

PATENT TECHNICAL FOCUS GROUP MEETING

Date	6 October 2016
Attendees	Mark Pritchard (IPONZ), Liz Francis (IPONZ), Warren Hassett (MBIE), Grant Buchan (IPONZ), Peta Baily Gibson (IPONZ), Duncan de Geest (AJ Park), Fiona Pringle (Baldwins), David Nowak (Henry Hughes), Ian Finch (James & Wells) Tom Robertson (Pipers)
Apologies	John Landells (FB Rice)

Agenda

1. Update -Patents (Trans-Tasman Patent Attorney Regulation) Amendment Bill
2. Consultation paper – proposed amendments to the transitional provisions Patents Act 2013
3. PCT Infographic – reveal and overview
4. Global Patents Prosecution Highway – way forward
5. Practice matters:
 - a. Draft examination manual updates
 - b. Divisional applications filed in Reg 78(2) period of parent application
 - c. Shortened period for response - divisional applications
 - d. 5 day discretionary extension – Patents Act 1953
 - e. Section 231 – Patents Act 2013
 - f. Authorisations of agent – revert to original agent
 - g. Support requirements
 - h. Prioritising applications close to end of s 71 deadline
6. Other matters

Topic	Action/Comment
1. Update -Patents (Trans-Tasman Patent Attorney Regulation) Amendment Bill	<ul style="list-style-type: none"> • Second reading of the Bill may be completed by Thursday next week (13 October), expected to pass by the end of the year. • A question was raised on whether NZ Patent attorney firms will be permitted to be incorporated following passage of the Bill. MBIE IP Policy will follow this up and report back to the TFG. • The empowering provisions (part 5) for SAP & SEP

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	<p>have been removed from the Bill. IPONZ and IP Australia have ceased work on these programs.</p>
<p>2. Consultation paper – proposed amendments to the transitional provisions Patents Act 2013</p>	<ul style="list-style-type: none"> • Submissions close on the 14th October 2016. Extensions to the deadline may be granted if requested. • Following close of the submissions process, it is hoped that a Cabinet paper will be submitted before the end of the year. However, it was noted that policy-related work supporting the TPP has been prioritised. • Permission will be sought to make amendments to some of the patent regulations that are anticipated to be covered within the Cabinet paper noted above. • New/amended regulations are anticipated to be in force by the middle of 2017.
<p>3. PCT Infographic – reveal and overview</p>	<ul style="list-style-type: none"> • An infographic was presented shows the incoming and outgoing PCT application statistics. • Due to the need to compile information from WIPO data, 2014 is the most recent year for which NZ applications data is available.
<p>4. Global Patents Prosecution Highway – way forward</p>	<ul style="list-style-type: none"> • Options are either bilateral agreements or the GPPH • Break down of GPPH countries show many are the same countries to which NZ applications go and from which NZ applications arrive. • Likely time line to apply to be part of GPPH is July next year.
<p>5. Practice matters</p>	
<p>(a) Draft examination manual updates</p>	<ul style="list-style-type: none"> • Copies of updated sections 8 & 230 and a new section 40 of the examination manual were distributed prior to the meeting for comment. • Suggestions were received and discussed on each of the guidelines.
	<ul style="list-style-type: none"> • Section 8 – the guideline has been updated to clarify the type of applications which would be citable under section 8(2).
	<ul style="list-style-type: none"> • Section 40 is a new guideline, and addresses the requirements to meet when making amendments before acceptance. The guideline includes the

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	<p>requirements to meet regulation 58.</p>
	<ul style="list-style-type: none"> • A copy of an updated Section 230 of the examination manual was distributed for comment. • Paragraph 3 of the original guideline has been amended to reflect current practice, where extensions of time under s 230 are applied at the time of issuing the relevant examination report. • The guideline now includes information on where an extension of time may be made available for delay by the Commissioner where a late objection has been raised. • There was discussion on where an extension of time may not be available on new objections e.g. where a new objection is raised based on prior art raised by a foreign IPO on a corresponding application as the applicant could reasonably have been expected to be aware of the citation. TFG members queried whether there would be extensions of time where new prior art was based on for example, lack of inventive step, as it could be argued that different jurisdictions had different criteria for raising lack of inventive step objections and these may not necessarily be the same as those in New Zealand. • IPONZ noted that extensions of time might be available where there are new inventive step citations and where it would not be reasonable to expect the same citations to be relevant to the New Zealand application under examination. • TFG members also queried whether 20 working days would be sufficient for certain instances, e.g. unity, for an extension, where additional work is required. Discussion around practicality and reasons for providing extensions of time. Consideration will be given to what might be done around longer extensions, although at present there was no intention to go beyond the 20 working days of current practice.
<p>(b) Divisional applications filed in Reg 78(2) period of parent application</p>	<ul style="list-style-type: none"> • Divisional applications filed in the regulation 78(2) extension period: A query was raised as to what is required to obtain extension for purpose of filing divisional application.

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	<ul style="list-style-type: none"> • Regulation 78(2) requires that a request for an extension of time be filed with the response to which it relates. • For a response to be treated as substantive then in the opinion of the Commissioner (section 67(6)) the response should be a bona fide or genuine attempt to address matters of substance (e.g. legal, technical or subjective) raised in the examination report. It was noted that IPONZ may not consider deletion of all of the claims to meet the criteria for a substantive response. • For a divisional application to be filed in the extension period, then a substantive response must be filed on the parent application. • Failure to file a substantive response may result in an application being treated as abandoned (section 68).
(c) Shortened period for response - divisional applications	<ul style="list-style-type: none"> • An email was issued on shortened time to respond to first examination reports on divisional applications which clarified this issue. • Regarding the parent-divisional comparison - generally a shortened response period will be given where a divisional application has been filed with substantially the same claims as were originally filed with the parent (or subsequently) and which have been searched and examined on the parent.
(d) 5 day discretionary extension – Patents Act 1953	<ul style="list-style-type: none"> • 5 day discretionary period practice was raised by a TFG members, this should still follow IFC 16 i.e. a discretionary extension of time of 5 working days may be granted where a response is filed on the last day of the period set under section 19(2).
(e) Section 231 – Patents Act 2013	<ul style="list-style-type: none"> • The possibility of a section 231 extension for failure or delay of delivery method was discussed and discounted as a possible route to extend timeline for priority documents where there are issues beyond the applicant’s control. • Where an applicant fails to provide a copy of a priority document to comply with a request under regulation 68, then applicants may request an extension of time to provide the document under regulation 147. Note – an extension of time under regulation 147 will only be granted where <i>exceptional</i>

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	<i>circumstances apply.</i>
(f) Authorisations of agent – revert to original agent	<ul style="list-style-type: none"> • Authorisation of agent – where an agent applies to record a change of ownership, and the agent is to act on behalf of the new owner and who also acted for the original owner, the agent will generally not be required to provide an authorisation of agent in favour of the agent from the new owner providing that the agent includes an explicit statement to effect that the agent has been authorised by the new owner to act as agent for the case in question. Without this statement, the agent will be removed from the case as agent in line with current practice. • Limited authorizations: ensuring that the original agent is retained on the application/patent after completion of the task for which there was limited authorisation provided to another agent. IPONZ wants a workable solution for this matter and will consider possible options to amend the case management system. • It was discussed and generally agreed that there are merits in referring to a general power of attorney for certain matters. It was noted that historic GPAs are not readily available to IPONZ staff, making them of limited use. IPONZ will consider use of GPAs for future discussion within the TFG forum.
(g) Prioritising applications close to end of s 71 deadline	<ul style="list-style-type: none"> • Prioritising examination of applications near the section 71 acceptance deadlines is important for IPONZ and applicants. It was noted that examiners do prioritise those applications with close section 71 deadlines, whilst balancing other competing priorities and deadlines of other applications and tasks. • IPONZ is still under high workloads from 1953 Act work (particularly within the science subject matter areas) arising mainly from the on-going filing of new divisional applications from Patents Act 1953 parent applications. These new divisional filings (and the subsequent examination of applicant responses) places significant ongoing workload on IPONZ patent examiners and affects the ability to prioritise and redistribute work within the examination team. • Staff levels within the patent examination team will

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	<p>increase by 12 FTE examiners above the present level over the next year, as part of a multi-year program to increase examiner numbers. This will mean more examination capacity in the long term, however, as expected, there will be a significant call on the patents team resource to train increasing numbers of new examiners, and the increase in examination capacity will be realised over the next few years, rather than in the short term.</p>
<p>(h) Support requirements</p>	<ul style="list-style-type: none"> • Support requirements: consistency of objections and an indication of what would be acceptable within statements of support and providing support for consistory clause identical to supported amended claim were discussed. • Object clauses filed with specifications were discussed particularly where proposed amendments to these have been objected to for lack of support. • Changes to scope of object clause may be an issue, or where there is limited support for all objects identified.
<p>6. Other matters</p>	<ul style="list-style-type: none"> • It was noted that where a deadline of 2 months has been set under regulation 70 to comply with requests to provide priority documents, this should be set out in examination reports. • Examination of patent applications in IPONZ relies heavily upon the electronic availability of documents and information. Where a priority document is reasonably available to an examiner from, for example a corresponding application filed with another IP Office and it would not place unreasonable or undue burden on the examiner to locate and obtain the relevant document, then it is not expected that an examiner would issue a request under regulation 70.