

Patents

Technical Focus Group (“TFG”) Meeting Agenda

Date/Time	26 September 2024
Location	Virtual/ Stout Street 8.08

Participants

MBIE / Intellectual Property Office of New Zealand (“IPONZ”)		<u>Members</u>	
Gaby Cowcill	Manager Patents (Science) & PVR	Tom Robertson	Pipers/ NZIPA
Ed Barclay	Manager Patents (Engineering) & Designs	Fiona Pringle	A J Park
Matt Allan	Team Leader	Jonathan Lucas	JAWS
Ben Sowman	Team Leader	David Nowak	Henry Hughes
Simon Maguire	Principal Patent Examiner	Sanjan Srivelan	DCC
Ellie McLellan	CGIPP team	John Landells	IPTA / F B Rice
Lizzy Eden	Senior Patent Examiner	Laura Hollingsworth	Catalyst
		<u>Apologies:</u>	
		Shelly Musgrave	NZ Law Society
		Duncan de Geest	NZIPA / A J Park
		Scott Sonneman	DCC
		David Herman	IPTA / F B Rice

Minutes

Previous action items	Update
IPONZ to provide an update on Māori Advisory Committee guidelines.	Ongoing – currently costing. High priority to progress.
IPONZ to continue to investigate inventor address formatting issues & provide an update next meeting.	Investigated issues. Considered main areas as per previous minutes addressed. David Nowak to send through a current issue. To be removed as an ongoing action point.
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.	Discussed at current meeting.

<p>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.</p>	<p>Actioned – guidelines published.</p>
<p>IPONZ to investigate the possibility of issuing a refund for the request for examination fee if an application is abandoned prior to examination.</p>	<p>Gaby – proposing continuing current practice, considered under manager discretion.</p> <p>Guidance on refunds is available on the IPONZ website: https://www.iponz.govt.nz/about-iponz/refund-policy/</p>
<p>IPONZ to evaluate internal practice relating to raising clarity/conciseness over claims to a list of named chemical compounds.</p>	<p>Matt – issue raised by members regarding clarity and/or conciseness objections against claims to lists of compounds identified by name only.</p> <p>Practice clarified:</p> <ol style="list-style-type: none"> 1) Clarity – no clarity objection to be raised in this situation. Applicants have the right to present their invention in "words of their own choosing". 2) Conciseness – approach will be the same as any other claim type.
<p>IPONZ Updates</p>	<p>Ed/Gaby</p>

Slides from this presentation to be provided.

IPONZ general updates including:

- **Appointments and recruitment**
 - Ed Barclay confirmed as Manager Patents (Engineering) & Designs.
 - Gaby Cowcill confirmed as Manager Patents (Science) & PVR.
 - Steven Hong confirmed as Principal Patent Examiner (ICT/Electrical).
 - No reduction in examiner positions for Patents, Designs or PVR.
 - No recruitment since last TFG.
- **Pendency**
 - Pendency times updated – see the [IPONZ website](#) .
 - 112 remaining 1953 Act cases ‘under exam examination’.
- **General stats** – the number of applications which have requested examination with an examination report not yet issued trending downward. Yearly volume overview for filings and output for 23/24 showed more first examination reports issued than requests for examination.

- **PPH update** – agreements for Patent Prosecution Highways (PPH) have been signed with the China National Intellectual Property Administration (CNIPA) and the European Patent Office (EPO).
- **Fees review** – consultation for the fees review to be held before end of 2024, implementation aimed for mid-2025.
- **Case management system upgrade** – customer reference group to be stood up for the case management system upgrade, members to get in touch with Gaby or Ed if interested.

Update from MBIE Policy Team

Ellie

- **Trans-Tasman IP Attorney Board** - expecting appointment to be made by the Australian Minister soon.
- **Copyright Act review** – Minister Bayly will be briefed regarding restarting the Copyright Act review in 2025. Legislative updates must be achievable enough to enact by May 2028 to align with obligations in NZ-EU Free Trade Agreement for extending the term of protection and technological protection measures.
- **Intellectual Property Laws Amendment Bill** – looking to progress the Bill next year, and currently reviewing any issues that have arisen since the Bill has been on hold.

Draft manual sections

Simon

1) Swiss type claims guidelines update

The Swiss type claims guidelines have been updated in view of the feedback provided at the previous TFG.

The main changes were:

- Clarification of the functional definitions in view of *Vital Food* and *a2 Milk* decisions.
- Removal of the wording indicating that the medical use relates to the “medicament”. Removal of discussion of other claim types.
- Clarification of the active language section.
- Clarification of practice around “subject”, “patient” and “mammal” within claims to emphasise purposive construction.
- Introduction of a Manner of Manufacture section.

Members were broadly in agreement with the changes, but provided the following feedback:

- The removal of reference to “conventional claim construction”, particularly regarding the reference to “suitable for” and differing claim construction, was questioned.
 - This was removed to address previous feedback and to focus on Swiss-type claims.
 - Other members submitted that the removal of this subject matter was preferred.
 - IPONZ to discuss further with AJ Park to clarify the feedback.
- IPONZ practice on active language was queried.
 - This feedback was noted.
- A member raised a query around Swiss type claims involving an apparatus or device. A case was referred to but not specifically identified.
 - IPONZ to follow up with the member to clarify feedback and will consider if further changes are required.

Any further revisions to the guidelines will be emailed to TFG members, with the aim to finalise the guideline for publication on the IPONZ website.

2) Translation guidelines (Regulation 65) minor update

- Minor amendments to the Regulation 65 guidelines to clarify practice when a Treaty application is not filed in English, but is published in English at WIPO (this can occur under rule 12.4 of the PCT).
- IPONZ practice is to accept the English language publication at WIPO. Applicants will not be required to file a verified translation of the treaty application.
- The updated Regulation 65 guideline will be published on the website soon, the specific changes will show in the historic record.

Other practice queries and discussions

1) Omnibus claims - Ed Barclay

- Refresher training on omnibus claims has been provided to the mechanical team.
- IPONZ practice on omnibus claims can be found in the [examination manual](#), at 95-100

Any Other Business

1) PPH implementation

Slides from this presentation to be provided.

- EPO and CNIPA PPHs to go live this year, comms to be released soon (mid-October).
- Implementation dates: 1 November 2024 for the CNIPA PPH and 1 December 2024 for the EPO PPH.
- An overview on the functionality and implementation of these PPHs was provided.
- Statistics and trends will be monitored to get a picture of the efficacy of these PPHs.
- CNIPA has offered training sessions for filing PPH requests in China, members can reach out to Gaby or Ed about this.
- Query from Laura about whether IPONZ monitors statistics from the GPPH.
 - There is some monitoring as part of the agreement which is sent to the JPO.
 - Statistical Data on Examination for the GPPH can be found on the [JPO website](#).

2) Clarity objections to CDR numbering schemes for antibodies

- Fiona noted an examiner unnecessarily objecting to clarity regarding CDR numbering.
 - Fiona to provide case number and IPONZ to look into.
- David Nowak queried IPONZ practice on this more generally.
 - IPONZ will discuss our practice.

3) Date of next meeting

- The date of the next meeting was agreed as February 2025.
- Ed to send around some proposed dates.

TIME	Close of Meeting
Actions summary	
IPONZ to circulate slides for general updates and PPH agreements.	

<p>IPONZ to email members the Swiss-type claim guidelines for any final feedback before publication.</p>	
<p>IPONZ to share current statistics measured as part of the GPPH (see link to JPO website above).</p>	
<p>Fiona to provide case number for CDR objection.</p>	
<p>IPONZ to discuss practice on CDR clarity objections.</p>	
<p>TFG members to get in touch with Ed or Gaby if interested in the working group for the case management system upgrade.</p>	
<p>TFG members to get in touch with Ed or Gaby if interested in training sessions for filing in China as part of the CNIPA PPH.</p>	