



Patents Technical Focus Group

Notes from meeting held at IPONZ

20 October 2017

Timelines and Targets

Timelines and targets for issuance of first examination reports after request for examination were discussed. It was agreed that updated timelines for each of the technology groups will be provided on the IPONZ website.

Expedited examination/GPPH

All expedited examination requests are given the same priority. The unexpectedly high demand for expedited examination under the GPPH is beginning to have an effect on other work.

Expedited examination is discretionary – factors such as the ability of IPONZ to service the expedited examination request are taken into account when considering any request.

Non- GPPH expedited examination requests must meet public interest or urgent commercial reasons such as potential infringement of the invention of the application. Reasons for expediting examination could be provided confidentially.

Requests for examination

IPONZ does not have a policy of issuing directions to request examination solely for the reason that the section 64(1) deadline (regulation 71) is imminent.

Applicants have a request examination task in their IPONZ case management facility in-box set at the 5 year deadline for requesting examination. Applicants are also provided with two 5th year maintenance fee reminder notifications before the deadline.

Applications which do not have a request for examination filed before expiry of the 5 year deadline will remain at filed status on the register. The application will not be deemed to have been abandoned. It was noted that the application will be deemed to be abandoned if the 6th year maintenance fee is not paid.

It was noted that the status of applications that do not meet the 5 year request examination deadline will be addressed in the proposed IP Omnibus bill.

Formalities

General comment

It was noted that IPONZ does not have a dedicated formalities team to review applications or amendments at the time of filing. As a result a range of non-examination matters may be included in examination reports.

All application documents and information are available to applicants and their agents at all times via the case management facility.

Notice of entitlement

IPONZ will investigate providing a radio-button option on the application page of the case management facility to allow for selection of the nominated person.

Notices of entitlement should bear the application number (either NZ or PCT international application number). Applicants are provided with the NZ application number immediately after filing.

Page and figure numbering

Regulation 24 - it was agreed that alphanumeric numbering of additional pages added to the complete specification as part of an amendment may be acceptable provided that final additional page indicates the number of the next page e.g. "2a, 2b followed by page 3".

- This is a temporary position and will be revisited within the next 12-18 months.
- Regulation 27 – it was noted that drawings may be labelled for example Figure 1A, 1B, 1C where the drawings relate to different aspects of the same embodiment. The drawings labelled as Figure 1A, 1B & 1C would collectively be considered to constitute Figure 1.

Authorisation of agent

It was discussed and agreed that where there has been a change in ownership that agents (including those of record for the previous owner) could provide an authorisation of agent in their favour from the new owner.

Where the agent of record for the previous owner is to continue, no authorisation of agent from the new owner will generally be required, provided the agent confirms they are authorised to act by the new owner.

It was noted that the case management facility does not facilitate authorisation solely for the assignment. IPONZ will consider the current functionality of the case management facility to identify where improvements may be made.

Practice

Amendments

Statements of support need to indicate where in the originally filed complete specification substantive support can be found.

Where the amendment is a change in the form of a claim, then the previously presented claim would not meet this requirement.

Response deadlines

The shortened two month period applies to claims which are of the same or substantially the same scope as those examined at any stage on the parent application.

Priority documents

As noted in a previous TFG meeting, when the applicant is requested to provide a priority document, then the 2 month deadline to provide priority document should be highlighted in examination report. This is done manually at present, and IPONZ will look to altering the examination report template to make highlighting of the date an embedded feature.

Generally, a copy of the priority document will not be requested by IPONZ when it is otherwise publically available online, or when there was no need to contest the priority date.

Abstracts

Regulation 33 requires an abstract to include the 'gist of the solution'. This can be the feature or features that provide the technical contribution of the invention. An examination manual guideline is presently being drafted, and will include a number of examples of acceptable abstracts.

There was discussion on the perception that the content of the abstract may be considered when construing the scope of the granted patent. It was noted other jurisdictions where the abstract may be considered generally include an express provision relating to the abstract or 'other documents' filed at the time of making the application. The Patents Act 2013 is silent on the role of the Abstract. It was noted that it may be possible to consider an amendment to the Act to introduce a provision which expressly removes the content of the abstract from consideration of the scope of the granted monopoly.

Examination reports

There was general agreement that examination reports should set out the relevance of each citation, including the relevant passages within the citation.

It was discussed that it is useful when examiners indicate the source of a citation, particularly if it was identified from a report from another IP office report. Noting the source of a citation is something that individual examiners may choose to do, however, it is not something that is enforced through practice guidelines.

Generally all claims in an application will be examined. Where the scope of the examination is curtailed, then this should be stated and a brief reason given. For example, where there is a lack of unity, then only the first invention may be examined; or the examiner may not give any substantive consideration to claims that include excluded subject matter.

IPONZ is considering the format and content of various examination report templates. This consideration will include how to reflect the scope of the examination undertaken by the examiner within the examination report.

Product by process

The approach taken by examiners is set out in the examination manual. Where the product is not novel per se, then the product or product by process claims may be objected to as lacking novelty. IPONZ will make some clarifying amendments to the examination manual.

Examination manual

IPONZ will look to introducing further examples relating to acceptable specification amendments.

IP Omnibus Bill & Amendments to Regulations

IP Omnibus Bill

A consultation document is expected to be issued early next year on matters previously identified by stakeholders and MBIE/IPONZ.

It was noted that the date of release of the consultation document will take into consideration the dates of release of other similar IP consultations.

Any changes arising from the proposed IP Omnibus Bill are expected to pass into law some time in 2019.

Amendments to the Regulation

A number of amendments to the Patents Regulations 2014 have been drafted and it is anticipated that these may come into force in February 2018. These include bringing into force amendments to allow for an address for service to be in New Zealand or Australia.

Next meeting dates

Next meeting dates proposed and tentatively accepted for February, July and November 2018