

Summary of IPONZ Technical Focus Group

Patents

Date of Meeting: 28 April 2021

Present

IPONZ/MBIE Policy

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

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), David Koedyk (Catalyst), John Landells (FB Rice)

Agenda Items	Comments
1. Review of Previous Meeting Action Points	<p>There has been discussion about whether s8(2) documents fall within the scope of s9 – that is, whether the grace period in s9 can be used to exclude a ‘whole contents’ novelty citation. There have been no Commissioner’s decisions on this issue, and IPONZ has not developed any Guidelines, because the issue has not yet come up.</p> <p>IPONZ confirmed that an agent will generally now not be required to file an authorisation of agent. The agent must, however, confirm that they are authorised to act by the applicant.</p> <p>IPONZ advised that a system update later this year will make the primary examiner visible to the case contact.</p> <p>In reply to a question, IPONZ advised that referral to the Maori Advisory Committee (MAC) has resulted in objections being raised against two applications to date. They were, however, unable to identify the two applications. IPONZ plan to use case studies from the MAC as the basis for some draft Guidelines.</p>
2. IPONZ update	<p>Recruitment</p> <p>Five new examiners started in January 2021, bringing the examination team to a total of 64. IPONZ hopes to have another recruitment round this year, but have not yet received approval.</p> <p>Backlogs and pendency times</p> <p>IPONZ confirmed that the timeframes on their website are the average total time from requesting examination to issuing the</p>

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	<p>first examination report. These timeframes are not in addition to the target timeframe of three months.</p> <p>IPONZ will reinstate the information advising that the target timeframe for expedited examination, e.g. under the GPPH, is two months.</p> <p>IPONZ confirmed that a GPPH request can be made after requesting examination. They will, however, decline the request if the application is already allocated to an examiner and in their queue because, if so, an examination report should issue within the next 20 working days.</p> <p>If a GPPH request is filed before the s52(1) examination eligibility date, then the box requesting examination before that date should also be ticked. This should be mentioned in the Guidelines relating to early national phase entry.</p> <p>As at 20 April 2021, there were 420 PA1953 applications under examination. Within the Biotech team, 25 PA1953 applications are unexamined, and around 130 pieces of mail are awaiting action. IPONZ hopes to reduce the backlog of PA1953 applications next year.</p> <p>Systems updates</p> <p>The unplanned outages in December 2020, February 2021 and March 2021 each occurred for different reasons related to platform stabilisation issues. Various performance issues have been identified, and these relate to optimisation of systems between different vendors.</p> <p>Platform upgrades are now largely complete, with no significant additional upgrades expected in the next two to four years.</p> <p>The Department of Internal Affairs is managing an upgrade of the RealMe system.</p> <p>There have been issues with EPO/WIPO data supplies from IPONZ. IPONZ sends acceptances etc. to EPO monthly, but has sent none since November 2020. WIPO's Patent Scope also now includes information from IPONZ.</p> <p>A data corruption issue occurred in December 2020. Paragraph and end of line characters were removed from inventor information. The data is still in the IPONZ system, and IPONZ</p>

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	<p>are working with their vendors to backup and restore data.</p> <p>As regards planned changes, IPONZ is working on agent identity improvements to drive efficiency and integrity of their system. Phase 1 will involve users having one account per person, with no shared logins. IPONZ also plans to develop team accounts, enabling them to link members of a firm, and administrator accounts (these will have 'super user' powers). IPONZ expects to bring in the first changes in July 2021.</p> <p>Patent data management improvements are directed to the management, storage and reporting of data. IPONZ hopes to user data analytics and reporting to improve examination efficiencies. Matters being considered include:</p> <ul style="list-style-type: none"> • adding a title page to specifications downloaded from IPONZ • citations • WIPO standard sequence data management • WIPO standard data exports • specification re-modelling. <p>A question was asked about the information on New Zealand national phase entries appearing in PatentScope only after acceptance of the New Zealand application, whereas they appear earlier for applications entered into national phase elsewhere. IPONZ advised that was an issue for WIPO.</p> <p>World IP Day</p> <p>IPONZ now have financial approval from MBIE co-host an event on 17 May 2021 relating to the theme 'IP and SMEs – Taking your ideas to market'. IPONZ will invite on-line registrations in the next few days.</p>
<p>3. MBIE policy update</p>	<p>IP Laws Amendment Bill</p> <p>MBIE are still preparing drafting instructions for the Parliamentary Counsel Office and hope to have them completed within the next month or so. They then expect to release an exposure draft in later in 2021. This bill is, however, a relatively low priority.</p> <p>Other matters</p> <p>The PVR Bill is expected to be introduced to parliament in the</p>

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	<p>first half of May 2021 (<i>postscript</i> – the Bill had its first reading on 19 May 2021).</p> <p>The Copyright Act review is progressing slowly. Several MBIE staff have been diverted to other areas of work, mainly serving government bills that are currently going through parliament.</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 TFG provided further feedback.</p> <p>IPONZ noted that a request to extend the deadline for requesting examination can be considered together with a request for restoration. But if the five year deadline has passed in addition to, e.g. a maintenance fee deadline, then both deadlines must be dealt with in the request, because an application does not currently lapse due to failure to request examination by the five year deadline.</p> <p>In some cases, an application will have lapsed <u>after</u> the five year deadline for requesting examination has passed. If so, a request under r147 should be filed together with the request for restoration.</p> <p>Regarding ‘undue delay’, reference was made to a recent IPONZ decision: <i>Marley New Zealand Limited</i> [2021] NZIPOPAT 1 (24 March 2021).</p> <p>Regulation 147</p> <p>A request will either be accepted or refused, although in some cases there has been informal dialogue by telephone to clarify matters relating to the request.</p> <p>Upcoming work</p> <p>IPONZ plans to review and improve the guidelines relating to methods of diagnosis and those relating to s51.</p> <p>In addition, the discussion of ‘reach-through’ claims in the s39 guidelines (see paragraph 77) may be deleted (this will not result in any change in practice).</p> <p>IPONZ will also review the Swiss-type claims guidelines soon.</p>

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5. Practice queries and discussion	<p>S8(2): Definition of prior art</p> <p>An issue has arisen as to whether a PCT international application that has not entered national phase in New Zealand is able to be cited under s8(2). IPONZ advised there is a hearing in the pipeline regarding this issue.</p> <p>ePCT rendering of drawings</p> <p>An issue has arisen with IPONZ as the Receiving Office objecting to. In some cases, the issues can be resolved by printing the drawings, scanning them in black and white and then refiling them. It was noted this seems quite onerous/inefficient.</p> <p>When electronically filing through ePCT the drawings can be viewed as they would be rendered. The document can also be validated against ePCT requirements using a pdf conversion checker. Warren will send the link.</p> <p>Other options include sending the documents in pre-conversion format (if the Receiving Office will accept them) by attaching them in the 'accompanying items' screen.</p> <p>Request for expedited examination under GPPH after 5 year request for examination deadline</p> <p>After the five year deadline has passed, the GPPH request tick box disappears, even if examination has been requested. IPONZ will look into a system change. In the meantime, we should contact the examiner/team leader by telephone and file the required documents by email.</p>
6. Any other business	IPONZ plans to initiate a Designs Technical Focus Group
7. Next meeting/upcoming meetings	Not discussed

Any other points of Discussion	Comments
1.	None