

REPORT TO CANDIDATES
PATENT ATTORNEYS PRACTICE PART II
2001 EXAMINATION

The Examiners were disappointed by the results of the 2001 exam paper and concurred that the standard exhibited in the paper submitted was lower than they have marked in this subject in preceding years. Candidates are reminded that it is necessary to score satisfactorily in most questions and failure to answer one or more questions altogether will severely inhibit their ability to pass. As always, it is also necessary to score consistently on foreign and Australian legal and practice issues as well as across all species of IP.

Question 1

- (a) This part of the question required only the points that an advisor would discuss in answering the client. It was not necessary to go into considerable detail concerning those points. In particular the Examiners were seeking an indication that the following points would be discussed: the nature of the disclosure in the drawings of a granted patent and the possibility that it might be novelty destroying; whether there was possibly an inventive step in the significant feature of the drawings, and what sort of protection might have been possible, for example, a divisional patent application, a patent of addition or an innovation patent application.
- (b) In part (b) the Examiners sought a logical and reasoned discussion of the best options available to the client. In particular they sought a discussion of whether or not the disclosure in the granted patent was novelty destroying, which of the three protection options was legally available and the most appropriate under the circumstances and the advantages and disadvantages of the most sensible option. The Examiners were inclined to the option of a patent of addition as the removal of co operation with the second component should have been seen to constitute a modification of the invention within s81(1) of the Patents Act, the disadvantage of this being that the term of the patent would be limited to that of the parent. Candidates were also required to indicate that the costs to the client were likely to come from filing, examination, prosecution and possibly acceptance and grant costs, although annuity fees are not payable in respect of patents of addition.

Question 2

Question 2 required a detailed explanation of matters substantially affecting the identity of a trademark as well as substantial identity and deceptive similarity.

- (i) The Examiners expected candidates to identify that amendment was only possible from lions head device A to lions head device B if the alterations did not substantially affect the identity of the mark as required by the Trade Marks Act. Candidates were required to

specifically identify the differences between trademark A and trademark B and then discuss whether those differences constituted a substantial affect on the identity of the trademark. The Examiners expected candidates to conclude that the change in the hat on the lion's head did affect the identity of the trademark and that therefore amendment was not likely to be allowed.

- (ii) (a) Candidates were required to go through the steps of querying whether C was substantially identical or deceptively similar to trademark A. Since trademark C is clearly not substantially identical to trademark A, candidates were expected to argue one way or the other

Question 4

- (i) This designs question required the candidates to recognise that it was possible to lodge a notice concerning the renewal of the design application under section 27A(4) alleging prior sale or prior use of the design the subject of the registration. In order to lodge that notice, the objector would need to substantiate the sale date of the item they produced and sold several years ago as well as details of the items sold; the most likely form for presentation of that information being in a statutory declaration. Candidates needed to indicate that that notice must be lodged within 11 months of the registration date of the design, that a hearing would be held and that any refusal of renewal would be advertised. It was also necessary to indicate that the hearing officer's decision would revolve around whether the item produced and sold by the client was an obvious adaptation or differed only in immaterial details or features used in the relevant trade from the registration.
- (ii) The client's article was clearly identified as a medal and candidates needed to conclude that there was therefore a possibility that the design registration was also a medal or could be considered as such. Medals are prima facie unregistrable and candidates needed to advise their client that they would need to go to court under section 39 to rectify the register if they wished to pursue this avenue of attack on the design registration.

Question 4 was poorly handled by candidates.

Question 5

- (a) Candidates needed to discuss the concept of privilege and that materials privileged are those brought into existence only for the purposes of communication between clients and attorneys for the client's assistance. Good answers then indicated whether or not each of the aspects of the advice provided to the client was privileged or not. The Examiners concluded that those documents that were not privileged were the list of prior art documents themselves, the patent documents themselves and any abstracts of public record.
- (b) In view of the issuance by the Federal Government of an ethics and standards document for the patent attorney profession early in 2001, the Examiners were disappointed by the quality of answers to part (b). Candidates should have indicated that if the recalcitrant attorney concerned was a member of the Institute of Patent & Trade Mark Attorneys, then that Institute provides a mediation facility whereby any dispute had the possibility of amicable resolution, or at least the establishment of proper facts. The client should also have been advised that under section 227(a)(2)(iii) a written complaint could be simultaneously or subsequently made to the Professional Standards Board which would then investigate and through its facilities prosecute the matter, if a case to be answered was found to exist.
- (c) This question required the candidate to indicate that there was a possibility that if permission was sought from B, the attorney might be able to act for A assuming of course that the approach to B was made with A's knowledge and informed consent. However, the

Examiners' preferred answer was that the attorney was no longer able to act for either A or B.

Question 6

In this question the Examiners awarded more marks to a discussion of US re-examination than they did to Australian re-examination law, and therefore a recitation of the Australian Statute in this regard achieved very few marks. The need for practical experience or at least exposure to other practitioner's experience was highlighted by the need in this question to identify relevant periods of time in which re-examination matters could be concluded as well as the relative costs likely to be incurred by the client. It was also important to recognise the difference in procedure between the United States and Australian re-examination processes such as, for example, that the Australian process is not truly inter partes. Other information regarding the process of re-examination in the United States is readily available from standard looseleaf texts.

Question 7

- (a) Candidates needed to distinguish those jurisdictions in which a Madrid Protocol application was possible from those in which a Madrid Protocol application was, at the time of examination, as yet impossible. Although the Australian case had not yet passed the five year mark, candidates should have recognised that it was still possible to attack the case under section 92(4)(a) but that 92(4)(b) was not relevant. In view of the recent adoption of the Madrid Protocol in Australia, candidates should have known that if the home registration failed under section 92(4)(a) then there was a risk that the Madrid Protocol based applications in the other jurisdictions would also fail unless they were converted to national filings.
- (b) This question sought to distinguish first to use jurisdictions from first to file jurisdictions. In Australia and the United States it was possible to refile the trademark application although in Australia it may even have been possible to seek an extension of time to pay the renewal fee. In Spain, however, because it is a first to file jurisdiction, the trademark is lost and candidates then needed to consider whether or not export constituted "use" in order to save the client's position. In the worst case scenario it was possible to conclude that in Spain the client could be considered infringing any intervening registration.

Question 8

- (a) Under section 15 of the US Trade Marks Act an optional provision exists to obtain a declaration of incontestability concerning a US trademark registration. This declaration is commonly sought at the time of renewal of a trademark application under section 8. If a declaration under section 15 is achieved, certain protection is afforded to the registered trademark.
- (b) The term "without prejudice" is used in reference to admissions made in the course of furthering negotiations to settle a dispute to achieve the understanding that such admissions are made on the understanding that they are privileged for admission into evidence. The purpose of the statement is to enable parties engaged in an attempt to avoid or compromise litigation to communicate with one another freely. Provided

negotiations take place in good faith in an effort to reach a compromise of the existing dispute, the negotiations will be taken to be without prejudice even when not labelled as such.

- (c) Candidates needed to discuss the meaning of the term “exhaustion of rights” and to conclude that exhaustion of rights does not apply where separate proprietors own the patent in separate jurisdictions. They also needed to recognise that there may have been conditions in the assignment of the property concerning territorial exclusion but that it was most likely that the client could not export their product to Germany because of the risk of infringement of the patent family member.

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