



Notes from the meeting of 21 August 2008

Notes from the patent & designs technical focus group meeting

2 pm, 21 August 2008

IPONZ,

205 Victoria St,

Wellington

Present

Liz Francis (IPONZ), Mark Pritchard (IPONZ), David Nowak (IPONZ), Helen Palmer (Baldwins), Matt Adams (AJ Park), Virginia Beniac-Brookes (Philips Ormonde Fitzpatrick, Australia; via teleconference link), Frank Callus (Henry Hughes)

Apologies

Tom Robertson (Pipers)

Guests

Jared Scarlett (Baldwins), Rachelle Beale (Henry Hughes) and Kate McHaffie (AJ Park).

1. Matters Arising

None.

2. Swiss style claims draft guidelines

Written comment from one member was received via email on the 20th August and a number of oral submissions were made at the meeting on the wording and legal correctness of the draft guidelines. These focused on the complexity of the guidelines and raised questions on the degree of disclosure in the specification to provide fair basis for Swiss style claims.

Members agreed to provide IPONZ with written submissions on the draft Guidelines.

IPONZ undertook to review all the submissions and have regard to them in the drafting of the final form of the guidelines.

3. S17(1) Practice Note

IPONZ issued a practice note on 14 May 2008 relating to its practice of raising objections under s.17(1). In preparation of the practice note IPONZ had sought a legal opinion on amongst other things the Commissioner's obligations under the Patents Act to raise objections s.17(1). The practice note does not represent a change in practice, but recites the practice as it current stands.

It was commented that there was an inconsistency in stating that the practice note recited the Commissioner's practice as it currently stands when the practice note appears to conflict with a Commissioners Decision (P22/2007) that was issued at substantially the same time. It was noted that better clarity

would have been achieved if the Practice Note took into account and specifically dealt with P22/2007.

A question was raised on reciting mention of the contrary to morality and public order provisions of the new Patents Bill in the practice note. In reply, IPONZ noted that the provisions of the new Bill were mentioned to bring to the fore that it is clearly still the intention of Government to place an obligation on the Commissioner of Patents to consider matters of morality (and public order) going forward with the proposed new legislation. Additionally, it was also noted by IPONZ that when the Patents Act 1953 was amended to bring the Act into line with the provisions of the TRIPS Agreement and remove the contrary to law provisions formerly under s.17(1) of the Act, Government did not remove the contrary to morality provisions at the same time.

It was noted by IPONZ that the Commissioner does have an obligation to consider patent applications in light of s.17(1) and raise objections as and when the Commissioner deems necessary.

The non-availability of IPONZ's legal opinion was again raised. It was noted by IPONZ that MED Legal had previously advised IPONZ that the opinion (like all such advice to Ministry departments) was privileged.

The point of the increased frequency of such objections was addressed in that there is an increase in number of patent applications in subject matter areas such as biotechnology which frequently contain claims to subject matter which has historically attracted such objections.

Consultation with the TFG was not sought at the time of producing the practice note, as it did not recite a change in practice. IPONZ acknowledged that in view of the recent Hearing Office decision (P22/2007) that even though there was no change in practice, the practice note is at odds with some of the Hearing Officer's opinion and in hindsight would have been useful to have provided the TFG members opportunity to sight the practice note prior to publication.

4. Any other business

(a) Availability of published specifications

An issue with specifications not being available on the website once published was raised. IPONZ noted that this was a one time issue with the IPONZ database effecting specifications uploaded on a particular day which has now been rectified. IPONZ also commented that the specifications remained publicly available as a IPONZ would provide copies of the specification to the public if requested.

(b) Publication of Commissioner decisions

Clarification of the circumstances in which IPONZ would withhold publication of a Decision of the Commissioner was sought. IPONZ stated it would only withhold publication of a Decision if it related to an application that was not yet accepted or it contained subject matter not capable of publication under section 90.

(c) New Patent Bill

It was brought to the attention of the meeting that the Patent Bill had now been introduced into Parliament and now was the opportunity for parties to consider making submissions.

The question was asked whether there were plans to write an examination manual to coincide with the passing of the Patents Bill. It was noted that there would be a range of aspects to be addressed once the Bill was passed.

(d) Late raising of objections

It was considered that not all of the late objections which were raised were substantive. IPONZ noted that the examination practice is to raise all objections at first examination and should in the prosecution of the application further information which could have a significant impact on the validity of any granted patent come to the attention of an examiner, then the examiner would raise the appropriate objection. However, it was considered that generally only those objections relating to sections 2 and 13 (and potentially some significant s.10 issues) would fall into this category of further objection. IPONZ will monitor the situation.

(e) Section 15 (1)(b)

The wording provided where a request has been made under section 15(1)(b) wherein the applicant has been requested to consider addressing issues raised in corresponding applications was discussed. IPONZ will look to requests of this type to clarify the nature of the request. However IPONZ noted that it was a request to aid the Office only and not a requirement of the applicant.

(f) Notice of acceptance

It was noted that notices of acceptance produced under the recently changed acceptance process no longer contain certain applicant details which were reproduced under the previous process. IPONZ explained that when the acceptance process was changed to provide that the examiner issue the notice of acceptance, the macro used to allow examiners to generate the notice does not allow certain information to be automatically drawn from IPOL and placed into a notice of acceptance. This was generally accepted but it was noted that this may result in more Deeds being returned to IPONZ for correction.

(g) Design restoration legislation

The status of the proposed legislation which is to introduce a restoration procedure for designs was queried. IPONZ informed that the latest information on this matter indicated that the Regulatory Improvement Bill would be enacted mid-2009.

(h) A number other minor issues were raised for discussion and appeared to be related to either single applications or a very small number of cases.