

## Patents

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

<b>Date/Time</b>	6 April 2023, 10.30am – 12.30pm
<b>Location</b>	Virtual/15 Stout Street, G.14

### Participants

MBIE / Intellectual Property Office of New Zealand (“IPONZ”)	Members
Gaby Cowcill (Chair) Steve Smith Simon Maguire Emma Stares Chloe O’Shea Ed Barclay Matt Allan Warren Hassett Ellen Gray (minutes)	Doug Calhoun NZ Law Society Tom Robertson Pipers Duncan de Geest NZIPA / A J Park Jonathan Lucas JAWS David Nowak Henry Hughes Scott Sonneman DCC David Herman IPTA / F B Rice Laura Hollingsworth Catalyt  Apologies: John Landells.

### Agenda

Time	Topic	Speaker
	<b>Review of Previous Meeting Action Points</b>	<b>Gaby</b>
Action		Status
IPONZ to implement a task-based workflow for GPPH.		Done.  IPONZ reminded users that they will need to complete the task, so that IPONZ re-examines the GPPH request and the user avoids an automatic decline.  IPONZ are moving the relevant instructions about this to be more prominent in the issues letter.
IPONZ to provide an update on Māori Advisory Committee guidelines.		Ongoing.  Note that high-level guidance is available on the IPONZ website <a href="https://www.iponz.govt.nz/about-">https://www.iponz.govt.nz/about-</a>

		<a href="http://ip/maori-ip/maori-committees-for-ip/">ip/maori-ip/maori-committees-for-ip/</a>
IPONZ to complete work on the regulation 82 guideline & implement practice.		Done.
IPONZ to follow up the error encountered when attempting to view assignment correspondence & report back to Duncan.		<p>IPONZ was able to replicate the error in a test environment when attempting to view 1953 Act cases. These have different OPI rules.</p> <p>However, Duncan noted this error also occurred with 2013 Act cases. He noted this could be due to multi-case requests which may have 1953 case requests included, in which case it is likely defaulting to 1953 Act rules.</p> <p>Agreed that if further instances of this issue arise, Duncan will send through specifics to Edward Barclay for investigation.</p> <p>Action closed.</p>
IPONZ to include a link to overseas reports, where useful.		<p>In the absence of a system solution, IPONZ can suggest this to examiners but would prefer not to make it mandatory in the interests of efficiency.</p> <p>It was also noted during the meeting that links could expire.</p> <p>IPONZ suggests contacting the examiner if encountering issues with finding a report or document.</p>
	<b>IPONZ Updates</b>	<b>Gaby</b>

**1953 Act cases**

All overdue cases have been cleared from IPONZ queues. All technologies are now up to date with both first and subsequent exams.

216 1953 Act cases remain at 'under examination' status.

**Pendency update**

All technologies are now through the 2020 fees spike.

We continue to measure pendency increase, this is slowing overall but not yet across all teams.

Duncan queried when timeframes will be updated on the IPONZ website. IPONZ are collecting this data next week, and will publish the update shortly.

**People update**

The team size is now over 80; recent recruitment has been a mix of new and experienced examiners however we continue to have a high training burden at present.

We are planning a final recruitment push in May, which should take us close to capacity. Remaining recruitment will concentrate on the Science teams. We will also continue to look at examination processes, settings and efficiencies.

Duncan asked how frequently examiners are taken off-task to do work in other areas of MBIE. IPONZ try to balance this given operational pressures. There are instances where staff have been asked to support the wider Ministry in a secondment role, but they are brought back to IPONZ as soon as possible. Current operational pressures remain a priority.

In terms of cases filed per examiner per annum, IPONZ’s examiner workload remains high in comparison to overseas offices. The additional recruitment is expected to push this down. Note the latest data found was from 2021.

**Update from MBIE Policy Team**

**Warren Hassett**

Warren indicated there was activity in the Geographical Indication space around the New Zealand-European Union free-trade agreement, but otherwise there is little to update.

Doug mentioned the intended statutory changes to 1953 Act divisional cases and queried whether this will be taken off the IP law reform bill agenda, given the reduction in the backlog. Warren advised this will remain on the agenda. With this year being an election year, there is some uncertainty on when this will go to Parliament.

David H queried if there is an update on the RSB4 Amendments. Warren explained this will not be going to Parliament before early next year; an earlier RSB3 is still in preparation.

**Māori Advisory Committee referral data**

**Simon**

IPONZ is making a change to the patent search function and to the bibliography data, for cases that are referred to the Māori Advisory Committee and cases which are indicated as including traditional knowledge.

There will be a check box on the bibliography screen which will indicate cases that have been referred to the Māori Advisory Committee, and a check box for Māori Traditional knowledge or New Zealand indigenous species. These will both be publicly searchable on the register under the ‘status’ search.

The Māori Traditional knowledge or New Zealand indigenous species tick box is editable at filed and under examination status, and includes the following help text:

If you believe that the invention may be derived from Māori traditional knowledge or from plants or animals indigenous to New Zealand please tick the checkbox below.

This checkbox is not a mandatory field and is not a requirement of the act or regulations. This is a voluntary declaration, which also provides an option to upload further documentation.

Doug queried if advice given by the Committee to the Commissioner will be published at the same time. IPONZ advised that the advice from the Committee will continue to be dealt with in the same way – advice is not

published. Examination reports should contain sufficient detail to support any objection, and advice is available to be requested via OIA once the case is OPI.

Doug also raised feedback around cases that are referred to the Hearings Office, and noted there is no correspondence visible until the decision itself. IPONZ advised Steffen Gazley (Hearings Manager) has been working on this and believes an update may be coming soon; Gaby will relay Doug’s feedback to Steffen.

**Draft manual sections for review and discussion**

**Chloe**

No draft sections from IPONZ this meeting.

IPONZ are working on updating two published guidelines:

- Section 16 – relates to excluded subject matter. This needed updating with the new PVR Act, and misunderstandings around methods of diagnosis.
- Section 51 – relates to transactions of PCT applications. IPONZ are proposing practice changes, which will make things easier for examiners and applicants to resolve filing issues. For example, the new practices will reduce the need for regulation 147 or 149 requests.

IPONZ invited members to bring to their attention areas in these guidelines that are an issue currently, with the aim of identifying and addressing issues prior to producing draft guidelines.

Doug queried if there will be guidance on how the Commissioner will assess whether an application is contrary to public order or morality, when the Māori Advisory Committee deems something contrary to Māori values. IPONZ noted that this is something IPONZ will include in the updated guidelines.

Duncan suggested IPONZ share a list of guidelines as this could be helpful to members to be aware of what is being worked on. IPONZ advised there is no formal list of guidelines at this stage but can provide a “what’s next” update at the next meeting.

David H raised that a Swiss-type claims guideline would be useful. IPONZ agreed that this is a high priority guideline.

### **Other practice queries and discussions**

- IPONZ Address Formatting errors – John Landells/David Herman

John had noted ongoing formatting issues with IPONZ’s inventor address data at national phase. He noted that fixing these is resource intensive and suggested a fix may be to stop recording inventor address data, noting this can be found on the WIPO website if needed.

Following some investigation into the underlying issue, IPONZ noted that address information is not always being entered in the correct format when the Treaty application is filed at WIPO (according to ST.66). This then leads to formatting issues when these enter national phase.

Inventor addresses are required to satisfy regulation 50, however, there is no requirement for publication of inventor addresses in the Act or Regulations.

IPONZ proposed an option may be to discontinue publication of inventor addresses, noting that as this data appears in multiple locations it would require some development time to implement. IPONZ welcomed additional feedback on this issue, and on any additional considerations around publication of inventor addresses.

Members mentioned potential privacy concerns arising from publishing inventor addresses and noted that there are valid reasons for requiring applicant/patentee contact information, but the same could not be said of

inventor information. Possibly, this could be used to distinguish between different inventors having the same name, or to resolve any entitlement issues.

IPONZ will continue to investigate and provide an update at the next TFG.

- IPONZ timeframes webpage update – Ed Barclay

The Information and Education team are looking at doing a refresh of the timeframes page on the IPONZ website. IPONZ sought any feedback on what information is useful, or that users may like to see incorporated.

Members commented that a forecast date of when IPONZ might resume issuing directions to request exam would be useful, as this is a common enquiry from applicants. In addition, other general statistics would be of interest, for example the number of applications per year.

Ed will pass on this feedback to the I&E team.

- Patent examination practice – Duncan de Geest

Duncan raised the following issues noted during examination:

- An objection to the addition of the term 'comprising', which was argued against and withdrawn.
- A new citation raised without context in a third examination report, which also noted 'an exhaustive search has not been carried out'. When providing instructions, the applicant noted that prosecution was unproductive and frustrating.

Jonathan noted the latter was not an isolated incident.

IPONZ confirmed it was aware of the specific case for the second issue, this had been picked up in QA processes and feedback was being provided.

Laura added that she had noted an increase in additional comments at the end of the exam reports, with some appearing to be more like an objection. This is undesirable and led to uncertainty on whether the issue needed to be addressed or not.

IPONZ acknowledged all this feedback, and proposed to investigate the issues further and provide feedback to individuals or teams as necessary. IPONZ also suggested the option of contacting the examiner or their team leader on case-specific issues, to enable feedback in a timely manner.

- Designs – Duncan de Geest

Duncan understood that it is possible to submit Authorisations of Agent for designs, if not available on filing, to [mail@iponz.govt.nz](mailto:mail@iponz.govt.nz) to avoid an examination report issuing in which the only objection is to the lack of an Authorisation of Agent on file. He noted that users are otherwise unable to use the on-line portal to file Authorisations of Agent until after an examination report issues, and that the same issues apply to certified copies of priority documents and verified English translations of a priority document. Duncan outlined several concerns that this raised for all parties, namely a risk of missing statutory deadlines, client and office inefficiencies, and increased costs.

There is therefore a desire to file documents in anticipation of objections, rather than waiting for the objections to be raised before having the opportunity to file.

IPONZ acknowledged that clients may wish to file documents other than at initial filing or when responding to examination reports – this is a known issue, and has already been raised as a possible system improvement.

At this stage, IPONZ would prefer clients contact the design examiner to set up an open discussion to allow adding such documents. Clients should not use the amendment/alteration function as this has undesirable flow on effects for clients and IPONZ examiners.

- Including next renewal deadline in patent search results – Duncan de Geest

Duncan queried if it would be possible to have ‘maintenance due date’ and ‘renewal due date’ added as two additional optional ‘Show/Hide columns’ for ‘Search Patent Case(s)’, as clients commonly asked for this information. They are included in the Excel file generated by ‘Get Result List’ but it would be useful to have them more immediately viewable.

IPONZ had raised the suggestion with the Systems team, but did not have a clear indication of feasibility at the time. IPONZ noted that if it is a simple fix (low development time), it could be included in a future release. IPONZ will continue to investigate and give an update at next TFG.

- IPONZ case management facility tabs expiring – Duncan de Geest

Duncan noted that the IPONZ case management facility tabs expire after a half hour, and asked if IPONZ could lengthen the amount of time that a case is allowed to be open, possibly by:

- lengthening the amount of time that a case is active in a tab, perhaps to one hour or two hours.
- developing a “refresh” button to automatically re-activate a case in a tab.
- developing a way for a tab displaying a case to be “static”, as per IP Australia.

IPONZ responded that the current system is session based, and moving to a ‘static’ type would be a significant change. IPONZ will be looking to move away from this during development of the next system.

In terms of timeout length, extending this would create the risk of performance issues due to us having to store all session information until the timeout period. IPONZ will continue to fully discuss this with the system team as they work on our next system release.

- Expediting examination under regulation 77 – Jonathan Lucas

Jonathan queried the current practice when considering expedited examination requests under regulation 77. In particular, the level of information that IPONZ requires and whether commercially sensitive information can be provided in a confidential manner.

Jonathan mentioned a specific request where the applicant was aware of a potential infringer. The request was declined on the basis that insufficient details were provided with the request, and follow-up conversations raised concerns that IPONZ is requesting an inappropriate level of information. This is particularly applicable if requests are not confidential.

IPONZ noted that regulation 77 requires there to be ‘good and substantial reasons’, and that the request must include evidence (per regulation 144 this means a statutory declaration or affidavit). IPONZ considers this requires more than a mere statement. In some circumstances it may be self-evident that there are good and substantial reasons without formal evidence. However, IPONZ does not want to be overly prescriptive in what is required to establish good and substantial reasons, as this will depend on the specific circumstances of the case.

IPONZ advised that confidential information can be provided to accompany a request but this would need to be processed manually, as any documents supplied in the normal way will be made OPI automatically.

Members discussed various aspects of this practice. This included distinguishing between a requirement that the evidence establishes that there are good and substantial reasons, and a requirement that the evidence establishes that infringement is occurring. There was also discussion of equivalent requirements under the Patents Regulations 1954, which are substantially equivalent, and noted there is an apparent change in practice by IPONZ.

IPONZ had previously noted a lack of information on the website regarding expedite requests under regulation 77, and are looking to include some further guidance on these types of requests. IPONZ will investigate this further and will provide an update at the next TFG.

### Actions

IPONZ to update website pendency pages.	Done.
IPONZ to provide an update on Māori Advisory Committee guidelines.	Ongoing. Note that high-level guidance is available on the IPONZ website <a href="https://www.iponz.govt.nz/about-ip/maori-ip/maori-committees-for-ip/">https://www.iponz.govt.nz/about-ip/maori-ip/maori-committees-for-ip/</a>
IPONZ to consider providing a guidelines 'pipeline' at the next meeting.	
IPONZ to continue to investigate inventor address formatting issues & provide an update next meeting.	
IPONZ to investigate examination practice re: objections, report wording and additional comments, and feedback to individuals or teams as required.	
IPONZ to consider including next renewal deadline in patent search results.	
IPONZ to explore tab expiry options.	
IPONZ to update guidance on practice when considering requests under regulation 77.	

Date of next meeting: July 2023

### Close of Meeting