

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

Date/Time	28 April 2021
Location	Ministry of Business, Innovation and Employment (“MBIE”) 15 Stout Street, Wellington
Room	Rutherford Room

Participants

MBIE / Intellectual Property Office of New Zealand (“IPONZ”)	Members in attendance	
Gaby Cowcill, Manager Patents and Designs (Chair) Warren Coles, Team Leader, Patents Simon Maguire, Principal Patent Examiner (Acting) Warren Hassett, MBIE Policy Tanya Carter, Stakeholder Engagement Manager (Acting) Rob Garrett, Manager, Business Systems	Doug Calhoun Duncan de Geest Jonathan Lucas David Nowak David Koedyk Scott Sonneman Tom Robertson John Landells	NZ Law Society NZIPA / A J Park JAWS Henry Hughes Catalyst DCC Pipers IPTA / F B Rice

Minutes

Topic	Speaker
Welcome	Gaby Cowcill
Matters arising from the previous action points	Gaby Cowcill
Publish: <ul style="list-style-type: none"> s.43 Deposit Requirements guideline s.9 Disclosure to be disregarded guideline PCT National Phase entry instructions 	Complete
Warren H to consider whether s.8(2) documents would fall under the scope of s.9.	No further information at this stage
Instigate & communicate change in practice around relaxing the requirement for an authorisation of agent signed by the applicant (reg.40).	In progress
Make Primary examiner visible to case contacts.	In progress

OPI status of requests made under reg.74.	IPONZ confirmed these are not OPI, however, they may be released under the OIA.
Excess claims fees & receipts.	IPONZ fixed an error in the discussion generated when an excess claims fee is paid. The discussion now includes confirmation the fee has been paid and the total number of claims.
IPONZ Update	Gaby Cowcill
<p>Recruitment:</p> <ul style="list-style-type: none"> • 5 new examiners were recruited in January 2021, across a variety of technical specialities and experience levels. • There is also a new team member in our Support/IP Formalities Team, who is providing cover for a team member on parental leave. • There is a total of 64 people in the Patents team. <p>Backlogs and pendency times:</p> <ul style="list-style-type: none"> • The 2013 Act pendency times were updated in April, and reflect the pendency time from requesting examination to when the first examination report is issued. • In future, the Timeframes page will be updated to include an indication of GPPH timeframes, likely also the GPPH pages (clients should expect to receive examination reports within 2 months of making an allowable request for expedited examination under the GPPH). • Some teams are making progress into their backlogs but this is not yet sustained. Other teams are still working hard to stabilise backlog growth. Consequently, recruitment is planned to continue. • As of 20 April 2021, there are 424 1953 Act cases under examination; all are divisionals. Of these, there are about 25 unexamined divisionals and 130 pieces of mail in the Biotech team. Previous strategies to address this mail have not been as successful as hoped, so the team are working on an alternative approach. <p>Patents MAC:</p> <ul style="list-style-type: none"> • The Committee have provided some case studies, which we are intending to incorporate into guidelines. • Doug Calhoun commented that providing more information on MAC cases would be helpful, for example being able to search for cases that have objections and what the outcomes were. Following a number of similar requests for this information, IPONZ will consider what information is available and whether this can be increased or made more easily accessible. <p>Matters arising</p> <ul style="list-style-type: none"> • John Landells asked whether IPONZ allow GPPH requests after the 5-year deadline has expired, given that GPPH cases and amendments generally benefit the Office in terms of efficiency, and thus applicants as well. IPONZ confirmed this is a known limitation, which is planned to be addressed in a future system 	

release. IPONZ agreed that GPPH or similar filing of overseas granted claims generally enables a more efficient examination, and encouraged users to consider this where appropriate.

- In the meantime, applicants and attorneys should contact IPONZ by phone and our Contact Centre will direct you to the appropriate team, who can organise an open discussion for you to file your GPPH request / documents.

World IP Day

- Tanya advised the World IP Day event will be happening on 17th May, and members should watch out for invites soon.

Systems Update

Rob Garrett

- There had been some outages since the previous TFG. IPONZ data had been migrated to a new platform, and this had resulted in some instability.
- IPONZ are also aware that there are some data issues at present, for example the formatting of addresses, which the team are working to resolve.
- A mock-up of a new front cover page for NZ patent specifications was shared with the meeting, which provides bibliographic information about the application.
- Rob provided an overview of future changes in the pipeline around agent identity and changes to patent data to better facilitate examination and data transfer.

Matters arising:

- It was noted that at present, NZ applications only appear on the Patentscope 'National applications' tab at acceptance. Rob confirmed that this data is available to WIPO to use if they wish. It was further noted that NZ applications do now appear on the 'Family' tab, following a recent Patentscope update.
- It was mentioned that if a user clicks the link to the 'particular case' in IPONZ notifications whilst being logged out of RealMe, following login, they are then directed to the inbox rather than the case. Rob advised this may be the expected behaviour, but would look into it.

MBIE Policy Update

Warren Hassett

IP Laws Amendment Bill

- This has been delayed, but is expected to go before PCO in the next month.

PVR Act Review

- This is anticipated to be introduced to Parliament and receive its first reading in mid-May.
- Note that shortly after the meeting ended, MBIE released the submissions and Cabinet Papers. These can be [found here](#).

Copyright Act review

- The next step is to consult on potential changes to the objectives for the review.
- Other than minor amendments as part of the IP Laws Amendments Bill, there are no reviews of the Designs Act 1953 currently under consideration.

Draft guidelines for review and discussion

- IPONZ briefly mentioned some minor changes to existing guidelines to improve readability and will circulate these before updating and archiving the marked-up version.
- IPONZ also provided an update on guidelines currently in draft and planned to be tabled for future meetings.

Restoration

Simon Maguire

- Members queried why evidence ‘must’ not contain trivial mistakes, and suggested that some additional case law on undue delay may help clarify this section. There was further discussion on why only 5 days is provided in some circumstances and approaches to avoid triggering such a tight deadline, and why addressing the 5-year deadline separately was needed.
- Generally, the guideline was largely agreed upon. IPONZ agreed to incorporate this feedback when making final edits.

Regulation 147

Simon Maguire

- The meeting discussed how the practice of re-submitting documents under reg.147 would work. It was noted that the guideline gave flexibility for a case-specific approach, such as a phone call.
- Several members commented on draft paragraphs 10-11 referring to case law under other legislation, and made some suggestions of ways in which the reader could be better warned to consider the legislative context.
- Generally, the guideline was largely agreed upon. IPONZ agreed to incorporate this feedback when making final edits.

Practice queries and discussions

s.8(2) Definition of prior art

Tom Robertson

- Tom proposed that PCT applications, which had not entered national phase should not be citable under s.8(2), and provided detailed submissions in support of this position prior to the meeting.
- Several members spoke in support, highlighting in particular the historical context of IPONZ’s practice and interpretation, the underlying purpose of the section, and noting that a similar proposal has been put before IP Australia. IPONZ considers that any change to this would likely require legislative change rather than mere practice change, and noted that the current practice is clearly set out in the s.8 guidelines.
- It was noted that a hearing is now pending on a case with this issue. Consequently, IPONZ proposed to defer full discussion of the issue pending the outcome of the hearing. The meeting generally agreed with this approach.

ePCT Rendering of drawings

Jonathan Lucas

- Jonathan noted that IPONZ frequently object to drawings when filing applications via ePCT, more so than other offices, and proposed that IPONZ reconsider practice or provide some information on how best to provide clear drawings that meet PCT requirements.

- IPONZ confirmed that the acceptability of drawings is largely dictated by the ePCT systems, which renders the figures into image format.
- IPONZ will confirm whether it accepts the inclusion of documents in pre-conversion format. Generally, IPONZ is looking to improve the PCT RO processes and will look at treatment of drawings in particular.

Close of Meeting

Summary of items requiring further action from IPONZ:

IPONZ to publish:

- Restoration guideline
- Regulation 147 guideline

IPONZ to update the Timeframes web page and other relevant pages with GPPH timeframes

IPONZ to consider accessibility of MAC cases and information

Rob to investigate whether RealMe login can redirect users to previous page.

Provide an update on definition of prior art, following hearings decision.

Confirm whether IPONZ accepts the inclusion of documents in pre-conversion format and consider treatment of drawings in particular.