

## Patents

### Technical Focus Group (“TFG”) Meeting Minutes

<b>Date/Time</b>	18 July 2023
<b>Location</b>	Virtual / Stout Street

### Participants

MBIE / Intellectual Property Office of New Zealand (“IPONZ”)	Members	
Gaby Cowcill (Chair)	Doug Calhoun	NZ Law Society
Steve Smith	Tom Robertson	Pipers
Simon Maguire	Fiona Pringle	NZIPA / A J Park
Chloe O’Shea	Jonathan Lucas	JAWS
Ed Barclay	David Nowak	Henry Hughes
Matt Allan	Scott Sonneman	DCC
Dan Sanson	John Landells	IPTA / F B Rice
George Wardle (Corporate Governance and IP Policy Team)	David Herman	F B Rice
Vaughan Trounson	Laura Hollingsworth	Catalyst
Ravi Kandula (minutes)	Apologies: John Landells, Duncan de Geest	

### Minutes

Matters arising / previous action items	Update
IPONZ to update website pendency pages.	Done. Currently working on next update, targeting end of July.
IPONZ to provide an update on Māori Advisory Committee guidelines.	Ongoing. High-level guidance is available on the IPONZ website <a href="https://www.iponz.govt.nz/about-ip/maori-ip/maori-committees-for-ip/">https://www.iponz.govt.nz/about-ip/maori-ip/maori-committees-for-ip/</a>
IPONZ to consider providing a manual section ‘pipeline’ at the next meeting.	Done, see discussion item below.
IPONZ to continue to investigate inventor address formatting issues & provide an update next meeting.	This is being worked on, we are awaiting an update from systems team.
IPONZ to investigate examination practice re: objections, report wording and additional comments, and feedback to individuals or teams as required.	Done. Please contact the examiner or team lead for case-specific issues (IPONZ to provide contact info with meeting minutes)

IPONZ to consider including next renewal deadline in patent search results.	IPONZ confirmed this should be possible, and has been added to the system upgrades list.
IPONZ to explore tab expiry/timeout options.	Done. This is not feasible to be implemented in the present platform, however, IPONZ will take note of the feedback for future platforms. Item closed.
IPONZ to update guidance on practice when considering requests under regulation 77.	See discussion item below.
<b>IPONZ Update</b>	<b>Gaby Cowcill</b>
<p>Gaby covered IPONZ general updates including:</p> <ul style="list-style-type: none"> <li>- Recruitment &amp; people movement, including contacts for escalated issues.</li> <li>- Patent pendency.</li> <li>- PCT Receiving Office updates &amp; improvements.</li> </ul> <p>Dan Sanson also gave a brief overview of intended Designs updates covering website and report content, with the aim of improving our public-facing information. There will be no changes in practice.</p> <p>Members were invited to contact Dan with any further items that would be useful to cover. Gaby also noted some existing feedback re: updates to IPONZ filing processes for some document types was also being discussed.</p>	
<b>Update from MBIE Policy Team</b>	<b>George Wardle</b>
<p>George gave an update on changes within the Corporate Governance and Intellectual Property Policy Team (CGIPP), and the IP law reform work programme.</p> <ul style="list-style-type: none"> <li>• Warren Hassett retired at the end of June after 40 years in the IP field, both as an examiner and as a policy advisor. Warren played a key role in reforming patents, plant variety rights and copyright legislation.</li> <li>• The IP work programme remains heavily focused on free trade agreement implementation: <ul style="list-style-type: none"> <li>○ UK free trade agreement came into force 31<sup>st</sup> May, including a minor amendment to the scope of performer’s rights under section 174B of the Copyright Act 1994 to including requiring the performer’s consent to play sound recordings in public.</li> <li>○ EU-NZ free trade agreement signed on 9<sup>th</sup> July (Brussels time).</li> </ul> </li> <li>• CGIPP’s work programme is primarily focused on developing amendments to the <i>GIs (Wine &amp; Spirits) Registration Act</i> to facilitate meeting EU GIs obligations necessary for ratification of the EU-NZ FTA.</li> <li>• EU-NZ FTA also includes obligations to: <ul style="list-style-type: none"> <li>○ Extend the term of protection to copyright by 20 years and providing additional protections for technological protection measures within 4 years of the agreement entering into force.</li> <li>○ Undertake reasonable steps to join <i>Hague Agreement Concerning the International Registration of Industrial Designs</i> (a similar obligation applies under the NZ-UK FTA).</li> </ul> </li> <li>• CGIPP anticipates providing advice to the Minister of Commerce and Consumer Affairs after the general election on a work programme to meet these obligations.</li> </ul>	

- The Trans-Tasman Patent Attorney regime review report was published in May on MBIE and IP Australia websites, after it was approved by the Australian and New Zealand responsible Ministers. There have been some very initial discussions with IP Australia regarding further work to implement the recommendations, including possible reforms to the disciplinary regime.

A member enquired about the status of the IP Laws Amendment Bill.

- George responded that work on the Bill had been suspended, due in part to the Minister of Commerce and Consumer Affairs being allocated limited Parliamentary time to progress their Bills. We are hopeful the Bill might be progressed by the new Minister after the general election.

### Draft manual sections for review and discussion

#### Regulation 65

Vaughan Trounson, Chloe O'Shea

IPONZ presented this manual section relating to translations of PCT applications, which it intends to replace the current section 51 guidelines. The general aims of the updates were:

- To clarify how to correctly file verified translation documents.
- To propose changes in practice to streamline the approach for resolving issues under regulation 65.

IPONZ sought feedback on the updates.

Members noted that a VETOS is not required in many other jurisdictions, and suggested that IPONZ move away from requiring these as a standard requirement, and toward providing them on request if/when necessary.

IPONZ noted that this requirement was in current legislation, having been removed in Australia at least through a change in legislation. George however noted it can be difficult to pursue ad hoc changes to regulations.

Member mentioned improved AI translation capability. IPONZ confirmed there is no concern with how a translation is obtained – whether by a human translator or a machine – only that a statement is provided from a person that the translation is a true and complete translation.

Members suggested that IPONZ include the legal basis in New Zealand for the extensions of time it is proposing. IPONZ agreed to do so, noting that under PCT Rule 51 *bis* 3a IPONZ must invite the applicant to meet any requirement not yet met and give them at least 2 months to comply.

Members considered whether having the certificate provided or dated after the translation would be problematic. IPONZ confirmed that the certificate could be provided later as a stand-alone document.

- **ACTION:** Members were asked to send any further feedback to Chloe or Vaughan by end of July. IPONZ will then circulate any additional changes by email before publishing.

#### Section 16

Vaughan Trounson, Chloe O'Shea

IPONZ presented this manual section relating to excluded subject matter. This includes:

- A rework of the existing content for improved readability and to ensure content is in plain English.
- A refreshed PVR section to incorporate the updates to the PVR Act, including more guidance on how we are assessing patent applications which relate to plant varieties.
- Clarification of the section on Methods of Diagnosis.

IPONZ sought feedback on the updates.

A member commented on a specific statement “Human embryos **comprising** human nuclear DNA are human beings”, that comprising makes this statement very broad. IPONZ confirmed this was broader than intended, and will address this feedback.

No other feedback was provided.

- **ACTION:** Members were asked to send any further feedback to Chloe or Vaughan by end of July. IPONZ will then circulate any additional changes by email before publishing.

## Other practice queries and discussions

### Manual section pipeline

Vaughan gave an overview of the pipeline of proposed manual sections, noting however that this is subject to change:

- Swiss-style claims.
- Section 39 update, to include guidance on support and a plain English review. Also clarify unity practice
- Section 40 update, to incorporate guidelines on intermediate generalisations.
- Section 14(a) guidelines, particularly on mere scheme or plans.
- Section 11 update, to incorporate recent hearings decisions.

Members were invited to comment or reach out later if there are specific areas of practice under these topics which were of concern or causing issues, or other topics of interest.

Multiple members noted that unity was a topic which could benefit from additional guidance. In particular, for 2013 Act national phase cases where unity was not raised during the international phase, and/or applying a consistent threshold or test for unity.

IPONZ noted this feedback and will look to incorporate it in any manual section updates.

IPONZ encouraged members to feed case-specific issues back to the relevant TL, so it can be considered more broadly and any practice inconsistencies addressed.

### Regulation 77

IPONZ had circulated draft Regulation 77 content with the meeting agenda aiming to clarify aspects such as statements included in a statutory declaration, and helped ensure that practice was consistent.

IPONZ sought feedback on the updates, and also insights on where users looked for this information.

Members generally commented that the threshold for expedited examination could still be clearer, and suggested having more positive statements, or positive examples, of what would be considered a ‘good and substantial reason’.

Member concerns around the confidentiality of documents provided as part of a request were also reiterated, and that a positive statement that the details of the infringement are not necessarily required would be useful. This followed the example of a case discussed during the last meeting, which was initially declined and subsequently allowed on the basis of a statutory declaration, where the declarant had reviewed the relevant information but without giving any specific details of the product or who was infringing.

Members suggested a specific revision to text which referred to a delay in allowance, noting that a granted right is required before infringement proceedings can be brought.

Members confirmed they used text searching to find the guidance.

**ACTION POINT:** IPONZ to collate & incorporate feedback, and circulate to TFG for further discussion.

### Any Other Business

#### The date of the next meeting

This was agreed as Thursday 9<sup>th</sup> November, with 7<sup>th</sup> November as a back-up date.

#### Reiteration of objections in exam reports

Members queried whether objections that are being reiterated could be reproduced or summarised in exam reports, if the examiner has the overseas report in front of them. Other members however noted this could lead to copyright implications, or further confusion about the objection.

IPONZ commented that it is a balance between efficiency and completeness, noting we are trying to use a streamlined approach. There may be more value in reiterating where there are lots of similar issues as opposed to one or two.

### Actions summary

IPONZ to provide an update on Māori Advisory Committee guidelines.	Ongoing. High-level guidance is available on the IPONZ website <a href="https://www.iponz.govt.nz/about-ip/maori-ip/maori-committees-for-ip/">https://www.iponz.govt.nz/about-ip/maori-ip/maori-committees-for-ip/</a>
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IPONZ to consider including next renewal deadline in patent search results.	IPONZ confirmed this should be possible, and has been added to the system upgrades list.
Members to send any further feedback on Regulation 65 manual content to Chloe or Vaughan by end of July. IPONZ will then circulate any additional changes by email before publishing.	
Members to send any further feedback on Section 16 manual content to Chloe or Vaughan by the end of July. IPONZ will then circulate any additional changes by email before publishing.	
IPONZ to collate & incorporate feedback on Regulation 77 guidance, and circulate to TFG for further discussion.	

### Close of meeting