

Patents

Technical Focus Group (“TFG”) Meeting Minutes

Date/Time	19 June 2024, 10:00 am – 12:00 pm
Location	Virtual / 15 Stout Street, G.17

Participants

MBIE / Intellectual Property Office of New Zealand (“IPONZ”)	Members	
Ed Barclay Steven Hong Simon Maguire Matt Allan Emma Stares Lauren Hudson Ellie McLellan (IP Policy team)	David Koedyk David Nowak Duncan de Geest Jason Wach Jonathan Lucas Pritesh Lohani Scott Sonneman Tom Robertson	Catalyst Henry Hughes NZIPA / AJ Park NZ Law Society JAWS Pipers DCC Pipers
	Apologies: David Herman John Landells	IPTA / FB Rice FB Rice

Minutes

Matters arising / previous action items	Update
Action	Status
IPONZ to provide an update on Māori Advisory Committee guidelines.	Ongoing. Aiming to get this back on the work plan for 2024/2025. Some minor changes to the Māori IP pages are being investigated, to clarify differences between Committee processes for the different IP types.

<p>IPONZ to continue to investigate inventor address formatting issues & provide an update next meeting.</p>	<p>Ongoing.</p> <p>Changes were released shortly after the previous TFG.</p> <p>Inventor address details are not shown on the patent summary report, specification cover pages and journal notifications.</p> <p>Further changes are being investigated.</p>
<p>IPONZ Updates</p>	<p>Ed Barclay</p>
<p>Ed covered general IPONZ updates, including:</p> <ul style="list-style-type: none"> • Recruitment <p>None since the last meeting.</p> <p>A member queried whether recruitment would be possible if an examiner left. Ed answered that this would be case-by-case; there is not an overall recruitment freeze, but a business case does need to be made for filling empty positions.</p> <ul style="list-style-type: none"> • Pendency <p>The team has hit record output over the last few months, with over 1000 reports issued last month for the first time. The number of cases awaiting exam is stable with a trend towards dropping. There is a small but dropping number of 1953 Act cases to be examined.</p> <ul style="list-style-type: none"> • Restructure <p>An IPONZ restructure has been confirmed and will be effective from 24 June 2024. The management team is currently working to implement this. Importantly: the number of patents, designs, and PVR examiners has not been reduced. The patents manager role has been split into two roles: (1) manager of patents (science) and PVR, and (2) manager of patents (engineering) and designs. There are also some changes to reporting lines within the various teams. Some roles are yet to be confirmed. IPONZ will provide updated contact details for the IPONZ management team once confirmed.</p> <p>A member asked for details on the changes to the structure and roles of the hearings team. Ed responded that there is a reporting line change, with the hearing team now reporting to the manager of business delivery. There are also some reporting line changes; a summary will be provided to members once the details are worked through.</p> <ul style="list-style-type: none"> • PPH <p>A pilot PPH with China National Intellectual Property Administration was signed last week as part of the visit from Chinese Premier Li Qiang. The target implementation date is 1 November 2024. Communications around the process will be released closer to this date, but the intention is that the filing requirements and process will closely match those currently followed by GPPH applications.</p>	

A member queried whether verified translations of relevant Chinese docs will still be required. Matt responded that IPONZ will allow machine translations wherever practicable, with the option to request manual translations if required.

- **Upcoming events**

IPONZ is currently enjoying a trademark examiner exchange with Australia and Singapore (June 17th to 26th).

The WIPO General Assembly is approaching (July 9th to 17th).

Fees review: A review of all IPONZ fees is in the early stages of being progressed: proposals are being prepared for public consultation later this year. The aim is for this to be implemented by mid-2025.

Update from MBIE Policy Team

Ellie McLellan

WIPO DipCon

Recently the WIPO Diplomatic Conference (DipCon) to Conclude an International Legal Instrument Relating to Intellectual Property, Genetic Resources and Traditional Knowledge Associated with Genetic Resources was held in Geneva and attended by our colleagues from Te Puni Kōkiri.

WIPO member states approved a new Treaty related to intellectual property, genetic resources and associated traditional knowledge after decades of negotiations.

Where a claimed invention in a patent application is based on genetic resources each contracting party shall require applicants to disclose the country of origin or source of genetic resources. Where the claimed invention is based on traditional knowledge associated with genetic resources, shall require applicants to disclose the Indigenous Peoples or local community who approved the traditional knowledge.

New Zealand voted in favour of the final text of the Treaty.

There is no immediate change of practice in NZ as a result of this Treaty.

Following the conclusion of negotiations, it will be up to Cabinet whether New Zealand takes steps to be bound by the instrument. This will be subject to Parliamentary scrutiny, including a National Interest Analysis.

Intellectual Property Laws Amendment Bill

No indication yet on when this work will be progressed.

Draft manual sections for review and discussion

Steven Hong and Simon Maguire

Unity

The unity section of the manual has been expanded to cover unity a priori and a posteriori with examples, Markush practice, treatment of international reports, assessment of prior art, and restriction of examination.

Members gave feedback, including:

- A request for clarification on whether IPONZ considers certain claims to nucleic acids or proteins “Markush groupings” (with reference to unity examples 30 and 35-39 of the PCT Guidelines).

- Suggestions to include clarification that claims of different categories, or claims to different parts of the same system, are usually considered unified if related by the same special technical feature.
- General agreement that unity should not necessarily be raised in every case of a lack of novelty.

Members agreed that any further changes to the guideline would be circulated by email.

Swiss type claims

A new Swiss-type claims section of the manual was presented. This updates the manual to include IPONZ practice relating to common types of Swiss-type claims. This section also includes guidance on the form and construction of Swiss-type claims and provides guidance on how the requirements such as novelty, inventive step, support, enablement, and unity are considered.

There was feedback and discussion on several points:

- **Construction of Swiss-type claims:**

A member submitted that Swiss-type claims relate to the purpose of the manufacture rather than the purpose of the medicament. The member submitted that this was consistent with *Pharmac* (para 59). This difference leads to some inconsistencies within the guideline around specific claim formulation.

- **Incorporation of further case law in the guidelines:**

A member suggested including a discussion of *NRDC* and [Ballance Agri-Nutrients v Ravensdown](#), which give useful guidance on how purpose-limitations are to be interpreted in NZ. The member also referred to [Vital Food Processors Limited v Anagenix Limited](#) which includes useful discussion of how these cases apply to Swiss-type claims.

- **Active administration language:**

A member queried whether objections to “is administered” are necessary. As Swiss-type claims are a claim to the manufacture, they should not be construed as encompassing a step of active administration, unless administration is a step within the manufacture of the medicament (such as a use of the human body as a bioreactor).

- **Uses in non-humans:**

A member queried the approach to Swiss-type claims encompassing non-humans, noting that [Genentech Inc and Washington University](#) considered and allowed a claim reciting “mammal”, and a dependent claim restricting the mammal to a human.

Simon clarified that an objection would only be made if the skilled person would purposively construe the claim as being directed to non-human animals. The presence of subject/patient/mammal in the claim will not alone give rise to an objection. The team may look at expanding relevant paragraphs in the guidelines.

Further feedback to be sent to via email or provided via discussion with Simon.

Section 11 update

The s11 section of the exam manual is being updated in view of the recent decision [Broadleaf Co., Ltd. \[2024\] NZIPOPAT 7](#). In para 41 of the decision, the AC recommends an update to the manual to reflect the “signposts” as laid out in *HTC Europe Co Ltd v Apple Inc*, rather than as in *AT&T*.

A mark-up of the changes will be circulated with the minutes.

Other practice queries and discussions

Refund for of request for examination fee: A member queried the possibility of getting a refund for a request for examination if an application is withdrawn prior to examination had been discussed previously.

IPONZ will look into this.

Design Law Treaty: A member queried whether IPONZ is looking at the Design Law Treaty.

The IP Policy Team provided this post-meeting update: “We are monitoring developments but at this stage no decision has been taken regarding attending the Dip Con later this year.”

Clarity/conciseness objections to claims reciting chemical names: A member mentioned clarity/conciseness objections being raised against claims reciting chemical names. As chemical nomenclature is well-understood by the person skilled in the art, the scope of such claims is clear. The member proposed sending some examples through to IPONZ to provide more context around this perceived issue.

IPONZ is aware of circumstances where this may be an issue if the number of compounds is significant. IPONZ will investigate further.

Any other business

The date of the next meeting was set as 26th September. IPONZ will send out an invitation.

Actions summary

IPONZ to provide an update on Māori Advisory Committee guidelines.	Ongoing – see status above.
IPONZ to continue to investigate inventor address formatting issues & provide an update next meeting.	Ongoing – see status above.
Members to send any further feedback on Swiss-type claim exam manual content to Simon (Simon.Maguire@iponz.govt.nz ; also happy to discuss verbally). IPONZ will circulate an updated version of this section before the next meeting.	
IPONZ to consider and incorporate feedback on unity exam manual content. Any changes will be circulated to the TFG members for further discussion prior to publishing.	

IPONZ to investigate the possibility of issuing a refund for the request for examination fee if an application is abandoned prior to examination.	
IPONZ to evaluate internal practice relating to raising clarity/conciseness over claims to a list of named chemical compounds.	
Close of meeting	