

## Summary of IPONZ Technical Focus Group

Patents

Date of Meeting: 6 December 2021

Present

### IPONZ/MBIE Policy

Gaby Cowcill, Simon Maguire, Warren Coles, Jenny Jebson, Monique Cardy, Sean Uy, ,  
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), Laura  
Hollingsworth (Catalyst), John Landells (FB Rice)

Agenda Items	Comments
<b>1. Review of Previous Meeting Action Points</b>	<p>IPONZ has been liaising with IP Australia in their capacities as PCT Receiving Offices regarding the treatment of drawings. Both IPONZ and IPAU are feeding back to WIPO about improving and updating the drawings tools in view of the strict requirement that drawings be black &amp; white. IPONZ try and take a pragmatic approach and not object if the drawings are understandable and the features are clear.</p> <p>IPONZ team leaders, principal examiners and the Quality Assurance team have been discussing ways to improve examination efficiencies.</p> <p>IPONZ is interested in pursuing a bilateral PPH agreement with the EPO, but that has not progressed.</p> <p>There has been no change to IPONZ policy regarding refunds of official fees. Any change would require an IPONZ-wide approach.</p> <p>IPONZ are developing a task-based workflow for GPPH requests, similar in concept to the workflow for handling restoration requests. They hope to include it in the software enhancement after the next release, which is due to be in February 2022.</p> <p>IPONZ are also looking to improve the visibility of applications that have been referred to the Maori Advisory Committee (MAC), most likely via the search function in the database.</p>

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<p><b>2. IPONZ update</b></p>	<p><b>Recruitment</b></p> <p>The large intake of new examiners that started in August 2021 have now completed their initial training and have joined examination teams. IPONZ is planning further recruitment in early 2022.</p> <p><b>Backlogs and pendency times</b></p> <p>The 'Facts and figures' section on IPONZ's website (under 'About us') includes information about IPONZ filing volumes. The 2020/2021 'Year in review' document will also include information about backlogs and pendency times.</p> <p>In response to a question regarding the output of first examination reports from the science teams, IPONZ advised that they have had a higher than usual volume of mail to process. There has also been some diversion of staff from IPONZ to support the MBIE-wide COVID response, but not from the science examination teams. The COVID extensions have led to a lot of cases having similar response deadlines and/or final acceptance deadlines.</p> <p>As at 3 December 2021, there were 380 PA1953 applications under examination. Dealing with a number of older cases has also reduced the output of PA2013 first examination reports from the science teams.</p>
<p><b>3. MBIE policy update</b></p>	<p><b>IP Laws Amendment Bill</b></p> <p>MBIE have received an initial draft and the policy team have provided comments to the MBIE legal section to prepare drafting instructions for the Parliamentary Counsel Office. The MBIE legal section are, however, also dealing with a large volume of COVID response work. MBIE hope to release an exposure draft in early 2022. This bill, however, remains a relatively low priority.</p> <p><b>Other matters</b></p> <p>The PVR Bill has been reported back by the Select Committee and is currently at 19 on the Provisional Order Paper for 7 December 2021. However, with only six more sitting days, the Bill is unlikely to pass in 2021. MBIE hope that the Bill will pass in February/March 2022, and are still aiming for it to come into force in June 2022.</p>

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	<p>The policy decisions for the PVR Regulations went through Cabinet on 24 November 2021. The MBIE legal section are preparing drafting instructions, MBIE hope to release an exposure draft of the regulations in February/March 2022.</p>
<p><b>4. Stakeholder Engagement update</b></p>	<p>IPONZ would like to receive feedback on what information/analytics would be helpful for their stakeholders. As noted above, the 'Facts and figures' section on IPONZ's website (under 'About us') includes information about IPONZ filing volumes, which is updated monthly.</p> <p>Pendency information is updated quarterly.</p> <p>It was noted that more rapid communication would be helpful in some circumstances, e.g. the recent situation where void notices were erroneously issued on a number of cases because of a change in status on the related hearings cases.</p>
<p><b>5. Draft Guidelines review and discussion</b></p>	<p><b>Section 67 - Applicants must act by deadline if deadline set by Commissioner (update) (Simon M)</b></p> <p>IPONZ provided an updated draft of these guidelines, which incorporated feedback from the last Patents TFG meeting. The TFG provided further feedback.</p> <p><b>Regulation 38 – 44 Change Agents (Jenny J)</b></p> <p>The TFG provided feedback.</p> <p><b>Sections 129 and 165 Ownership changes (Jenny J)</b></p> <p>The TFG provided feedback.</p>
<p><b>6. Practice queries and discussion</b></p>	<p><b>Parent-divisional overlap in view of <i>Oracle</i></b></p> <p>It was noted that the IPONZ guidelines on parent/divisional overlap required further amendment in view of <i>Oracle</i>. IPONZ has deferred consideration of that decision in the hope that the IP Laws Amendment Bill may resolve at least some of the issues. However, the pace of progress of that Bill suggests that strategy may need to be revisited.</p> <p><b>Designs representations</b></p> <p>The IPONZ system only allows the filing of designs representations in .jpg or .gif format. Representations cannot be filed in .pdf format, unlike many other offices. IPONZ explained this is because they follow WIPO standard ST88.</p>

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	<p>Extracting and converting images from pdf documents may lead to errors etc.</p> <p><b>Request IPONZ provide links to new citations</b></p> <p>Often , IPONZ cites prior art that has been cited by other offices and/or during international phase. However, where IPONZ cites a new document, it would be helpful if the examination report provides a link or other source information. IPONZ are currently working on how they store citation information in their database, but copyright issues are also relevant.</p>
7. Any other business	Following the acquisition of Baldwins by AJP, there is a vacancy on the Patents TFG. IPONZ suggested an in-house representative would be appropriate.
8. Next meeting/upcoming meetings	It was suggested that the Patents TFG should meet four times per year. The next meeting is tentatively scheduled for Tuesday, 29 March 2022

Any other points of Discussion	Comments
1.	None