

# PATENTS TECHNICAL FOCUS GROUP

12 June 2019  
10am – 12.30pm  
IPONZ Boardroom, Wellington

## Present

### IPONZ / MBIE Policy

Simon Pope (Chair), Mark Luiten, Gaby Cowcill, Warren Hassett (MBIE Policy), Steffen Gazley (IPONZ), Monique Cardy (Minutes)

### TFG members

Fiona Pringle (Baldwins), Duncan de Geest (AJ Park, NZIPA), David Nowak (Henry Hughes), John Landells (FB Rice, IPTA), Doug Calhoun (NZ Law Society), Richard Clement (James and Wells), Tom Robertson (Pipers), Scott Sonneman (DCC), Laura Hollingsworth (Catalyst)

## Apologies

Tanya Carter (IPONZ)

## Previous minutes

The minutes of the previous meeting were approved.

## Minutes

Agenda item / topic	Discussion	Action
1. <b>Actions from previous meeting</b>	The actions from the previous meeting were reviewed.	N/A
2. <b>Fees Review Update – Process</b>	IPONZ advised that amendments to the trade mark and patent regulations are currently being	IPONZ to ensure that fees review

<p><b>and time frames</b></p>	<p>drafted to update the fees.</p> <p>The original target implementation date for the new fees was October 2019 but it is now more likely to be early February 2020.</p> <p>Summary of initial Fee Proposals, and the Consultation Papers and final Cabinet approvals (proactively released), can be found here.</p> <p>The 'Recommendations' section of the Cabinet approvals provides a summary of the updated fees.</p>	<p>paper includes final amounts.</p>
<p><b>3. IP Omnibus consultation paper</b></p>	<p>Warren provided a brief summary on the paper at the meeting, and the process going forward.</p> <p>In discussing the proposals for divisional applications, one member questioned whether there was any actual evidence of a problem. IPONZ confirmed the proliferation and uncertainty around divisional application chains was a significant operational problem.</p> <p>Gaby Cowcill noted that the proposal in the Omnibus Paper was similar to the UK practice. Warren also pointed to the uncertainty for the public as illustrated by reference to recent litigation involving a high profile NZ technology company.</p> <p>Warren noted that the paper remained open for consultation until 2 August 2019, and offered to discuss it further with members in July.</p>	<p>Arrange a time with TFG members and Warren for further discussion on the paper.</p>
<p><b>4. Parent / divisional overlap – reg 82</b></p>	<p>This item was raised by the Manager of Patents because of concerns with the practice agreed in the earlier TFG meeting of 28 March 2018 on amended regulation 82 (as briefly noted in topic 14 of the minutes).</p> <p>He was concerned that the plain wording of reg 82 meant that the Commissioner could not accept a divisional application with claims that were substantially the same as the claims of the parent application, notwithstanding that the parent application had been accepted but subsequently abandoned or lapsed or</p>	<p>Minutes of March 2018 TFG to be redacted and updated practice is being drafted.</p>

	<p>surrendered (and vice versa).</p> <p>He sought clarification from Warren Hassett on the policy intention of amended reg 82, who confirmed the intent was to prevent the possibility of a third party having to re-litigate on claims they had already challenged for an earlier accepted/granted patent.</p> <p>Ultimately, MBIE Policy confirmed that the plain wording of reg 82 reflected the policy intent and meant that IPONZ could not accept an application with claims that had previously been accepted, notwithstanding that the earlier application/patent had been surrendered.</p> <p>It was agreed that IPONZ should redact the previous TFG minutes to avoid confusion and produce an updated practice guideline.</p>	
<b>5. Hearings practice on implementing decisions</b>	<p>A member raised concerns about tasks on a patent examination case expiring while the matter was under a hearing. Steffen advised that new practices had been adopted to prevent this reoccurring, and IPONZ was working on IT enhancements to automate this practice.</p>	<p>IPONZ has developed new practice which has been incorporated into its internal operations manual.</p>
<b>6. Approach to GPPH requests</b>	<p>Members mentioned that that IPONZ was applying a more stringent approach than the Australian IP office with respect to GPPH requests.</p> <p>IPONZ encouraged attorneys to contact team leaders if they experience any discrepancies of this nature in future, and confirmed that it was looking to ensure consistency of approach with other GPPH member offices.</p>	<p>See IPONZ update on new GPPH practices, and updated guideline.</p>
<b>7. Xyleco, Inc [2019] NZIPOPAT 7 – implications on office practice for divisional</b>	<p>This decision looked at which act applies to a divisional of a 1953 act case filed after commencement of the 2013 Act.</p> <p>The Assistant Commissioner held that s 258 of the transitional provisions requires a preliminary</p>	<p>IPONZ has created new standard letter regarding</p>

<p><b>applications</b></p>	<p>assessment of whether the divisional is entitled to antedating under s 34 of the new act ('subject matter in substance disclosed by the parent application as filed' as opposed to 'fair basis' under the old act).</p> <p>In short, the divisional is treated as an application under the 2013 Act until such time as it deemed eligible for antedating, at which time examination proceeds under the 1953 Act.</p> <p>The Assistant Commissioner also noted the preliminary assessment for antedating must be directed to the specification as filed, including any broadening amendments to the specification.</p> <p>This led TFG members to suggest it may be beneficial for applicant's to hold off filing any amendments to the specification until after the preliminary assessment for antedating, and a first examination report had issued under the 1953 Act. IPONZ confirmed there was nothing to prevent applicants taking this approach if they prefer their divisional application to be examined under the 1953 Act.</p> <p>It was agreed that further clarification was needed on this process and IPONZ would create a standard letter for clients about the preliminary assessment undertaken under s 258 of the transitional provisions, and update its practice guidelines where applicable.</p>	<p>preliminary assessment under s 258.</p>
<p><b>8. Examination of post-acceptance and pre-grant amendments under 1953 Act</b></p>	<p>Scott noted that IPONZ have become increasingly particular towards amendments filed on 1953 Act cases, post-acceptance, pre-grant, over the last year.</p> <p>IPONZ confirmed that there have been no updates to the examiner guidelines and urged the attendees to contact IPONZ team leaders if they have concerns over the correct standard of support being applied.</p>	<p>This matter was discussed at team meetings and Team Leaders continue to monitor the situation.</p>
<p><b>9. Nature of post-acceptance amendments</b></p>	<p>Jonathan noted that examiners seem to be requesting a greater level of detail for the nature and purpose of the proposed post acceptance</p>	<p>IPONZ working on new</p>

<p><b>under 2013 Act</b></p>	<p>amendments. In Australia, the equivalent regulation is satisfied by submitting marked-up copy of the claims showing the amendment.</p> <p>Mark confirmed that the applicant will need to note why they are making the amendment and the nature of the amendment i.e. limitation, deletion etc, as required by s.85(3).</p>	<p>guidelines for post acceptance amendments.</p>
<p><b>10. Section 70 - requests for evidence in support of convention application</b></p>	<p>Jonathan noted that the examiners frequently request the search results of other jurisdictions under section 70 and inquired whether the examiners do so with a view to achieving a consistent outcome?</p> <p>IPONZ confirmed that we want to know what other offices have said with a view to achieving consistent outcomes where possible. IPONZ practice is, however, focused on finding this information itself and only making such requests when we are unable to find these search results.</p>	<p>N/A</p>
<p><b>11. Review of draft examination guidelines:</b></p>	<p><b>Amendment of complete specifications before acceptance - section 40:</b></p> <p>Scott noted that the guidelines provide examples of voluntary amendments that were previously allowable under the PA 1953, but are not allowable under the PA 2013.</p> <p>Members noted that the guidelines are not what was discussed at a previous TFG and pose an issue from an industry perspective, in that attorneys are often unaware of the reasons for the amendments.</p> <p>The meeting agreed that further clarity is required on what is expected, particularly with respect to points 23, 26 and 28.</p> <p>Queries were raised in regards to point 38. It seems as though the applicant is required to pay a separate fee, if an amendment is filed after the exam has been requested. Mark agreed that a system update would be required to rectify this.</p> <p>The meeting noted that point 51 on entering a</p>	<p>IPONZ to update guidelines based on TFG feedback and re-circulate.</p>

	<p>disclaimer seems to accord more with the EU approach to intermediate generalisations than with the remainder of the guidelines.</p> <p>The members confirmed that overall the guidelines were very useful and user-friendly.</p> <p><b>Verified Translations of documents:</b></p> <p>Members queried why verified translations were compulsory, and expressed a preference for verified translations to be requested only if necessary.</p> <p>IPONZ confirmed that it would require a verified, but not certified, translation of the complete specification within 5 months of entry into national phase. This is to ensure a reliable translation is available for examination. If documents have not been properly verified, examination may continue but proper verification will be required.</p>	
<b>12. Patents updated letter template project</b>	TFG members were given an update on the Patents Letter Template Project and will be invited to a review session to provide feedback on the new template.	Presentation on draft templates to be arranged to get member feedback.
<b>13. Next meeting</b>	To be scheduled for early September	Meeting delayed due to work on IPONZ Fees Review (now completed) and IP Omnibus Bill