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Dear Ms Bailey

NZIPA submissions on the Intellectual Property Laws Amendment Bill 2017 (the Bill)

Introduction

These submissions have been prepared by the New Zealand Institute of Patent Attorneys Inc. (NZIPA). The NZIPA was established in 1912. It is an incorporated body representing most Patent Attorneys registered under the New Zealand Patents Act, and who are resident and practising in New Zealand. Many of our patent attorneys are also registered in Australia.

The current membership of NZIPA comprises 152 Fellows, 2 Honorary, 60 Students, 18 Non-resident, 14 Associates and 7 Retired. The membership comprises virtually the whole of the senior professional staff of all of the firms of registered patent attorneys practising in New Zealand comprising more than one partner, plus most of the registered patent attorneys who practice as sole practitioners. In addition a number of our Fellows are partners or senior staff solicitors in the intellectual property law sections of some major law firms in New Zealand.

Part 2 – Examination, re-examination and reconsideration – items 68-120

Item 99 substitutes a new subsection 101K(3) stating that ‘if an opposition ... to an innovation patent is pending, the Commissioner must not re-examine the complete specification relating to the patent’.

The draft explanatory memorandum acknowledges that complexities arise if there is an opposition pending and re-examination is requested for the same patent. The new subsection prevents the Commissioner from re-examining the innovation patent for the reason that it is most efficient to complete the opposition first.

The memorandum states that a similar provision is not necessary for standard patents because the Commissioner has the discretion whether to re-examine an accepted specification and would not do so if an opposition is pending.

There is no explanation as to why the Commissioner cannot be allowed to exercise discretion whether to re-examine an innovation patent in the same way the Commissioner is allowed discretion whether to re-examine a standard patent.

While it is acknowledged that, in almost all cases, the Commissioner would not re-examine an innovation patent if an opposition is pending, it is possible there will be some circumstances in which this is desirable and doing so might be preferable to all parties.

A stated purpose of the Bill is to improve and streamline the administration of the Australian IP system to reduce regulatory costs and better meet the needs of businesses dealing with the system. In the absence of compelling reasons to the contrary, creating an arbitrary distinction between the treatment of innovation patents and standard patents does not appear to satisfy this stated purpose of the Bill.

NZIPA believes that innovation patents should be treated the same as standard patents in this case.

Part 3 – Extensions of time and protection of third parties – items 121-172

Item 143 introduces new provisions for extension of time for patents. New section 223B provides a streamlined process for situations where the extension period sought is three months or less. New section 223C inserts provisions for extensions of more than three months.

In 2015 the NZIPA made submissions in response to a consultation paper on Proposals to Streamline IP Processes and Support Small Business. The consultation paper set out various options in relation to alignment and complexity, balancing the interests of all parties, and administrative burden.

In the earlier NZIPA submission we agreed with a proposal to limit the ‘error or omission by applicant/owner’ extension to 12 months. Following wider consultation we do not agree that this option should be adopted. The very nature of an error or omission means that it might not come to light for a considerable period of time after the error or omission has occurred. This means that the question of whether or not an extension of time was available could depend solely on whether or not the error or omission was discovered within twelve months.

The Bill seeks to impose a two month deadline on requests for extensions. To the extent that a two month deadline must be imposed at all, NZIPA supports the proposal that this deadline extend from either when the applicant becomes aware of the error or omission, or from when the circumstances that prevented the relevant act from being done within the certain time cease to exist.

Part 9 – Computerised decision-making – items 386-397

Item 387 introduces into the Designs Act 2003 new section 135A to enable the Registrar of Designs to use computer programs for any purposes for which the Registrar may, or must, make a decision, exercise a power or comply with an obligation, or do anything else related to these.

Proposed subsection 135A(4) states that the Registrar may substitute a decision for a computerised decision if the Registrar is satisfied that the decision made by the operation of the computer program is incorrect.

The wording suggests that the Registrar has a discretion whether or not to correct a decision made by the operation of the computer program that the Registrar knows is incorrect. NZIPA does not agree with this proposal. NZIPA believes that the Registrar **must** correct a computerised decision that is incorrect.

It is assumed that computerised decision-making is intended to primarily benefit IP Australia. In doing so there is the potential to increase regulatory costs to applicants if they are required to take steps to deal with a computerised decision that is incorrect. The onus to correct such decisions should lie with the Registrar who should not be given a discretion.

Similar observations apply to computerised decision-making in relation to the Patents Act 1990, the Plant Breeder's Rights Act 1994, and the Trade Marks Act 1995.

Part 12 – Requirements for patent documents – items 420-434

Item 420 replaces subsections 29(3) and 29(4) and inserts new subsections 29(4A) and 29(4B). The stated intention is to enable the Commissioner to ensure that formalities requirements are in line with changing technologies and Australia's international obligations.

New subsection 29(4A)(d) requires a patent request in relation to a complete specification to comply with the formalities requirements determined in an instrument under section 229. New subsection 29(4B)(c) imposes the same requirement on the complete specification.

The situation is unclear in situations where there is no instrument created under section 229. NZIPA believes the language in each of the subsections should be amended from 'comply with the formalities requirements ...' to 'comply with any formalities requirements ...'.

Part 19 - Publishing personal information of registered patent or trade marks attorneys – items 505-509

Item 506 inserts new section 227B related to disclosure and publication of personal information of patent attorneys. The new section ensures that the Board can publish specified information about registered patent attorneys even where the patent attorney does not provide consent for publication of personal details.

The stated intention of the amendment is to enable the public to readily verify that a patent attorney is registered to practice in Australia or New Zealand. The amendments reduce the risk of businesses using unqualified people to prosecute their intellectual property rights who are not registered to practice as intellectual property attorneys in Australia or New Zealand.

The new section states that the Board may publish any or all of the following:

- the name of the attorney
- the State or Territory in which the attorneys work address is located
- the attorney's work email address.

New Zealand addresses do not include either State or Territory. The locations of patent attorneys in New Zealand are typically referred to by city. In the interests of establishing a trans-Tasman patent

attorney register, rather than simply an Australian one, NZIPA suggests amendment to enable the Board to also publish city and country.

Item 505 inserts new section 183(1A) into the Patents Act 1990 to enable the Designated Manager to disclose to the Board personal information about a registered patent attorney that the Designated Manager considers to be relevant to the Board's functions. **Item 229** inserts new section 229AA into the Trade Marks Act 1995 to enable the Designated Manager to disclose to the Board personal information about a registered trade marks attorney that the Designated Manager considers to be relevant to the Board's functions.

NZIPA is concerned about the amount of discretion given to the Designated Manager over what type of personal information is considered to be relevant. Furthermore, NZIPA is also concerned that the individual affected has no input or notice of what personal information is to be provided. The individual affected has no option to object before information is provided to the Board.

Yours faithfully,



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