

PATENTS TECHNICAL FOCUS GROUP

2 December 2019
10am – 12.30pm
IPONZ Boardroom, Wellington

Present

IPONZ / MBIE Policy

Simon Pope (Chair), Warren Hassett (MBIE Policy), Mark Luiten, Warren Coles, Tanya Carter, Monique Cardy, Cole Lomas

TFG members

Fiona Pringle (Baldwins), Duncan de Geest (AJ Park, NZIPA), Jonathan Lucas (James and Wells), 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

N/A

Minutes

Agenda item / topic	Discussion	Action
1. Actions from previous meeting	The actions from the previous meeting were reviewed.	N/A
2. Intellectual Property Laws Amendment Bill – discussion following review of submissions	<p><u>Modified approach to divisional applications following review of submissions</u></p> <ul style="list-style-type: none"> MBIE discussed an updated approach to divisionals that was based on a proposal in IPTA's submissions intended to provide applicants with greater flexibility, and to better serve IPONZ operational needs, while still maintaining policy objectives. Under this approach applicants can file as many divisional applications as they like (including daisy chain divisionals) provided they are all filed, and examination requested, during the 12 month examination period for the original parent application. Applicants would then have 12 months from the first 	

	<p>examination report for the divisional(s) to put them in order for acceptance. The rationale is to provide applicants with the opportunity to file divisionals in response to any issues raised during examination of the original parent, while preventing the uncertainty for third parties of an indefinite chain of pending divisional applications for the entire term of the original parent.</p> <ul style="list-style-type: none"> • While members made clear their preference to be able to file divisionals at any time, they largely viewed this modified approach as a sensible compromise over the original proposal in the discussion paper. However, they raised some concerns about the possibility of late unity objections being raised against divisional applications beyond the 12 month examination deadline for the original parent – in which case a further divisional could not be filed. MBIE / IPONZ expressed the view that this was highly unlikely (particularly at 6 years from the filing date of the original parent) but agreed to give this aspect further consideration. <p><u>Poisonous priorities and divisionals</u></p> <ul style="list-style-type: none"> • There was some difference of view on this topic. Members, in particular IPTA and NZIPA, remained of the view that allowing multiple priority dates for claims was the best way to deal with both issues, which would be consistent with IPAU’s approach. However, MBIE remained of the view that poisonous priority was something that attorneys were aware of and could be managed. They should be able to advise their clients on how to avoid it. Poisonous divisionals are a greater issue in practice, and these were best dealt with by a specific anti-collision provision. <p><u>Treatment of so called ‘zombie applications’</u></p> <ul style="list-style-type: none"> • The treatment of so called ‘Zombie applications’ (divisional applications that can’t be examined because they were filed after the 5 year examination deadline for the parent – and therefore unable to be 	<p>MBIE to consider options to deal with the possibility of late unity of invention objections.</p> <p>MBIE likely to stay with proposal in consultation paper.</p> <p>Patents Amendment Bill to include provisions to render ‘zombie applications’ void.</p>
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	<p>examined) will be addressed in the exposure draft of the Bill. The intention is to include a specific provision that will render them void.</p> <p><u>Regulation 82</u></p> <ul style="list-style-type: none"> • Discussed the possibility of introducing a double patenting provision to address members' concerns about reg 82, which prohibits the Commissioner from accepting claims for an application if they are substantially the same as claims already accepted for a related parent or divisional application - even when the earlier accepted parent / divisional application is withdrawn. • This is the approach adopted by the United Kingdom ("UK"), in section 18(5) of the Patents Act. Warren noted the UK approach to double patenting was favoured over the Australian approach because it is more rigorous and aims to protect third parties. • Some members expressed dissatisfaction at the lack of evidence to support this claim and raised concerns about adopting this approach. They felt it removes flexibility and will encourage applicants to file multiple divisionals and pushes them towards Hearings. • John added that IPTA is opposed to adopting this double acceptance policy and would prefer alignment with Australia. The Select Committee will be informed of these concerns. • Warren pointed out that the Act, as it currently stands, contradicts itself because it contains strict time limits to prosecute a patent application but allows whole of contents divisionals to be used as a back door extension of time. He further noted that expanding claims via divisionals or amendments after acceptance was never the intention of the Act. <p><u>Amendment to section 8(2)</u></p> <p>The current provision is worded as 'after the priority' which will be updated to 'on or after'. Although the number of cases affected by this are</p>	
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	<p>minimal.</p> <p>Warren offered members the opportunity to submit further submissions on any of the proposals discussed.</p>	
<p>3. Presentation on new Patents Letter Templates</p>	<p>Cole Lomas gave a presentation on behalf of the IPONZ Patents Team on the Letter Template Project he has been leading.</p> <p>He went through the various design features to make the new letters more user friendly for clients, and to take advantage of the modern digital environment (for example using colour to create visual cues, consolidated cover page information with all relevant dates, and keeping the letters as short as possible by linking to relevant web guidelines and sections of the Act).</p> <p>Feedback from the members was overwhelmingly positive, and Cole and the team will take the members' suggestions from the meeting and incorporate this into an updated draft template. This will be circulated to members for further feedback from staff within their firms, including staff in their docketing departments.</p>	
<p>4. Implementation of new patent fees</p>	<p>Tanya Carter updated members on new information that had been posted on the IPONZ website about the fees review.</p> <p>There was discussion around when the excess claims fees would be charged. IPONZ advised that they will raise a task in the system for payment of the excess claims at the same time the notice of acceptance is issued.</p> <p>Members discussed the possible implications of having no deadline to pay the excess claims fees, notwithstanding that the application will not proceed to grant until they are paid. Warren agreed that it made sense to address this in the Intellectual Property Laws Amendment Bill.</p>	
<p>5. Patent team updates</p>	<ul style="list-style-type: none"> • Patents have employed 15 people this year. • Richard Butterfield has been permanently appointed as the Team Leader of the Mechanical Team. 	

	<ul style="list-style-type: none"> • 2 further recruitment rounds are scheduled for the first half of 2020. • Warren Coles (who oversees enhancements for the patents case management facility for the patents team) gave an update on recent enhancements, including the new functionality to show all applications in a divisional chain. Information on a divisional chain can now be found in the bibliography page of applications under the heading 'Patent Family'. More information can be found on the IPONZ website here. 	
6. Review of draft practice guidelines	<p>TFG members reviewed the following draft practice guidelines:</p> <ul style="list-style-type: none"> • Amendment of complete specifications after acceptance. • Verified translations for Treaty applications. • Amendment of description, claims and drawings of Treaty Applications. • Parent and divisional claims overlap – reg 82. <p>IPONZ and members discussed the draft guidelines, and IPONZ will update the draft guidelines to incorporate members' feedback before publishing them on the IPONZ website. This will be communicated more widely in a future IPONZ eNewsletter.</p>	
7. Information published in journal for amendments after acceptance	<p>This item was raised by a member who had noted some inconsistency in IPONZ practice between the details published for amendments after acceptance in the journal for 1953 and 2013 Act applications. IPONZ accepted there had been some inconsistency and had since updated its internal practices to address this.</p>	<p>IPONZ has updated internal practices.</p>
8. Next meeting	<p>To be scheduled.</p>	<p>IPONZ to confirm possible dates.</p>