

To: MBIE  
Wellington

2<sup>nd</sup> August 2019

## **Submissions by Thomas George Robertson.**

I am a registered NZ & AU patent and trade mark attorney representing predominately clients in NZ and Australia, however I do represent other international clients.

I am currently employed with Pipers Patent and Trade Mark Attorneys (Pipers) and have been employed with Pipers since 2002. Prior to that I worked at IPONZ from 1986 to 2002 as a Patent Examiner and as a Trade Mark Examiner.

I provide the following submissions in an individual capacity only and I am not making these submissions on behalf of Pipers. The views and opinions raised in the following submissions are purely my own and in no way reflect or are to be taken as views or opinions of that of Pipers.

### **Submissions**

#### **Patents**

##### **Answer to Q P1**

No.

The reasons given by MBIE are overstated and not supported by any actual facts. The reasons put forward by MBIE are speculative. The option proposed by MBIE would ultimately be unjust and unfair to Applicants lodging divisional applications for inventions that are derived out of an original patent filed under the 1953 Act. Since the 2013 Act came into force I have not been made aware from any of my clients or other third parties of any concerns or instances in relation to divisional applications derived from a Patent filed under the 1953 Patent Act being considered under the provisions of the 1953 Act and not the 2013 Act.

The current transitional provisions are fit for purpose and work effectively well. The current transitional provisions were devised, canvassed and considered in full prior to the implementation of the 2013 Patents Act. Since 2014 to present nothing has changed, there have been no hearings or court cases decided in which the viability and suitability of the transitional provisions have been questioned. If this had been the case, then that could be a tangible and viable reason for the change as proposed by MBIE.

Not sure how the transitional provisions can be considered an administration burden. It should not be difficult or not be a burden for an examiner to just examine for novelty for the divisional applications divided out of a Patent filed under the 1953 Act. Actually the examining of a divisional application divided out of a Patent filed under the 1953 Act should

be easier compared to that of a patent application filed under the provisions of the 2014 Act. This is because with the former the examiner only has to consider novelty, whereas for the latter the examiner has to consider both novelty and inventive step. With the former the examiner is not tasked with an extra task to consider, but has one less task. The examiners should be able to easily discern what tests are applicable to a particular patent application that they are about to examine.

The proposal by MBIE to change the transitional provisions would place an undue burden on Applicants for divisional applications derived out of a Patent filed under the 1953 Act. The content of a divisional application derived out of a Patent filed under the 1953 Act has to be of the same scope as that content to which was disclosed in the original disclosure of the Patent filed under the 1953 Act. The disclosure of Patents filed under the 1953 Act were drafted and prepared at the time the 1953 Patents Act was in force, and this includes the disclosure of those divisional applications filed after 2014 and were derived from a Patent that was filed under the 1953 Act. The subject matter of such a divisional application was not prepared to comply with the 2014 Act, it was prepared to comply with the 1953 Act.

What MBIE is proposing is effectively a retrospective provision. The application of provisions of the 2013 Act on matter that was effectively lodged under the provisions of the previous 1953 Act is not in the interest of natural justice as it places unfair burden and disadvantages an Applicant who originally lodged the subject matter from a Patent filed under the 1953 Act to which the divisional application pertains to.

The patent process is there to serve the public not the convenience of IPONZ/MBIE.

So I recommend that there be no change to the transitional provisions of the 2013 Act (the status quo).

#### Answer to Q P2

No.

The apparent problems have been overstated and have not been supported by real substantive facts as no actual evidence was provided to satisfactorily establish there being a problem. No actual instances of the problem existing and being raised by users of patents or by the Courts. In the 33 years of working in the field of patents, firstly as a patent examiner and then as a Patent Attorney, has any member of the public raised a problem with daisy chaining of divisional applications and nor in that time I am aware of any NZ hearings or court decisions on the issue of daisy chaining of divisional applications. Both Australia and the USA allow for daisy chaining of divisional applications.

The subject matter and likely scope of the invention to be claimed for any patent application whether it be a divisional or not can be ascertained once the patent application is published, namely 18 months after the earliest filing date. In respect of divisional applications, by the time they are filed the patent application to which the divisional applications are originally derived from would have already been published. So from that time onwards the subject matter and likely scope of any inventions would be publically available to any interested

party, such as a competitor. So it is possible from reading of the subject matter of the patent application to which the divisional applications are originally derived from to determine what the likely scope of any invention that could be in a divisional application. Third parties do not need to wait till a divisional application is granted to ascertain what the likely scope of an invention pertaining to the divisional is. That information would already have been in the public domain since the publication of the original patent from which the divisional application is derived from.

MBIE has stated that they have “not identified any significant benefits to the New Zealand economy from permitting daisy-chaining of divisional patent applications”. MBIE would seem to have overlooked one of the main tenants and benefits of the patent system, which is by giving an inventor a monopoly for their invention in return of the inventor making the invention public fosters and encourages further inventive endeavor. Also by allowing inventors to obtain patents for all their inventions is likely to lead commercialization, investment and economic benefit of those inventions, which would not likely be the case or at least be of the same extent if patents to those inventions were not patented.

“Daisy chaining” allows inventors to obtain patents to all their inventions that were disclosed in the original patent specification from which the divisional applications are derived from.

#### Answer to Q P3

No

MBIE in para 92 of the discussion paper states in sub para (iii) that “*Give applicants an opportunity to obtain patent rights for any or all of the inventions disclosed in their patent applications if that is what they wish. (emphasis added)* and then stated that “*Factor (iii) above is effectively what is required by our obligations under Article 4G of the Paris Convention*”.

Option (iii) as preferred by MBIE would not meet the requirements of the obligations under Article 4G of the Paris Convention because it would severely restrict or prevent the Applicants an opportunity to obtain patent rights to all of their patent rights in their patent applications. Patent applications under Article 4G of the Paris Convention are open to all types of patent applications, including divisional applications, they are not limited to just the earliest or original patent application lodged, but includes those patent applications that are subsequently divided out of an earlier application, whether that be an original patent application or an earlier divisional application.

The status quo should remain.

#### Answer to Q P4

No.

Each divisional should be allowed the same time as for any other patent application. This is

because Applicants should have a reasonable time to address any issues (such as novelty or inventive step) raised in an examination report for a divisional application. If the time is set to the 12 month deadline set for the original patent application there would in most cases insufficient time in which to respond to substantive issues raised in the examination report for a divisional application. In the majority of cases divisional applications are filed toward the end of time limit set for the original applications from which the divisional application is divided out of.

Currently any patent application has to have an examination request lodged within five years from the filing date that the complete specification was filed. In respect of divisional applications the five year request for examination deadline is linked to the date to which the complete specification was filed for the parent patent application from which the divisional application. Failure to request examination within the five year time limit results in the patent application not been able to proceed to grant. Thus it would not be possible to obtain a patent to a divisional applications if the divisional application is filed after five years from the filing date of the complete specification of the parent patent application. Any divisional applications would have to be filed within five years of filing date of the complete specification of the parent patent application if the Applicant wants a patent granted..

The current 2013 Act has sufficient time restraints for divisional applications, such as that any divisional applications has to be placed in order for acceptance within 12 months of an examination report being issued and that in order to obtain a patent all divisional applications have to be in effect filed within 5 years of the filing date of the complete specification of original patent application from which the divisional patent applications are divided out of.

The status quo should remain.

#### Answer to Q P5

Yes, I agree that the apparent anomaly as to what happens to a patent application if a request for examination is not filed within five years of the filing date of the complete specification should be addressed. I agree that if a request for examination is not lodged within the five year timeframe, then the application should be deemed to be abandoned upon expiry of the five year deadline.

However, I do not agree that divisionals to be only filed from an original parent application and requiring all such divisionals to be in order for acceptance by the 'in order for acceptance' deadline that applies to the parent application. My reason for not agreeing to has already been canvased in my answer to Q4 above which is referred to. The current 2013 Act already has sufficient time restraints for filing and examination of divisional applications

I have no problem of having a requirement that when a divisional application is filed that the request for examination should also be filed or be filed with two or three months of the divisional application been filed.

#### Answer to Q P6

Yes.

Answer to Q P7

Yes.

Answer to Q P8

Yes.

Answer to Q P9

I prefer neither option.

Once a hearing has been requested the Applicant has no effective control over the time as to when the hearing is completed and a decision issued. As such when a hearing has been requested the “clock should stop” for the Application till after the hearing decision is issued. The Applicant should not have to request an extension of time for an Application whilst it is in the hearing stage. Whilst waiting for the outcome of a hearing the Application should be held in abeyance and then once the outcome of the hearing is determined the “clock” is restarted if required to attend to a matter or matters as determined by the hearing so that the Applicant is allowed to use any remaining time that was still available at the time the hearing was requested or a prescribed period of time if there was no time available at the time the hearing was requested or less than one month (or other suitable time) time left at the time the hearing request was requested.

Having to request an extension of time or to request the Commissioner use their discretion to extend the time when a hearing is requested is an unnecessary compliance cost for the Applicant and waste of time for both the Applicant and IPONZ, especially when the whole process can be automated by just placing the application in abeyance pending hearing outcome.

Answer to Q P10

Yes.

Answer to Q P11?

No.

Answer to Q P12

Yes.

Answer to Q P13

Yes

Answer to Q P14

Yes to the Act providing for international exhaustion.

No there would not be any disadvantages in providing for international exhaustion.

Answer to Q P15

No as would seem to now been an unnecessary requirement that has never been used, as I am not aware of the Attorney General intervening before.

Answer to Q P16

Not applicable re answer to P15

Answer to Q P17

Yes.

Answer to Q P18

Yes.

**Trade Marks**

Answer to Q T1

No.

Answer to Q T2

No.

The status quo should remain. Series trade marks provide a useful way of registering trade marks that only vary in formatting and that are not different in scope. This serves both the Applicant and the public well as the registration readily identifies the series of marks to which the Applicant seeks registration for. The current Act is sufficient along with case law as to what can and cannot be constituted as a series.

Answer to Q T3

Yes.

Answer to Q T4

Yes. However guidance as to what constitutes “clear” and “clear to whom” needs to be provided.

Answer to Q T5

No.

IPONZ pick list and even the Nice Classification Index are not a complete list of every type of good or service. Limiting use to the IPONZ pick list could lead to Applicants ultimately not obtaining TM registration for goods and services to which they are entitled because those goods and services were not on the pick list.

Answer to Q T6

I agree that option (iii) should be considered as long as there are clear guidelines as to what meets the requirements outlined in this option.

Answer to Q T7

No impact is expected if option (iii) is adopted.

Answer to Q T8

Yes.

Answer to Q T9

Yes.

Answer to Q T9 – second instance

Yes reference to “aggrieved” should be removed

Answer to Q T10

Yes.

Since the registered rights associated with a NZ trade mark registration and a NZ designation of an IRDNZ are the same, then the same standards should apply to both during the examination stage. Why should a NZ national trade mark application be disadvantaged over a NZ designation during examination?

Answer to Q T11

Yes.

Answer to Q T12

No.

Answer to Q T13

Not applicable in light of answer to Q T12

**Designs**

Answer to Q D1

Yes.

Answer to Q D2

Yes.

Answer to Q D3

Yes.

Answer to Q D4

Yes.

Answer to Q D5

Yes.

Answer to Q D6

Yes.

Answer to Q D7

Yes.

## Artificial Intelligence

### Answer to Q A1

IPONZ should not delegate power to an AI system. An AI system should be used as a guide only and the delegation of power remain in the hands of a person.

### Answer to Q A2

No-one as the decision should always remain in the hands of a person.

### Answer to Q A3

Yes.

End of Submissions

Kind Regards



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