

Patents

Technical Focus Group (“TFG”) Meeting Minutes

Date/Time	28 June 2022, 10.30am – 12.30pm
Location	TBC – Pastoral House, L03 01C

Participants

MBIE / Intellectual Property Office of New Zealand (“IPONZ”)	Members	
Rebecca James (Chair) Simon Maguire Warren Hassett Edward Barclay Matt Allen Emma Stares Chloe O’Shea Steve Smith Irina Minyukhina (minutes)	Doug Calhoun Tom Robertson Duncan de Geest Jonathan Lucas David Nowak Scott Sonneman John Landells	NZ Law Society Pipers NZIPA / A J Park JAWS Henry Hughes DCC IPTA / F B Rice
Apologies	Laura Hollingsworth	Catalyst

Agenda

Time	Topic	Speaker
	Welcome	Rebecca
	<ul style="list-style-type: none"> If in person - Health and Safety items: Fire escape, earthquake, toilets Introductions 	
	Review of Previous Meeting Action Points	Rebecca
	Action	Status
	Finalise change agent guidelines & publish Publish changes to section 39 have been published	Published
	Real Me issues	The 1 July update should fix the issues
	Workflow for GPPH	Ongoing

ST.26 guidance has been published on our website.		
- finalise & publish comms		Done
- capture in Issues Register		Done
Double patenting:		
- s 14 change in practice		Done
- Reg 82 guideline		Ongoing
Māori IP guidelines		Ongoing
	IPONZ Updates	Rebecca
<p>Recruitment/People movement</p> <ul style="list-style-type: none"> • Simon Gallagher has resigned from his role as National Manager, IPONZ to take up a new role within MBIE. • Recruitment for the new National Manager role has concluded, with Becky White joining IPONZ in August. • Rebecca James is currently Acting Manager, Patents and Designs until August. • Warren Coles and Simon Reeve have taken up new roles as Assistant Commissioners in the hearings team. • Within the Patents team, there has been a heavy focus on recruitment as we look at putting a new organisation structure in place and then looking at filling the remaining Patent examiner vacancies. <ul style="list-style-type: none"> ○ Matt Allan (Chemistry), Daniel Sanson (Mechanical), Lizzy Eden (Biotech), Ed Barclay (ICT/Electrical) and David Rotherham (Biotech) have all been appointed as team leaders. ○ 11 new associate examiners joined the team in April, with further recruitment planned for the next quarter. <p>Pendency Times</p> <ul style="list-style-type: none"> • With the current training and future recruitment planned, the pendency time in all technology areas is increasing. These were last updated in May and are available on the IPONZ website. • May 2022 saw the highest number of actions this year with 564 examination tasks (first examination and correspondence inclusive across all Patent types). May also saw the highest individual tech team output in the Mechanical, ICT/Electrical and Chemistry teams. <p>1953 Act update</p> <ul style="list-style-type: none"> • There were 339 cases remaining as of 8 June 2022, all of these are divisional applications and roughly half are Biotech cases. <p>Systems update</p> <ul style="list-style-type: none"> • IPONZ is currently developing a work flow task for expedited examination requests to move away from the current discussion system to a letter and task based workflow. We are hopeful that this will be included in the next release in August. <p>Member Questions:</p>		

Members asked about how many patent examiners IPONZ is aiming to have, as well as how IPONZ compares internationally in the number of first examinations completed.

- IPONZ response is that we are looking to get to 99 examiners we are expecting the pendency to increase before it will improve as we will need to take into account training time.
- In regard to the international comparison, Rebecca did not have that information at hand, and we can provide that detail at the next meeting.

Member enquired on whether IPONZ was through the 2022 bubble yet.

- IPONZ responded that we are almost there

Update from MBIE Policy Team

Warren H

- IP amendments bill still pretty much on hold expecting to get a draft early next year, however, some items are being transferred to Regulatory System Bill updates
- PVR bill is still in train
- EUFTA is reaching a conclusion, will most likely lead to a re-write the GI legislation to hopefully align with the EU meet our obligations under the NZ-EU FTA.
- UK NZ FTA has made it to parliament and will be reviewed by the committee
- Members queried which items from IP Amendment Bill are being shifted to RSB4, Warren to provide this information in an email

Draft manual sections for review and discussion

Regulation 82 - Parent and divisional overlap

Emma and Simon

- Guideline is being replaced to reflect the changes resulting from [Ganymed](#) and [Oracle](#) decisions. Members provided feedback that the proposed guideline was not consistent with the approach taken in the recent decisions and that this will lead to additional complication during examination.
- Members disagreed with including 1953 Act case law as discretion is not applicable under the 2013 Act. Therefore, the use of notional rewriting from Abbott Laboratories was not agreed with.
- David Nowak noted that applying regulation 82 to other family member (e.g. sibling applications) was not an accurate interpretation of the regulation. IPONZ submits, that this is within the intent of this regulation.
- IPONZ will reconsider the guideline and update TFG members accordingly.
- Warren mentioned that amendments to deal with double patenting may be included with the Regulatory Systems Amendment Bill. This may make regulation 82 obsolete.

Sections 200-202 - Correcting errors or omissions in patents

Steve S

- Members generally agreed to this guideline.

<ul style="list-style-type: none"> Members queried the practice around errors or omissions that may result from an “error of judgment”. Particularly around errors of judgment when identifying inventors. IPONZ stated that current practice is that inventorship is tied to the disclosure of the specification, not to the scope of the claims. This position was queried by some members. IPONZ will investigate this further. 		
	<p>Section 165 - Licenses and financial interests involving Patent and Patent applications</p>	<p>Simon M</p>
<ul style="list-style-type: none"> Members generally agreed to the guideline. Feedback was provided that the guideline could provide more detail on what documentation is required. Duncan de Geest enquired if there is any way to monitor the status of applications and to receive a notification when a patent application is granted. <p>John Landells noted that IP Australia has the Application Subscription which allows third-party monitoring of patent applications.</p> <p>IPONZ will look into this. It was noted that regulation 132 does allow for status information to be requested by third parties. However, there is no active monitoring/subscription service available through IPONZ.</p> <ul style="list-style-type: none"> David Nowak requested clarification around merges and how these should be filed. <p>IPONZ noted that merges are generally associated with a change of ownership. IPONZ will investigate if this requires clarification.</p>		
	<p>Definition of S 8(2) art</p>	<p>(Tom Robertson had previously raised this)</p>
<ul style="list-style-type: none"> The Viking Corporation [2022] NZIPOPAT 4 decision was issued earlier this year, this upheld IPONZ practice that PCT applications which have not yet entered national phase are citable under s 8(2). See Manual section, paragraph 11b. IPONZ stated that there would be no change in practice. Members noted that applicants have no way of being aware of novelty destroying prior art. There is particular concern around foreign language PCT applications. Doug Calhoun disagreed with the decision citing his recent article in The Patent Letter. IPONZ acknowledges the feedback and notes the members comments on potential legislative reform. 		
	<p>Design Examination matter</p>	<p>Tom Robertson</p>
<ul style="list-style-type: none"> IPONZ practice when objecting to page numbering on Design registrations was queried. <p>In particular, regulation 26 was being used to object the presence of page numbering. This regulation does not seem to be appropriate for this objection as it does not prohibit the use of page numbering. When page numbering is in the footer it does interfere with the clarity and unambiguity of the novel design features of the design as applied to the article.</p>		

- IPONZ responded that the presence of page numbers should only be objectionable when the page numbering is ambiguous. IPONZ requested that the case numbers be forwarded so that IPONZ can investigate further.

Any Other Business

- Date of next meeting 21 September 2022

TIME

Close of Meeting