

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

Date/Time	25 June 2020, 10.00am
Location	Ministry of Business, Innovation and Employment (“MBIE”) 15 Stout Street, Wellington
Room	Rutherford Room
Apologies	John Landells (FB Rice, IPTA)

Participants

MBIE / Intellectual Property Office of New Zealand (“IPONZ”)	Other
Simon Pope (Chair), Simon Maguire, Gaby Cowcill, Warren Coles, Tanya Carter, Warren Hassett (MBIE Policy), Monique Cardy (minutes)	Fiona Pringle (Baldwins), Duncan de Geest (AJ Park), Doug Calhoun (NZ Law Society), Scott Sonneman (DCC), David Koedyk (Catalyst)
	Video Conference
	Jonathan Lucas (James and Wells), David Nowak (Henry Hughes), Tom Robertson (Pipers)

Topic	Speaker
Welcome	Simon Pope
Update from MBIE Policy	Warren Hassett
<p><u>IP Omnibus Bill</u></p> <ul style="list-style-type: none"> This is now with Cabinet’s Economic Development Committee. We expect it will be approved by Cabinet on Monday and drafting of the legislation will begin shortly after. The aim is to have the exposure draft complete by November. There will be communication to notify clients of the paper’s proactive release, closer to the time. <p><u>The PVR Act Review</u></p> <ul style="list-style-type: none"> The PVR Act Review is currently being drafted and the consultation document released in July, for Cabinet approval over the next few weeks. It is expected that the paper will be proactively released in August. <p><u>Copyright Review Paper</u></p> <ul style="list-style-type: none"> The options paper is being drafted, it is not expected that it will be ready until early 2021. 	

IPONZ Updates	Simon Pope
<ul style="list-style-type: none"> • Graphs displaying patent application volumes were displayed to the meeting. The number of patent applications remains steady. Gaby added that there are no 1953 Act PCTs remaining under examination, only divisionals, of which there are around 40 unexamined in Biotech team and around 130 pieces of mail. • The meeting provided feedback on the new patents letter templates. It was noted that attention to detail on dates was required. Warren C added that some inaccuracies were due to system errors which have since been identified and rectified, as part of the next phase of system enhancements. • Simon P noted that the revised letter template will be rolled out to the Trade Marks and Designs Teams later this year. It will not be applied to 1953 Act patent cases. The PCT Receiving Office will also be updating their invoice and refund letters, to be aligned with the new letter templates. • The Patents team recruited additional trainees over the lockdown period. There had been another progression round within IPONZ, in which 3 members of the Patents team were progressed. • The guidelines previously discussed have now been published. Note a minor consequential amendment was required to the guideline 'Section 39: Contents of complete specification', to make it consistent with the new guidelines. Specifically, paragraph 49 was removed, as this practice was changed by the new guidelines. The historical section below the exam manual has track change copies. However, the recent s.40 update was an extensive rewrite of this section, and a document showing all changes was not possible. • Automatic Covid-19 extensions were due to cease at the end of July. The meeting agreed that this seemed like a reasonable date and currently aligns with both the UK and IP Australia. The meeting noted that IP Australia are providing a week's notice for any further updates, and IPONZ could align with that. Warren C confirmed that, in instances where the 3-month extension exceeds the Section 71 deadline, the s.71 deadline is also being extended so the two dates coincide. David N added that there is some information on this in the web guidelines. • The provisions under which the extensions were given remain, and extensions are available upon request and will be considered on a case-by-case basis for Covid-related reasons and/or other exceptional circumstances. • Applicants should use the existing regulation 147 document type for extensions to the s.64 and s.71 deadline on cases which have not lapsed. Extensions under regulation 78(3) can only be requested after the expiry of other deadlines, but if IPONZ are notified in advance (by letter on file), we can stop the case voiding by applying a provisional extension manually. This will need to be followed by an examination response, including a formal request for the extension of time. 	
Using trading name as an address for service and understanding of 'Agents'	Simon Pope
<ul style="list-style-type: none"> • Simon P raised a query from the Trans-Tasman Patents Attorney's Board, on using a trading name as the address for service. The Patent and Trade Mark regulations say that an agent means "a person", and a trading name is not a legal person, but both IPONZ and IP Australia seem to accept them. • The meeting agreed that they are happy with the current practice, rather than including the name of the natural person, for those who are still functioning as partnerships. Warren H confirmed that the definition of "person" in the Interpretation Act 1999 includes unincorporated bodies, therefore this would not be an issue for unincorporated bodies. • Simon P added that IPONZ plan to implement new practices around 'agent verification', which will focus on the agent being a verified person, rather than verifying their relationship to each case. Duncan noted IPA 	

require each natural person using eServices to have a username and login.

Lack of unity as a ground for revocation

Jonathan Lucas

- An inconsistency between s.92(1)(c) and s.114(1)(c) appears to indicate that unity is a ground for revocation, but this seems to be inconsistent with the intentions.
- Warren H clarified that lack of unity is not a ground for revocation. Section 104(2) prevents unity from being used as a ground for revocation.

Implementation of new practice towards abstracts

Jonathan Lucas

- We have seen the implementation of the recently agreed approach to abstracts following the previous TFG, whereby examiners amended abstracts themselves, which the meeting agreed was a helpful change. It was noted that there are inconsistencies to how this is done in practice. In one case the examiner objected to the abstract and said they would amend it, if the applicant did not do so. In another cases the examiner simply amends the abstract, and notified the applicant of the change.
- The meeting agreed that the preference would be for the examiners to touch up abstracts in a way they are happy with, to progress applications at a faster pace.
- It would also be beneficial to include a notice in the acceptance letters, to notify the applicant of the change. Simon M added that this has been incorporated in to the new letter template.
- Tom added that it would be useful to make note of the changes in the abstract i.e. to italicise or underlined, to make it obvious where changes have been made.

Restoration of patents and patent applications

IPONZ

- The draft guidelines were presented for discussion, and this centred on who can apply for restoration and matters in relation to assignment. The meeting noted issues with the draft guidelines referring to recording an assignment on a lapsed case, which appeared to be an error. And according to the Act, only the patentee recorded on the register at the time of lapse can apply for restoration.
- It was asked whether there was a reason for not recording an assignment on a lapsed case. Warren H confirmed that there is no other incentive for assignees to register assignments.
- David N mentioned that Australia does allow assignment of a lapsed patent, as there are still rights outstanding.
- After some time the discussion was stopped, with an action on IPONZ to reconsider the guidelines in light of the points raised, revise the current draft, and re-table at the next meeting. The meeting also noted additional areas requiring clarification which would also be addressed.

Any Other Business

- The meeting noted soft phone issues for examiners working remotely. Many examiners were now back in the office and contactable normally, but the meeting were encouraged to contact the relevant Team Leader in such instances, who will be able to assist. This issue should be rectified with the full roll out of Microsoft

Teams (currently expected November 2020).

- Fiona asked whether the Excel spreadsheet of exported patent search results could have the columns rearranged, to bring the status column closer to the beginning of the page, as it the case for Trade Marks or Designs.
- Tom noted that it would be helpful for clarity objections to be specific where possible, for example using line numbers.
- The meeting asked if it possible that when a case is reassigned to another examiner, they be notified of this change. Gaby confirmed that this information is included internally, on the Bibliographic page, and we would look into making it external.
- The meeting asked that the minutes be circulated soon after the meeting.
- There have been a number of instances where parent and divisional applications are being examined at the same time, which is resulting in parallel arguments on both cases. This was tabled for further discussion at the next meeting.

Close of Meeting

Summary of Action Points

Owner	Action	Status
Warren H/ Tanya	Notify clients of the proactive release of IP Omnibus Bill papers, nearer the time.	
Tanya	Update timeframes on IPONZ website.	Complete – 7 th July
Tanya / Gaby	IPONZ to consider publishing more detailed Patents stats on the IPONZ website	In progress – expected to be published in August
Tanya	IPONZ to liaise with IP Australia on the timing of ceasing automatic Covid extensions, and provide an overview of applying for these extensions on the IPONZ website.	Complete – 16 th July
Warren	IPONZ to check that notifications on automatic Covid extensions were referring to the correct section and regulation.	Complete – there were previous errors, which had already been corrected
Patents Team Leaders	IPONZ to feedback examination practice issues (dates, abstract, clarity) with examiners.	Complete
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
IPONZ	Restoration of patents and patent applications guideline to be reconsidered in line with discussions	Table next meeting

Gaby	IPONZ to look into making the assigned examiner available on the external Biblio page.	In progress
IPONZ	Schedule next TFG to follow the exposure draft of the IP Omnibus Bill, in Oct/Nov 2020.	