

Patents

Technical Focus Group (“TFG”) Meeting Minutes

Date/Time	21 September 2022
Location	Virtual / Pastoral House

Participants

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

Agenda	
Matters arising / previous action items	Update
IPONZ to implement a task-based workflow for GPPH	In progress. Expected to launch towards the end of 2022
IPONZ to finalise & publish: <ul style="list-style-type: none"> Sections 200-202 – Correcting errors Section 165 – Licenses and financial interests 	At the time of the meeting, both were in progress. They have since both been published.
IPONZ to respond to query on whether it is possible to monitor the status of a case	A subscription functionality is available with the use of APIs, to use this we suggest getting in touch with the technical team. There is a non-API-based subscription function, this has had low usage and further enhancement is unlikely at this stage.

<p>MBIE Policy to provide information on RSB4 recommendations from IP Laws Amendments Bill</p>	<p>Done, in part.</p> <p>Warren had provided this to NZIPA; members requested him to distribute to all TFG members.</p> <p>This has since been done.</p>
<p>IPONZ to provide an update on Māori Advisory Committee guidelines</p>	<p>No update.</p> <p>Chloe added that IPONZ have a number of other guideline topics on which there is no guidance, and IPONZ will be looking to prioritise these, including taking TFG feedback into account.</p> <p>Ed updated the meeting on the pillar structure around such project work.</p>
<p>IPONZ Update</p>	<p>Gaby Cowcill</p>
<p>Gaby had circulated a written update prior to the meeting, and summarised the key points.</p> <ul style="list-style-type: none"> • Recruitment: this is ongoing, and will be proportional to where the work burden is. We will continue to have a high training load. • All tech types except Biotech are through the fees change ‘bubble’. • We are making good progress through 1953 Act Biotech mail, having trained additional examiners on 1953 Act examination. The majority of 1953 Act tasks are now on client queues. • PCT Receiving Office have continued to streamline their processes and are increasingly working in ePCT, similar to IP Australia. Following an audit this year, we will also be looking at our invoicing and financial processes in 2023. • The Office will be closed for the upcoming Queen Elizabeth II Memorial Day public holiday. Tasks due on that day will roll over to the next, in the usual way. WIPO were also notified. 	
<p>Update from MBIE Policy Team</p>	<p>Warren Hassett</p>
<ul style="list-style-type: none"> • PVR Legislation <ul style="list-style-type: none"> ○ The next step is for Parliament to pass the Bill, this is expected to be by the end of October 2022. ○ The new PVR Regulations depend on the Bill being passed, but are otherwise prepared and ready. • IP Laws Amendment Bill <ul style="list-style-type: none"> ○ No update, this is still on hold. • Free trade agreements & consequent work programmes <ul style="list-style-type: none"> ○ The FTA with UK necessitated a minor change to the Copyright Act, this is in front of the Select Committee. 	

- The policy team is preparing a consultation brief on GI Act reform.
- A Hague consultation is not an immediate priority.

Draft guidelines

Double patenting & regulation 82

Simon Maguire, Emma Stares and
Chloe O’Shea

- IPONZ summarised the updates since the previous TFG in response to feedback. The changes were:
 - Removal of references to 1953 Act and UK caselaw.
 - Introducing an analogy to the reverse infringement test, for practical reasons, given examiners’ familiarity with this test.
 - To clarify IPONZ’s approach to overlap and follow the double infringement test more closely.

IPONZ sought feedback on the changes.

- The removal of references to 1953 Act and UK caselaw was well received by members.
- Members expressed caution in relation to the analogy to the reverse infringement test, noting that it was not in the Oracle decision, but could provide clarity for examiners if applied consistently with Oracle.
- There was detailed discussion on the scope of “substantially the same matter”, and how this would apply in circumstances such as where one application claims alternative embodiments “A or B” and the other application claims one of the embodiments “A”.
- Members provided clear feedback that “substantially” in this context should be interpreted as closer to “the same” scope than not. In particular, members reiterated the position that all infringements of a claim should be all infringements of another claim, and vice versa, for an objection to arise (rather only some infringements of one claim infringing the other claim, as in the example of claims to “A or B” and “A”).
- Members also noted some general inconsistency of language between the regulation and the guideline, and recommended aligning them more closely.
- Finally, members noted that IPONZ was proposing to apply this to all family members, where the regulation only refers to parent and divisional. The underlying intent of this provision was largely agreed upon however members expressed different opinions on this practice, and suggested that IPONZ make it clear this was its own interpretation.

Any Other Business

- Duncan had encountered an error message when attempting to view linked assignment cases, the error message not allowing access to the case. IPONZ confirmed that assignment correspondence should be OPI where the case also is, and offered to follow up on this issue and report back to Duncan.
- Duncan passed on feedback that it would be helpful for IPONZ to provide copies of overseas objections reiterated in exam reports, particularly AU objections when the NZ agent is not also the AU agent. Suggestions were that examiners upload the overseas report(s) to the case, or provide the re-iterated objection text in full within the NZ report. IPONZ noted that re-iteration was intended to improve examining efficiency and would be reluctant to introduce this measure. However, an alternative may be to provide a hyperlink to relevant overseas documents in the report. IPONZ members will pass on this suggestion to examiners.

Actions

- IPONZ to continue to work on the reg 82 guideline; since the next meeting is not likely to be scheduled until March 2023, to circulate further drafts by email.
- IPONZ to follow up the error encountered when attempting to view assignment correspondence & report back to Duncan.
- IPONZ to circulate the suggestion to include a link to overseas reports where feasible.

Date of next meeting

- March 2023

Close of meeting