

EXAMINATION FOR REGISTRATION AS A PATENT ATTORNEY

OCTOBER 2000

SUBJECT 7

Patent Attorneys' Practice Part I

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) Supplemental Register
- b) Paris Convention as applicable to trade marks
- c) Continuation-in-part
- d) Election of species
- e) Whole of contents

(15 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)

.../2.

3. Your client asks you to advise whether SEA BREEZE is available for use and registration as a trade mark in respect of air fresheners in class 3.

Your search reveals the following:

- a) OCEAN BREEZE: - registration date 3/3/93
- class 3
- "domestic grade cleaning agents included in this class"
- b) SEA WIND CLEANING: - registration date 5/7/98
- class 42
- "commercial cleaning services"
- c) www.seabreeze.com - a domain name apparently associated with a U.S. company retailing groceries and cleaning products via the internet.
- d) FEBREEZE - application date 12/12/99
- classes 1 and 3
- "perfumes for wholesale, air fresheners, cleaning fluids and cleaning chemicals".

Write a letter to your client reporting the search results and advising whether or not they can use and register their proposed brand.

(15 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. At a recent conference an American Associate asked you to send to him on your return to Australia advice on the scope of Australian Design registrations including the principles to be followed in drafting statements of monopoly and statements of novelty.

Write the letter of advice to your Associate.

(10 marks)

.../3.

6. Germany and Japan provide protection for a class of inventions characterized as utility models.
- a) Explain briefly how utility models differ from patentable inventions in both of the above countries.
 - b) Explain briefly the procedure for filing applications.
 - c) Explain briefly the differences, if any, between the rights given by patent grant and utility model registration in both countries.

(12 marks)

7. A new client contacts you with a view to filing a new trade mark application in respect of a total home renovation service. Together with a number of tradespeople he is proposing to offer a total makeover service thereby avoiding the need for clients to separately organise the attendance of each tradesperson at their home. Since this is the idea of a group of his mates he proposes to file the trade mark application in their joint names. He also wants to know whether he has to register a business name and/or company name. After hearing of the costs involved, he is reluctant to proceed with a trade mark application at all.

Write a letter to your client advising him in relation to your discussions. Discuss the ownership structures he has queried in relation to the proposed business, in whose name/s he should file his trade mark application and the pros and cons of the available options.

(14 marks)

8. You are prosecuting a trade mark application which has had a fifth official action issued against it in Australia. The outstanding objection is under s.41(5) of the Trade Marks Act 1995. The 21 month date is next week. You are still trying to determine the availability of evidence to overcome the s.41(5) objection. What are the options for pursuing Trade Mark protection for the mark whilst minimising risk to your client if -

- a) The trade mark has not been used by your client in Australia?

(6 marks)

- b) The trade mark has been used by your client in Australia?

(4 marks)

Indicate the chances of success of each of the options.