

Summary of IPONZ Technical Focus Group

Patents

Date of Meeting: 28 March 2018

Agenda Items	Comments
Matters arising from last meeting	
1. IPONZ system enhancements	<p>There are a number of enhancements IPONZ would like to make to their case management system.</p> <p>However, competing demands within MBIE mean those enhancements are not likely to be able to be made until the November 2018 or February 2019 quarters.</p>
Formalities matters	
2. IPONZ work-fronts & direction policy	<p>IPONZ website includes the timeframes that the different technology groups are meeting for issuing first examination report after a request for examination.</p> <p>IPONZ is currently issuing directions only on divisional applications. Otherwise, they have sufficient work and so are generally not issuing any directions.</p> <p>There can be significant delays in IPONZ issuing a further examination report on Patents Act 1953 applications. There is no general policy to delay work on those applications and any delays are, instead, due to examiner workloads. Only a limited number of examiners are handling Patents Act 1953 applications, especially in the Biotech team.</p> <p>IPONZ considers that most examination teams are meeting the 20 working day turn around. The Biotech team may not always meet that target.</p> <p>Attorneys should contact examiners when filing responses close to the final acceptance deadline so that the examiner can take any urgency into account when prioritising their work load.</p>
3. Extensions of time – section 230 & regulation 147	<p>Section 72 enables the Court to extend the section 71 deadline if there is an appeal to the Court. However, there is no corresponding section under which the Commissioner can extend the deadline under section 71 when the applicant requests a hearing before the Commissioner.</p> <p>The Assistant Commissioner in <i>BIOCON</i> expressed doubt as to the legitimacy of using section 230 to grant an extension to</p>

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	<p>allow for a hearing after the section 71 time limit has expired, and after an examination hearing is completed to allow an applicant to make further amendments if any objections are upheld.</p> <p>IPONZ acknowledges there is a problem with the Patents Act 2013 and that the law is unclear. They consider the Assistant Commissioner did not want to create a situation in which an applicant lost all rights.</p> <p>The ability to request a hearing before the Commissioner was specifically provided for in the Patents Act during the select committee process. It appears that no thought was given to the interaction with other provisions.</p> <p>IPONZ/MBIE hope to resolve this issue in the IPONZ Omnibus Bill. In the meantime, extensions under section 230 are a measure to reflect the policy intent. In particular, the intention is to make provision for amendments during the hearing process.</p> <p>There is widespread concern at the impact of the five year deadline to request examination, particularly in relation to divisional applications. A number of mechanisms or approaches to enable an applicant to file a divisional application and request examination after the five year deadline were discussed. For example, reference was made to the High Court's decision in <i>Merial</i>, which lowered the threshold for 'exceptional circumstances'.</p> <p>IPONZ does not regard the filing of a divisional application after the five year deadline has expired is an exception circumstance, <i>cf</i> the use of regulation 147 to extend the deadline for filing microorganism deposit receipts. That circumstance was viewed as being exceptional because applicants entering the national phase could not possibly comply with the requirement.</p> <p>The IP Omnibus Bill will consider issues of filing divisionals more broadly.</p> <p>IPONZ does not anticipate any significant practice changes before the IP Omnibus Bill.</p> <p>MBIE noted the policy intention was to allow section 230 to be used to allow extensions for delay during examination, albeit less liberally than the corresponding section 93 in the Patents</p>

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	<p>Act 1953.</p> <p>In addition, the intention of the intermediate response deadlines was to avoid applicants coming up against the final acceptance deadline.</p>
Practice matters	
4. Voluntary amendments	<p>Some examiners have been objecting to the introduction of multiple claim dependencies using reasoning based on EPC article 123.</p> <p>There is no specific policy against the introduction of multiple claim dependencies.</p> <p>There has been a recent hearing considering the allowability of amendments to object clauses and that the decision in that hearing is likely to provide some guidance. The hearing took place in February 2018 and a decision is likely to issue in a few months.</p> <p>Acceptable reasons for making amendments include: to meet an objection, and by way of voluntary amendment.</p>
5. Omnibus claims	<p>What format of omnibus claim is allowable can be case specific because an otherwise allowable omnibus claim may not be clear in the context of the particular application.</p> <p>The allowability of omnibus claims may feature in the IP Omnibus Bill.</p>
6. Reference numerals	<p>In general, deleting reference numerals requires support in the specification, for example a passage discussing the particular feature without use of a reference numeral. However, there may be some circumstances in which deleting reference numerals leads to ambiguity and, in such cases, IPONZ would still object.</p>
7. Substantive responses	<p>Cancelling all claims in an application and presenting an informal omnibus claim would not be sufficient as a substantive response to obtain the one month extension of the response deadline. A substantive response should address the substance of the examination report and make some progress in advancing the application towards acceptance.</p> <p>IPONZ plans to issue guidelines as to what is a substantive</p>

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	response.
Other matters	
8. Update on IP Omnibus Bill	<p>Preparation of a consultation document for the IP Omnibus Bill is progressing.</p> <p>MBIE hope to release the document in June/July.</p> <p>Consultation documents on a review of the Copyright Act and a review of the Plant Variety Rights Act are also expected to be released this year.</p> <p>MBIE will aim to stagger release of these consultation documents.</p> <p>In the patent area, much of the IP Omnibus Bill deals with divisional applications.</p> <p>MBIE intends that the IPONZ Omnibus Bill will provide more certainly as to when a divisional application can be filed. There was some discussion regarding the use of divisional applications to simply continue prosecution.</p>
9. Amendments to Patents Regulations	<p>The Patents Amendment Regulations 2018 come into force on 5 April 2018.</p> <p>If a parent was accepted, but subsequently lapsed/abandoned/surrendered, that would not present a barrier to pursuing the same claims in a divisional.</p> <p>Regulation 82 should only apply to a claim or claims for substantially the same matter in a live parent.</p>
10. Re-examination	<p>IPONZ was asked if they would be issuing any guidelines on re-examination practice.</p> <p>There have been surprisingly few requests for re-examination (only around eight so far). IPONZ practice is still developing.</p> <p>However, the process does allow for several rounds within the overall three months (extendible by one month) deadline.</p>
11. Publication of provisional applications	<p>IPONZ does not intend to publish New Zealand provisional applications that served as the priority document for an application filed and published elsewhere.</p>
12. Designs – The Hague Agreement	<p>The UK has recently joined the Hague Agreement.</p>

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	<p>Whether NZ joins the Hague Agreement would be considered as part of a wider review of the Designs Act. But such a review is not likely to take place for several years due to capacity constraints in the MBIE IP Policy team.</p>
<p>13. Patents (Advancement Patents) Amendment Bill</p>	<p>National had lodged a Patents (Advancement Patents) Amendment Bill as a private members bill with the Clerk of the House.</p> <p>MBIE has had no involvement with the drafting of the Bill.</p> <p>The Bill needs to be balloted for a first reading to progress.</p> <p>UPDATE – The Bill was subsequently drawn from the ballot</p>
<p>14. Comprehensive and Progressive Agreement for Trans-Pacific Partnership (CPTPP)</p>	<p>The CPTPP was signed on 8 March 2018.</p> <p>MBIE is unsure as to the government plans for dealing with ratification. The Foreign Affairs and Trade Select Committee has requested submissions.</p> <p>It is likely the TPP Amendment Act will be amended or replaced to bring the provisions of the CPTPP into force after ratification.</p> <p>The only amendment likely to be made to the Patents Act 2013 is to provide for a grace period, which would only apply to disclosures made after the CPTPP comes into force.</p> <p>A number of amendments to the PVR Act are required within 3 years of the CPTPP coming into force.</p>
<p>15. Witness statements</p>	<p>An applicant can file witness statements in the UK and Australia, whereas the Patents Act 2013 requires the filing of an affidavit or a statutory declaration.</p> <p>Whether IPONZ should accept witness statements should be discussed in the hearings TFG because such a change in practice would likely require an amendment to the Patents Act. In addition, an appeal in New Zealand is not <i>de novo</i>. A simple witness statement would not satisfy High Court evidence requirements for any appeal.</p>
<p>16. Next Patents TFG Meeting</p>	<p>Expected mid-late July 2018.</p> <p>The consultation document for the IP Laws Amendment Bill may have been released by then. If not, a further meeting will be scheduled soon after the release of that document.</p>

Any other points of Discussion	Comments
17.	None