

EXAMINATION FOR REGISTRATION AS A PATENT ATTORNEY

OCTOBER 2000

SUBJECT 8

Patent Attorneys' Practice Part II

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) Terminal disclaimer
- b) File wrapper estoppel
- c) Presumption of validity
- d) Re-examination

(12 marks)

2. Your client's trade mark GOURMAND has been registered in Australia and continuously used for over 30 years. The trade mark is nationally well known in relation to gas ovens, electric ovens and barbecues, and has for the past few years also been used in connection with microwave ovens manufactured under licence from your client. As a means of boosting sales, the licensee regularly offers the ovens with free sets of casserole dishes which are unbranded except for an adhesive label bearing the words "For use with your GOURMAND oven". Your client becomes aware that an Australian company has commenced importing cookware suitable for use in microwave ovens and is marketing these dishes under the name MASTER GOURMAND.

Advise your client including his chances of success in stopping the Australian company's activities.

(14 marks)

3. a) On instructions from client A, you prepare and lodge a patent application. Client A provides you with substantial prior art material including trade brochures. For unexplained reasons client A transfers the care of the application in question to an interstate Attorney before the application is examined.

Client B, one of your firm's larger clients, now instructs you to lodge Notice of Opposition to A's patent application, and to conduct a novelty search in respect of the accepted claims of A's patent application.

What are you able to do for Client B?

(5 marks)

- b) Your patentee client has written what could be easily interpreted as a threatening letter to a competitor who he thinks may be infringing his patent. The competitor promptly commences an action for groundless threats. What courses of action are open to your client?

(5 marks)

4. 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)

5. 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.

.../3.

- (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)

6. Your client's competitor has had granted 10 months ago

- a) a Design
- b) a Petty Patent

You believe that both the design and petty patent are clearly invalid in the light of the importation and sale of 100 samples of a very similar product several years ago. Explain in detail the options open to your client if he wants to manufacture a product that would amount to infringement of the design and petty patent.

(12 marks)

7. a) An overseas Associate has owed you \$15,000 for over 12 months. You have written to him on numerous occasions and on the last occasion you told him that you would not do any work for him unless the \$15,000 was paid. You have received no response to any of this correspondence. You have now received instructions from that Associate to respond to an Official Report on a patent application filed on his instructions. The final date for acceptance expires in two days (that is, the First Report issued nearly 21 months ago). In the instructions your Associate says that he is going to pay the money in the next mail. What would you do?
- b) You have filed a design for a client. The application is not open to public inspection. Your client has explained to you that he will keep his design secret until it is registered. You walk into the office of one of your partners and you see an almost identical product on his desk. Your partner says that he has just received instructions to file a design for the product. What do you do, if anything?

- c) You are prosecuting a trade mark application on instructions of a Taiwanese Associate. You receive a letter from the President of the applicant company asking you in future to correspond directly with him. What would you do? Would the position be different if you also received a letter from your Taiwanese Associate pointing out that you may hear from the applicant direct but if this happens you should correspond with the Associate only?

(12 marks)

8. Your client NBC Television Inc. is the producer of a very well known television series "Surry Hills 90210" featuring the trials and tribulations of a group of young adults living in the American suburb of Los Angeles known as Surry Hills. The programme has been shown on Channel 9 in Australia since 1995. Your client has not yet sought trade mark protection for their product. It has come to your client's attention that Channel 7 is about to launch a lifestyle infotainment series directed at Generation "X" called "Surry Hills, 2010" based on the Sydney suburb of Surry Hills. Your client wishes most urgently to stop Channel 7 from using this name for their series, and also to stop use of "Surry Hills 2010" on a range of merchandising falling into classes 16, 18, 21, 24 and 25 by Channel 7.

In order to ascertain the strength of your client's rights, you conduct a Search and find the following:

1. www.surryhills90210.com.au – an internet site set up by Australian fans of the U.S. show offering fan magazines, T-shirts and postcards of the stars of the TV show.
2. "Surry Hills" – entry in Lippincott's Gazetteer describing both the Los Angeles and Sydney suburbs and their primarily residential nature. The entry also discusses the burgeoning fashion industry in Surry Hills, Australia.
3. "Surry Hills" – filing date 31.1.2000 in class 21 directed to "homewares including crockery, cutlery and ornaments included in this class" in the name of "Seven Television Network".
4. "Stylishly Surry Hills" – registration date 27/4/94 in class 42 for "interior design services".

Advise your client of their rights and what they can do to protect them.

(20 marks)