

Patents

Technical Focus Group (“TFG”) Meeting Agenda

Date/Time	13 March 2025
Location	15 Stout Street, G.17
Apologies	Laura Hollingsworth

Participants

MBIE / Intellectual Property Office of New Zealand (“IPONZ”)		<u>Members</u>	
Gaby Cowcill	Manager Patents (Science) & PVR	Tom Robertson	Pipers
Ed Barclay	Manager Patents (Engineering) & Designs	Sam Ting	NZIPA / AJ Park
Simon Maguire	Principal Patent Examiner	Jonathan Lucas	JAWS
Steven Hong	Principal Patent Examiner	David Nowak	Henry Hughes
Daniel Sanson	Team Leader	Scott Sonneman	DCC
Ellie McLellan	CGIPP team	David Herman	IPTA / FB Rice
George Wardle	CGIPP team	Jason Wach	NZ Law Society / JAWS
Ash Thyne	Senior Patent Examiner		
Lizzy Eden	Senior Patent Examiner		

Previous action items		Update
IPONZ to circulate slides for general updates and PPH agreements.		Provided in draft minutes email for September 2024 TFG
IPONZ to email members the Swiss-type claim guidelines for any final feedback before publication.		Swiss-type claims guideline has been published
IPONZ to share current statistics measured as part of the GPPH.		Presented in current meeting
Fiona to provide case number for CDR objection.		Provided – case specific issued that has been resolved
TFG members to get in touch with Ed or Gaby if interested in the working group for the case management system upgrade.		To be removed as ongoing action
TFG members to get in touch with Ed or Gaby if interested in training sessions for filing in China as part of the CNIPA PPH.		To be removed as ongoing action
	Update from the policy team	Ellie/George
New Minister for Minister of Commerce and Consumer Affairs, Hon Scott Simpson. Copyright Act review – work currently on short pause until we have a chance to discuss the copyright work programme previously agreed to by the former Minister. IP Laws Amendment Bill (IPLAB) - Still working towards having a bill ready for introduction later this year. Consultation on an exposure draft of a Patents Amendment Bill - Minister for Economic Growth, Hon Nicola Willis, has asked us to progress an amendment to the Patent transitional provisions currently in IPLAB on a faster timeline than IPLAB as a whole (Recommendation 3.1 from the original Cabinet decision DEV-20-MIN-0109). - Exposure draft to be released on about 18 March 2025 for a period of 2 weeks. - Potentially introducing the Bill into Parliament in May. - One member questioned why such a short feedback period. It's a short Bill of four clauses and aiming for it to be ready for introduction in May.		
	IPONZ Updates	Ed/Gaby
Slides from this presentation to be provided. General updates: IPONZ staff updates - National Manager role disestablished as of February 2025 - Reporting line changes for IPONZ management team - Continue to contact Ed Barclay (Patents (Engineering) & Designs) and Gaby Cowcill (Patents (Science) & PVR) for queries/concerns - Recent recruitment for 6 patent examiners Pendency		

- Pendency times updated – [see the IPONZ website](#)
- 85 remaining 1953 Act cases “under examination”
- **General stats** - The number of applications which have requested examination with an examination report not yet issued showed slight uptick since Jan 2025, overall still trending downward.
- **Recent and upcoming events**
 - Gaby and Ed attended PCT Working group on 17th-20th February, including multi-lateral PPH meeting
 - World IP Day 24th April
 - IPTA 2-4th of April – Ross Van der Schyff will be speaking
 - WIPO General Assembly – IPONZ delegation will be attending

Project updates:

- **Fees review**
 - IPONZ is undertaking review of all fees – intention for consultation in mid-2025 with fee changes coming into effect 2026.
 - Last fees review implemented Feb 2020. Design and Hearings fees included in last review but no changes proposed. Likely changes in these areas in scope for consultation in current review.
 - Discussion document and related approvals currently being prepared to get Cabinet approval to consult.
- **IPONZ IT Platform upgrade (Aurora) project**
 - Work continues on the IPONZ IT platform upgrade
 - Initial Designs IP group set up, more external reference groups to be formed as project progresses
 - The first stage of the build of Designs IP and common features is underway with an anticipated release date of January 2026.
 - The trade mark phase will begin late 2025, anticipated release 12 months after designs. Patents and PVR to follow with full completion in 2027.
 - Current and new systems will run in parallel for at least the first 18 months. IPONZ will be reaching out to the large IP firms to discuss optimisation of user and organisational setups in the new system.

	PPH Stats	Gaby
Slides from this presentation to be provided. Statistics provided on: - Number of GPPH requests with IPONZ as the office of earlier examination - Number of GPPH requests IPONZ as the office of later examination - Breakdown of GPPH requests by IPC class and % of technology team volumes - Pendency and reports per cases Noted the data is for GPPH only – other PPH pathways too recent to provide stats on.		
	Draft manual sections	Simon

Section 9: Disclosure to be disregarded in certain circumstances

IPONZ is proposing updates to the Section 9 guidelines to address some practice matters relating to the 'grace period' provision.

The changes include:

- Confirmation that the grace period can be applied to s8(2) art, that the disclosure relates to the publication date and to provide further guidance on when the grace period applies.
- The request requirements have also been updated so examiners can disregard art that clearly falls within the criteria without needing a specific request. The requirements around (formal) evidence have also been updated.

Queries and feedback from members:

- Members queried which date applies for Section 9)1)a)-e)
 - IPONZ to confirm practice and clarify in guideline if needed
- Clarification of the language regarding when a formal request is required
- Clarification around the relevance of cited case law in paragraphs was requested
- A member requested more detail in the guideline around the relationship between Sections 9)1)f and 8(2)

Upcoming manual sections

Ash/Lizzy/Steven/Simon

Section 39: Contents of complete specification

IPONZ are beginning work on a refresh of the section 39 guidelines. The purpose of the refresh is to clarify existing practice and incorporate any relevant hearings decisions under the 2013 Act.

Other exam manual sections

IPONZ is at the initial planning stage for examination manual pages for:

- **Section 14(a): Manner of manufacture**
- **Patent Māori Advisory Committee Guidelines**

Members are invited to identify any areas that could be addressed or to identify any practice pain points for the above exam manual sections.

Designs updates and discussion

Dan / Ed

- **Letter template and objection wording:** design reports are changing to a refreshed format to align more with the Patent Examination format. To be released in next update of the case management system.
- **Staff updates:** more patent examiners to be trained in designs
- **Designs examination manual:** to be produced, seeking feedback on any areas of practice that should be prioritised
- **Designs TFG:** contact Ed (edward.barclay@iponz.govt.nz) for expressions of interest

A member queried when the designs examination manual was likely to be published

- Aiming to begin work on the manual this year, however some capacity building needed

	Designs Practice	Dan
IPONZ are proposing to use regulation 80 to dispense with the requirement to file an authorisation of agent (AoA) in most circumstances. We will still request an AoA where there is doubt with respect to agent representation, or when changing agents. Main considerations and background: - The requirement for filing an AoA has been discussed as part of IPLAB. This proposal is an alternative way to dispense with the AoA requirement under the current legislation. - The historic practice of withholding AoA to delay registration has been obsolete since the Design Amendment Regulations in 2011 (introduction of regulation 20A). - Currently about 20% of design applications have at least one examination report where AoA is the only outstanding issue. This results in around 200-300 additional reports each year. We are seeking any feedback from the profession. Questions and comments from members: A member queried whether the approach under Patents (providing a proactive statement that the agent is authorised) will also be acceptable for Design - IPONZ to discuss and clarify A member noted there may be issue regarding the use of discretionary provisions for a general rule. Actions - IPONZ to provide further updates for feedback to TFG members - Members involved in designs work encouraged to reach out to Ed for comment		
	Other practice queries and discussions	Ed
Correct filing of documents – reminder about using correct document types - Can have flow on effects in the system if wrong document types are used - IPONZ can run training for staff involved in filing A member noted issues with fraudulent activity at IP Australia - Some trade mark customers have had their address for service details changed without their consent - This is being looked into at IPONZ, however unlikely there is a similar issue here, as it is not an automated system.		
	Any other business	Ed
Date of next TFG: 26th June afternoon proposed		

Actions summary	
Exposure draft for amendment of transitional provisions to be released on 18 April for a period of 2 weeks.	
IPONZ to circulate slides for general updates and PPH stats	
IPONZ to review and update Section 9 guidelines in view of member comments, guidelines to be recirculated	
Members to provide any comment on areas of interest for proposed updates to Patent examination manual sections	
Members to contact Ed Barclay for expressions of interest for Designs TFG	
IPONZ to provide further updates on authorisation of agent for Designs for feedback	