**Summary of IPONZ Technical Focus Group**

**Patents Date of Meeting: 12 June 2019**

| **Agenda Items** | **Comments** |
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| 1. **Fee review update - process and timeframes** | The Parliamentary Counsel Office has prepared a first draft of amendments to the Trade marks and Patents Regulations.  IPONZ has requested approval from MBIE to release exposure drafts.  IPONZ hopes to have the fee increases take effect in October 2019.  The actual fee changes have not been released yet, but are be in the Cabinet Paper. It is unclear whether that Cabinet Paper has been proactively released. |
| 1. **MBIE policy update on IP Omnibus consultation** | Warren Hassett is happy to meet for discussions with any interested parties in July. |
| 1. **Parent / divisional overlap – Regulation 82** | Advice given in a previous Patents TFG Meeting regarding IPONZ’s approach to Regulation 82 was incorrect.  IPONZ considers it is not possible to interpret Regulation 82 to allow surrender of an application post-acceptance to resolve a parent/divisional overlap objection. This is a departure from previous practice, and was not foreshadowed in what was supposed to be merely a ‘technical’ amendment to Regulation 82 to clarify that parent/divisional overlap is an acceptance matter, not a filing matter.  MBIE considers the divisional system is being used in ways that it was never intended to be used. Policy reasons mean that an applicant should not be permitted to surrender an accepted application and present the same claims in a divisional (or parent).  Interested parties can make submissions on this issue as part of the IP Omnibus Bill consultation. |
| 1. **Hearings practice on implementing decisions** | Previously, when a decision issued following a request for a hearing on an examination issue, a hearings task was created, setting a deadline for appeal. But the examination task would linger, and the application would go abandoned if that was not dealt with.  IPONZ have implemented changes to their process to avoid this. An application will not have multiple tasks outstanding and, instead, the change in the hearing status will be linked back to the examination status. |
| 1. **Approach to GPPH requests** | This was discussed when reviewing the minutes for the previous meeting. It was pointed out that there is often inconsistency between IPONZ’s approach and that of other offices.  IPONZ aims for consistency with overseas offices. |
| 1. ***Xyleco, Inc* [2019] NZIPOPAT 7 – implications on office practice for divisional applications under Patents Act 1953** | This decision relates to ante-dating of divisional applications. Specifically, an application needs to be eligible for ante-dating on filing.  The practical effect is that a divisional from an application proceeding under PA1953 is *prima facie* an application under PA2013 until it has been assessed as eligible for antedating. That assessment is, therefore, done under s34(3) PA2013, which requires ‘the divisional application is only in respect of subject matter that was in substance disclosed by the parent application as filed’. Once assessed as eligible for antedating, examination of such a divisional should then proceed under PA1953 – e.g. fair basis instead of support.  If the application is not antedated, the applicant should be advised before substantive examination commences, which would proceed under PA2013.  Any amendments that would be permitted under PA1953 but not under PA2013 (e.g. addition of definition of ‘comprising’ etc) should, therefore, be made AFTER filing and not when filing a divisional from an application proceeding under PA1953. Filing the divisional with a specification identical to that of the parent PCT (for applications ultimately derived from a national phase entry), and then making any amendments after the first examination report issues may be the best approach. |
| 1. **Examination of post-acceptance and pre-grant amendments under 1953 Act** | IPONZ confirmed that amendments after acceptance, but before grant, of applications proceeding under PA1953 should be dealt with under PA1953 – e.g. fair basis instead of support. |
| 1. **Nature of post-acceptance amendments under 2013 Act** | PA1953 requires that any amendment after acceptance be by way of disclaimer, explanation or correction.  PA2013 requires the applicant for amendment state the ‘nature’ of the amendments. Some examiners have required that each amendment be categorised as a disclaimer, explanation or correction.  See s85(3): Every request for leave to amend a specification under this section must— (a) state the nature of the proposed amendment; and (b) give full particulars of the reasons for the request; and (c) be made in the prescribed manner (if any) – i.e. amended specification, marked up specification, statement of support and declaration (see r87).  IPONZ considers that the nature of the amendment is different from the reason for the request – i.e. the nature is the ‘essential property’ of the amendment. Disclaimer, explanation and correction are examples, but amendments allowable under PA2013 are not limited to only these. |
| 1. **Examination of inventive step in NZ compared to other countries** | See also item 5 above.  IPONZ considers that examiners should utilise the work product from other offices, where possible. |
| 1. **Regulation 70 - Requests for evidence in support of convention application** | IPONZ should only be requesting priority documents when there is a need to verify the priority date of a claim, e.g. to determine whether particular prior art can be cited. |
| 1. **Page numbering in specifications – update to approach** | IPONZ is still considering whether alphanumeric numbering, e.g. 1, 2, 2a, 2b, 3 etc is permissible. |
| 1. **Review of draft examination guidelines** | Draft guidelines had been circulated regarding:   * Amendment of complete specifications before acceptance - section 40 * Verified Translations of documents   IPONZ invited any further comments and suggestions in response, preferably within a couple of weeks. |
| 1. **Patents updated letter template project** | IPONZ plans to invite TFG members to a review session to provide feedback on the new template being developed. |
| 1. **Any other business** | No |
| 1. **Next meeting/upcoming meetings** | Proposed that the Patents TFG meet again in September 2019. |

| **Any other points of Discussion** | **Comments** |
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| 1. **Abstracts** | IPONZ has prepared a draft guideline regarding abstracts. This will be released sometime. |
| 1. **Object statements** | With reference to the *CNH* decision, IPONZ will now accept amendments to object clauses to add e.g. ‘at least provide the public with a useful choice’. |
| 1. **Issues register** | MBIE/IPONZ want to develop an ’issues register’ for matters affecting New Zealand’s IP provisions. |
| 1. **Verification of translations** | It was suggested that IPONZ should relax its requirements regarding translations because it often seems unnecessary that a translation should require verification, which places a further burden on applicants, e.g. for documents other than complete specifications. |
| 1. **PVR Review** | An options paper has gone to the minister. MBIE is not sure when cabinet will approve that. It could be released for consultation in July. |