

## Patents

### Technical Focus Group (“TFG”) Meeting Minutes

<b>Date/Time</b>	29 March 2022, 10.30am – 12.30pm
<b>Location</b>	Virtual/Pastoral House

### Participants

MBIE / Intellectual Property Office of New Zealand (“IPONZ”)	Members	
Gaby Cowcill (Chair)	Doug Calhoun	NZ Law Society
Warren Coles	Tom Robertson	Pipers
Simon Maguire	Duncan de Geest	NZIPA / AJ Park
Warren Hassett	Jonathan Lucas	JAWS
Rob Garrett	David Nowak	Henry Hughes
Irina Minyukhina (minutes)	Laura Hollingsworth	Catalyst
	Scott Sonneman	DCC
	John Landells	IPTA / F B Rice

Agenda item	Speaker
<b>Matters arising / previous action items</b>	<b>Gaby Cowcill</b>
Publish changes to manual sections 39 and 67	Done.
Finalise and publish new Change agent and change owner manual sections	Finalised; to be published.
RealMe issues / links to cases from email notifications if you’re not logged in	This should be fixed in the next release.
Workflow for GPPH & MAC search	Ongoing.
Regular catch ups with IP Aus & in contact with WIPO about PCT RO drawings.	Ongoing.
Research how other jurisdictions apply ST.88	Ongoing.
<b>IPONZ Update</b>	<b>Gaby Cowcill</b>
<b>Recruitment</b>	
<ul style="list-style-type: none"> <li>We continue to see some fluctuation in examiner numbers due to resignations, meaning that despite recent recruitment efforts the overall examiner numbers have remained roughly stable this year, and are currently</li> </ul>	

around 65. We have not seen any changes in terms of numbers of requests for examinations coming in, so operationally we continue to face considerable pressure.

- We have just completed the largest recruitment IPONZ has seen in recent years, and are working hard to increase critical mass & retain senior staff on whom the majority of training pressure falls. We remain bottom heavy in terms of experience. Previously we have also benefitted from overseas experience coming into IPONZ, this may be an option again with borders opening up.

#### Pendency

- As above, at present this continues to increase. These were last updated in February and are available on the [IPONZ website](#).

#### 1953 Act update

- There were 364 cases remaining as of 18 March 2022, all of these are divisional applications and roughly half are Biotech cases.

#### IPONZ Update

**Rob Garrett**

#### System changes

- Next release will add team account function. This is part of an ongoing piece of work around agent verification aimed at reducing instances of sharing accounts. This will have no immediate change or impact as we are not mandating their use, but we encourage you to consider how they might work in your firms.
- We are looking at changes to how patent data is stored. Currently we use a single PDF for patent specifications, this would mean that different components ie. description, drawings, claims etc. can be split into separate documents, which would align our approach with Australia. We are still at the start of this work so we will be seeking some input around this proposal. If you are keen to have an input into that either high-level or more details, please get in touch.
  - Members generally responded positively to this, if it meant for example there will be no need to resubmit drawings every time a specification amendment is made.
  - Later in the meeting, concerns were raised that investment into systems should not overshadow people investment to get through outstanding examination work. Gaby confirmed that whilst systems investment is needed due to the age of existing infrastructure, IPONZ also recently received approval to invest in increasing examiner numbers. With the most recent recruitment we will be a team of around 75 examiners, and we are anticipating needing to grow to around 100 in the next few years.

#### Strategic review

- We are currently undertaking a review of our strategic capability, to identify our medium- and long-term capability requirements over the next 5-10 years to ensure we can achieve our ideal target state. We have conducted some external consultation as part of this to inform our thinking. If you would like to know more or contribute to this, please let me know. If any members are keen in participating in this feel free to ask Gaby for more details.
  - Members raised questions regarding the timeframes we are looking at. Rob clarified that there are no concrete deadlines set, but the aim is to have input stages complete by the end of April and working towards June/July to have the strategic review complete.

#### Update from MBIE Policy Team

**Warren Hassett**

**IP Laws Amendment Bill**

- For this year at least, the Bill will not proceed as the Minister is prioritising other pieces of legislation.
- We are looking at including some of the amendments to into an upcoming Regulatory Systems Bill and have made an expression of interest to do so. This would only be possible for minor technical changes and non-contentious issues. Note that the Cabinet paper gives some ideas over what is considered minor and technical and what was contentious.

**Other IP policy work**

- At the time of the meeting, the PVR Bill was number 19 on the list waiting for its second reading.
- The Copyright Act review remains on pause. Some changes may be coming based upon the work done with the UK free trade agreement.

**Draft guidelines for review and discussion**

**New standard for presenting biological patent sequence listings (ST.26)**

**Simon Maguire**

- ST.26 is the new WIPO standard for sequence listings, and enters into force 1 July 2022. We are seeking feedback on the draft comms circulated with the agenda, which outlined the following general approach:
  - New PCT/International apps: Any sequences must be provided in ST.26 format from 1 July 2022. WIPO has provided tools to enable applicants to meet this standard: <https://www.wipo.int/standards/en/sequence>
  - NZ apps filed after 1 July: ST.26 format is recommended.
  - PCT National phase: IPONZ will use the filing date, not national phase entry date.
  - Divisionals: IPONZ will use the ante-dated filing date, not the divisional submission date.
- Conversion of the sequence listings standard is possible but will be treated as an amendment.

**Questions/discussion.**

- The draft comms were generally well received.
- There was some discussion over the proposal for NZ completes. In particular, members noted that the Act doesn't explicitly deal with sequence listings, and IPONZ does not re-publish them at acceptance or grant stage. This raises concern that a sequence listing provided separately does not form part of the complete specification.
- IPONZ confirmed that ST.26 is only being recommended and is not being mandated for NZ completes, since this is a WIPO standard and is not in our legislation. Regulation 12 allows the Commissioner to receive documents in approved file formats, we are interpreting this as allowing for ST.26 format to be used for sequence listings; however this does not exclude other formats which are already used.
- Members recommended that the omission of sequences from the Act be looked at, due to a potential risk that sequences may not be recognised to be a part of the specification which can lead to invalidation of a claim. Members also recommended that sequence listings should be published with the specification.
- IPONZ will consider the legislative aspect for inclusion on the risk register, and look at ways to make it clear that sequences are present when a specification is made OPI and any system updates that may need to occur (e.g. providing reference to the sequence listing on the complete specification cover page).

- For the comms themselves, David kindly agreed to work with Simon to finalise wording, so that IPONZ could publish the guidance.

**Double patenting**

**Simon Maguire**

- Practice in this area continues to evolve. The recent case [Taiho Pharmaceutical Co., Ltd \[2022\] NZIPOPAT1](#) commented on IPONZ's approach to double patenting in a case where there was not a parent-divisional relationship, and provided a further illustration of how double patenting should be assessed
- In particular, it appears that section 14 is not valid for raising double patenting. Simon confirmed this would be a change in practice and would be taken through the normal change channels in IPONZ. He also noted there is no currently published practice on this. Members therefore requested to be advised when this change had been communicated to examiners and would become practice.
- Members expressed a strong preference to put this into practice sooner rather than later. In the meantime, members asked if it was possible for IPONZ to put a hold on cases where this is an outstanding issue, or whether an extension of time could be provided.
- Simon noted that IPONZ is expecting to proceed with an update to the regulation 82 manual section in light of this case, and previous cases Oracle and Ganymed. Members requested clarity on the proposed updated and repeated calls for NZ to align with Australian practice.
- Gaby confirmed that the case law appears to provide guidance to look at the scopes of all claims, and if the claimed scope is not substantially the same then there should be no objection. This will mean that 'wholly within' type objections are no longer maintainable, which is a change of practice. IPONZ recognised the need to manage this carefully and intended to change the practice at the same time as the new guideline is out.

**Any Other Business**

- Laura raised an issue in regard to General powers of attorney and there seemed to be some inconsistency over accepting these, particularly when a general authorisation is provided for a specific case. IPONZ confirmed that these were not generally acceptable unless they listed the case numbers it was applicable to, with potential for confusion if a general authorisation is intended only for one case. There was also a tension between regulation 15 in an electronic case context, and regulation 40 requiring number. Gaby to raise with the team specifically to look into inconsistencies, as well as progress the publication of the relevant manual section.
- Tom raised a question on re-examination, and in particular whether these should be done by the original examiner or not. There may be potential that an examiner has an unconscious bias or may not want to change or alter their initial opinion etc. However, they are familiar with the case and re-examination would be smoother. IPONZ confirmed current practice, that re-exams go to the original examiner except if they are an Associate examiner, that re-examination work is peer reviewed, and that examiners are expected to uphold codes of conduct and treat all cases equally. IPONZ also confirmed it does not get many requests for re-examination. Members did not express any particular preference, but suggested that re-examinations could be done by more senior staff since they are likely to indicate validity issues or a dispute. IPONZ to consider.
- Laura requested clarification in relation to acceleration of examination requests under regulation 77, in particular what level of detail is needed including whether evidence is required, and whether the documents are OPI. She gave the example of several cases which were declined where the request had been on the basis of commercial reasons, and noted that there seemed to be a high requirement for expedited processing ie

infringement. A workaround may be to expedite in another country and go through GPPH but this was not desirable. IPONZ to provide clarity on these issues.

- Doug enquired whether any Māori Advisory Committee guidelines were available. Gaby indicated that although there are currently no guidelines available, we intend to continue to work closely with the MAC and progress this work in due course.
- Doug enquired about when proceedings documents filed with the Hearings Office would be open to public inspection. Gaby will follow up regarding this with the Hearings team.

**General efficiency, feedback and suggestions from the Members.**

- Duncan noted a recent examples examiners going into unnecessary detail over conciseness objections, where there are multiple independent claims but which are not 'eminently perplexing'. IPONZ to feedback to examination teams.

**The date of next meeting was agreed as the 28<sup>th</sup> June.**

**Close of Meeting**