

# PATENT TECHNICAL FOCUS GROUP MEETING

<b>Date</b>	9 <sup>th</sup> February 2016
<b>Attendees</b>	Mark Pritchard (IPONZ), Liz Francis (IPONZ), Warren Hassett (MBIE), Jesse Strafford (IPONZ), Duncan De Geest (AJ Park), Fiona Pringle (Baldwins), David Nowak (Henry Hughes), David Tadjell (IPTA (by phone))
<b>Apologies</b>	Virginia Beniac-Brooks

## Agenda

1. Update: Single Economic Market – single application process & single examination process – Brief verbal overview of state of play
2. Legislation:
  - a. Patent Act 2013 & Patent Regulations 2014 – proposed amendments
  - b. Patents (Trans-Tasman Patent Attorneys and Other Matters) amendment bill
3. Practice matters:
  - a. Amendment of the specification (fee, consistory clauses, amendment to clarify/amplify intent of drafter).
  - b. Abstracts
  - c. Omnibus claims
  - d. Re-examination
  - e. Assignment of applications
4. Other matters

<b>Topic</b>	<b>Action/Comment</b>
SEM Update	
SAP – Single Application Process	<ul style="list-style-type: none"> <li>• IPONZ, IP Australia and WIPO are investigating the possibility of using the ePCT platform as a technology solution to implement the SAP.</li> <li>• ePCT would be beneficial as the majority of SAP applications are likely to be PCT national phase entry.</li> </ul>
SEP – Single Examiner Process	<ul style="list-style-type: none"> <li>• IPONZ and IRD are assessing GST implications of the SAP and SEP before progressing with the public</li> </ul>

Topic	Action/Comment
	<p>consultation, which has been pushed out until mid-2016.</p> <ul style="list-style-type: none"> <li>• A pilot programme to explore the benefits and operational aspects of the SEP is proposed to commence by mid-2017. The pilot would involve a number of volunteer applicants on a limited number of applications (approximately 50 pairs of applications) over a period of approximately two years.</li> <li>• Members of the TFG indicated that they would be willing to comment fully on SAP and SEP when more details of the proposals for the SAP and SEP became available, perhaps during the consultation process.</li> </ul>
Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Bill	<ul style="list-style-type: none"> <li>• Had a first reading 9 February 2016</li> <li>• Submissions to the Commerce Select Committee are due by 24 March 2016</li> <li>• Select Committee are to report by 9 August 2016.</li> </ul>
Proposed Trans Pacific Partnership Implementation Bill	<ul style="list-style-type: none"> <li>• The Bill will be referred to the Foreign Affairs, Defence and Trade Select Committee after the National Interest Analysis has been tabled.</li> <li>• The proposed bill is to contain all necessary amendments to the IP legislation, other than for the Plant Variety Rights Act.</li> </ul>
Unity to be removed as a ground of opposition ( <b>section 92</b> )	<ul style="list-style-type: none"> <li>• The amendment is part of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Bill</li> <li>• This change is not proposed to be retrospective. However, parties may make submissions for it to be retrospective in the Select Committee process.</li> </ul>
Divisional applications – it is proposed to amend the Patents Act 2013 to introduce a	<ul style="list-style-type: none"> <li>• Consideration is being given to introducing a deadline of 5 years from the commencement date of the Patents Act 2013) for the filing of divisional applications from applications originally filed under</li> </ul>

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<p>deadline for the filing of divisional applications made under the Patents Act 1953.</p>	<p>the Patents Act 1953.</p> <ul style="list-style-type: none"> <li>• There was discussion around use of section 245 to amend the Patents Act 2013 by way of regulation, as this provision was introduced into the Act to permit changes arising during the transitional period following commencement.</li> <li>• Members of the TFG were curious about the notice period or lead-in which would be provided for this change. There would be a consultation process for this change (and any others of a similar nature).</li> <li>• The intent behind the change is to enhance consistency with the principles of the 2013 Act (i.e. to ensure that the scope of monopolies granted by patents was not unduly broad), to remove the possibility that some applications may be pending for the full patent term with one or more patents being granted over a period of time, to promote a focus on examiner competency under a single patent regime, and reduce the operational burden of maintaining infrastructure for two different patent regimes.</li> <li>• The retrospectivity of this change was discussed and it was noted that typically divisional applications are filed in response to unity objections raised during examination.</li> <li>• Some members of the TFG were of the view that the proposal may make it difficult for applicants who after filing a divisional application prior to the deadline, subsequently receive a new unity objection where a further divisional cannot be filed.</li> </ul>
<p>Amendment to allow claims to have more than one priority date (<b>sections 57 and 61(2)</b>)</p>	<ul style="list-style-type: none"> <li>• It was agreed that the proposal to amend the Act to permit a claim to have more than one priority date would be useful.</li> <li>• It was noted that this proposal was not intended to address the matter of ‘poisonous priorities’ or ‘poisonous divisionals’.</li> </ul>
<p>Use of hearing as a de</p>	<ul style="list-style-type: none"> <li>• Hearings are intended to be used to address genuine</li> </ul>

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<p>facto extension of time to address outstanding objections (<b>section 208</b>)</p>	<p>conflicts, rather than merely extending time to prosecute an application under examination.</p> <ul style="list-style-type: none"> <li>• Where the applicant requests to be heard on one or more matters and proposes further amendments after expiry of the section 71 period, then subsequently withdraws from the hearing process without a hearing, then consideration will be given only to those amendments which were filed immediately prior to expiry of s71 period. No consideration will be given to amendments filed after expiry of the section 71 period.</li> <li>• Should a hearing be held, then the normal process of amendment will be followed.</li> <li>• The Act and Regulations are silent on this matter. To clarify the practice, it is proposed to introduce an amendment to the regulations to reflect the practice noted above.</li> <li>• It was also noted that requiring a non-refundable fee when requesting a hearing may have a discouraging effect on unnecessarily requesting hearings. However, this will not necessarily have the same effect i.e. it would not limit consideration of the amendments to those filed prior to expiry of the section 71 period.</li> </ul>
<p><b>Regulation 19(2)(b)</b> is not clear, as it appears that a document may not be considered to be in proper form if it does not comply with any of the requirements of the Act/Regs.</p>	<ul style="list-style-type: none"> <li>• Regulation 19 as presently drafted does not take account of the examination process with respect to the complete specification and the existing regulations relating to the form of the complete specification.</li> <li>• The proposed amendment to introduces a clarification in this respect.</li> </ul>
<p><b>Regulation 59(1)</b> – Microorganism deposit requirements</p>	<ul style="list-style-type: none"> <li>• Proposal to correct an error in this regulation where it was impossible for applicants to comply with the requirement to provide a receipt from the depository institution within three months of the date that the micro-organism was deposited in the institution,</li> </ul>

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	<p>when at that time it may not be known whether or not there is an NZ application</p> <ul style="list-style-type: none"> <li>• It was also discussed that the TPP requires accession to Budapest Treaty. Once the Select Committee has dealt with the TPP, NZ can formally accede to the BT.</li> </ul>
	<ul style="list-style-type: none"> <li>• An issue was raised with IPONZ regarding the provision of access and availability of microorganisms in NZ. The issue of access (or lack of) is controlled primarily by other Acts which control this issue in terms of import/export of microorganisms. It was acknowledged that the Act and Regulations do not presently explicitly provide for the Commissioner to issue a direction to make certain microorganism available.</li> </ul>
<b>Regulation 124</b>	<ul style="list-style-type: none"> <li>• A brief discussion was held on whether it matters whether a request is made on behalf of the assignor or the assignee. Consideration being given to possible amendments to r124 to remove the requirement for request to include the identity of the requestor.</li> </ul>
<b>Amendments to the specification</b>	<ul style="list-style-type: none"> <li>• Fees – when are they payable? And why, if they correspond to the acceptable claims e.g. to introduce consistency clauses?</li> <li>• Specifications are reviewed by examiners at every stage of the examination process. The amendment fee is payable where the applicant includes an amendment to the specification and where the amendment is not otherwise required to meet an examination objection which has already been considered by the examiner.</li> </ul>
	<ul style="list-style-type: none"> <li>• Amendments to clarify/amplify intent of the drafter</li> <li>• Specification won't be permitted to be amended to clarify drafter's intent where the person skilled in the art would have understood what was meant by a term (see for example <i>Sealed Air New Zealand Limited CIV-2003-485-2274</i>). There is no reason to amend or provide a definition where a person skilled</li> </ul>

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	<p>in the art knows what is meant by the original term in light of the specification as a whole. The differences in dealing with amendments in NZ were noted with respect to the Australian approach.</p> <ul style="list-style-type: none"> <li>• IPONZ will continue to object to these amendments.</li> </ul>
<b>Regulation 58</b>	<ul style="list-style-type: none"> <li>• The statement of support is intended to differ from the support requirement of s39 but the nature of the amendment is important. Typographical errors will not require onerous statements, but a claim drawing on multiple aspects of a specification in order to define a claim will require more detailed statements of support.</li> </ul>
<b>Amendments after grant – when these are considered, can an examiner raise new objections?</b>	<ul style="list-style-type: none"> <li>• Re-examinations are a separate process from the amendment after acceptance process.</li> <li>• There is no re-examination policy with respect to identifying patents granted under the Patents Act 1953 where there may be a case made for lack of inventive step.</li> <li>• During the amendment after acceptance process, an examiner will generally look overseas at corresponding jurisdictions when considering a proposed amendment, and it is possible that there may be relevant prior art which would provide grounds for re-examination.</li> </ul>
<b>Abstracts</b>	<ul style="list-style-type: none"> <li>• There was a discussion around the level of consistency and detail within objections made to the abstract under regulation 33 and in view of the similarity of regulation 33 to Rule 8 of the PCT.</li> <li>• It was agreed that objections should be consistent, and IPONZ will review the practice within the examination team.</li> <li>• However, it was noted that the lack of comment by an international examiner does not preclude IPONZ from raising an objection to the abstract.</li> </ul>

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	<ul style="list-style-type: none"> <li>• It is accepted by all parties that some abstracts “approved” in the PCT process are inadequate and do not appear to meet PCT Rule 8.</li> <li>• It was noted that the approach to abstracts by IPONZ is different to that of IP Australia.</li> <li>• Abstracts facilitate searching of the register so it is important that abstracts fulfil this requirement from a public policy perspective.</li> </ul>
<b>Consent from co-owners vs consent from co-applicants</b>	<ul style="list-style-type: none"> <li>• No consent required from co-applicants under s129.</li> <li>• Granted patents require consent from a co-owner as applicable.</li> </ul>
<b>Omnibus claims</b>	<ul style="list-style-type: none"> <li>• These claims are not explicitly allowed or disallowed and will be interpreted consistent with the practise for the interpretation of claims generally.</li> </ul>
<b>Restoration</b>	<ul style="list-style-type: none"> <li>• There was some discussion of what was required for restoration</li> <li>• No undue delay must occur between discovery of lapse and filing of restoration. It was also noted that the diligence of the applicant/patentee in pursuit of an application or maintenance of a patent are also factors considered during restoration.</li> </ul>
	<ul style="list-style-type: none"> <li>• It was noted that the patent examination manual (section 39) indicated that product-by-process claims were not permitted. Discussion followed on the requirement to allow product-by-process claims as a requirement of TRIPS (Article 28). IPONZ will revisit the examination manual content.</li> </ul>

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<b>Microorganism deposit extension</b>	<ul style="list-style-type: none"><li>• Further guidelines were requested regarding requesting an extension of time under regulation 147. Also discussed was possibility of introducing a specific document type for requesting an extension of time to file a deposit receipt.</li></ul>