

EXAMINATION FOR REGISTRATION AS A PATENT ATTORNEY

OCTOBER 2000

SUBJECT GROUP F

Patent Systems

Time Allowed : 4 hours

Instructions to Candidates

- ◆ *Standard required to pass:* 50%
- ◆ *Reading time:* 10 minutes
- ◆ *Candidates should attempt ALL questions*
- ◆ *The maximum marks for each question are indicated at the end of the question*

1. Discuss the following terms naming at least one country outside Australia in which each term is used where relevant.

- a) File wrapper estoppel
- b) Terminal disclaimer
- c) Presumption of validity
- d) The Budapest Treaty
- e) Exclusive and sole licensee

(20 marks)

2. With the assistance of a U.S. Associate, you are responsible for the prosecution of a patent application before the U.S. Patent Office. Your U.S. Associate has just interviewed the Examiner following the issuance of a final rejection. Your Associate indicates that the Examiner has admitted that the specification appears to contain patentable subject matter but is not prepared to accept the claims as presented. Your Associate disagrees with the Examiner. The Associate indicates that he believes claims could be drafted to satisfy the Examiner but that he is unsure whether there is sufficient support for these claims.

What alternative procedures are available to proceed with the application with a view to obtaining allowance of claims to the invention. Your answer should indicate both drawbacks and advantages associated with the alternatives offered.

(12 marks)

3. You have been instructed to oppose a New Zealand patent application. Explain the stages of the Opposition procedure mentioning the major differences with the Australian Patent Opposition procedure.

(10 marks)

4. Two months ago your client made application for an Australian patent relating to a new kite. A competitor K Limited has recently offered for sale a similar kite which you find falls within the scope of claim 1 of the patent application.

Explain all actions available to your client to prepare them for action against K.

(12 marks)

5. a) Explain the steps by which European patent applications proceed from allowance to grant.
- b) Explain the steps by which South African patent applications proceed from filing to grant.
- c) Explain the processes available in Europe and South Africa for post grant amendment.

(12 marks)

6. Your client is an exclusive licensee under a patent related to a sleep apnea device and has been supplying these to the Commonwealth Department of Human Services. Recently the Department awarded a tender for a small quantity of these devices to another company, but the devices have apparently not yet been delivered. The Department has now called for tenders for the supply of a large quantity of the devices and your client is concerned that, for pricing reasons, this tender may be awarded to its competitors.

Advise your client.

(8 marks)

7. Your client manufactures air conditioners, brackets for supporting the air conditioners off the ground and ducting systems for use with reverse cycle air conditioners. He has patented a novel fan blade shape which he has been approached to licence. The potential licensee is a manufacturer of wall heating units who wishes to use the fan blade shape to improve his heating units. Naturally, your client wishes to maximise his profits. Your client suggests the following clauses for the licence.

- (i) The patentee will grant an irrevocable licence for 25 years to manufacture fan blades according to the patent for heating units.
- (ii) The licensee will pay a royalty of 5% on the manufacturing cost of the fan blade.
- (iii) All technical improvements on the fan blade and any Intellectual Property arising therefrom shall be the sole property of the licensor.
- (iv) The licensee will not supply any ducting systems with units including the fan blades unless the ducting systems are purchased from the patentee.

Advise your client in respect of each of these clauses with suitable explanations.

(12 marks)

8. One of your firm's clerks approaches you with a facsimile they have received from a client of your firm. The client seeks advice as to the location of their Patent Deed. On investigation it appears that whilst the patent application was successfully prosecuted to allowance, the fifth year annuity, which was due around about the time of allowance, was never paid. Further investigations reveal that the clerk sought instructions from the client regarding the payment of the annuity but cannot remember, and has no record of receiving, any reply to his letter. The grace period for paying the annuity expired last week. You recall that around about the due date for payment of the annuity your firm was heavily involved in installing a new IP management system. In fact, the data upload from the old system took place one week before the unextended deadline for payment of the annuity. A rummage through your firm's duplicate incoming fax records from a year ago finds that a copy of the client's instructions were received in good time for payment of the annuity.

Draft a declaration to support an application under s.223 for a Extension of Time to pay the annuity.

(14 marks)