

PATENT TECHNICAL FOCUS GROUP MEETING

Date	28 March 2018
Attendees	Mark Pritchard (IPONZ), Liz Francis (IPONZ), Warren Hassett (MBIE), Simon Pope (IPONZ, for part of the meeting), Sam Ting (IPONZ), Fiona Pringle (Baldwins), Doug Calhoun (NZ Law Society), Tom Robertson (Pipers), Duncan de Geest (AJ Park), David Nowak (Henry Hughes), Jonathan Lucas (James & Wells), John Landells (FB Rice, by phone)
Apologies	No apologies

Agenda

1. Matters arising from last meeting
 - a. Enhancements – priorities
 - b. Guidelines
2. IPONZ work-fronts & direction policy
3. Extensions of time – section 230 & regulation 147
4. Practice matters
 - a. Substantive responses
 - b. Voluntary amendments
 - c. Omnibus claims
 - d. Reference numerals
5. Case management facility
 - a. Validations
6. Update on IP Omnibus Bill
7. Amendments to patent regulations
8. Other matters

Topic	Action/Comment
1. Enhancements – priorities	<ul style="list-style-type: none"> • The enhancements program for the online case management facility is delayed due to increased demand on the IT provider by MBIE. • Next release is expected to be in November this year.
2. Guidelines	<ul style="list-style-type: none"> • Various examination guidelines are being drafted by the Patents team, including guidelines on abstracts.

Topic	Action/Comment
	Draft guidelines will be shared with TFG members over the coming weeks.
3. IPONZ work-fronts & direction policy	<ul style="list-style-type: none"> • Processing times for applications are now available on the website. • IPONZ will consider the suggestion to also include an indication of the priority date of the last application that was directed to request examination on the IPONZ website
4. Extensions of time – s 230 & reg 147	<ul style="list-style-type: none"> • The Assistant Commissioner’s comments regarding section 230 in the recent <i>Biocon</i> decision drew attention to the lack of a specific provision in the Act or Regulations for extending time to hold examination hearings. This matter has been identified previously and is expected to be considered as part of the consultation on the proposed IP Omnibus Bill.
5. Extensions of time – divisionals	<ul style="list-style-type: none"> • Clarification sought around five year deadline for requesting examination of divisional applications. • Examination may be requested at time of filing a divisional application to prevent filing of a divisional application that cannot be examined. • Reg 147 may be used to extend the five year deadline but it must first be established that exceptional circumstances apply. Filing outside of the five year deadline would not in itself be considered exceptional circumstances. • Issue raised that, due to higher examination standards and examination backlog, flexibility in filing divisional applications was required to offer clients certainty and prevent rights being lost. • IPONZ has agreed to consult further with TFG members on this matter. • Core issues will be identified and sent to the group by the end of next week.
6. Practice matters – substantive responses	<ul style="list-style-type: none"> • Clarification sought on whether cancelling all claims and leaving an omnibus claim would be considered a substantive response. • Generally, a substantive response must be a bona fide attempt to address the matters raised in an examination report.

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	<ul style="list-style-type: none"> • Further guidelines on what constitutes a substantive response may be considered.
7. Practice matters – voluntary amendments	<ul style="list-style-type: none"> • There are no general policies on amendments such as addition or removal of dependencies. Decided on a case by case basis. • Concern raised that examiners are applying reg 58 inconsistently. TFG members asked to inform IPONZ of these instances of inconsistency as they occur so this issue can be addressed directly.
8. Practice matters – addition of object statements	<ul style="list-style-type: none"> • A recent hearing concerned the allowability of amendments to add object statements. • A decision is expected in the coming months. • There will be no change to policy until the decision is released.
9. Practice matters – omnibus claims	<ul style="list-style-type: none"> • Concern raised that there has been inconsistent examination of omnibus claims. • IPONZ is currently drafting further guidelines on the examination of omnibus claims. The draft guidelines will be shared with TFG members before publication.
10. Practice matters – reference numerals	<ul style="list-style-type: none"> • There is no general policy on the removal of reference numerals; it depends on the facts of a specific case. • This has been considered earlier by the TFG and is in the Examination Manual.
11. Practice matters – re-examination	<ul style="list-style-type: none"> • Guidelines around re-examination requested. • IPONZ will look into this.
12. Case management facility	<ul style="list-style-type: none"> • The case management facility does not currently notify an agent when they are reinstated as agent for a case. This is on the list of enhancements to be made to the case management facility
13. Update on IP Omnibus Bill	<ul style="list-style-type: none"> • A consultation document for the Bill is being prepared. At this stage, the consultation document is likely to be issued around June/July. • The National Party has tabled a Private Members Bill for a second tier patent system – Patents (Advancement Patents) Amendment Bill. • CPTTP signed on 8 March. The TPP Amendment Act will be amended or replaced as appropriate.

Topic	Action/Comment
14. Amendments to patent regulations	<ul style="list-style-type: none"> ● Will enter into force on 5 April 2018. ● Summary of some changes made: <ul style="list-style-type: none"> – Definition of address for service amended to include Australia. – Deposit requirements for micro-organisms changed to fix issue where it was not possible to file the receipt within the prescribed time. – Requirement that a parent application and divisional application do not include a claim for substantially the same subject matter changed to an acceptance requirement. – Changes to regulations for extensions of time limits for filing of counter-statement. ● Query was raised whether the change of regulations on parent–divisional overlap to an acceptance criteria meant that an objection could be raised for overlap with an application that had been accepted but was subsequently abandoned or lapsed. IPONZ is not taking that approach.
15. Next Meeting	<ul style="list-style-type: none"> ● Suggested next meeting should be in late July.
16. Action points	<ul style="list-style-type: none"> ● Draft guidelines to be shared with TFG members over coming weeks. ● IPONZ to consider suggestion to include on the IPONZ website an indication of the priority date of the last application that was directed to request examination. ● Core issues around the five year deadline for filing divisional applications to be identified and sent to TFG members this week for consultation. ● IPONZ will draft guidelines on re-examination. ● Provisional dates for next meeting to be sent to TFG members.