

Summary of IPONZ Technical Focus Group

Patents

Date of Meeting: 25 June 2020

Present

IPONZ/MBIE Policy

Simon Pope, Simon Maguire, Gaby Cowcill, Warren Coles, Tanya Carter, Warren Hassett (MBIE Policy), Monique Cardy

TFG members

Fiona Pringle (Baldwins), Duncan de Geest (AJ Park), David Nowak (Henry Hughes), Doug Calhoun (NZ Law Society), Jonathan Lucas (James and Wells), Tom Robertson (Pipers), Scott Sonneman (DCC), David Koedyk (Catalyst)

Agenda Items	Comments
1. Update by MBIE Policy on the Intellectual Property Laws Amendment Bill and PVR Review	<p>The cabinet paper for the IP Laws Amendment Bill is currently with the Cabinet Economic Development Committee and is expected to be approved early next week. The cabinet paper should be released with 30 days of approval.</p> <p>MBIE hopes to release an exposure draft of the bill in October/November 2020, and are aiming for the bill to be introduced into the house in March/April 2021.</p> <p>A cabinet paper regarding the PVR Review is expected to be released around mid-August 2020.</p> <p>Prior to that, MBIE expect to release a PVR consultation document in mid-July 2020. That consultation document relates to policy proposals to address Treaty of Waitangi issues, such as the proposed Maori advisory committee. MBIE is developing regulatory/administrative processes and will be seeking feedback. They expect to have a separate process regarding new regulations under the PVR Act in 2021.</p> <p>MBIE are still working towards having a new PVR Act in force by the end of 2021. They are conscious of the deadline imposed by the CPTPP. Under a worst case scenario, even if the new Act is not in force by that deadline, they consider that NZ's obligations under the CPTPP will likely be satisfied if the bill has been introduced into the house and is progressing.</p> <p>MBIE are also working on the Copyright Act review. They are currently drafting an options paper, which is not expected to</p>

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	be released until 2021.
<p>2. Patents team updates</p>	<p>Volumes post lockdown</p> <p>While IPONZ had some IT issues during the Covid-19 lockdown, due to the MBIE network, the patents team's output in the four weeks after lockdown was back to normal.</p> <p>IPONZ has noted little if any change in the number of patent filings or requests for examination since the Covid-19 pandemic began.</p> <p>They have noticed a slight increase in abandonments, most of which are due to non-payment of maintenance fees.</p> <p>The timeframes information on the IPONZ website currently dates back to early December 2019. These are usually updated every three months. IPONZ expects to update them again in mid-July. The Chemistry and Biotech teams have seen an increase of around three months in the average time from requesting examination to issuing the first examination report, while those in the ICT team have stayed about the same, and those in the Mechanical team have decreased slightly.</p> <p>There was a significant increase in the number of requests for examination made in the period leading up to the fee increases in February 2020. That will have an impact on the timeframes.</p> <p>There are no more national phase entry applications filed under the Patents Act 1953 awaiting a first examination report. There are around 40 PA1953 divisionals awaiting a first examination report, and around 100 PA1953 responses awaiting reply from IPONZ.</p> <p>Covid-19 extensions (when to review practice)</p> <p>IPONZ is currently planning to discontinue their automatic Covid-19 extensions at the end of July. This is consistent with IP Australia and the UKIPO.</p> <p>IPONZ was asked to notify well in advance when they will stop the automatic extensions.</p> <p>Release of new patent letters / system enhancements (client feedback?)</p> <p>IPONZ received generally positive feedback on the new patent</p>

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	<p>examination report template.</p> <p>Examination reports for PA9153 applications will not be issued on the new template.</p> <p>Design examination reports are now numbered.</p> <p>New trade mark letter templates will be introduced later in 2020.</p> <p>Capacity building / new trainees / further recruitment</p> <p>IPONZ's development of flexible working practices, which were intended to improve resilience and ensure business continuity, have had a positive impact on staff retention. Their staff turnover in the past two years has been significantly reduced compared to previous years.</p> <p>There are two periods each year during which patent examiners can apply for progression. Three examiners progressed in the most recent round.</p> <p>Posting of TFG minutes and guidelines reviewed at the last meeting (amendment of complete specifications before acceptance; verified translations of documents; amendment of description, claims and drawings of treaty applications; parent and divisional claims overlap – reg 82)</p> <p>It was noted a minor consequential amendment was required to the guideline 'Section 39: Contents of complete specification' to make it consistent with the new guidelines.</p> <p>This was in relation to amendments such as the addition of a definition of 'comprising' etc.</p>
<p>3. Question about using trading name as an address for service (raised in context of TTIPAB)</p>	<p>The TTIPAB had raised an issue with IPONZ about whether it was appropriate for an authorisation of agent to specify a trading name instead of a natural person or several people.</p> <p>Warren noted the PR2014 specify that 'agent' means 'a person — (a) who is a patent attorney or a barrister or solicitor (to the extent that the barrister or solicitor is entitled to practise in matters under the Act or these regulations) ...'. The Interpretation Act 1999 provides that 'person includes a corporation sole, a body corporate, and an unincorporated body'. Accordingly, an agent need not be a natural person, and could be a partnership, incorporated company etc.</p>

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	<p>IPONZ also noted they are currently developing internal processes for agent verification to ensure the integrity of their on-line systems.</p>
<p>4. Lack of unity as a ground for revocation, and proposal that this be considered as an addition to Intellectual Property Laws Amendment Bill</p>	<p>It was suggested to duplicate the language of s92(1)(c) 'that the complete specification does not comply with any provision of subpart 2 (which relates to specification requirements) <u>other than section 39(2)(a) (which requires claims to relate to 1 invention only)</u>' in s114(1)(c), which currently recites 'that the complete specification does not comply with subpart 2 (which relates to specification requirements)'.</p> <p>Warren pointed out such an amendment is unnecessary. S104(2) recites 'However, it is not competent for any person in an action or other proceeding to take any objection to a patent on the ground that it has been granted for more than 1 invention'.</p>
<p>5. Implementation of new practice towards abstracts (as agreed at TFG previously)</p>	<p>IPONZ received positive feedback in response to their practice changes regarding their approach to abstracts.</p> <p>It was noted that there is some inconsistency between examiners. Some examiners will object to an abstract and advise that they will amend the abstract if the applicant does not overcome the objection, while other examiners amend the abstract and invite the applicant to make further amendments if they disagree with the examiner's amendment. It was generally agreed the latter approach is preferable. However, it would be helpful if examiners specified the amendment(s) made instead of simply advising they have amended the abstract.</p>
<p>6. Review of draft examination guidelines</p>	<p>Restoration of patents and patent applications</p> <p>IPONZ released draft guidelines 'Restoration of patents and patent applications' earlier this week for review and comment.</p> <p>Some minor issues were pointed out.</p> <p>In addition, it was noted the guidelines suggest that an assignee must record an assignment before they can apply for restoration. But, the IPONZ system does not permit recordal of assignments or lapsed applications/patents.</p> <p>Warren pointed out that the Act provides that the applicant/patentee can apply for restoration – not their</p>

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	<p>successor in title. The policy reason is to encourage prompt recordal of assignments, so the information in the register is accurate.</p> <p>In some circumstances, however, this could lead to rights being irrecoverably lost, because the applicant/patentee may no longer have any interest in assisting and may even, in some circumstances, no longer exist.</p> <p>IPONZ will consider this issue further.</p> <p>A question was asked regarding handling restorations where, in addition to a maintenance fee not having been paid, examination has not been requested by the five year deadline. The latter does not result in lapsing (although the IP Laws Amendment Bill will alter that).</p> <p>An extension under R147 is required to enable the applicant to request examination. R147 requires 'exceptional circumstances', so the applicant should explain how that requirement is satisfied when requesting an extension under R147 to request examination.</p>
<p>7. Any other business</p>	<p>IPONZ has had some issues with their soft phones when examiners work remotely. If unable to reach an examiner, and they do not respond to a voice mail, we should contact their Team Leader. MBIE are moving to using MS Teams, and expect that to resolve their phone issues.</p> <p>IPONZ was asked to specify page and line numbers when raising clarity objections to ensure precise identification of the issue.</p> <p>It was noted IPONZ typically examines a parent application and any divisional application(s) at the same time, regardless of when examination of each was requested. This is a departure from the usual order of examination. In many cases, this does not lead to more efficient examination. An applicant is then required to address issues simultaneously on both applications, instead of being able to resolve the issues on one application and then make amendments to adopt a similar approach on the other applications, which would simplify examination of the other application.</p>
<p>8. Next meeting/upcoming meetings</p>	<p>Aiming for October/November 2020, after release of the exposure draft of the IP Laws Amendment Bill.</p>

Any other points of Discussion	Comments
1.	Simon Pope has resigned his position as Manager Patents and Designs at IPONZ to take up a role as Enforcement Manager at the Overseas Investment Office starting late July 2020. He expects one of the examination Team Leaders to be appointed acting Manager, pending a permanent appointment to the role.
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