product. No citations were raised during examination.

The main claim of the US patent is narrower than claim 1, but broader than claim 2, of the New Zealand patent. This restriction occurred due to an amendment made in late 2003 during examination in the US following citation of US Patent "Z". The citation clearly anticipates claim 1 of the New Zealand patent, but not claim 2.

The New Zealand patent application for the improvement has just been accepted and published on 20 June 2005. The claims are not anticipated by US Patent "Z", and do cover the competing product.

Advise your client of what action she (or you on her behalf) should take in New Zealand. (10 marks)

Question 2 (30 marks)

Your client, Ms X, has a granted New Zealand patent (“Patent A”) having the following dates:

- | | | |
|-------|---|------------------|
| (i) | Application date (with provisional specification) | 8 June 2001 |
| (ii) | Complete specification filing date | 8 June 2002 |
| (iii) | Publication date | 13 July 2003 |
| (iv) | Grant date | 15 November 2003 |

Ms X has just become aware of the publication of acceptance of a New Zealand patent application (“Application B”) having the following dates:

- | | | |
|------|--|--------------|
| (v) | Priority date (US) (“US priority application”) | 9 June 2001 |
| (vi) | Application date (with complete specification in NZ) | 9 June 2002 |
| (vi) | Publication date | 14 June 2005 |

The two broadest claims of Patent A cover subject matter that is included within the two broadest claims of Application B. Each other claim in Application B is substantially identical with a claim in Patent A (the “identical claims”).

Patent A is very important to your client. She wants a report on her options.

- What documents do you need to obtain to provide this report? (2 marks)
- What action is possible to your client to prevent Application B proceeding to grant, and what ground or grounds are available to your client based on the above information? (2 marks)
- Under that ground or those grounds, what analysis is needed? (6 marks)
- In making that analysis, what legal test or tests need to be applied? Cite any applicable case law. (6 marks)

Upon further investigation of the circumstances, you find that the US priority application for Application B was a Continuation-In-Part (CIP) application of an earlier US application filed on 8 January 2001 (US Parent Patent).

You obtain a copy of the US Parent Patent and find that it includes claims which are identical to the “identical claims” in the complete specification for Application B. But you also find that the US priority application includes further subject matter and two claims to that further subject matter. These two claims are identical to the two broadest claims of Patent A.

- (e) What further ground or grounds would now be available to Ms X in any action available under part (b) above? Cite the legal test or tests of any relevant case law. (6 marks)
- (f) What remedies might the applicant for Application B have against any adverse finding on the ground or grounds available under (e) above? (3 marks)
- (g) Given the relevance of the US Parent Patent to Application B, discuss what remedies might have been available to the applicant for Application B before acceptance of Application B. (5 marks)

Question 3 (12 marks)

Discuss four of the five following terms with reference to any relevant case law:

- (i) notional addressee (3 marks)
- (ii) diligent searcher (3 marks)
- (iii) selection invention (3 marks)
- (iv) ex post facto analysis (3 marks)
- (v) inventive step lying in the idea (3 marks).

Question 4 (10 marks)

- (a) Who is entitled to apply for a patent in New Zealand? (4 marks)
- (b) When and why is a Declaration as to Inventorship required? (2 marks)
- (c) Your client, Big plc, a UK company, writes to you complaining that Mr Pierre Lyon, an employee of Henri SA, a French company, may well have misappropriated confidential information from Big when Mr Lyon visited Big’s premises in the UK. Big suspects that Henri SA has subsequently filed a New Zealand patent application. You check the IPONZ records and indeed find that a patent application in the name of Henri SA exists with Pierre Lyon named as inventor. Acceptance of the application was published on 15 April 2005. Today is 6 July 2005. Advise Big what it can do about Henri’s patent application. Refer to any applicable case law. (4 marks)

Question 5 (8 marks)

The Patents Regulations include provisions for protecting third parties who commence infringing activity at certain times after a patent lapses and before it is restored. Discuss the scope of the provisions in the Regulations relating to:

- (a) The time of commencement of such activity and the duration of the protection. (6 marks)
- (b) Any variation in the scope of such provisions in view of the nature of the subject matter covered by the claims of the patent. (2 marks)

Question 6 (12 marks)

Discuss the patentability of claims to the following with reference to any relevant case law:

- (a) A method of diagnosing a predisposition to eczema comprising shining light onto the skin of a patient and measuring the angle of the reflected light and comparing that angle with angles in a database taken from patients who were known to have later acquired eczema. (3 marks)
- (b) A mixture of a toxic (to humans) herbicide and a stenching (foul smelling) agent. (3 marks)
- (c) An ear tag having two numbers printed on its face, the first being of at least 7 digits (and being the number allocated by a database that is unique for that animal in New Zealand) and the second being of 2 to 4 digits which are enlarged and are selected by each individual farmer from the digits in the first number (the second enabling the farmer to visually distinguish each animal on a farm). (3 marks)
- (d) A method of wagering on a sporting event, wherein an investor selects a single digit number, and then invests on that number, the method further comprising computing in a predetermined way from the number of participants in the sporting event a total number having a plurality of digits, and comparing the last digit in that total number with the selected number to thereby decide the winning number for the investor. (3 marks)

Question 7 (10 marks)

- (a) Discuss the advantages and disadvantages (and time limits) of each of:
- (i) Opposing the grant of a patent under section 21,
 - (ii) Applying to the Commissioner for revocation (belated opposition) under section 42, and
 - (iii) Applying to the High Court for revocation under section 41. (6 marks)
- (b) Who may seek a declaration of non-infringement (and when)? Discuss the restrictions applicable when the Court considers such a declaration, and any other disadvantages to a person seeking the declaration. (4 marks)

Question 8 (8 marks)

On Friday 1 July 2005 you receive, by courier, a letter dated 22 June 2005 from a US agent containing instructions to file a convention application in New Zealand with a US convention date of 2 July 2004. The US agent is obviously inexperienced because the letter merely refers to the US convention application by date and number and does not include any other information or documents.

You send an urgent request to the US agent by both fax and email for further information and documents that you require.

- (a) List the information and documents (if any) that you require, besides the complete specification, to file a convention application. (2 marks)

On Monday 4 July 2005 you then receive a fax with an 18 page specification and 2 sheets of drawings, together with the information and documents that you requested. But unfortunately your fax machine malfunctioned and parts of the specification are barely legible, including parts of the single claim. You have an educated guess at the text of the barely legible parts but you are not confident that you have it correct.

The letter from the US agent does indicate that the invention is important particularly in New Zealand, and that the claim to convention priority is critical. You attempt to make contact by fax and email but because of the weekend in the US you do not succeed.

- (b) Discuss what action or actions would be required to best protect the applicant's rights in New Zealand, and what further documents or information (if any) would be needed. (3 marks)
- (c) You subsequently get a clean copy of the specification on 6 July 2005. Your educated guess at the barely legible text was not accurate. What action would you take now? (3 marks)