



## Notes from the meeting of 3 April 2009

### Notes from the patent and designs technical focus group meeting

9.30am, 3 April 2009

IPONZ,

205 Victoria St

Wellington

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#### Present:

Liz Francis, Mark Pritchard, Mark Luiten, Paul Carroll, Simon Gallagher, Mike West (all IPONZ), Warren Hassett (CTI, MED), Frank Callus (Henry Hughes, late arrival), Virginia Beniac-Brookes (Philips Ormonde Fitzpatrick, Australia via teleconference), Helen Palmer (Baldwins), Matt Adams (A J Park), Tom Robertson (Pipers)

#### No apologies received

#### Welcome

Meeting was opened by Liz Francis at 9:30am.

#### Matters arising from previous meeting

No matters arising.

#### Administrative issues

##### (1) Disposal by IPONZ of some of its overseas patent collection.

A recent article "IPONZ overseas patent collection" published in the April 2009 issue of the MED Newsletter informed readers that as a consequence of the imminent closure of the long-term storage facility at Toop Street, IPONZ is in the process of disposing of some parts of its overseas patent collection.

The disposal process will result in many of the microfiche and CD-ROMs containing foreign patent documents being destroyed or relocated to an alternative long-term storage facility. Paper copies of the foreign patents will be disposed of in an appropriate manner. The process is not yet complete and is on-going. A record of the various documents, CD-ROMs and other media received by IPONZ over time and the dates these materials were received will be kept. The record will be updated as the disposal process proceeds to completion with a view to placing the record on the IPONZ website.

Should an accession date of a document contained on either a stored microfiche or CD-ROM be required, then this may take up to about one month to be obtained. Any urgent requests for accession dates should be accompanied by a justification for the urgency.

##### (2) Retrieval of published NZ patents that are not on the IPONZ Database with the impending closure of the Toop St. What is the latest update on this and how documents are to be obtained in the future?

All pre-1984 patents and designs are held at New Zealand Archives. IPONZ is presently preparing a document outlining the process to be followed when requesting a copy of pre-1984 patents and designs from New Zealand Archives. IPONZ and New Zealand Archives follow a pre-determined retention and disposal schedule for the maintenance and destruction of various documents including patents and designs.

During the examination process, where an examiner obtains a copy of a patent or design from New Zealand Archives for the purpose of citing in an examination report, the examiner will provide a copy of the document to the applicant as a matter of courtesy. The document will then be scanned by IPONZ and retained on an IPONZ database.

## **Presentation**

### **(3) IPONZ service enhancements**

IPONZ has recently introduced an online patent filing service which has seen an initial modest uptake in use. The uptake in use continues to rise with 20-25% of all patents (compare approx. 30% designs) being filed online. More online applications are filed by Australian patent firms than New Zealand patent firms.

A concern was raised around the security of documents filed using the online filing service. It was noted that there are always risks in sending documents via any delivery means whether it be by conventional post or by electronic media. The security aspects of the software of the patents online filing service are robust and that other Government departments use similar systems for transmitting commercially sensitive documents without security breaches.

IPONZ also has a number of IT related projects underway including:

#### **I. View IP history online**

An overview of the project objectives was provided i.e. to increase transparency of certain documents and actions associated with a patent/application by providing clients /agents with limited access to the IPONZ database to view certain documents.

A brief description of service was given and a screen shot was circulated. A description of how documentation visibility is envisaged to work was provided.

An invitation was extended to interested members of patent firms to participate in pilot study to be in late April, including for example suggestions for user-friendly document labels.

#### **II. Correspondence via email**

An overview of project objectives was provided i.e. reduce compliance costs, speed up delivery of information to users.

Services contemplated by this new service will include providing examination reports, renewal reminders, certificates of the Commissioner and providing an electronic version of the current Patent Form 72 service electronically.

A brief discussion around the setting of deadlines and certain terminology used in patent specifications which may be rejected by mail marshals. These issues will be addressed within the project development with clients. An invitation to clients to be involved in a pilot study was extended.

The project is currently in a testing phase and is planned to be released after the View IP History service has been rolled out.

#### **III. Status changes for patents PCT**

Changes to IPOL are coming in next few weeks that will identify allow easier determining of the status of a PCT national phase application.

Two new status classes will be introduced into IPOL: 40 and 45.

Therefore, the status of a typical national phase application in IPONZ will be one of the following:

- 20 - waiting on information to complete the filing formalities;
- 40 - the application has met all of the formalities for examination and is awaiting the 31 month examinable date to pass;
- 45 - the application has met all of the formalities for examination and has passed the 31 month examinable date; and
- 50 - the application has been reserved to an examiner and an examination report can be expected to be issued shortly.

The new status classes in addition to the existing status classes will reduce the need for status requests on progress of applications. The status of an application will be apparent from the corresponding application record available via the IPONZ website.

#### **IV. System to system interface development**

The existing interface was built for Trade Mark applications. Work has begun on defining interfaces for Patents / Design applications and renewals for all divisions. A general invitation was issued for IT contacts from stakeholder firms to discuss options and further details.

#### **V. Miscellaneous enhancements**

WIPO link et al. IPONZ will be publishing tips and tricks section in coming weeks to detail how to....

#### **VI. Feedback request on online services**

A general invitation was issued to all present on the merits and areas for potential improvement of the IPONZ online services.

### **Technical issues**

#### **(4) Requests for verified translations.**

A brief discussion was held around the reasons for IPONZ issuing a practice note in November 2008 on requests for verified English language translations to be provided within the PCT Rule 3 time-frame. The practice note was issued to publish the existing practice of issuing requests for verified translations and was not a new practice.

Some discussion followed on where practice notes were to be found. Practice notes are viewable on the MED Business Update website and the IPONZ website.

#### **(5) Acceptance notification and the one month period provided for placing the application in order for acceptance.**

Where an application be found to be in order for acceptance at first examination, IPONZ practice is to inform the applicant of this and provide a discretionary one month period to allow the applicant to either make voluntary amendments or file to a divisional application.

If an examiner inadvertently does not provide the discretionary one month period to the applicant, then within the one month period after issuance of the notice of acceptance and prior to publication of the acceptance in the Journal, the applicant can request that the acceptance be withdrawn and the one month period be provided to the applicant.

If the application has been published in the Journal, then the acceptance cannot be withdrawn.

A practice note will be issued on this matter in the near future.

### **Further administration issues**

#### **(7) Design representations not forming part of the online IP summary report.**

Online filing summaries of design applications do not contain a copy of the representations filed by applicants as document containing the representations is not accessible to the online filing system for this purpose. This is a technical limitation of the system, rather than a decision made during the design phase of the online filing system.

#### **(8) The "status" of patent applications on IPONZ database e.g. Applications that have the status "ready for/under examination.**

Covered in item 3 above.

## **(9) The IPONZ procedure for sending correspondence (e.g. examination reports) by email to firms.**

Covered in item 3 above.

## **Other matters**

### **(10) Updates on practice and process changes since last meeting.**

Several practice notes were issued by IPONZ since the last TFG meeting.

The content of the notes and practice were briefly discussed for each note.

### **(11) Release of swiss type claims guidelines.**

A copy of the final version of the Guidelines for the examination of Swiss-type Claims were circulated to the TFG members prior to the meeting.

The purpose of the Guidelines is as an examiners' tool, rather than directions for applicants.

## **Next meeting & close**

The meeting was closed at 11:40am. The date of the next meeting will be fixed at a future date.