

**EXAMINATION FOR REGISTRATION AS A PATENT ATTORNEY
OCTOBER 2000
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 but candidates are required to attempt **ONLY FIVE** parts of question 1.
 4. The maximum marks for each question are indicated at the end of the question.
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Question 1. Write explanatory notes on **ONLY FIVE** of the following:

- (a) Common general knowledge in the context of patent law.
- (b) Reexamination in the context of the Patents Act 1990.
- (c) What is meant by the term "useful" in s 18(1)(c) of the Patents Act 1990 ?
- (d) Exclusive licensee in the context of patent law.
- (e) The springboard doctrine in the law of confidential information.
- (f) Secret use in the context of patent law
- (g) A "person aggrieved" may apply to a prescribed court for an order to rectify the Register provided one of the conditions set out in sections 192 (1) (a)-(d) is met. Explain what is meant by a "person aggrieved" in this context.
- (h) What is the current approach of the Federal Court to "purposive construction" of patent claims when determining whether a "variation" is an infringement of a claim? You must refer to relevant case authority.

(Total: 20 marks - 4 marks for each of the five parts)

Question 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 red cricket ball with white polka dots that can be seen more easily in flight by a batsman.

(2 marks)

(b) A pen with a small compass located in one end.

(2 marks)

(c) An out tray with an integrated weighing machine. The weighing machine can either be read manually to determine the weight of mail in the out tray at the time of reading or it can be linked to a computer which can record the accumulated weight of mail that is placed on the out tray during a particular period (e.g. daily, weekly, monthly or yearly).

(2 marks)

(d) A known chemical which is known to fluoresce in certain circumstances (those circumstances not being inside a fluorescent tube) applied to the inner surface of a fluorescent tube:

(i) Where the chemical is found to fluoresce its known fluorescent colour on application of the threshold voltage or higher between the electrodes of the fluorescent tube; and

(2 marks)

(ii) Where the chemical is found to fluoresce its known fluorescent colour on application of the threshold voltage up to twice the threshold voltage between the electrodes of the fluorescent tube and where it is found to fluoresce a different colour on application of twice the threshold voltage or higher between the electrodes of the fluorescent tube.

(2 marks)

(Total: 10 marks)

Question 3. Your client, Biozze, is scrutinising the specification of an Australian patent application in the name of one of its competitors, to determine whether there is any basis for filing a Notice of Opposition to grant. The application has been advertised as accepted in the most recent Official Journal of Patents.

Biozze notices under the heading “Best Method for Performing the Invention” that the specification refers to a micro-organism deposit made under the Budapest Treaty. Biozze asks you to advise whether it is possible for either Biozze or another party to obtain a sample of the micro-organism for testing purposes and, if so, under what circumstances. Biozze also asks you to describe briefly any procedures that are involved in obtaining a sample of the microorganism.

Advise Biozze.

(Total: 10 marks)

Question 4. A foreign associate informs you that one of its clients, an international pharmaceutical corporation, Candoo, is the patentee of patent M having a claim directed to a synergistic composition of active ingredient A and solvent S where the weight: to weight ratio of A:S is in the range of 40:60 to 60:40. There is also a claim to a method of treating a patient who has lung cancer by administering the synergistic composition of A and S in accordance with a specified dosage regime.

Active ingredient A has been known publicly for about 30 years and solvent S has been known publicly for about 100 years, but as far as Candoo is aware the synergistic composition of A and S were not known publicly prior to the priority date of patent M.

It has come to Candoo's attention that one of its competitors Genrica is selling ingredient A to hospital H with instructions to mix it with S in a weight :to weight ratio of A:S of 50:50 and to treat patients with lung cancer by administering the subsequent composition in accordance with a dosage regime that falls within the method claim of patent M.

Candoo has found out that a pharmacist employed by hospital H is making the synergistic composition in accordance with the Genrica's instructions and is providing the composition to doctors employed by the hospital. The doctors are then administering the composition to lung cancer patients of hospital H in accordance with a dosage regime that falls within the method claim of patent M.

Candoo advises you that it does not want to sue the hospital or its employees for infringement. Candoo asks you to advise whether it has one or more causes of action which if successful would stop Genrica from supplying A to the hospital.

Advise Candoo.

(Total: 20 marks)

Question 5. One of your corporate clients, Morac, has a granted Australian patent R, with a claim directed to compound C and a process for making compound C. The research director for Morac contacts you and advises that he has come across a prior patent, D, that was published 5 years earlier than patent R and which names compound C along with hundreds of other compounds. However, he indicates to you that he needs to read patent D in more depth because it is unclear to him at this stage whether patent D describes a process for making compound C. He asks you whether it would be

possible to restrict the claims by amending the compound claim to a crystalline form of compound C and the process claim to a process of making a crystalline form of compound C. You check the specification and note that it describes: (a) a powdered form of compound C; (b) a crystalline form of compound C; (c) a process for making a powdered form of compound C; and (d) a process for making a crystalline form of compound C.

The research director asks you to advise Morac by outlining the potential issues that may be relevant to this set of circumstances and what action(s) it should take in relation to the patent, if any, including a description of any relevant ramifications that result from such actions.

Advise Morac.

(Total: 20 marks)

Question 6. John has run an electroplating business for the past 25 years. Last year John was asked by Mike, an importer of metal statues, whether he could electroplate statues to produce a pale yellow film about 50% lighter than the yellow film produced by the well known gold electroplating process and which would be cheaper.

After experimentation John developed a suitable electroplating process which resulted in an appropriately light yellow film on the statues and which was also much harder and resistant to scratches than the standard gold film. Apart from using a special formulation in the electroplating bath, John also developed a cylindrical electrode made of stainless steel mesh. The statue was placed in the middle of the cylindrical electrode during the electroplating process.

John wrote down the details of the process including the necessary ingredients and the relative amounts of the ingredients required and put the description in the top drawer of his desk. Mike was so pleased with the result that he gave John a contract to electroplate 5,000 statues a month.

In order to cope with the increased workload John employed Peter, an electroplater whose sole job was to electroplate the statues. Peter signed a confidentiality agreement on commencing employment with John. John then showed Peter the electroplating process that he had developed.

The electroplated light yellow statues proved to be very popular. One day, when John was away from the factory, Andrew came to the factory with a scratched bumper bar for electroplating. While talking to Peter, Andrew noticed a row of the electroplated light yellow statues and stated how attractive they looked. Andrew then told Peter that he imported similar, but in his opinion more attractive looking statues than the ones that Peter was electroplating and suggested that Peter could make a lot of money if he left his current employment and electroplated Andrew's statues to produce a similar light yellow coating

During the course of conversation Peter became very excited at the commercial potential of going into business for himself. He went to John's drawer, pulled out John's description of the light yellow film electroplating process and showed it to Andrew as a way of illustrating to Andrew how simple it would be to set up. Peter also showed to Andrew John's cylindrical stainless steel electrode.

Within a week of the meeting with Andrew, Peter resigned from his position with John, rented a factory, hired electroplating apparatus and built a cylindrical stainless steel mesh electrode identical to John's stainless steel electrode. Peter then contacted Andrew who supplied him with an initial 5,000 statues which he proceeded to electroplate using the cylindrical stainless steel mesh electrode in accordance with John's process which he recalled from memory.

About a month later while John was shopping he noticed a group of electroplated light yellow statues. When he examined the statues more closely he noticed a sticker which indicated that the statue had been electroplated by Peter. John wishes to stop Andrew and Peter using the electroplating process and the cylindrical stainless steel mesh electrode he has developed and to prevent sale of the competing statues. Advise John of the legal issues involved.

(Total: 20 marks)