

EXAMINATION FOR REGISTRATION AS A PATENT ATTORNEY
OCTOBER 2001
Patent Law
Time allowed: 3 hours 30 minutes

Instructions to Candidates

1. Standard required to pass: 50%.
 2. Reading time: 10 minutes.
 3. Candidates should attempt ALL questions.
 4. The maximum marks for each question are indicated at the end of the question.
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1. Write explanatory notes on FIVE of the following:
 - (a) Priority date in the context of patent law.
 - (b) Advantages and disadvantages of modified examination compared with normal examination in the context of the Patents Act 1990.
 - (c) Sub-section 40(2)(a) of the Act requires the complete specification to describe the invention fully, including the best method known to the applicant of performing the invention. What is meant by the expression “to describe the invention fully” in this context?
 - (d) Compulsory licences in the context of the Patents Act 1990.
 - (e) The springboard doctrine in the law of confidential information.
 - (f) Crown use in the context of the Patents Act 1990.
 - (g) Selection inventions.

(15 marks)

 2. Comment on the patentability of each of the following referring to any relevant authorities, assuming that each is new, inventive, has utility and has not been secretly used:
 - (a) A surfboard painted on the bottom surface with the image of the head of a white pointer shark with open jaws. The surfboard is ignored by sharks.
 - (b) A floor mat for a car having an integrated miniature light located in the top surface of the mat which can be turned on for about 1 minute at a time by applying foot pressure to the front 10cm of the mat.
 - (c) A wooden office chair with a thermometer located in a recess in the top of the right arm rest.

- (d) A known paint, which is usually applied to a wall in two coats, where a wall painted with 4 coats of the paint is found to absorb 70% of sound directed at the wall (compared with 12% sound absorption for a wall painted with 2 coats of the paint).

(16 marks)

3. Your client, Novator, rings you and advises that he has read an article in the newspaper which briefly mentions that a new type of patent called an innovation patent is now available. Novator asks you to write him a letter summarising the main features of innovation patents and the innovation patent system including any pre- and post grant procedures that you consider to be relevant, and to contrast such features with those of a standard patent application/patent. Advise Novator.

(15 marks)

4. Your client, Synco, is the owner of in force Australian patent N having two claims. The first is composition claim A directed to a cosmetic composition comprising a synergistic mixture of enzyme E and olive oil O. The second is process claim B directed to a method of using the cosmetic composition of claim A to remove sunspots by topically applying it onto sunspots every day until the sunspots are removed. The ranges of amounts of E and O are specified in both claims. Synco sells the cosmetic composition with instructions to topically apply it onto sunspots as defined by the method claim B.

It has come to Synco's attention that its main competitor, Facepack, has been selling enzyme E together with instructions to mix it with olive oil O in an amount falling within composition claim A and to topically apply the resultant composition onto sunspots every day until the sunspots disappear.

The company secretary of Synco, Simon, advises you that enzyme E was publicly known before Synco filed the patent application which resulted in patent N and gives you a paper which describes enzyme E and was published about 1 year before the earliest priority date of patent N. Simon further states that Synco is not interested in taking action against any of the people that buy enzyme E from Facepack. Simon asks you to advise Synco whether there is any action Synco can take against Facepack to prevent them from selling enzyme E together with instructions to make a cosmetic composition in accordance with claim A and to use such a composition in accordance with claim B of patent N.

Advise Synco. If you require any further facts please state what you would like to know and why it would be relevant to your advice.

(16 marks)

5. One of your clients, Mr Brilltone, has learned that one of his competitors, Axiom Ltd, has just been released a new product called Xenon into the marketplace. Mr Brilltone advises you that he believes that the product Xenon falls within one of his granted Australian patents, Patent A which you drafted and prosecuted. He asks you to compare the claims of Patent A with the product to determine whether Xenon infringes one or more of the claims of Patent A and advise whether he could commence infringement action.

Patent A has one independent claim (claim 1) and five dependent claims (claims 2-6). On examining the claims you note that claim 1 includes Feature Y that is not in Xenon and that Feature Y is also solely claimed in claim 4. In addition, the specification contains a consistency clause in identical terms to claim 1. On reviewing your file you find instructions in a diary note of an earlier telephone conversation that you had with Mr Brilltone to delete Feature Y from claim 1 and to make it the subject of a dependent claim.

Briefly advise Mr Brilltone:

- i. The circumstances in which an amendment to the claims of a patent are
 - (a) allowable; and
 - (b) not allowable;
- ii. Whether in your view an amendment to claim 1 of Patent A is necessary, and, if so, why;
- iii. Under what circumstances the proposed amendments to the claims of patent A are likely to be allowable;
- iv. Whether any amendments to the specification of patent A should also be made;
- v. The procedure involved;
- vi. The effects, if any, of the proposed amendments, on any subsequent infringement action based on patent A.

(18 marks)

Robert has run a wooden floor polishing business for 25 years. One of the most popular ways of polishing a wooden floor, known for many years, is to coat it with polyurethane. However, the

polyurethane coating has to be stripped every four to five years and reapplied otherwise the different expansion rates between the polyurethane and the underlying wood eventually causes the wood to split. In addition, with use, the polyurethane shows shoe heel marks within a short time.

Robert has been experimenting with additives to polyurethane for about 15 years. He has a large shed, which he keeps locked and does not let anyone enter apart from himself. The shed has a wooden floor and he has applied polyurethane with various additives to different areas of the floor. The floor coated with one particular formulation, has not shown any signs of deterioration after 10 years despite Robert having walked across it 5 days a week. Robert has decided to market this formulation which is a mixture of polyurethane (89% volume/volume (v/v)), catalyst (1% v/v), beeswax (7% v/v) and blue gum honey (3% v/v).

Robert has developed an automatic mixer to add beeswax to a polyurethane/blue gum mixture at the correct temperature and rate. Robert has found that beeswax at a temperature in the range of 90-95°C has to be added dropwise to a slowly stirred polyurethane/blue gum honey mix at a temperature of 75-85°C otherwise the beeswax precipitates out. Once all the beeswax has been added the mixture is stirred for 1.5-2 hours at 60-65°C and is then gradually cooled to room temperature over 3 to 4 hours. The cooled mixture can be stored indefinitely. Catalyst is added to the polyurethane/blue gum honey/beeswax mixture just prior to application to a wooden floor.

Robert employed Mike to prepare the polyurethane/blue gum honey/beeswax mixture. Mike signed a confidentiality agreement on commencing employment and Robert then showed Mike the automatic mixer and the mixing process that he had developed.

The new floor polish formulation proved to be in such demand that within nine months everyone of Robert's customers wanted the new floor polish formulation. Robert decided to go on a holiday for a week and left Mike in charge of the shop. During this time Bill who was Robert's biggest customer came to the office to buy a large quantity of the new floor formulation. Bill told Mike that he could make a lot of money if Mike left his current employment and worked for Bill to produce a similar floor polish formulation. During the course of conversation Mike, who became very excited at the prospect of making more money,

opened one of Robert's filing cabinets, pulled out Robert's description of the formulation and the manufacturing process and showed it to Bill as a way of illustrating to him how simple it would be to make. Mike also showed Robert's automatic mixer to Bill,

When Robert came back from holidays Mike resigned from his position and went to work for Bill. He built an automatic mixer which was identical to Robert's automatic mixer and proceeded to prepare the polyurethane/blue gum honey/beeswax mixture in accordance with Robert's process. Bill started selling the polyurethane/blue gum honey/beeswax mixture at 75% of the price that Robert was selling it at.

Robert noticed that his sales were dropping dramatically and wondered why. One day an old customer came in to the office and told him that Bill was selling a new floor polish formulation much more cheaply than Robert and that Mike was now working for Bill. Robert asked the customer if he would buy a tin of Bill's new formulation and bring it to him. Robert gave the customer \$50 for his trouble in addition to the required amount of money to buy a tin of the formulation. The customer provided Robert with a tin of Bill's new formulation and after examining it Robert was sure that it was identical to his formulation.

Does Robert have a cause of action against Mike and/or Bill? What remedies should Robert seek against Mike and/or Bill?. If you need any further information explain what you would like to know and why it would be relevant to your advice.

(20 marks)