

Summary of IPONZ Technical Focus Group

Patents

Date of Meeting: 12 November 2020

Present

IPONZ/MBIE Policy

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

TFG members

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), Laura Hollingsworth (Catalyst), John Landells (FB Rice)

Agenda Items	Comments
1. Review of Previous Meeting Action Points	
2. IPONZ update	<p>IPONZ is currently recruiting five new examiners (three for the science team and two for the engineering team) to start in January 2021. This will take their total number of examiners to 66.</p> <p>For internal management purposes, the science team will be split into three: biochemistry; biotechnology; and chemistry.</p> <p>IPONZ has changed the way they calculate their patent examination timeframes, and no longer include those applications examined under the GPPH in the calculated average.</p> <p>The timeframe for examination by the ICT and electrical teams is decreasing, as it is for the mechanical team. The science team had has the greater number of new examiners, and their timeframe for examination is beginning to stabilise.</p> <p>IPONZ has around 490 applications pending under the Patents Act 1953. Around 30 are awaiting a first examination report, and there are around 120 pieces of mail awaiting action.</p> <p>IPONZ has almost completed their project to refresh their letters, including those from the PCT Receiving Office.</p> <p>Since the Patents Act 2013 came into force, eight applications have been referred to the Māori Advisory Committee.</p>

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	<p>Objections were subsequently raised against two of those applications. No response was filed for either application, both of which have now lapsed.</p> <p>IPONZ explained the recent service outage (on 29 October 2020) was due to an issue with the server configuration settings for several of MBIE's business registries. They expected the issue to be resolved more quickly than it was. 24 cases (20 of which were patent cases) were manually managed the next day. If they have an outage, IPONZ will accept filings by email. IPONZ then asks that the documents be uploaded as normal when the system is back online, and IPONZ will then manually backdate the filing date.</p>
<p>3. MBIE policy update</p>	<p>IP Laws Amendment Bill</p> <p>The policy decisions for the IP Laws Amendment Bill were made by the Cabinet Economic Development Committee in June 2020. The cabinet paper has now been released.</p> <p>MBIE hope to have drafting instructions for the Parliamentary Counsel Office completed by the end of the year. They then expect to release an exposure draft in March/April 2021.</p> <p>The Copyright Act review is progressing. MBIE are preparing an options paper, and a discussion paper, which seeks to develop the objectives for the review. MBIE hopes to release the latter in early 2021.</p> <p>The remaining cabinet decisions required as part of the PVR review are likely to be made in early 2021.</p> <p>FTA negotiations with the EU and the UK are ongoing. MBIE expects that, once concluded, those agreements will lead to changes to New Zealand's IP laws.</p>
<p>4. Draft Guidelines review and discussion</p>	<p>Restoration (Simon M)</p> <p>IPONZ provided an updated draft of these guidelines, which incorporated feedback from the last Patents TFG meetings. The Group provided further feedback.</p> <p>Section 43 – Deposit requirements for m/orgs (Simon M)</p> <p>IPONZ proposed amending these guidelines to include hyperlinks to relevant information. The Group provided additional feedback.</p>

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	<p>PCT National Phase Entry (Warren C)</p> <p>IPONZ proposed amending these guidelines to include hyperlinks to relevant information. The Group provided additional feedback.</p> <p>Section 9 – Disclosure to be disregarded (Warren C)</p> <p>This is a proposed new guideline. The Group provided feedback.</p>
<p>5. Practice queries and discussion</p>	<p>Authorisation of agent (Reg.40) (David N)</p> <p>IPONZ’s policy regarding Authorisations was queried in view of the difficulties of obtaining an Authorisation of Agent in the current pandemic. Particularly in view of regulation 40, which specifies the Commissioner <u>may</u> require the applicant to file a written authority in respect of the agent.</p> <p>IPONZ will consider the issue, as part of a wider project investigating the robustness of their identity verification procedures.</p> <p>Divisional examination practice (parallel vs staggered) (David N)</p> <p>Regulation 76 requires the Commissioner to examine applications in the order in which examination is requested. Regulation 77(1)(a) empowers the Commissioner to advance the order of examination to ‘expedite the business of IPONZ’.</p> <p>Practice among the examination teams varies as to whether they will examine a divisional and parent at the same time, regardless of the relative timing of the request for examination of each application. IPONZ is more likely to examine the applications separately. However, if an applicant has filed requests for examination at different times, and would like to have both applications examined at the same time, they should call an examiner.</p> <p>IPONZ noted that it is possible to request a refund of the examination fee if an application is subsequently abandoned before any examination work has begun. Such requests are, however, dealt with on a case by case basis.</p> <p>Threshold for public interest/directing to request exam (Reg 74)</p>

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	<p>Section 64(5) requires the Commissioner to direct the applicant to request examination if any person requires the Commissioner to do so in the prescribed manner under s64(3). Regulation 74 sets out the prescribed manner, which requires: the person to identify the nature of the public interest in which the applicant can be directed to request examination; or the person to describe the special circumstances that make it desirable that the applicant be directed to request examination.</p> <p>IPONZ was asked to clarify what threshold they will apply to the 'public interest' requirement in r74.</p> <p>Excess claim fee payments (Duncan dG)</p> <p>Upon issuing a notice of acceptance for an application for which excess claims fees are due, IPONZ sets a task with a three month deadline to pay those fees. If that task is not satisfied by that three month deadline, another task with a three month deadline will be created, and so on. If the excess claims fees are not paid, the application will not be granted, but the application will not lapse for failure to pay the excess claims fees by the task deadline.</p> <p>2013 Act responses filed within the last 20 working days before acceptance (Duncan dG)</p> <p>IPONZ repeated past advice that applicants/agents filing responses close to the final acceptance deadline should telephone the examiner. IPONZ will not, however, commit to any expedited review of such applications, only that they will aim to meet their 20 working day correspondence target.</p>
6. Any other business	
7. Next meeting/upcoming meetings	Not discussed

Any other points of Discussion	Comments
1.	None