**Summary of IPONZ Technical Focus Group**

**Patents Date of Meeting: 20 October 2017**

| **Agenda Items** | **Comments** |
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| 1. **Matters arising from last meeting** | Minutes from the last Patents TFG Meeting should now be available on the IPONZ website. |
| **Formalities matters** |  |
| 1. **Timelines and targets** | IPONZ aim to examine patent applications around three months after receiving a request for examination. The current examination time frames are:   * Biotech/Chemistry/ICT – 4 months * Electrical – 4.5 months * Mechanical – 4.75 months.   IPONZ would like to issue Directions to Request Examination at around 39 months from the application filing date. But, Directions are a tool to maintain IPONZ’s workflow and, at present, IPONZ has sufficient work and is issuing few directions.  IPONZ still has a high volume of Patents Act 1953 divisionals, especially in chemistry. Typically, around 40 to 50 Patents Act 1953 divisionals are filed each month.  IPONZ aims to meet a 42 working day (2 month) target for examining applications for which a request for expedited examination is filed under the GPPH and is accepted.  As with all examinations, IPONZ aims to issue an examination report 20 working days after the application is allocated to an examiner’s queue. IPONZ aims to allocate or reject requests for expedited examination under the GPPH within 22 working days.  It is not possible to amend method of treatment claims examined by another office to Swiss-type pharmaceutical use claims when requesting expedited examination under the GPPH. More specifically, Swiss-type pharmaceutical use claims are not considered to ‘sufficiently correspond’ to method of treatment claims. An applicant would need to request expedited examination under the GPPH with the method of treatment claims and then subsequently amend the method of treatment claims to Swiss-type pharmaceutical use claims in a response.  IPONZ will not issue Directions to Request Examination at some point close to the 5 year deadline for requesting examination if examination had not been requested. The task deadline in the IPONZ system provides an alert to applicants so they consider a Direction would be redundant in those circumstances.  The proposed IP Omnibus Bill (see below) will clarify that an application lapses if examination is not requested within the five year deadline. The Bill will also clarify that an application could be restored. Within the first 12 months of the deadline, a request for restoration only needs to meet the ‘unintentional’ standard. |
| 1. **Formalities** | IPONZ raising new objections late in the examination process should be the exception. They are aiming to be pragmatic when close to the final acceptance deadline.  If a hearing request is filed the examination team would not review any amendments filed after that request. Instead, the application would proceed to a hearing.  IPONZ often object to Notices of Entitlement filed without the patent application number. It is acceptable to include the PCT application number for national phase entry applications. Otherwise, the Notice of Entitlement needs to include sufficient information to link the Notice to the relevant application. Some Notices of Entitlement are being filed with minimal information. |
| 1. **Page and figure numbering** | IPONZ expected that all documents would be prepared and filed electronically. They will, however, revisit their application of Regulations 24 and 27 regarding page numbering.  It is acceptable to use alphanumerics to number specification pages, provided the sequence is clear, for example ‘2c (followed by 3)’. |
| 1. **Authorisation of agent** | It should be acceptable to use an Authorisation of Agent, signed by the new owner, authorising one agent to handle recording the assignment and another agent, for example the currently-recorded agent, to handle subsequent prosecution. |
| **Practice matters** |  |
| 1. **Support and Amendments** | The statement of support should indicate where the proposed amended claims find substantive support in the description and claims currently on file.  As regards the reasons for amendments, the guidelines include two reasons: to meet an objection, and a voluntary amendment.  Amending claims in two part format to single part format should be acceptable. More specifically, he confirmed amending ‘characterising in that’ to ‘wherein’ should generally be acceptable. |
| 1. **Response deadlines** | IPONZ should note the two month deadline for filing the priority document under Regulation 68 in any examination report in which a request to provide the priority document is made..  IPONZ has applied a shortened two month response deadline for the first examination report on some divisional applications where the claims were not substantially the same as or identical to those of the parent (or a grandparent) application.  IPONZ considers those issues were one off instances. In general, the IPONZ system defaults to a two month response deadline for first examination reports for divisional applications. If that deadline has not been amended to six months, when appropriate, then applicants should contact the examiner. |
| 1. **Priority documents** | We discussed a case in which the examiner requested a copy of the priority document, despite acknowledging in the examination report that they had already reviewed the USPTO file history. It should be unnecessary to file a copy of the priority document where it is readily available to the examiner.  IPONZ considers that this was a one off issue. |
| 1. **Abstracts** | We discussed the problem/solution approach that several examiners have requested be adopted for abstracts.  There is an issue in relation to what the abstract means and its effect on interpretation in New Zealand. It was suggested that the IP Omnibus Bill could usefully include a provision clarifying what effect, if any, the abstract has on interpretation of the specification. |
| 1. **Examination report detail** | It was noted that it is helpful if examiners identify where documents have been previously cited if they are reiterating citations that have been raised by other Patent Offices. IPONZ advised that, depending on how the examiner accessed those prior citations, they may not have that information however.  Examiners should review all claims, including dependent claims. In some circumstances, particularly where there is a large number of claims, examiners may consider only the independent claims. But, if so, the examination report should include a comment to that effect.  When filing voluntary amendments for an application that is in order for acceptance, applicants should not withdraw the request for postponement of acceptance. That will then generate a task for the examiner to review the voluntary amendment. Otherwise, if the postponement of acceptance is withdrawn, the case will go to the acceptance team because of the way the IPONZ system is set up. |
| 1. **Examination manual** | There was some discussion on useful additional matters that could be covered in IPONZ’s examination manual. |
| 1. **IP Omnibus Bill & Amendments to Regulations** | One of the major issues to the dealt with in the IP Omnibus Bill is that of divisional filing and the five year bar.  The IP Omnibus Bill may clarify that an application will lapse if examination is not requested within five years of the filing date. The Bill is also likely to require that any divisional application be filed with a request for examination. Such a divisional application could, however, be filed after five years from the ante-dated filing date.  MBIE expects to release a consultation document for the IP Omnibus Bill in early 2018. They would then prepare recommendations to go to Cabinet in July-August 2018, with subsequent release of an exposure draft and the introduction of the Bill into Parliament in 2019.  The issues of multiple priorities and ‘poisonous priority’ are on the agenda for the IP Bill consultation document.  MBIE is concerned about timing because there are two other significant consultation documents expected in early 2018; concerning the PVR review and the Copyright Act review.  Some amended regulations have been drafted. These relate to:   |  |  | | --- | --- | | **Regulation** | **Change** | | 19(2) | Properly filed documents – remove compliance with Act and Regulations | | 52(3) | Divisional applications – parent-child overlap – meet at acceptance | | 59(1) | Microorganism deposit receipts due before acceptance | | 61 | PCT Art 34 amendments – 22 months | | 103(2) & 161(2) | Extension of time to file counter-statement |   MBIE has the amended Regulations already drafted. They had hoped to get approval before Parliament rose for the general election. They are now hoping to gazette the Regulations in early 2018. There will be no exposure draft. MBIE regards the amended Regulations as dealing with oversights during drafting and/or minor issues that are non-controversial. |
| **Other matters** |  |
| 1. **Product-by-process claims** | IPONZ was asked about the status of product-by-process claims following the comments in the meeting minutes from the February 2016 Patents TFG Meeting.  Referring to the rights given by a patent in s18(2)(b), IPONZ considers a claim to a new process encompasses the product produced by that process.  IPONZ will interpret a claim to a known product when produced by a new process as a claim to the product *per se*.  IPONZ intends to update the examination guidelines for section 39 of the PA2013 to remove *Kirin-Amgen Inc.* v *Hoechst Marion Roussel* [2005] RPC 9 as the authority for this approach. That decision held that the UKIPO must stop accepting product-by-process claims because that change in practice was needed to bring the UK into line with the EPO. |
| 1. **Frequency of Patents TFG Meetings** | IPONZ is likely to aim for three Patents TFG meetings per year. |

| **Any other points of Discussion** | **Comments** |
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|  | None |