

Summary of IPONZ Technical Focus Group

Patents

Date of Meeting: 29 March 2022

Present

IPONZ/MBIE Policy

Gaby Cowcill, Simon Maguire, Warren Coles, Jenny Jebson, Monique Cardy, Sean Uy, Rob Garrett, Warren Hassett (MBIE Policy)

TFG members

Doug Calhoun (NZ Law Society), Laura Hollingsworth (Catalyst), John Landells (FB Rice), Jonathan Lucas (James and Wells), David Nowak (Henry Hughes), Tom Robertson (Pipers), Scott Sonneman (DCC), Duncan de Geest (AJ Park)

Agenda Items	Comments
1. Review of Previous Meeting Action Points	<p>Updates to the section 39 (Contents of complete specifications) and section 67 (Applicants must act by deadline if deadline set by Commissioner) parts of <i>The Patent Examination Manual</i> have now been published.</p> <p>Some updates have been made to the Changing owner/agent sections of the Manual and these are almost ready to be published.</p> <p>There have been issues with links to cases in emails from IPONZ not working. This is connected to issues with RealMe. These were expected to be fixed in the latest systems release (this week). Unfortunately, they were withdrawn because the fixes interfered with other things. These issues are now expected to be fixed in the next release due in July 2022.</p> <p>The patent aspects of the latest release are more focussed on internal-facing matters to assist examiners. A task-based GPPH workflow is also scheduled for a future release, as is an update to improve the visibility of applications that have been referred to the Maori Advisory Committee (MAC).</p> <p>IPONZ continues to liaise with IP Australia in their capacities as PCT Receiving Offices regarding the treatment of drawings.</p> <p>The issue regarding designs representations and the use of WIPO standard ST88 remains outstanding.</p>

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<p>2. IPONZ update</p>	<p>Recruitment</p> <p>There has been a reasonable turnover of staff at IPONZ. The most recent recruitment round is the largest that any one can recall. They currently have around 60 examiners and have approval to recruit a further 20, with the aim of achieving a total examiner workforce of around 75. IPONZ hopes that the opening of the border will mean they can again benefit from recruiting examiners with overseas experience.</p> <p>Backlogs and pendency times</p> <p>Pendency times continue to increase. The most recent update to the examination timeframes reflected a change in the way these are calculated so they continue to remain useful even when approaching the end of the three month update cycle.</p> <p>1953 Act numbers update</p> <p>There are 364 PA1953 applications under examination. Most have tasks currently with IPONZ.</p> <p>Strategic review</p> <p>IPONZ is working on a strategic capability review of IP needs. The review is looking at what IPONZ's role in the IP regime will be, with a 5-10 year timeframe. IPONZ have sought views from various stakeholders, and the review will likely involve subsequent communication and consultation. The review will inform plans for the planned refreshment/replacement of IPONZ's case management system, which is 10 years old, in around 3 years.</p> <p>System changes</p> <p>The current systems release (30 March 2022) is expected to include a new teams account function. This will be particularly relevant to firms with large numbers of users and cases and assist them to optimise their set up. IPONZ will notify the changes made in this release later this week.</p> <p>In response to a question, IPONZ will check whether any progress has been made in getting Hearings Office documents on-line.</p>
<p>3. MBIE policy update</p>	<p>IP Laws Amendment Bill (IPLAB)</p> <p>The minister has decided that, due to the limited</p>

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	<p>parliamentary time available to him, the IPLAB will not proceed this year, at least. MBIE have expressed an interest in presenting the minor/technical amendments that were planned for the IPLAB in a regulatory systems bill that is likely to proceed late-2022 or early-2023. The Cabinet Paper for the IPLAB indicates what amendments are considered minor/technical. These are generally not contentious, e.g. the changes to deal with the status of applications for which a request for examination has not been filed within five years from the complete specification filing date. The changes dealing with divisional applications, on the other hand, are considered contentious.</p> <p>Other matters</p> <p>MBIE is still awaiting a second reading of the PVR Bill, which was at 12 on the Final Order Paper for 31 March 2022.</p> <p>An exposure draft of the PVR Regulations and a discussion document on PVR fees are likely to be released later in April 2022, both with a 5-6 week consultation period.</p> <p>The minister has paused the Copyright Act review. Some changes to the Copyright Act will be made as part of the UK Free Trade Agreement (FTA). If a FTA is concluded with the European Union, that would likely require substantial changes to the Copyright Act and the Geographical Indications regime.</p>
<p>4. Draft guidelines review and discussion</p>	<p>New standard for presenting biological patent sequence listings (ST.26) (Simon M)</p> <p>IPONZ provided a draft new article.</p> <p>It was noted that there is nothing in the Patents Act or Patents Regulations to enable IPONZ to require filing of a separate sequence listing document in XML format. IPONZ will recommend the filing of sequence listings that meet the Standard ST.26, and understand they cannot mandate that.</p> <p>IPONZ plan to make any XML sequence listing filed publicly available when an application is made open to public inspection.</p> <p>There was discussion as to whether a separate sequence listing in XML format is part of a complete specification.</p>

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<p>5. Practice review and discussion</p>	<p>Double patenting</p> <p>The most recent <i>Taiho</i> decision includes comments about double patenting. IPONZ are currently working through their internal change control processes, but expect they will no longer raise double patenting objections under s14 (manner of manufacture/generally inconvenient).</p> <p>IPONZ is preparing a revised guideline regarding r82 (patent-divisional overlap) for discussion at the next Patents TFG meeting. The revised guideline will take account of <i>Oracle</i> and <i>Taiho</i>. IPONZ had deferred revising that guideline in view of the expected progress of the IPLAB, but with the apparent demise of that bill will now proceed with preparing a draft.</p> <p>IPONZ expect they will no longer raise objections when divisional claims are wholly encompassed by, but not identical to, parent claims or <i>vice versa</i>. Again, IPONZ's internal change control processes are relevant; any change in practice will occur with publication of the revised guideline.</p>
<p>6. Any other business</p>	<p>IPONZ's approach to the requirement that claims be concise, and its application of <i>Bancroft</i> to applications with multiple independent claims was discussed.</p> <p>The use of general powers of attorney was discussed. In general, a cover letter identifying the specific applications for which the general power of attorney is being relied on should also be filed.</p> <p>IPONZ's practice regarding re-examination was discussed, in particular whether the original examiner should conduct the re-examination. IPONZ's procedures currently only exclude associate examiners from conducting re-examinations.</p> <p>IPONZ was asked what evidence, if any, a third party would be required to file for the Commissioner to direct an applicant to request examination – see s64(3) and r74.</p> <p>The requirement for 'good and substantial reasons' for requesting expedited examination was also discussed. Requests under r77 'must be accompanied by evidence in support of the request'. All such requests are review by an IPONZ team leader. IPONZ advised that the threshold for 'good and substantial' reasons is likely lower than what they have been applying.</p>

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	<p>IPONZ is in active talks with the EPO regarding a bilateral PPH agreement. IPONZ is currently awaiting a document from the EPO.</p> <p>Maori Advisory Committee (MAC) guidelines are a work in progress for IPONZ, but they are not a high priority because they have some significant administration issues to work through first.</p>
7. Next meeting/upcoming meetings	The next meeting is tentatively scheduled for Tuesday, 28 June 2022

Any other points of Discussion	Comments
1.	None