

Patents and Designs Technical Focus Group (“TFG”) Meeting Minutes

Date/Time	11.00am – 12.30pm, 12 November 2020
Location	Ministry of Business, Innovation and Employment (“MBIE”) 15 Stout Street, Wellington
Room	Rutherford Room
Apologies	Fiona Pringle, AJ Park

Participants

MBIE / Intellectual Property Office of New Zealand (“IPONZ”)	In Person
Gaby Cowcill, Manager Patents and Designs (Acting) (Chair) Warren Coles, Patents Team Leader Simon Maguire, Principal Patent Examiner (Acting) Tanya Carter, Stakeholder Engagement Manager Warren Hassett, MBIE Policy Monique Cardy, Team Administrator (minutes)	Duncan de Geest, AJ Park / NZIPA Jonathan Lucas, James and Wells David Nowak, Henry Hughes Doug Calhoun, NZ Law Society Laura Hollingsworth, Catalyst
	Video Conference
	Scott Sonneman, Davies Collison Cave Tom Robertson, Pipers John Landells , FB Rice

Topic	Speaker
Welcome	Gaby Cowcill
Matters arising from the previous action points	Gaby Cowcill
The previous actions points were discussed and had been completed, with the following exceptions/matters arising:	
Warren	Bring status column closer to the beginning of the spreadsheet, when exporting the patent search results when using the external search function on the IPONZ website.
	In progress, to be released shortly. The meeting noted that these results only display the first named applicants; could it please

		display all the applicants?
IPONZ	Restoration of patents and patent applications guideline to be reconsidered in line with discussions	Re-tabled for discussion in this meeting.
Gaby	IPONZ to look into making the assigned examiner available on the external Biblio page.	IPONZ proposed an alternative solution, where users are able to see who a task is sitting with. This was generally agreed. IPONZ will add this to our enhancement program.
IPONZ Update		Gaby Cowcill

Recruitment

- The Patents team are currently recruiting for 5 examiners, 2 in Engineering, 3 in Science. This will bring the team to 66 in total. Recruitment will likely continue into next year, focusing on the Science teams.

New teams

- Due to the growing team numbers, an additional Science team has been created. There are now three Science teams. There will be no changes to tech groups from the clients' perspective.

Backlogs and pendency times

- The pendency times were updated in October. GPPH cases are no longer included in the calculations, so there may have been some movement in the numbers. However, they now provide a better indication of when most clients can expect to receive their first examination report.
- The GPPH timeframes have not changed. Clients should expect to receive examination reports within 2 months of making a request for expedited examination under the GPPH
- The backlog has been dropping in the ICT/Electrical and Mechanical teams. The Chemistry and Biotech teams have far higher incoming case numbers and the additional challenge of larger proportions of less experienced examiners. These teams are just about breaking even.

Letter templates refresh

- The new letter templates have been rolled out across most of the key Patents letters, as well as the PCT Receiving Office. Some templates are expected to be rolled out in Trade Marks before the calendar year end, with further updates to follow.

Patents Māori Advisory Committee ("MAC")

- A MAC meeting took place in October, and to date 8 cases have been referred for consideration. In two cases, this resulted in an objection being raised. The MAC and Patents team will be looking to produce guidelines for release in future.

Recent service outage

- There had been a recent outage to IPONZ online services, which impacted a small number of customers, mainly relating to new applications (PCT entry and divisional) and requests for examination. A workaround was provided, where clients file by email and later upload documents when the system is back up, which can then be backdated manually. All of those impacted were contacted individually. The IPONZ Business Systems team are currently conducting a review of this outage, to ensure that IPONZ are better equipped to deal with

these kinds of issues going forward.

- The meeting commented that the workaround of emailing documents to mail@iponz, rather than declaring a closed day, worked well.

Comments from the meeting:

- Duncan noted that the guidelines were sent out with a relatively short turnaround time; *IPONZ/Gaby to endeavour to provide draft guidelines with 2-4 weeks' notice in future.*
- Doug asked about the remaining 1953 Act pending cases. IPONZ currently has ~490 1953 Act cases with the status 'Under Examination'. Of these, around 40 are awaiting a first exam report, and around 140 have mail waiting to be actioned.

Update from MBIE Policy Team

Warren Hassett

The IP Laws Amendment Bill

- The Cabinet briefing papers were proactively released on 20 October 2020, and are now on the [Ministry website](#). There had been a delay getting the required approval from the Ministers Office.
- Drafting instructions are being prepared, the Policy team is hoping to get drafting instructions completed by the end of the year. The exposure draft is currently expected in March/April 2021.

Copyright Act Review

- The Policy team are putting together discussion and options papers, and will be seeking further feedback to develop the objectives for the review. Due to the election, this has been pushed back.

Foreign Trade Agreement Negotiations

- Negotiations with the EU and UK continue. These are likely to have implications for New Zealand legislation, however, it is not yet clear what these will be.

Draft guidelines for review and discussion

Restoration

Simon Maguire

- Feedback from the previous meeting had been taken into account. In particular, substantive changes had been made to the paragraphs discussing who can apply for an assignment (paragraph 31 – 37), following discussion in the previous TFG.
- IPONZ can confirm that the system allows for assignments to be submitted on withdrawn, abandoned, lapsed and revoked patents/applications. IPONZ practice is to only register such assignments if the assignment date is before the failure date (which in effect assigns the residual rights). However, registration of an assignment after failure does not change who needs to make the restoration request as this is stated in the act.
- The meeting drew attention to further areas which required updating. Some wording was agreed and updated during the meeting, with some for IPONZ to consider after the meeting.
- The meeting agreed that the restoration and other guidelines could be improved generally by using clear language, and making reference to the specific section, regulation or case law which gives authority to any guidance.

S.43 Deposit requirements for m/orgs	Simon Maguire
<ul style="list-style-type: none"> • IPONZ were proposing minor changes to paragraph 2 and a new paragraph 8, to add a link to the Budapest Treaty and IPONZ' International Patents page, respectively. • The meeting was invited to propose any additional amendments. Some amendments to paragraphs 1, 2 and 9 were suggested, clarifying the timing for obtaining and providing receipts, and which depositaries can be used. These suggestions were noted and would be incorporated into the guidelines. • IPONZ to publish this guideline. • Doug asked who would be legally entitled to request samples. IPONZ confirmed that there is a form (WIPO form BP/12) for entities to request the furnishing of samples which can be certified by IPONZ, but IPONZ makes no other determination of legal entitlement. It is IPONZ' understanding that the depositary would contact the depositor if a sample is requested. 	
PCT National Phase Entry	Warren Coles
<ul style="list-style-type: none"> • The proposed additional content was displayed and reviewed by the meeting, and member's feedback incorporated. It was noted that this is not a change in process, but IPONZ is seeking to make it publically available. • It was proposed and agreed that this information be accessible from the 'Maintain a Patent' page. IPONZ to publish this information. 	
S.9 Disclosure to be disregarded	Warren Coles
<ul style="list-style-type: none"> • The meeting reviewed the guideline and provided feedback during the meeting. • The meeting discussed whether s.8(2) disclosures would or should be disregarded. It was noted that the preamble for s.9 states it is 'for the purposes of s.8', but in the case of s.8(2) art, there is not a public disclosure in the 12 month grace period. To avoid misleading readers, it was agreed that the guideline would not draw any conclusions at this stage. Warren H would consider this further. • IPONZ to publish this guideline. 	
Practice queries and discussions	
Authorisation of agent – reg.40	David Nowak
<ul style="list-style-type: none"> • David queried whether the Patents Team still requires an authorisation of agent signed by the Applicant, when a file is transferred from one attorney from one to another. It has been difficult to meet this requirement with Covid. It was noted that reg. 40 states that it "may" be required by the Patent Office, so there is some discretion. It was noted that it is hardly ever required for trade mark applications. • It was agreed to allow the filing of an authorisation of agent signed by the agent, provided it is accompanied by an explicit statement to effect that the agent has been authorised by the owner to act as agent for the case in question. 	

- **IPONZ to instigate this practice change, and provide communications when complete in the normal way.**
- It was also noted that IPONZ is working on an agent identification project and related process initiatives, which will focus on how identity records are defined, verified and managed. This will also involve a review of the rights of users to change and maintain their records and portfolios. An internal working group has been set up, including some ex-attorney examiners to test possible solutions.

Discussion on divisional examination practice (parallel vs staggered)

David Nowak

- David outlined that whilst reg.76 prescribes that cases must be examined in the order the requests for examination are received, IPONZ is currently using reg.77 to move later-requested divisionals up the queue for business reasons, and examining them at the same time as the parent application. He outlined reasons that this may not be a more efficient or desired approach for either applicants or the Office.
- It was noted that practice may vary across the office, with ‘parallel examination’ being more common in the Science teams, where there are longer queues and more divisionals. This is more efficient for the examiner at the first exam stage, particularly if there are clearly multiple inventions and overseas divisionals. It was noted that overseas divisionals may not always guide NZ divisionals.
- Warren C outlined the practice within his team, which is simply to examine cases in the order that examination is requested. The meeting agreed that Warren’s current process is preferred, and should be extended to the wider team. **IPONZ has communicated this to all teams.**
- It was requested that if an application is being expedited for IPONZ’s purposes, it should be noted in the report.
- Duncan asked about refunds for examinations if cases are subsequently abandoned. It was noted that this is at IPONZ’s discretion, on a case-by-case basis.
- It was noted the timing of filing divisionals and requesting examination will also be affected by the IP Laws Amendment Bill.

Threshold for public interest/directing to request exam (Reg 74)

David Nowak

- David commented that refusing such requests might be *ultra vires*, and also requested clarification on the threshold of public interest which is or should be applied.
- IPONZ noted that numbers of these requests were quite low, but that indications from Warren H/MBIE Policy were that the threshold of public interest should be relatively low. No opinions were put forward on whether refusing such requests would be *ultra vires*. It was however discussed whether such requests should be open to public inspection. **IPONZ to clarify this in the next meeting.**

What happens if the excess claims fee isn’t paid?

Duncan de Geest

- Duncan asked what happens to an application where the excess claims fees are not paid, and the task is not satisfied by the deadline.
- It was confirmed that if the fee is not paid, then the patent does not go to grant, however there is no other formal consequence of not completing the task. The task simply regenerates with another 3 month deadline.
- In investigating this, IPONZ has also noted that the number of excess claims is not displaying in the discussion confirming payment of the excess claims fee, and have arranged to correct this.

Delays in examination during the final 20 days of s.71 period	Duncan de Geest
<ul style="list-style-type: none"> • Duncan noted an instance where a response to the fourth examination report was filed 10 working days before the final deadline. An examination report was issued some time after the final acceptance deadline, and no extension of time was allowed. He noted that this, along with the rigid application of the '20 working day' rule in such circumstances, is far from ideal for applicants and has the effect of shortening the s.71 period to 11 months. • IPONZ noted that the Patents team normally responds to ~95% of mail within 20 days. However, the team currently has a large number of applications all at the end of the s.71 dates, which were bunched up as a result of the Covid extensions. • IPONZ examiners should also be reminded that these cases are to be prioritised. <i>IPONZ has reminded examiners of this.</i> Attorneys were also encouraged to phone examiners to alert them to such cases. 	
<p>Any other business</p>	
<ul style="list-style-type: none"> • Before the meeting, Tom Robertson had raised the issue of interpretation of s.8(2) in relation to PCT applications which had not entered the national phase. IPONZ' interpretation/guidance is that such documents are citable under s.8(2). The team agreed to discuss this outside of the meeting, due to time constraints. • Doug Calhoun requested a quick turnaround of minutes. It was agreed that minutes will be published on the IPONZ website without needing to be approved at the following TFG meeting. All members will be given an opportunity to provide feedback by email prior to publication. 	
<p>Close of Meeting</p>	
<p>Summary of items requiring further action from IPONZ:</p>	
<p>Publish:</p> <ul style="list-style-type: none"> - s.43 Deposit Requirements guideline - PCT National Phase entry instructions - s.9 Disclosure to be disregarded guideline 	
<p>Warren H to consider whether s.8(2) documents would fall under the scope of s.9.</p>	
<p>Instigate change in practice around removing the requirement for an authorisation of agent signed by the applicant, and communicate the same.</p> <p>Contact IP Australia to discuss how they deal with issues of disputes between attorneys or unregistered persons, in relation to the authorisation of agent.</p>	
<p>Clarify whether requests made under reg.74 should be open to public inspection.</p>	