

Stopped at the door

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A single publication in a catalogue imported by a New Zealand company has been enough to stop a patent being granted to a Christchurch company for a doorstop. In 2007 Resolutionz 101 Limited applied for a patent for a doorstop which limited travel of hinged doors. The application was opposed by an Invercargill company, Windsor Brass Limited.

Under New Zealand law, a patent cannot be granted if there was a publication in New Zealand of the invention claimed in the patent before the patent is applied for, and that published material is available to the public.

In this case, Windsor Brass Limited had requested a copy of a catalogue from a Chinese company based in Guangdong, China in 2005. One of the items in the catalogue was a particular type of doorstop which was the same as that claimed in some of the claims of the patent application.

This single publication was sufficient to stop the patent being granted for those claims.

The Assistant Commissioner said that the requirement for prior publication is that the

relevant document is sent to one person in New Zealand without fetter, and he found that there was no evidence of any confidentiality being sought or imposed by either party. There was no attempt by either the Chinese company or the New Zealand recipient of the catalogue to keep the catalogue secret. The Chinese company was interested in selling its product, and the New Zealand company was interested in buying it. The fact that Windsor Brass neither disseminated the catalogue any further nor ultimately bought the doorstops from that particular company was irrelevant - one publication was enough.

The remaining claims, which were not identical to the doorstep in the catalogue, also failed on the related ground of obviousness. A patent cannot be granted for an invention which is clearly obvious. The illustration in the catalogue, together with evidence from those in the trade of what was common general knowledge at the time the patent was applied for, was sufficient to prevent the remaining claims from passing the threshold of inventiveness necessary for the grant of a patent.

The case acts as a reminder for New Zealand companies, such as those supplying the building trade, to retain any catalogues and trade publications they receive as evidence of what was available at a particular date, in order to prevent the grant of or later enforcement of patents of doubtful validity.

When proposed changes to New Zealand patent law come into force next year or the year after, the position will change. New Zealand companies will be able to rely on

publications anywhere in the world in order to successfully challenge patent applications or granted patents on the grounds of prior publication, prior use and obviousness. New Zealand is one of a tiny number of countries which still require proof of prior publication of the claimed invention in New Zealand.