

EXAMINATION FOR REGISTRATION AS A PATENT ATTORNEY

OCTOBER 2002

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 each question

1. Your U.S. Associate writes in respect of AU-B-798654 in the name of LOTSABUGS, INC. as follows:

"In the course of our normal quality control procedures we were reviewing the file wrapper of Australian patent case 798654 in relation to which you sent us the Deed of Letters Patent one month ago, and we have discovered that the junior who was conducting the work has made the following errors:

(a) We have discovered that one inventor, Mr X, has not been named at any stage in the proceedings and as a consequence does not appear on the Deed. Further, Mr Y and Mr Z who have been named as inventors, are not inventors.

(4 marks)

(b) Furthermore, it seems that Mr A who is employed by the University of Tennessee, never assigned his rights to LOTSABUGS, INC. He is now refusing to do so.

(4 marks)

(c) Finally, please be advised that the invention now subject of the claims was actually first described, at least in part, in US 09/741,080. US 09/943,172 from which 798654 claims priority, is a continuation in part of and was filed 18 months after, US 09/741,080. In other words, the Notice of Entitlement you have filed and which has been accepted incorrectly states that the invention the subject of the patent was first described in application US 09/943,172."

(3 marks)

Advise your client about what will be required to correct the deficiencies in the records relating to the Australian patent.

2. Your client, PLASTIC PRODUCTS PTY LTD which trades as FOAMABLE FILLINGS, brings to you a letter they have received from a US law firm. The letter says:

“Our client’s review of your company’s web site shows that it is infringing their intellectual property rights by the improper use of representations which appear to be photographic images of our equipment. Moreover, the site makes use of our registered trade mark “FOAMABLE FILLINGS”.

We require your undertaking by return that all infringing subject matter will be removed from your company’s web site immediately.”

Your client advises that until 6 weeks ago, they were the exclusive Australian distributors of equipment sourced from the complainant.

Your review of your client’s web site and that of the complainant shows that your client’s site has photos on it that are remarkably similar to those on the US complainant’s site. Part of the text on the site reads:

“FOAMABLE FILLINGS makes and sells a foamable filling product, using proprietary equipment, which is particularly suited to the packaging of fragile items. We can supply product and equipment to you wherever you are”.

A review of the US Trade Mark Register shows that the US complainant is the proprietor of a 1999 registration of FOAMABLE FILLINGS, TM 3,427,010 on the US Principal Register.

Write letters to the US law firm and to your client dealing with the issues raised.

(12 marks)

3. Your European client writes to you:

“We notice in the newsletter of one of your Australian colleagues that Australia now requires the lodgement of an Information Disclosure Statement according to the practice in the United States. Please advise us what we must do to comply with this law and what are the penalties for disobeying”.

Your review of your client’s portfolio shows that as of today’s date they have the following cases in your care:

AU 54321/98 - granted 02/04/2002
AU 43215/00 - acceptance advertised 20/2/02

Advise your client.

(8 marks)

4. Your client, Inarush, is the Patentee of an Australian Patent 765432, its corresponding patent in the USA 7,654,321 and its corresponding cases in the Germany, France and the United Kingdom (which were achieved through the EPC). In order to compare and contrast the invention with the prior art you relied during prosecution on an argument which depended heavily on data extracted from Figure 1 in the description. Your client now advises that when his Technical Director was reviewing the claims together with the Business Development Manager with a view to licensing the technology he discovered a problem with the claims as granted in every jurisdiction. The Technical Director advises

"that the data in that Figure is incorrect. After the production of that Figure, we revised the experiment from which the data arose, and produced a new version of the Figure. You must have forgotten to incorporate it into the description because I know I sent it to you two years ago".

When you go back to look at the file wrappers you realise that in every jurisdiction there are independent claims which exist which incorporate data available from nowhere else in the specification but Figure 1.

Advise your client about their options for rectifying the situation with the incorrect Figure 1 in all the jurisdictions in which a patent has been granted, and what ramifications there are of the options you identify.

(12 marks)

5. In June 2002 your client Company X, opened a combined retail outlet and Café in Gundagai, the birthplace and sometime abode of the well known bushranger FLASH JACK. The retail outlet is called the FLASH JACK GENERAL STORE and the Café is called the FLASH JACK COUNTRY KITCHEN. The combined premises is called the FLASH JACK CENTRE and uses the logo of a bearded man on a horse holding two pistols at the viewer of the logo, together with the words "Flash Jack Celebrations 2002" across the top, and the words "Gundagai, NSW" across the bottom.

Your client advises that the establishment of the Centre follows on from a successful New Year's Weekend Celebration in January 2002 run by your client, with the assistance of the Gundagai Council, to honour the memory of FLASH JACK. During that weekend a range of merchandise being commemorative cups, tea towels, caps and T-shirts all carrying the logo were sold from a Marquee in the main street of Gundagai.

The client also advises that in February 2002 it had packaging designed for foodstuffs which it intended to sell in the FLASH JACK COUNTRY KITCHEN, and also had designs created for a range of clothing to be sold in the FLASH JACK GENERAL STORE.

Further, pre-opening advertising in the February 2002 edition of the New South Wales Tourism Guide referred to the intended opening of the Centre in June 2002, by its name, and recommended a visit to the FLASH JACK GENERAL STORE for the purchase of unique souvenirs, and FLASH JACK COUNTRY KITCHEN for a traditional bushranger's meal.

The client advises that he has just become aware of application no. 999000 filed 10 April 2002 for the mark FLASH JACK for the following goods and services:

Class 29: Meat, fish, poultry and game; foodstuffs and prepared foodstuffs in this class.

Class 30: Coffee, tea, cocoa; foodstuffs and prepared foods including this class.

Class 42: Establishment and operation of outlets for the supply and provision of meals, snacks and refreshments, including cafes, foods and fast food outlets and restaurants.

You check the records and find application 999000 was accepted on 30 September 2002, and also that a prior registration for FLASH JACK exists in the name of another party, for goods being the class headings in classes 32 and 33. The registration no. 800000 dates from 2000.

Advise your client of their position in the light of 999000 and include advice, with reasons, on:

- (i) Whether the use of the "Flash Jack Celebrations 2002" logo on the New Year's weekend would constitute use of the mark FLASH JACK, and if so, whether that use would be in respect of any of the goods or services of application 999000;

(2 marks)

- (ii) Whether the use of the terms FLASH JACK CENTRE, FLASH JACK COUNTRY KITCHEN or FLASH JACK GENERAL STORE,

- (a) as part of the packaging for foodstuff, or range of clothing which were designed, or,
 (b) in the pre-opening advertising,

was use of the trade mark FLASH JACK in commerce, for any of the goods or services of application 999000;

(4 marks)

(iii) Whether the existence of the prior registration no. 800000 from 2000 is relevant to application 999000; and

(3 marks)

(iv) What the likelihood of success in an Opposition to registration of 999000 based on any or all of the above would be.

(6 marks)

5. Write about each of the following subject matters:

- (a) Patent opposition in Japan
- (b) Reissue in the USA
- (c) Declaration of Use and Declaration of Incontestability in the USA
- (d) Extension of Trade Marks rights to new members of the Madrid Protocol

(16 marks)

6. (a) In what circumstances might privilege be waived?
- (b) Explain the concept of lien and its shortcomings in debtor management.
- (c) What are your duties to your client as a Patent Attorney?
- (d) Your Patent Attorney firm has merged with a large law firm. You find that your colleague from the law firm is acting in a matter against a party who was a client of your firm about 6 years ago. Write a memo to your colleague in the law firm explaining your position and possible ways of dealing with any issues you perceive to exist.

(16 marks)

7. Basil is the author of a design of a pencil sharpener in the shape of a sheep. Pencil sharpeners according to the design are moulded from dies, which were produced from drawings made originally by Basil in Australia in 1998. The design was registered in Australia by Basil in 2000, on an application filed in 1998, and you may assume the Australian registration is valid. No foreign design applications were filed by Basil.

In January 2001, Basil began to export pencil sharpeners according to the design to New Zealand, and many thousands have been sold there. In August this year, Basil learned that a New Zealand company,

Yellowbeard Ltd, has directly copied the design and has been selling pencil sharpeners according to that design through souvenir shops in Christchurch and Auckland.

Basil has written to the Managing Director of Yellowbeard Ltd drawing attention to his Australian registered design and demanding that Yellowbeard Ltd cease selling the offending pencil sharpeners and that it pay him a royalty for each pencil sharpener already sold. Yellowbeard Ltd's Managing Director has refused to comply with that request, pointing out that the Australian registration does not extend to New Zealand. He further advised Basil that Yellowbeard Ltd filed its own design application in New Zealand in November 2001 and that if Basil continues selling pencil sharpeners according to the design in New Zealand after the registration issues, he will be infringing.

Basis now seeks your advice. Advise him.

(10 marks)