**Summary of IPONZ Technical Focus Group**

**Patents Date of Meeting: 6 October 2016**

| **Agenda Items** | **Comments** |
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| 1. **Update ‐Patents (Trans Tasman Patent Attorney Regulation) Amendment Bill** | A second reading of the Bill may be completed next Thursday (13 October 2016) with the Bill being passed by the end of the year. The precise timing is, however, uncertain.  The Select Committee recommended Part 5 be removed from the Bill. Subject to Government approval, this will end the SAP/SEP proposals. |
| 1. **Consultation paper – proposed amendments to the transitional provisions Patents Act 2013** | Submissions are due 14 October 2016 and none have yet been received. Warren Hassett noted he may be able to extend the deadline if someone wishing to make a submission requires further time.  Recommendations to the Government based on analysis of the submissions might be made this year, but more likely next year. The MBIE team is currently busy working on the TPPA Bill and the report for that is due next month. The government would like to pass that Bill by the end of the year.  MBIE would also like to amend the Patents Regulations 2014 to deal with, for example, the microorganism deposit receipt issues. |
| 1. **PCT Infographic – reveal and overview** | See scanned copy attached at the end of this document. |
| 1. **Global Patents Prosecution Highway – way forward** | IPONZ and MBIE are considering options for implementing a Patent Prosecution Highway, e.g. by pursuing bilateral agreements or applying to join the GPPH pilot programme.  There are two windows each year for applying to join the GPPH, in January and July. An application in July 2017 may be possible. |
| **Practice matters** |  |
| 1. **Draft examination manual updates** | See attached draft documents. Revision of these documents is likely following our discussion.  **Section 8 (The prior art base)**  Paragraph 1 seems to suggest a liberal standard for combining documents to find a lack of inventive step. Such a combination requires more than merely identifying a combination of more than one document that would anticipate the invention.  The discussion of prior secret use in paragraph 17 appears to be inconsistent, in particular the last sentence.  The document list in paragraph 11 should be exhaustive.  **Section 40 (Statements of support)**  IPONZ considers the statement of support to include the entirety of the response letter as filed, not just any section of the response letter headed ‘statement of support’. Hence the reference in paragraph 7 to the statement of support including an explanation of how the proposed amendment overcomes the objection where the amendment is, for example, made in response to a lack of novelty objection.  Concern was expressed that the specification published at 18 months may not be the original specification but could include proposed amendments that have not yet been accepted. IPONZ will investigate their processes in relation to this issue.  **Section 230 (Extensions for delay by the Commissioner)**  Any section 230 extension should be set out in the examination report following the delay by the Commissioner instead of the section 71(1) deadline being extended towards the end of the 12 month period, if necessary. This provides greater certainty for applicants. |
| 1. **Divisional applications filed in Reg 78(2) period of parent application** | A substantive response to the examination report on the parent is required to validate the filing of a divisional that is filed in the one month extension for responding to the examination report.  IPONZ regards a substantive response as one that makes a bona fide attempt to overcome the objections. Simply deleting all of the claims is not considered a substantive response. A bona fide attempt to overcome at least one objection is a substantive response.  IPONZ are working on a draft update in relation to this issue. |
| 1. **Shortened period for response ‐ divisional applications** | Generally a shortened response period will apply where a divisional has been filed with substantially the same claims as were originally filed with the parent (or subsequently) and which have been searched and examined on the parent. |
| 1. **5 day discretionary extension – Patents Act 1953** | IPONZ Information for Clients issue 16, dated 30 June 2001 indicates the five day extension should ordinarily be granted as a matter of course. |
| 1. **Section 231 – Patents Act 2013** | Section 231 provides for the possibility of an extension for filing a complete after provisional or convention application, or for failure or delay of a delivery method. Restoration is possible in other circumstances where an application lapses.  Regulation 147 provides for extensions in exceptional circumstances that do not fall within the scope of section 231 or the restoration provisions. |
| 1. **Authorisations of agent – revert to original agent** | IPONZ confirmed no authorisation of agent signed by the assignee is required for the current agent to record an assignment. But, as requests to records assignments are now OPI, the request should include a positive statement confirming the agent is authorised to act on behalf of the assignee. In some cases, IPONZ may still request an authorisation signed by the assignee.  IPONZ is investigating system changes to make it more convenient for agents to record an assignment under a limited authorisation of agent while still leaving the current agent recorded.  IPONZ would like to return to the use of general powers of attorney to simplify various matters and are investigating how this might be done. |
| 1. **Support requirements** | IPONZ examination guidelines make specific provision for reference numerals to be deleted from claims.  Discussed IPONZ’s approach to the amendment of object clauses. Amending an object clause that no longer relates to the claimed invention, for example where claims to methods of medical treatment are deleted or amended, should be allowable. |
| 1. **Prioritising applications close to end of s 71 deadline** | IPONZ expects examiners to prioritise cases close to the section 71 deadline, but there are no formal guidelines or processes. It is an issue of resource allocation. IPONZ has a small number of examiners and has less flexibility than, for example, IPAU. |
| 1. **Other matters** | **None** |

| **Any other points of Discussion** | **Comments** |
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|  | If a request for a copy of a priority document is made in an examination report, the two month deadline prescribed in regulation 68 applies to that request.  It was suggested that the examination report should clearly identify that deadline. IPONZ is currently investigating how that deadline will be shown in examination reports.  The copy of the priority document does not need to be certified. However, any accompanying translation must be a verified English translation. |
|  | IPONZ has had four new examiners start this week and has approval to increase the number of examiners by a further 12, with six expected to start in early 2017 and six in mid-2017. In addition, IPONZ plans to recruit two IP administrators to handle various matters and reduce the workload on examiners. |

