

Patents

Technical Focus Group (“TFG”) Meeting Minutes

Date/Time	11.00am – 12.30pm, 23 August 2021
Location	Virtual only

Participants

MBIE / Intellectual Property Office of New Zealand (“IPONZ”)		External Participants	
Gaby Cowcill	Manager, Patents (Chair)	Doug Calhoun	NZ Law Society
Warren Coles	Team Leader, Patents	Tom Robertson	Pipers
Simon Maguire	Principal Patent Examiner	Duncan de Geest	NZIPA / A J Park
Warren Hassett	Senior Policy Advisor, IP Policy	Jonathan Lucas	JAWS
Monique Cardy	Team Administrator (Minutes)	David Nowak	Henry Hughes
		Laura Hollingsworth	Catalyst
		Scott Sonneman	DCC
		John Landells	IPTA / F B Rice

Agenda item	Speaker
Matters arising / previous action items	Gaby Cowcill
IPONZ to publish: <ul style="list-style-type: none"> Restoration guideline Regulation 147 guideline 	Complete.
IPONZ to update the Timeframes web page and other relevant pages with GPPH timeframes	Complete.
IPONZ to consider accessibility of Māori Advisory Committee (MAC) cases and information	The IPONZ Year in Review will include some high-level information on numbers of cases referred to the MAC. A technical solution to search for these cases is in progress.
IPONZ to investigate whether RealMe login can redirect users to previous page.	We are working to resolve this, but there is no solution at this stage.
Provide an update on definition of s.8(2) prior art, following hearings decision.	This will be reviewed once the decision has been issued.

Confirm whether IPONZ PCT RO accepts the inclusion of documents in pre-conversion format, and consider treatment of drawings in particular.	Confirmed. IPONZ to continue dialogue with international partners on this.
From November 2020 meeting: Primary examiner & requesting GPPH after 5 years.	Both will be included in upcoming release, scheduled for 1 September (possibly subject to delay).
IPONZ Update	Gaby Cowcill

Recruitment

- The new examiners who started in January 2021 have now joined the examination teams.
- We recruited for several additional vacancies earlier this year, including 7 new examiners and a Formalities team member, who are now in training. After a resignation, the team total is now 71.

Backlogs and pendency times

- The timeframes published on the IPONZ website were recently updated and include GPPH timeframes.
- Two tech pendencies have gone down, two tech pendencies have gone up, one has stayed the same.
- Whilst the Engineering (ICT, Electrical and Mechanical) teams are now over the February 2020 spike of work, the Science teams have a way to go.

1953 Act update

- 397 cases are still under examination.
- The team have increased resources in this area, by providing training on 1953 Act examination. There is no specific timeframe as to when we will clear the list of cases, but it is expected that the team will be completing some of our older case files soon.

MAC

- IPONZ have been focused on resolving some administrative issues.

Clarivate Report

- IPONZ commissioned Clarivate to produce a report on innovation in New Zealand. The report uses publically-available data and does not necessarily represent the views of IPONZ.
- This has now been published on the [IPONZ website](#).
- It was mentioned that the Productivity Commission also produced a report on the New Zealand Innovation System, which would probably line up quite nicely with this report.

Tech Update

- IPONZ continue to investigate the formatting issues discussed previously, which is removing spaces from inventor names, design checksheets etc. Whilst there is an algorithmic option, it will be very resource intensive,

so we are unable to confirm the timeframe for completion at this stage. The team can make changes on request.

- The data link with EPO is back up and running.

Update from MBIE Policy Team

Warren Hassett

The IP Laws Amendment Bill

- This is now with Parliamentary Council Office drafter. There is no indication of timeline for this, however, we remain optimistic that the exposure draft will be available by the end of the year.

PVR Act Review

- This went to Select Committee last week. There are a number of submissions still required. We are expecting the Committee to report back around October 2021.

Draft guidelines for review and discussion

Regulation 82

Gaby Cowcill

Ganymed

- It was noted that this decision overturns current practice around whether surrender is a way of overcoming regulation 82 objections.
- Members agreed that discussion of Ganymed was accurate in the draft, and provided some minor feedback.
- The meeting agreed that in future, if short-term changes were needed in light of case law, these could be circulated via email with a shorter deadline for comment.

Oracle

- It was noted that there is currently minimal discussion of this case and no proposed change in practice around 'wholly within'-type objections. IPONZ confirmed that Oracle is likely to receive more attention in future, but the priority was changes in light of Ganymed.
- Members provided feedback highlighting relevant passages in Oracle, and why it should change practice.

Section 67

Simon Maguire

- At the moment, with an early non-substantive response, there is a shortened time period of a month to respond. This occasionally results in a second exam deadline, which is before the first exam deadline expiring. It was proposed to change this, so that the deadline does not get shorter.
- Members generally agreed with this approach, and provided some additional feedback:
 - A query was raised regarding a new paragraph discussing further subsequent non-substantive responses, and when these might be refused. It was confirmed that non-substantive responses would only be refused if multiple non-substantive responses are submitted.
 - Positive feedback was received about including discussion of responses being in good faith.
 - For consistency, refer throughout to 'response deadline', rather than 'response date'.

Section 39	Gaby Cowcill
<ul style="list-style-type: none"> • IPONZ is proposing to delete paragraph 77, which relates to reach through claims, as it seems to be causing some confusion. • It was agreed to remove the paragraph. 	
IPONZ backlog	Gaby Cowcill
<ul style="list-style-type: none"> • This is a priority for IPONZ. The member were asked to provide ideas to improve efficiency, including a reminder of the 5-year deadline and a prompt for filing overseas claims. Members provided the following additional feedback: <ul style="list-style-type: none"> ○ A refund would be an incentive for applicants to abandon applications which they no longer want to progress. An automatic refund option could operate in a similar way to the EPO. Examiners could then focus on preparing reports for applications intended for progress. ○ It was also suggested that statements of support and inventive step objections be reviewed. ○ Additional bilateral PPH agreements would be useful, as would loosening provisions in the Act and Regulations around request for exam and filing of divisionals. 	
Design Authorisations of Agent (AoA)	Jonathan L
<ul style="list-style-type: none"> • Jonathan queried around IPONZ' practice for filing AoA for designs, and whether there had been any changes. • In one recent case, the agent was advised that IPONZ has changed its practice, so that an AoA for designs can only be filed in certain circumstances. It may not often be necessary to file an AoA at other times, but it can be useful. • IPONZ confirmed that the amendment/alteration function was set up as a correction of error, and was being used incorrectly. This had been communicated on a case-by-case basis. • The team are collecting data on what this was being used for, with the aim of providing a system solution to functions that are required regularly. • In the meantime, a workaround is to phone the examiner, who will create an open discussion. 	
GPPH	Jonathan L
<ul style="list-style-type: none"> • Jonathan noted that there have been some instances where GPPH requests were refused outright, without the option to correct the application. • IPONZ confirmed the current process is to issue a discussion if there are issues with the supporting documentation, and decline the request if it relates to the claims not corresponding (noting that requests can be refiled). This is so that amendments to the complete specification are dealt with correctly. • Members provided feedback around a preference not to re-file requests, and suggested a task-based workflow rather than a discussion. • IPONZ to review possible system enhancements to streamline this. 	

Any Other Business	
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- 6 December 2021 will be the date of the next meeting.

Close of Meeting

Summary of items requiring further action from IPONZ:

Continue discussion on PCT RO treatment of drawings with international partners.

Publish agreed manual sections.

Record and consider feedback on examination efficiencies.

Review possible enhancements to provide a workflow for GPPH requests.
