

PATENTS TECHNICAL FOCUS GROUP

27 February 2019

10am – 12.30pm

IPONZ Boardroom, Wellington

Present

IPONZ / MBIE Policy

Simon Pope, Mark Luiten, Steve Smith, Sanjay Tapnikar, Gaby Cowcill, Neroli Ayling, Warren Coles, Tanya Carter, Jenny Jebson, Richard Butterfield, Harriet Davis, Warren Hassett, Steffen Gazley

TFG members

Fiona Pringle (Baldwins), Duncan De Geest (AJ Park), David Nowak (Henry Hughes), John Landells (FB Rice, IPTA), Doug Calhoun (NZIPA), Jonathan Lucas (James and Wells), Tom Robertson (Pipers), Scott Sonneman (DCC), Laura Hollingsworth (Catalyst)

Apologies

None

Minutes

Previous Minutes agreed / ~~not agreed~~

Agenda

1. Introductions
2. Patent Office updates:
 - Restructure of the Patents Team – overview and introduce Team Leaders (for each technical team) and Principals.
 - Recent progression round
 - Recruitment and training
 - MBIE flexible working pilot
 - Project to identify areas to improve efficiency and remove friction in system
 - IPONZ fee review
 - Team updates – work volumes, trends, etc
3. IPONZ Hearings delays
4. MBIE policy update on IP Omnibus consultation
5. Review of terms of reference for the TFG.
6. Crown Law advice regarding:
 - Application of s 64(2) – the 5 year deadline for the Commissioner to direct, and/or applicants to request, examination; and
 - Time limit for applicant's to request examination of a divisional application under reg 71(a) that has an earlier complete filing date of more than 5 years.
7. Patents Act 2013 timeframes – applications progressing past 5 year deadline for filing and requesting examination
8. Discussion on office approach to abstract requirements.
9. *CNH Industrial Belgium NV* [2018] NZIPOPAT 7 (30 April 2018) Consideration of decision and practice implications.
10. Request for a hearing – substantive response.

11. Regulation 70 - requests for evidence in support of convention application.
12. Examination report deadlines – instances of 1953 Act applications not receiving sufficient response time.
13. Omnibus claims – and objections to them.
14. Budapest Treaty – access to deposited micro-organisms.
15. Review of draft examination guidelines (including discussion on appropriate format and style):
 - Amendment of complete specifications before acceptance - section 40
 - Examination of Swiss-type claims
 - Correction of Error – third party errors - section 202
 - Correction of Error – commissioner’s error - section 201
 - Parent-Divisional claims overlap - regulation 82
16. Any other business.
17. Next meeting/upcoming meetings.

Minutes

Agenda item / topic	Discussion	Action
<p>1. Introductions</p>	<p>The new IPONZ Patents & Designs Manager, Simon Pope, introduced himself and his extended leadership team to TFG members:</p> <p><i>Team Leaders</i></p> <ul style="list-style-type: none"> • Gaby Cowcill, Team Leader Biotech • Neroli Ayling, Team Leader Chemistry • Richard Butterfield, Team Leader Mechanical (acting) • Warren Coles, Team Leader ICT / Electrical/ Designs/ PCT Receiving Office • Jenny Jebson, Team Leader Training & Business Support <p><i>Principal Examiners</i></p> <ul style="list-style-type: none"> • Mark Luiten, Principal Patent Examiner • Steve Smith, Principal Patent Examiner • Sanjay Tapnikar, Principal Patent Examiner <p>He also welcomed the two new TFG members Scott Sonneman and Laura Hollingsworth.</p>	<p>N/A</p>
<p>2. TFG terms of reference and expectations</p>	<p>The Patents Manager provided TFG members with updated terms of reference and expressed a desire to adopt a more collaborative approach where issues were considered and worked through as early as possible.</p>	<p>N/A</p>
<p>3. Patent Office updates</p>	<p>The Patents Manager apologised for the delay since the last TFG meeting. This was</p>	<p>N/A</p>

	<p>due to the need to complete significant internal changes in the patents team over the last 6 months including:</p> <p>Retirement of Liz Francis</p> <p>The previous Patents Manager, Liz Francis, retired after a long tenure in the role. The acting manager then left to pursue an external opportunity. To address this departure Simon Pope transferred from the IPONZ Hearings Office to manage the Patents Team in an acting capacity. He has subsequently been permanently appointed. Steffen Gazley has been appointed the new IPONZ Hearings Office Manager.</p> <p>Restructure of the patents team</p> <p>Following an internal review to ensure IPONZ was appropriately structured to cope with significant growth over recent years the new Patents Manager led a restructure of the Patents Team. The most significant change is the appointment of Team Leaders for each of the patents technical teams (Biotech, Chemical, ICT/Electrical, and Mechanical). The Team Leaders are now responsible for the day to day management of their technical teams, and report through to the Patents Manager. The Principal Examiners also report directly to the new Patents Manager.</p> <p>TFG members were advised that the new Team Leaders should be their first point of contact for escalating any issues regarding work being done by their teams.</p>	
<p>4. Capacity building - recruitment and training</p>	<p>The team has been increasing its efforts to build examination capacity to cope with increased workloads under the Patents Act</p>	<p>N/A</p>

	<p>2013.</p> <p>A separate Training and Support team run by Jenny Jebson (who led work on developing IPONZ's online training and learning system) has been established to streamline the recruitment and training of new examiners. The aim is to improve training quality and minimise the impact training has on examination output by reducing training demands on the technical teams.</p> <p>There are currently 10+ new examiners in training and two further Mechanical Patent Examiners have recently been recruited. There is a further recruitment round planned for mid-year.</p>	
5. Recent progression round	<p>An important part of building IPONZ examination capacity is developing and retaining our staff. This remains a challenge with the recent loss of some senior IPONZ patent examiners to the profession.</p> <p>To achieve this IPONZ runs bi-annual competency based progression rounds. A number of patents staff were recently promoted to new roles having successfully applied for progression. It was particularly pleasing to see a good number of trainee examiners progress to full patent examiner roles, and to recognise the contribution and abilities of examiners who have now progressed to senior examiner roles.</p>	N/A
6. MBIE flexible working pilot	<p>IPONZ is currently taking part in an MBIE flexible working pilot, which included a re-fit of the IPONZ Offices to better suit flexible working. As early adopters of flexible working IPONZ has already seen the significant benefits of providing flexible working options. This is crucial to retain experienced staff – which is a business</p>	N/A

	<p>priority.</p> <p>In addition to IPONZ's Wellington offices we now have patent examiners working out of MBIE Offices in Auckland, Napier and Christchurch, and a number of examiners working from home on a full or part time basis.</p>	
7. IPONZ fee review	<p>Cabinet has approved the policy paper in respect of fees changes. However, the final fee changes are still subject to Cabinet and Executive Council approval of the amended regulations, once they have been drafted by the Parliamentary Counsel Office.</p> <p>IPONZ is preparing a summary of fees changes package, and is aiming to release this package by early April 2019.</p> <p>To stay up to date on this matter, please visit the IPONZ Fees Review page on our website.</p>	N/A
8. Re-organisation of PCT Receiving Office / WIPO fee netting pilot	<p>The PCT Receiving Office has undergone a re-organisation to provide an improved service for local clients. Warren Coles, Team Leader ICT / Electrical, is now in charge of the day to day management of the PCT Receiving Office, reporting to the Patents Manager.</p> <p>IPONZ is currently participating in the WIPO fee netting pilot with WIPO and the EPO to manage currency risk (fluctuations) and improve the flow of PCT search fees from receiving offices to international search authorities.</p>	N/A
9. Re-organistaion of Designs team	<p>The Design team has also been reorganised to increase examination capacity, improve internal processes, and provide for better contingency and</p>	IPONZ making initial enquiries to establish Designs TFG.

	<p>continuity planning. Warren Coles is also now responsible for the day to day management of this team. Mark Luiten is the Principal Examiner for this team. Both report directly to the Patents Manager.</p> <p>IPONZ is investigating establishing a Designs Technical Focus Group to test and improve examination practice, and to develop further practice guidelines.</p>	
10. Productivity focus	<p>The Patents Manager advised there is a project underway to identify opportunities to achieve further productivity gains, and to increase examination output. Various measures have already been implemented, and further options are being investigated. Changes that have practice implications will be discussed and tested with the TFG before commencement.</p>	<p>IPONZ to discuss any proposed practice changes with TFG.</p>
11. IPONZ hearings delays	<p>The new Hearings Office Manager, Steffen Gazley, addressed the question of hearings delays. He advised that the average wait for a hearing is presently 6-12 months and that IPONZ is looking to recruit additional Assistant Commissioners and Hearings Office staff to bring this wait time down.</p>	<p>N/A</p>
12. Practice of using s 230 to extend time for putting patent application in order for acceptance	<p>A TFG member referred to a recent hearings decision in which the Assistant Commissioner discussed the Office's practice of using s 230 to extend the time for putting an application in order for acceptance beyond the s 71 deadline to enable a hearing to take place. IPONZ recognised (as did the Assistant Commissioner) that this was a pragmatic, yet imperfect, situation and would be tidied up in the upcoming IP Omnibus Bill. It was further asked if IPONZ was likely to go down the Australian or UK approach to examination hearings. IPONZ advised that the Australia approach looked most</p>	

	suitable, but that was a policy matter for further consideration.	
13. MBIE Policy update on IP Omnibus Bill	<p>Warren advised that the draft IP Omnibus Bill is nearly ready to go to the Minister. It's expected to be released and ready for public submissions by the end of April.</p> <p>A member enquired how long the consultation process will take. Warren advised it is likely to be about three months. From there, depending on Parliament priorities, it's likely to be in the house mid- 2020. How long it takes to go through Parliament depends on Government work priorities.</p> <p>Warren confirmed that an exposure draft of the Bill is likely to be issued.</p>	IPONZ to notify stakeholders when IP Omnibus Bill is released for public consultation.
14. Crown Law advice on disputed examination practice	<p>IPONZ advised that it had sought legal advice from Crown Law given the difference of opinion at the last TFG meeting on the correct interpretation of the following:</p> <ul style="list-style-type: none"> • Application of s 64(2) – the 5 year deadline for the Commissioner to direct, and/or applicants to request, examination; and • Time limit for applicant's to request examination of a divisional application under reg 71(a) that has an earlier complete filing date of more than 5 years. <p>The Patents Manager informed TFG members that their written submissions on the subject had been considered by Crown Law in providing their advice.</p> <p>The advice affirmed that current IPONZ practice was correct. However, it noted</p>	IPONZ to maintain current practice.

	<p>the legislation could be improved for clarity and Warren Hassett from the MBIE IP Policy team confirmed it will be addressed in the IP Omnibus Bill.</p>	
<p>15. Abstract requirements</p>	<p>At the NZIPA Annual General Meeting some concerns were raised that IPONZ's was raising unnecessary objections in this area. The president of IPTA noted IPONZ took a far more stringent approach than IP Australia, which was more likely to accept abstracts already considered by WIPO. Having noted these concerns, the Patents Manager raised this matter for discussion.</p> <p>Given the abstract is not part of the specification defining the scope of an applicant's rights, and its purpose is to facilitate searching, it was agreed that IPONZ could take a more permissive approach provided the abstract fulfilled its role.</p> <p>In cases where the abstract was clearly deficient it was proposed that examiners could amend the abstract on their own initiative rather than raising an objection. Applicants would be made aware of any changes to the abstract prior to acceptance. In such circumstances, IPONZ would be open to discussing the changes with applicants and could make further changes if and where needed.</p>	<p>IPONZ to update practice guideline on abstract requirements</p>
<p>16. CNH Industrial Belgium NV [2018] NZIPOPAT 7</p>	<p>A member expressed concern that the Assistant Commissioner's decision was not being correctly followed by the patents examination team. In particular, the member noted that the Assistant Commissioner had not upheld the Office's objection requiring the introduction of the object clause in the specification to be</p>	<p>IPONZ has since changed its position and withdrawn all outstanding objections of this nature against pending</p>

	<p>post-dated on the basis it lacked specific support under the Patents Act 2013.</p> <p>The Office agreed to re-visit the Assistant Commissioner’s decision in light of this discussion.</p>	<p>applications.</p>
<p>17. Does a request for an examination hearing amount to a ‘substantive response’ under s67</p>	<p>A member inquired if a request for an examination hearing constitutes a ‘substantive response’ for the purposes of s 67 such that the application won’t go void under s 68.</p> <p>It was agreed that practice guidelines would be updated to make it clear that a request for an examination hearing was considered a ‘substantive response’ for the purposes of s67.</p>	<p>IPONZ to prepare updated practice guideline.</p>
<p>18. Setting of deadlines for responses nearing the s 71 deadline for placing the application in order for acceptance</p>	<p>As a follow on from item 16 above, a member noted that where IPONZ grants an extension of less than a month for a substantive response, and that takes the deadline out to the s71 deadline, the extension period is deemed to be for a substantive response and the applicant is unable to file a divisional application.</p> <p>It was suggested that in the situation where there are more than 3 months to the s 71 deadline, but less than 4 months, it would be appreciated if IPONZ could set the final (s 71) deadline as the response deadline - and not provide a shortened extension period. This would allow applicants to file a divisional application if necessary.</p>	<p>IPONZ agreed to adopt this practice and has updated its guidelines and internal operations manual.</p> <p>See notification to clients confirming update.</p>
<p>19. Examination report deadlines –1953 Act applications</p>	<p>Member raised concerns that examiners had been issuing examination reports for 1953 Act applications late in the working day reducing the response time for</p>	<p>Team Leaders to discuss this with their respective teams.</p>

	<p>applicants particularly if the timescale is already short.</p> <p>Patent Manager advised that applicants / attorneys could call Team Leader of relevant team in the first instance if this occurs.</p> <p>A member asked how many 1953 applications are still left to examine, advised there are ~800 cases still under examination.</p>	<p>Examination reports with short deadlines should be sent as early as possible in the day to give adequate time for consideration of the report.</p>
<p>20. Omnibus claims – and objections to them</p>	<p>Member raised concerns over inconsistent examination of omnibus claims.</p> <p>Mark Luiten advised that IPONZ are working on a guideline and reviewing practice so that omnibus claims can be treated in a more consistent fashion. In the meantime, they are examined in the normal way for clarity, etc.</p>	<p>The current s.39 guideline was reviewed but not changed. This will be addressed as a practice reminder across all staff instead.</p>
<p>21. Budapest Treaty – request for deposited micro-organism</p>	<p>Member enquired into process for requesting IPONZ for a deposited micro-organism under the Budapest Treaty.</p> <p>Warren Hassett advised there is a WIPO form that applicants must fill in and submit to IPONZ to certify. This is then used to obtain the micro-organism from the approved depository. He mentioned that interested parties would need to consider border checks if bringing the micro-organism into NZ.</p>	<p>Guidelines on this process were published online in May 2019 alongside related communications and can be found here.</p>
<p>22. GPPH - meaning of ‘sufficiently correspond’ in the context of amending method of medical treatment claims into Swiss style claims</p>	<p>Members raised concerns on what they considered IPONZ’s overly restrictive interpretation of what ‘substantially correspond’ means in the context of GPPH applications, notably applications for a method of medical treatment that are put into Swiss style claim format for NZ. Members considered IPONZ current approach of refusing such requests was</p>	<p>IPONZ has investigated this matter and notes that IP Australia considers claims put into Swiss type format to ‘substantially correspond’ for</p>

	assessing this requirement as meaning 'identical'.	the purposes of the GPPH agreement. Given the over-arching objective of the GPPH is to create efficiencies by allowing office's to rely on each other's work products, IPONZ sees the benefit in aligning its approach with AU. An updated practice guideline will be drafted for consideration by the TFG.
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