

SUMMER EXAMINATIONS 1998/1999

LL.B. EXAMINATIONS - SECOND THIRD & FOURTH YEARS  
B.COMM. EXAMINATIONS - THIRD YEAR  
B. CORPORATE LAW  
OCCASIONAL STUDENTS

INDUSTRIAL AND INTELLECTUAL PROPERTY LAW (LW356)

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Time Allowed: TWO hours; ERASMUS Students: 2½ hours.  
Answer any THREE questions. All questions carry equal marks.

1. Answer **BOTH** part (a) **AND** part (b):

- (a) Certain types of beneficial innovations are excluded from patent protection as 'excluded subject-matter' (or 'statutory exceptions to patent grant'). Briefly outline the categories of excluded subject matter and explain the rationale for such exclusions.

**AND**

(b) Advise as to patentability in the following hypothetical situations:

- (i) Flora plc has developed two new products: a new variety of tomato developed by plant cross-breeding, and a new transgenic plant and its seeds created by genetic engineering (scientists used recombinant DNA technology to modify the genetic material of a plant found in nature);
- (ii) Advance plc has developed a new and better process for the manufacture of a known drug using a computer running a specially-written computer program to control the process;
- (iii) Minerva Ltd has developed a new slimming product which, if used as part of its ten-week slimming method, is alleged to be very effective. It is discovered that it also has useful therapeutic qualities with regard to the treatment of acne.

2. Answer **EITHER** part (a) **OR** part (b).

- (a) Section 13 of the Patents Act, 1992 states: 'An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the state of the art....'  
Write a concise memorandum explaining the tests for inventive step applied in English and Irish courts and by the European Patent Office (EPO).

**OR**

- (b) Section 45 of the Patents Act, 1992 states that the extent of patent protection 'shall be determined by the terms of the claims; nevertheless, the description and drawings shall be used to interpret the claims'. It also provides that in the interpretation of the section 'the Court shall have regard to the directions contained in the Protocol on the Interpretation of Article 69 of the European Patent Convention [EPC]...'.  
With reference to case law as appropriate, analyse and discuss the application of section 45 in determining the scope of patent claims and their infringement.

PTO

3. Section 8 of the Copyright Act, 1963 states, in part, that: 'Copyright shall, subject to the provisions of this Act, subsist in every original literary, dramatic or musical work...' Given that work must be original for copyright to vest, analyse and discuss how the law of copyright is applied to compilations of subject material, where the material as opposed to the compilation itself was not created by the compiler.

4. Answer **EITHER** part (a) **OR** part (b).

- (a) "[F]ollowing the uncertainty as to whether computer programs were protected by copyright...the pendulum has swung too far in the other direction and the extent of the protection now offered by copyright may be too extensive. This could unduly inhibit innovation and competition within the computer software industry." (Bainbridge, "The Scope of Copyright Protection for Computer Programs" 54 MLR 643)  
Critically assess the validity of the views expressed in the above quotation.

**OR**

- (b) Intellectual property law has failed utterly to cope with the development of modern technology, particularly with the development of digital technology.  
Discuss.

5. Answer **BOTH** part (a) **AND** part (b):

- (a) Explain and discuss the circumstances and principles on which a person will be bound in confidence despite the fact that there is no express contractual obligation to keep the particular confidence.
- (b) Advise as to whether a breach of confidence action is likely to be sustained in the following hypothetical situations:
- (i) Two actors and their manager told a scriptwriter of their idea for a television series about UFOs (unidentified flying objects) and the scriptwriter discussed the idea with a producer. There was general agreement that the series would be made with the actors taking lead parts. It transpired, however, that the actors were unavailable and the scriptwriter and producer proceeded to make the series without getting the consent of the actors or their manager.
- (ii) Enterprise Ltd entered into an agreement whereby Finance plc agreed to obtain finance from a third party in relation to a proposed business venture. Enterprise Ltd has now learned that the identity of the third party financier has been disclosed to "Scandal" magazine whose editor intends to publish the information. When threatened with an injunction, the owner and editor replied that they were not party to the original agreement, and were under no duty of confidence, under contract or otherwise. They also maintained that their right to freedom of expression was in any event guaranteed by the Constitution.

6. Answer **BOTH** part (a) **AND** part (b):

- (a) Examine the definition of a trade mark in the Trade Marks Act 1996 and the principal grounds on which the Controller may refuse to register a proposed mark.
- (b) Section 10 of the Trade Marks Act 1996 provides as a ground for the refusal to register a mark that it is an identical mark to an earlier trade mark, which was registered in relation to similar goods or services, or a mark which is similar to an earlier trade mark, which was registered in relation to identical or similar goods or services and  
*'there exists a likelihood of confusion on the part of the public, which includes the likelihood of association of the later trade mark with the earlier trade mark'.*  
Section 14 similarly provides that a trade mark will be infringed where a person uses in the course of trade an identical sign in relation to similar goods or services, or a similar sign in relation to identical or similar goods or services where  
*'there exists a likelihood of confusion on the part of the public, which includes the likelihood of association of the sign with the trade mark'*  
Analyse and discuss the meaning of 'likelihood of association' in these sections.