

Summary of IPONZ Technical Focus Group

Patents

Date of Meeting: 28 June 2022

Present

IPONZ/MBIE Policy

Rebecca James, Edward Barclay, Simon Maguire, Chloe O'Shea, Matthew Allen, Emma Stares, Steve Smith, Irina Minyukhina (minutes), Warren Hassett (MBIE Policy)

TFG members

Doug Calhoun (NZ Law Society), 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 & matters arising	<p>The change of agent/change of name guidelines have been finalised and published.</p> <p>The ongoing RealMe issues should be resolved in the next release scheduled for 1 July 2022.</p> <p>IPONZ is continuing their work to develop workflows for GPPH requests and referrals to the Maori Advisory Committee (MAC).</p> <p>The issue regarding designs representations and the use of WIPO standard ST88 remains outstanding.</p>
2. IPONZ update	<p>Distributed prior to meeting</p> <p>Recruitment/People movement</p> <p>Simon Gallagher has resigned from his role as National Manager, IPONZ to take up a new role within MBIE.</p> <p>Recruitment for the new National Manager role has concluded, with Becky White joining IPONZ in August.</p> <p>Rebecca James is currently Acting Manager, Patents and Designs until August.</p> <p>Warren Coles and Simon Reeve have taken up new roles as Assistant Commissioners in the hearings team.</p> <p>Within the Patents team, there has been a heavy focus on recruitment as we look at putting a new organisation structure</p>

Agenda Items	Comments
	<p>in place and then looking at filling the remaining Patent examiner vacancies.</p> <p>Matt Allan (Chemistry), Daniel Sanson (Mechanical), Lizzy Eden (Biotech), Ed Barclay (ICT/Electrical) and David Rotherham (Biotech) have all been appointed as team leaders.</p> <p>11 new associate examiners joined the team in April, with further recruitment planned for the next quarter.</p> <p>Pendency Times</p> <p>With the current training and future recruitment planned, the pendency time in all technology areas is increasing. These were last updated in May and are available on the IPONZ website.</p> <p>May 2022 saw the highest number of actions this year with 564 examination tasks (first examination and correspondence inclusive across all Patent types). May also saw the highest individual tech team output in the Mechanical, ICT/Electrical and Chemistry teams.</p> <p>1953 Act update</p> <p>There were 339 cases remaining as of 8 June 2022, all of these are divisional applications and roughly half are Biotech cases.</p> <p>Systems update</p> <p>IPONZ is currently developing a work flow task for expedited examination requests to move away from the current discussion system to a letter and task based workflow. We are hopeful that this will be included in the next release in August.</p> <p>Discussed in meeting</p> <p>Recruitment and Backlogs & pendency times</p> <p>There are currently 73 people in the patents examination team, including 70 examiners and three IP support officers. Around 40% of examiners are training, so IPONZ are under a significant training burden. IPONZ is aiming to have 99 people in the patents examination team (96 examiners plus 3 IP support officers).</p> <p>IPONZ is aware of the current examination pendency issue, but don't feel they can address that other than by increasing staff numbers. IPONZ is not expecting any decrease in pendency</p>

Agenda Items	Comments
	<p>time for the next 12-18 months, and the pendency times could increase in the meantime. The chemistry and biotech team s are still working through, but coming to the end of, the February 2020 examination fees change bubble of examination requests.</p>
<p>3. MBIE policy update</p>	<p>IP Laws Amendment Bill (IPLAB)</p> <p>The IPLAB remains on hold.</p> <p>MBIE are seeking cabinet approval to draft amendments to be included in the next Regulatory Systems Bill (Regulatory Systems Bill 4). This is not expected until mid-2023.</p> <p>Subsequent to the Patents TFG Meeting, MBIE provided an update to NZIPA of the issues they have proposed for inclusion in the Regulatory Systems Bill 4. Regulatory Systems Bills are intended for relatively minor technical issues. The more substantive issues proposed for the IP Laws Amendment Bill, such as changes to divisional practice, are not suitable for inclusion in a Regulatory Systems Bill. The proposed issues are (trade marks and designs matters included for completeness):</p> <p>Patents Act 2013</p> <ul style="list-style-type: none"> • Provide that if a request for examination is not filed within the prescribed time, the application is deemed to be abandoned. • Provide that a divisional patent application must be accompanied by request for examination. • Amend s254 to clarify that documents that would be kept confidential under s91 of the Patents Act 1953 remain confidential. • Provide that the abstract must not be used for interpreting the nature of the invention. • Provide that, where two or more patent applications for the same invention are filed by the same applicant or their successor in title, and the applications have the same priority date, only one of the applications can be granted a patent. • Amend s8(2) to clarify that, where two patent applications are filed by the same or different

Agenda Items	Comments
	<p>applicants describing the same invention , and one of the inventions is published on or after the priority date of the other, only the application with the earlier priority date can be granted a patent (i.e change “after” in section 8(2)(b) to read “on or after”).</p> <ul style="list-style-type: none"> Amend s 199(e) clarifying the scope of the regulation making powers in respect of the border protection measures applying to both imports and exports of infringing good (MBIE has prior approval to include this minor amendment). <p>Trade Marks Act 2002</p> <ul style="list-style-type: none"> Allow for partial refusals of national (i.e. non-Madrid) trade mark applications, where the applicant does not respond to a notification issued under section 41 of the Act within the time set by the Commissioner of Trade Marks. Require that trade mark specifications of goods be clear. Repeal the requirement that only an “aggrieved person” can apply to revoke or invalidate a trade mark. <p>Designs Act 1953</p> <ul style="list-style-type: none"> Provide for substitution of applicant, with procedures based on the corresponding provisions in the Patents Act 2013, and the Patents Regulations 2014. Provide that information or documents required to be filed with the Commissioner of Designs be filed through the IPONZ case management facility. Allow the Commissioner of Designs to serve, or give information or a document to a person by using a prescribed electronic delivery means or other means that are reasonable in the circumstances. Allow the Commissioner of Designs or the courts to require any party to legal proceedings under the Act to give security for costs under the proceedings in appropriate circumstances. Provide that before the Commissioner makes a decision

Agenda Items	Comments
	<p>involving the exercise of the Commissioner’s discretion, and person adversely affected by that decision must be given an opportunity to be heard.</p> <ul style="list-style-type: none"> • Remove the requirement for an authorisation of agent to be filed with an application for registration, or in connection with proceedings under the Designs Act. The requirement would be replaced with an approach consistent with the approach taken under the Patents Act 2013, and the Trade Marks Act 2002. • Amend the Designs Act to provide for regulations setting out the procedural and evidential requirements for proceedings before the Commissioner of Designs. The proposed provisions could be modelled on the provisions in Parts 3 and 6 of the Patents Regulations 2014. <p>Plant Variety Rights</p> <p>The PVR Bill is awaiting consideration by the Committee of the whole House (this was at number 30 on the Order Paper at the time of this meeting, and number 18 on the Order Paper for 2 August 2022).</p> <p>Other matters</p> <p>An announcement of the conclusion of a free trade agreement with the European Union is expected later this week. That agreement will necessitate amendments to New Zealand’s IP laws, with the introduction of a regime reflecting the EU’s Geographical Indications system most likely. Amendments to the Copyright Act are also likely. The MBIE policy team expects to be busy with this work for the next 12 months or so.</p> <p>Legislation implementing the UK-NZ free trade agreement has been introduced to parliament and will be referred to select committee. Submissions will be able to be made to the select committee.</p>
<p>4. Practice review and discussion</p>	<p>Section 200-202 – correcting errors or omissions in Patents</p> <p>These draft guidelines are based on a draft that was prepared in 2019. There was extensive discussion at that time, particularly in relation to adding or deleting inventors. These guidelines have been revised taking that feedback into</p>

Agenda Items	Comments
	<p>account.</p> <p>Section 165 – licences and financial interests involving Patent and Patent applications</p> <p>These are similar to the change of ownership guidelines discussed previously. A request can be made under regulation 132 to be notified when an application is granted, so that a licence can be recorded.</p> <p>Regulation 82 – Patent and divisional overlap</p> <p>There was extensive discussion of these draft guidelines. They were last updated in 2021, following the <i>Ganymed</i> decision, and these draft guidelines are intended to provide a more comprehensive consideration of <i>Oracle</i> decision.</p> <p>IPONZ will still object when the claims of a parent or divisional are wholly within the scope of another if notional rewriting of either claim set leads to a claim that is of identical scope to one in the other application.</p> <p>IPONZ considers notional rewriting is appropriate in instances where a claim can be clearly divided, for example where a claim presents a limited number of definable integers.</p> <p>There was not widespread support for the proposed approach set out in the draft guidelines. IPONZ will reconsider and further review the draft guidelines in view of the feedback provided.</p> <p>MBIE advised that the proposed Regulatory Systems Bill will include a provision amending the Patents Act to prevent two patents being granted to the same invention.</p>
5. Any other business	<p>Designs page numbering</p> <p>It was suggested that IPONZ should not object to the numbering of pages in designs applications unless that numbering creates a definite ambiguity.</p> <p>Section 8(2)</p> <p>The <i>Viking</i> decision was discussed. This decision clarifies IPONZ practice as to the art that may be cited under section 8(2). Submissions suggesting changes to that section can be made to MBIE. However, such submissions would need to demonstrate that there is a problem with the current law and that some</p>

Agenda Items	Comments
	amendment should be made to avoid a disadvantage or provide an advantage to the NZ economy.
6. Next meeting/upcoming meetings	The next meeting is tentatively scheduled for Wednesday, 21 September 2022

Any other points of Discussion	Comments
1.	None