

## Patents

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

|                  |                                    |
|------------------|------------------------------------|
| <b>Date/Time</b> | 6 December 2021, 10.30am – 12.30pm |
| <b>Location</b>  | Virtual/Pastoral House, L03 01T    |

### 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            |
| Jenny Jebson   | David Nowak         | Henry Hughes    |
| Sean Uy  | Laura Hollingsworth | Catalyst        |
| Monique Cardy (minutes)                                      | Scott Sonneman      | DCC             |
|  | John Landells       | IPTA / F B Rice |

| Agenda item  | Speaker                            |
|--|------------------------------------|
| <b>Matters arising / previous action items</b>   | <b>Gaby Cowcill</b>                |
| Continue discussion on PCT RO treatment of drawings with international partners.   | Ongoing.                           |
| Publish agreed manual sections.  | Done.                              |
| Record and consider feedback on examination efficiencies.  | Feedback recorded.                 |
| Review possible enhancements to provide a workflow for GPPH requests.  | Feedback recorded and prioritised. |
| RealMe issues  | No update.                         |
| Searchable MAC referral box  | Ongoing.                           |
| <b>IPONZ Update</b>  | <b>Gaby Cowcill</b>                |
| <b>Recruitment</b>   |                                    |
| <ul style="list-style-type: none"> <li>The previous intake of Associate Examiners are now examining full-time. The team are planning further recruitment early in the new year.</li> </ul> |                                    |

- There have been some resignations, this has impacted our ability to train new examiners and get through work.

### Pendency

- Pendency time was [recently updated on the IPONZ website](#). The IPONZ Year in Review will contain additional statistics; additionally, Sean will discuss related matters later in the meeting.
- Duncan queried work outputs in the Science teams, in respect of issuing of first examination reports. Gaby confirmed that the team are tracking first examination output. All teams had been experiencing an increase in subsequent examinations over the past few months, and some resources have been diverted to Covid response teams elsewhere in the Ministry.
- John reiterated concerns in relation to the increasing examination pendency, in combination with the 5-year deadline to request examination and strict legislative settings for divisionals. Gaby confirmed that pendency should not affect examination requests for PCT National phase entries, and that the team continues to streamline processes where possible in addition to further recruitment being planned.

### 1953 Act update

- There were 380 cases as of 3 December 2021.
- The increase in resources to examine Biotech cases under the 1953 Act has been successful, and there has been some progress on issuing reports on some of the older cases. However, this work has to be balanced with the 2013 Act deadlines and timeliness of responses.

### Update from MBIE Policy Team

Warren Hassett

### IP Laws Amendment Bill

- A draft has been received from Parliamentary Counsel Office. Comments on this have been provided by MBIE which will be included in the second draft, however, due to resource constraints an exposure draft is not expected to be available before the second quarter of 2022.

### PVR Act & regulations

- The draft regulations went to Cabinet at the end of November. The exposure draft is expected early next year.

### Stakeholder Engagement Update

Sean Uy

- IPONZ are looking to refresh the information included in the Facts and Figures page of the IPONZ website and sought feedback on what additional information would be useful.
- Currently, the team were considering including: filing volumes; backlogs and pendency times; anticipated milestones; legislative and services changes such as tentative consultation dates etc; dates of proposed events/meetings.
- Doug mentioned it would be useful to have number of cases awaiting a hearing, and number of cases referred to the MAC.
- David noted that a means of notifying and tracking system issues would be beneficial, following a recent issue where abandonment notices were issued in error on both patent and trade mark cases. Whilst a discussion

had been received for most cases, this was a few weeks after the initial error. A notification specific to firms or affected cases would be helpful to know what action, if any, is required of attorneys and applicants at these times.

- IPONZ confirmed it had determined that a large-scale response was not required for this instance, as the majority of cases had already received a notification. However, the team will record this feedback and acknowledged this is an area to improve on in future.
- Members were invited to contact Gaby or the Stakeholder team with any additional suggestions.

#### **Draft guidelines for review and discussion**

#### **Section 67**

**Simon Maguire**

- Changes have been made to the guideline to incorporate the feedback from previous TFG meeting.
- One additional change has been made, which makes practice consistent between substantive and non-substantive amendments. Overall, time will not be reduced from any previously set deadline when an early response is filed.
- The meeting made some suggestions to improve clarity.
- There was some discussion on quantifying 'repeated' non-substantive responses. IPONZ is reluctant to set a specific number of responses and noted it would only apply to a very small number of cases where no progress is being made.
- Reference to 'exceptional circumstances' and taking all 'reasonable' and 'prudent' steps in final paragraph was also discussed. IPONZ will review and update this in line with *Merial Inc v Intervet International B.V.* [2017] NZHC 2918. The guidelines were otherwise generally agreed.

#### **Regulation 38 – 44 Change Agents**

**Jenny Jebson**

- Members welcomed formalising the change in practice around authorisations of agent, which had been a helpful timesaver for the profession.
- Members provided feedback on some paragraphs where the meaning could be clearer.
- There was some discussion on IPONZ's proposed practice around general authorisations, which may be useful when transferring large portfolios. IPONZ confirmed that the numbers for the specific cases are required, as outlined in regulation 40, however these could be provided on a separate document along with a general authorisation.

#### **Sections 129 and 165 Ownership changes**

**Jenny Jebson**

- Members provided feedback on some paragraphs where the meaning could be clearer, in particular the requirements for deeds, amalgamations and mergers (which can be executed outside New Zealand).
- The meeting agreed that it seemed logical to have these detailed documents as manual sections, with links to the Maintain a Patent page where appropriate.

#### **Regulation 82 and Oracle**

**Jonathan Lucas**

- Jonathan noted that in the last TFG there was a brief discussion on the implications of the Oracle decision on the exam guidelines, and that while the priority was to update the guidelines in view of the Ganymed decision, the Oracle decision would be given more attention in the future. Given that, it would be appropriate to maintain Oracle as an item on the agenda.
- Gaby confirmed that there had not been much progress on this. It was noted that the IP Laws Amendment Bill exposure draft may also shape practice in this area.

### Representations of designs

Jonathan Lucas

- It was asked whether representations of designs could be uploaded in PDF format, rather than JPG or GIF, as this is often the format in which clients provide them.
- IPONZ confirmed they align with WIPO Standard ST.88, which notes that PDF is designed for complex documents and may contain some information besides the image, which may introduce errors or unintended consequences. IPONZ would prefer to keep the process as streamlined as possible. It is unlikely that the system would change to accept these images.
- IPONZ will also look into practice in other jurisdictions.

### Any Other Business

- The meeting discussed membership of the TFG in light of recent mergers. Some expressions of interest had been received, and members were invited to get in touch if they had any suggestions for additional members.
- Tom R noted that Trade Marks TFG are trialling 4 TFG meetings per year, and suggested Patents TFG consider similar. Gaby confirmed the intention of using the website and facts and figures page to include the regular IPONZ and Policy updates, to enable the TFG meetings take a more technical focus.
- It was noted that having additional meetings would mean that topics are pushed through faster and stay front of mind.
- The meeting agreed to continue with three meetings per year for now, but noted that an additional meeting may be needed to discuss the IP Laws Amendment Bill exposure draft.
- The next meeting was proposed for 29<sup>th</sup> March.

### Close of Meeting

#### Summary of items requiring further action from IPONZ:

Update manual sections & publish where agreed.

Follow up on whether other jurisdictions align with ST88.