

Summary of IPONZ Technical Focus Group

Patents

Date of Meeting: 23 August 2021

Present

IPONZ/MBIE Policy

Gaby Cowcill, Simon Maguire, Warren Coles, Monique Cardy, 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
1. Review of Previous Meeting Action Points	<p>The restoration guidelines and Regulation 147 guidelines have been published on the IPONZ website. There was no communication advising of this due to COVID communication priorities within MBIE.</p> <p>IPONZ updated the information on their 'Timeframes' webpage recently, and it now includes GPPH timeframes, which are not yet on the GPPH webpage.</p> <p>IPONZ is working on a solution to enable users to identify applications that have been referred to the Maori Advisory Committee (MAC). Comments will be included in the upcoming IPONZ 'Year in Review' report.</p> <p>IPONZ is awaiting a decision on the scope of s8(2) documents ('whole contents' novelty citations).</p> <p>IPONZ has reviewed the PCT applications in which the drawings have been rejected for not being clear, or for being unable to pick out the relevant features of the drawings. They consider their approach is not overly restrictive. IPONZ noted that it can be more difficult to resolve issues with the drawings during national phase due to the risk of 'added matter' objections.</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 their next system update will enable the</p>

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	<p>case contact to view the primary examiner, and will also enable a request for examination made within the five year deadline to be supplemented with a GPPH request made after expiry of the five year deadline. This update has, however, been delayed due to the current COVID situation.</p>
<p>2. IPONZ update</p>	<p>Recruitment</p> <p>The new examiners that started in January 2021 have now joined the examination teams. IPONZ have also recruited a further 7 new examiners who started in August, together with a new formalities team member, bringing the examination team to a total of 71.</p> <p>Simon Maguire and Simon Reeve have both been appointed Principal Examiners.</p> <p>Backlogs and pendency times</p> <p>The February 2020 examination ‘bump’ has been cleared in the electrical and engineering teams.</p> <p>There are 397 PA1953 applications under examination, most of which are with the Biotech team. Several team members have now completed training on PA1953 examination.</p> <p>Patents Māori Advisory Committee</p> <p>IPONZ have been working on addressing some administrative obstacles.</p> <p>Third party report on innovation in NZ</p> <p>IPONZ commissioned Clarivate to produce a report on innovation in New Zealand. That report is now complete and published on the IPONZ website.</p> <p>Other matters</p> <p>There has been an issue with the format of some data in the IPONZ database, which removed spaces from inventor names. They have exhausted the options with their vendor, so no convenient solution is available. Requests to correct these can be made on a case-by-case basis using the ‘Maintain client’ feature.</p> <p>IPONZ’s data link with the EPO is live again. IPONZ is discussing</p>

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	the possibility of a bilateral PPH agreement with the EPO
3. MBIE policy update	<p>IP Laws Amendment Bill</p> <p>This is still with the drafter at the Parliamentary Counsel Office. There is no estimated date for completion, but MBIE hope to have it completed by the end of the year.</p> <p>Other matters</p> <p>The PVR Bill is now in the Select Committee process. 17 oral submissions are expected, with 4 due to be presented this week. MBIE is unsure whether they will be able to go ahead.</p> <p>A departmental report then needs to be prepared for the committee to report back in late October or early November.</p>
4. Draft Guidelines review and discussion	<p>Regulation 82</p> <p>The recent <i>Ganymed</i> and <i>Oracle</i> decisions are relevant to IPONZ practice. In particular, <i>Ganymed</i> has substantially changed IPONZ practice as set out in the current r 82 guidelines, which necessitated changes be made as soon as possible. The revised guidelines do not discuss <i>Oracle</i> in much detail, IPONZ plans to expand that discussion in the future. IPONZ does not plan a practice change to allow claims that are ‘wholly within’ the claims accepted on another application, despite the ‘double infringement’ test set out in <i>Oracle</i>.</p> <p>As the requirements of r 82 are not discretionary (compare r23(2) PR1954), it was suggested IPONZ must be certain claims should not be allowed before objecting under r82.</p> <p>Section 67</p> <p>There was general agreement with the draft guidelines. IPONZ explained that an applicant who files two non-substantive responses risks the application being refused.</p> <p>Section 39</p> <p>There were no comments against IPONZ proposal to delete paragraph 77.</p>
5. Practice queries and discussion	<p>Discussion focusing on IPONZ’ backlog</p>

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	<p>IPONZ is adopting a systems approach to increase the number of examinations to try and reduce their examination backlog. They sought feedback on what further efficiencies could be achieved during examination. For example, IPONZ is considering issuing a reminder of the upcoming 5 year deadline to request examination and inviting the applicant to file claims that have been accepted overseas.</p>
<p>6. Any other business</p>	<p>Designs – Authorisations of agent</p> <p>There are only certain circumstances in which an authorisation of agent can be filed for a design. This is a systems issue. The amendment/alternation function is not intended to provide a mechanism for filing an authorisation of agent. IPONZ is investigating how best to change their system. In the meantime, if requested to do so, the examiner can create an open discussion to facilitate the filing of an authorisation of agent.</p> <p>GPPH issues</p> <p>IPONZ is declining GPPH requests without providing the applicant an opportunity to respond and rectify any issues. IPONZ can open a discussion in some circumstances to allow a response to be filed. IPONZ has a pending request for a systems enhancement to facilitate dialogue for GPPH requests.</p>
<p>7. Next meeting/upcoming meetings</p>	<p>6 December 2021</p>

Any other points of Discussion	Comments
<p>1.</p>	<p>None</p>