

## Summary of IPONZ Technical Focus Group

Patents

Date of Meeting: 21 September 2022

Present

### IPONZ/MBIE Policy

Gaby Cowcill, Steve Smith, Simon Maguire, Emma Stares, Chloe O'Shea, Ed Barclay, Matt Allen, Sean Uy, Becky White, Natasha Storey (minutes), Warren Hassett (MBIE Policy)

### TFG members

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

Agenda Items	Comments
<b>1. Review of previous meeting action points &amp; matters arising</b>	<p>IPONZ has developed a workflow for GPPH requests to replace the current discussion system with tasks for deficient GPPH requests. That will permit responses to be filed with documents attached. IPONZ expects that workflow to be launched in the last Ptolemy release of 2022.</p> <p>The section 200-202 (correcting errors) and section 165 (licenses and financial interests) guidelines are being finalised and should be published very soon.</p> <p>IPONZ is continuing their work to develop guidelines for referrals to the Maori Advisory Committee (MAC).</p> <p>IPONZ was asked about public access to the documents filed etc. for assignment cases and will investigate that.</p>
<b>2. IPONZ update</b>	<p><b>Distributed prior to meeting (see appended)</b></p> <p>Additional comments were provided during meeting:</p> <p><b>Comparison to overseas offices</b></p> <p>While it is difficult to find publicly available data, the plot included in the update compares the number of applications filed (where there is no separate request for examination) or examinations requested per examiner per year for various patent offices.</p> <p><b>Approaches to IPONZ staff</b></p> <p>IPONZ expressed disappointment at direct approaches with job</p>

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	<p>offers being made to their staff, particularly Team Leaders and often during work hours at IPONZ, and consider such approaches unprofessional.</p> <p><b>1953 Act update</b></p> <p>Of the 314 pending cases, there are only 70 pieces of mail currently with IPONZ for action; so most are awaiting action by applicants. The IPONZ examination team is clearing mail at the rate of approximately 30 items per month.</p> <p><b>Pendency Times</b></p> <p>The Biotech team is the only team not yet through the February 2020 fees increase 'bubble'.</p> <p><b>PCT Receiving Office</b></p> <p>IPONZ have made significant updates to their processes in the PCT RO, mostly from an internal application processing perspective at this time, to streamline workflows.</p> <p>Following an audit, IPONZ will also be looking into how they carry out our invoicing and financial processes, and increasingly moving to working entirely in ePCT.</p> <p>IPONZ are a long way from implementing any changes yet, and will have robust testing and communications plans ahead of any changes.</p> <p>IPONZ are regularly in touch with IP Australia on this, sharing experiences and tips as well as feedback to WIPO.</p> <p><b>Queen Elizabeth II Memorial Day</b></p> <p>IPONZ has now communicated that 26 September 2022 will be a closed day.</p>
<p><b>3. MBIE policy update</b></p>	<p><b>Plant Variety Rights</b></p> <p>The PVR Bill is partway through consideration by the Committee of the whole House (at number 15 on the Order Paper on the day of this meeting). MBIE is hopeful of having the new Act enter into force by the end of the year. That would require Royal Assent by the end of October.</p> <p>The PVR Regulations are ready but cannot be presented to cabinet until the Bill passes and receives Royal Assent (because</p>

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	<p>the regulation making power is in the Bill).</p> <p>After approval by cabinet, the Regulations then need to be gazetted and cannot come into force any sooner than 28 days after being gazetted.</p> <p><b>IP Laws Amendment Bill (IPLAB)</b></p> <p>The IPLAB remains on hold.</p> <p>Subsequent to the Patents TFG Meeting, MBIE provided an update to TFG members of the issues they have proposed for inclusion in the next Regulatory Systems Bill (Regulatory Systems Bill 4). The proposed issues are (trade marks and designs matters included for completeness):</p> <p><b>Patents Act 2013</b></p> <ul style="list-style-type: none"> <li>• Provide that if a request for examination is not filed within the prescribed time, the application is deemed to be abandoned.</li> <li>• Provide that a divisional patent application must be accompanied by request for examination.</li> <li>• Amend s254 to clarify that documents that would be kept confidential under s91 of the Patents Act 1953 remain confidential.</li> <li>• Provide that the abstract must not be used for interpreting the nature of the invention.</li> <li>• 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.</li> <li>• Amend s8(2) to clarify that, where two patent applications are filed by the same or different 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.</li> </ul> <p><b>Trade Marks Act 2002</b></p> <ul style="list-style-type: none"> <li>• Allow for partial refusals of national (i.e. non-Madrid)</li> </ul>

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	<p>trade mark applications, where the applicant does not respond to a notification issued under s41 of the Act within the time set by the Commissioner of Trade Marks.</p> <ul style="list-style-type: none"> <li>• Require that trade mark specifications of goods be clear.</li> <li>• Repeal the requirement that only an “aggrieved person” can apply to revoke or invalidate a trade mark.</li> </ul> <p><b>Designs Act 1953</b></p> <ul style="list-style-type: none"> <li>• Provide for substitution of applicant, with procedures based on the corresponding provisions in the Patents Act 2013, and the Patents Regulations 2014.</li> <li>• Provide that information or documents required to be filed with the Commissioner of Designs be filed through the IPONZ case management facility.</li> <li>• 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.</li> <li>• 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.</li> <li>• Provide that before the Commissioner makes a decision involving the exercise of the Commissioner’s discretion, and person adversely affected by that decision must be given an opportunity to be heard.</li> <li>• 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.</li> <li>• Amend the Designs Regulations 1954 to include provisions 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</li> </ul>

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	<p>Regulations 2014.</p> <p><b>FTA implementation</b></p> <p>Legislation implementing the UK-NZ free trade agreement is before the select committee. The only change being proposed to IP legislation is a minor amendment to the Copyright Act.</p> <p>The main IP issue arising due to the EU-NZ free trade agreement is in relation to Geographical Indications. MBIE hopes to release a consultation document in late October or early November.</p> <p>Significant amendments to the Copyright Act are also required, but the FTA provides four years to implement those, so they are not an immediate priority for MBIE. Similarly, consultation in relation to joining the Hague Agreement (relating to the international registration of industrial designs) has also been deferred, and no decision made about when that consultation will begin.</p>
<p><b>4. Practice review and discussion</b></p>	<p><b>Regulation 82 – Patent and divisional overlap</b></p> <p>IPONZ has significantly updated the draft in response to previous feedback and discussion. The main changes are:</p> <ul style="list-style-type: none"> <li>• To clarify the approach to follow the double infringement test more closely, at [15]-[18] and [38]-[48].</li> <li>• References to the 1953 Act and UK case law have been removed.</li> <li>• An analogy to the reverse infringement test is introduced at paragraphs [18], [41] and [45]. This is done for practical reasons, given examiners' familiarity with this test.</li> </ul> <p>IPONZ sought to further discuss the approach outlined in paragraphs [28], [42]-[45] and examples 1 and 2 of the guideline (and paragraph [46] and example 5 as counterexamples). These are unchanged insofar as there are examples where claims are not identical in scope, but IPONZ considers there may still be grounds for objection. For example, IPONZ would object where a person skilled in the art would understand a claim to be directed to individual embodiments, with only one of those embodiments claimed in a divisional application. This situation was not considered in</p>

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	<p><i>Oracle</i>.</p> <p>References to case law under the 1953 Act were removed because, unlike r23(2), the Commissioner has no discretion as regards the application of r82.</p> <p>IPONZ wishes to clarify the application of the double infringement test in <i>Oracle</i>, and considers the reverse infringement test to be a useful analogy.</p> <p>There was extensive discussion of the draft guidelines.</p> <p>TFG members pointed out that <i>Oracle</i> requires double infringement be inevitable, not merely possible.</p> <p>IPONZ pointed out the <i>Ganymed</i> sets out that it is unjustifiable to doubly claim the same invention.</p> <p>TFG members suggested the examples provided be reconsidered and more examples provided, particularly some examples illustrating when an objection would not be raised.</p>
<b>5. Any other business</b>	None
<b>6. Next meeting/upcoming meetings</b>	The next meeting is planned for March 2023. Proposed revisions to the Regulation 82 guidelines may be provided/discussed ahead of that meeting.

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