

REPORT TO CANDIDATES

PATENT ATTORNEYS PRACTICE PART I

2000 EXAMINATION

The papers presented, in general, showed a satisfying improvement over those presented in 1999 particularly in the attention candidates paid to answering the questions put. Questions directed to mainstream subjects in Patent and Trade Mark areas were generally well handled, however, questions directed to Australian Designs and foreign practice achieved lower marks than was considered desirable. Good candidates scored consistently on Foreign and Australian legal and practice issues, as well as across all species of IP.

Question 1

- a) Candidates were required to recognise that the US Trade Mark Act provides for a Supplemental Register upon which Trade Marks which generally lack distinctiveness may be registered. Marks on this Register have less robust rights attached to them than those on the Principal Register.
- b) The Paris Convention provides certain fundamental rights to Trade Mark Applicants in countries which are a party to the Convention. One of the primary rights is that of the six month "convention" period within which applicants can file an application in a foreign member jurisdiction while still claiming the filing date of their home country filing.
- c) The Continuation in Part application is a species of application available under US law whereby further subject matter may be added to the description. Claims based on the new matter may have the priority date of the filing of the CIP. At least one claim must have the priority date of the parent case and the CIP must have at least one inventor in common with the parent case.
- d) Candidates needed to recognise that this term is also one related to US patent prosecution practice. It was necessary to describe what a "species" is (e.g. a product as opposed to a process etc) and to briefly outline the process by which an Examiner can require that a species be elected before further prosecution occurs. Good answers indicated what steps were then possible in relation to the species not elected.
- e) The term "whole of contents" refers to the basis for novelty examination in respect of patent applications forming part of the prior art but not OPI at the time of the filing of the application in question. European novelty law requires a whole of contents approach, as does Australian practice. Under "whole of contents" principles the whole of the prior application is considered. c.f. prior claiming under the Australian Patents Act 1952.

Question 2

Candidates had some difficulty discussing this very practical aspect of US patent practice. A final rejection, when issued by the USPTO indicates that only a limited number of options exist to progress a patent application to allowance. An extendable period of three months is allowed for response. Positive action must be taken in response. Argument alone is considered not fully responsive. Candidates needed to discuss the alternatives including amending to completely overcome the Examiner's objections, filing a continued prosecution application or a continuation in part application, appealing the rejection or petitioning the Commissioner. Discussion of the advantages and disadvantages should have included time, cost and issues of priority date and scope of protection.

Question 3

The letter to the client prepared in answer to this question had to include "details" of the search conducted, its scope and limitations. The letter also needed to draw a conclusion. Provided this conclusion was well supported by appropriate argument, its nature was considered largely irrelevant. Candidates need to be aware of what impact the existence of a relevant domain name might have on their client's proposed activities, and application for registration. This involves some consideration of where it appears that goods are being offered for sale (if this is the case) and consequent upon that, the existence or not of common law rights in Australia. Candidates could handle better the practical realities of whether or not goods are of same or a similar nature.

Question 4

This question was relatively well handled. Again, the Examiners were seeking practical advice to the client. As such it was expected that a comment on the ramifications of steps proposed be made to assist the client in determining the most recommended route. The client could request that his specification be laid open to public inspection as soon as possible; if not already conducted a validity search could be commenced; expedited exam could be requested; a letter could be sent to the competitor to warn of the client's rights although the pros (availability of damages) and the cons (possibly alerting the competitor to the option of lodging opposition) needed to be discussed; or a petty patent could be filed to bring on grant as quickly as possible. Ideally candidates needed to warn of the pitfalls of the petty patent system if they recommended taking this route to stopping the competitor.

Question 5

This question was not well handled by the majority who were unable to properly describe the purpose of a statement of monopoly and a statement of novelty. The former has been described as "a disclaimer of features necessarily illustrated to show the article to which the design is applied but which form no part of the design themselves". A statement of novelty directs attention to the features distinguishing the design from the prior art and is relevant in infringement proceedings". The answer also desirably needed to mention the very narrow scope of design registrations in Australia and the infringement tests of obvious and fraudulent imitation as well as the historical chances of success in winning an infringement case.

Question 6

Candidates generally handled this question satisfactorily. Part (a) required that candidates identify the subject matter not protectable by way of a utility model, and any differences in examination rigour, term and scope of protection. Part (b) highlighted the fact that there are ostensibly no differences between filing for patent protection and utility model protection. Part (c) required a comment on the effect that less rigorous tests for inventive step might have on the rights afforded the owner of a utility model, and the effect of the diminished term.

Question 7

This was the question least well handled by candidates. It was expected that candidates would outline the benefits of seeking formal Trade Mark protection, discuss the difficulties associated with co ownership of a Trade Mark registration (and therefore recommend against filing in joint names), differentiate between business names, company names and Trade Marks highlighting at least that whilst the former are effectively government mechanisms for ensuring consumer protection and tax collection, Trade Mark protection provides monopoly rights to the benefit of the owner. It would have been ideal to point out how business names differ from company registrations in terms of their jurisdiction and relative cost to establish. Candidates should have formulated the best possible route for their client to take which was probably the formation of a company with the "mates" as Directors, the company then being the owner of any Trade Mark.

Whilst it is not expected that candidates should be fully cogniscent of corporate structures and how they can be established, in the context of advising a client about ownership of a Trade Mark, it is important to be able to simply distinguish the various species, and what might best suit the client's needs from the point of view of IP owner.

Question 8

This question was well handled. In each case the options available were to seek an extension of time, file a divisional application, lapse the application and refile it as a new application having a new priority date, identify circumstances other than use that might persuade the Examiner to allow the case or perhaps even take the matter to a hearing depending on the circumstances. The difference between answers to part (a) and (b) lay in the effect that each of these options would have potentially on the rights of the client, and the success that was likely given that use had or had not occurred. In each part, the route likely to result in the best outcome for the client needed to be identified and was probably different.

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