Group discussion – past exam question (patents)

1. A past exam question dealing with patents issues (attached) will be discussed.

Introduction and general principles of confidential information

2. What is the jurisdictional basis for the ‘breach of confidence’ action?

3. The 3 elements for the jurisdiction in equity: Coco v AN Clark.

4. Breach of confidence in the context of ‘employees’: the tripartite classification of information received in the course of employment: Faccenda Chicken v Fowler.

5. The role of third parties.

Past Exam Question – Patents

Part A

Joshua is the head researcher at a private laboratory which has been conducting research into the transmission of illnesses through body cavities such as the mouth, ears and the nose. In 2005, after about 4 years of research, he believes he has developed a process for lining the outermost layer of skin tissue in body cavities with a series of special ointments. He calls the process ‘BodyGuard’. Joshua also developed the ointments used in the BodyGuard process.

Joshua says that the unique aspect of the BodyGuard process is that it successfully repels all airborne viruses, including some of the most deadly viruses known to humankind. He also says that the BodyGuard process is also, potentially, curative, in that his research findings so far indicate that using the BodyGuard process acts as a sterilisation agent which aids in the cure of a number of common, but not life-threatening, airborne viruses.

Joshua visits a patent attorney to discuss whether his invention is patentable. The patent attorney, Sue, is concerned that Joshua’s invention may fail one of the preliminary matters required for patentability in Australia, namely that the invention does not involve a ‘manner of manufacture’.

You are a barrister specialising in intellectual property law. Sue has briefed you to provide advice in this matter.

On the basis of the information above, advise Joshua and Sue in relation to whether you consider Joshua’s invention involves a manner of manufacture within the meaning prescribed under Section 18(1)(a) of the Patents Act 1990 (Cth). [17 marks]

Part B

Irrespective of the conclusion you reach for Part A above, assume that Joshua decides to file an application for a patent for his BodyGuard process. During the course of the application process, Sue undertakes various searches for prior art documents to determine whether Joshua’s invention is inventive as at the priority date. Sue discovers two documents published before the priority date of Joshua’s invention, namely:

1. A document found in the library of a large American pharmaceutical company. The American company sells its pharmaceutical products worldwide, including in Australia. The library’s catalogues can be accessed on the internet, and members of the public can order copies of library materials through the Head Librarian. Whilst the document does not disclose all the features of Joshua’s invention, it does however disclose most of them. The document is known by the title ‘Method for Defensive Protection of Skin Layers’.
2. A document found in the library of a small private research company in Austria. Copies of documents can be obtained from the library, but only by university research laboratories. There is no restriction on where the university research laboratories must be located. So, the library facilities are available to any researcher in any university around the world. Whilst the document does not disclose all the features of Joshua’s invention, it does however disclose most of the features missing from the other document referred to in paragraph 1 above.

In light of this further information, advise Joshua and Sue in relation to the potential relevance of the two prior art documents in determining whether Joshua’s invention involves an inventive step. [8 marks]