

HEARINGS TECHNICAL FOCUS GROUP

30 April 2019

10.30am-12.00pm

MBIE Building, 15 Stout Street

Room G.07

Present

Steffen Gazley (IPONZ), Matthew Currie (IPONZ), Nigel Robb (IPONZ), Monique Cardy (IPONZ), John Landells (IPTA), Nick Holmes (IPTA), Jason Wach (James & Wells), Richard Watts (Simpson Grierson), Dan Winfield (Duncan Cotterill), Sheana Wheeldon (NZLS), Elena Szentivanyi (NZIPA), Greg Arthur (NZLS)

Invitees for this meeting

Warren Hassett (MBIE Business Law)

Apologies

Andrew Brown (QC), Clive Elliot (QC), Gary Williams (Barrister), Ian Finch (James & Wells), Kate McHaffie (AJ Park), Thomas Huthwaite (Baldwins), Marcus Caulfield (IPTA)

Minutes

The 2 October 2018 Minutes were agreed.

Actions from previous meeting

No.	Action	Comment
1.	Draft proposed content for Hearings Office letters advising of mediation as an option and mediation web content, for further review by HTFG members.	Item 8
2.	Length of submissions – Hearings Office to look at Court of Appeal requirements, and discuss further with Assistant Commissioners.	Item 5
3.	Amended costs schedules to be	Complete and uploaded to website.

	implemented, and newsletter sent to clients.	Circulate newsletter to clients.
4.	IPONZ to draft a suggested structure for examination hearings, and look to receive feedback at the next meeting.	Item 2
5.	Update draft Amendment Guidelines for patent proceedings, and recirculate for final comments / approval.	Amendment has been updated and will be sent to members for final comments shortly, before being uploaded to the IPONZ website.
6.	Patent re-examination and public interest decisions to be considered further and discussed with MBIE policy.	Item 6
7.	IPONZ to liaise with MBIE policy regarding amendment to the Patents Regulations 2014 to allow for an extension of time to file a Statement of Case.	Item has been added to list of possible regulation updates.
8.	Trade Mark Opposition Guidelines to be updated.	Complete.
9.	IPONZ to draft a proposed practice on Māori Tikanga in IPONZ hearings, for discussion at the next meeting	Item 3
10.	Tanya Carter to contact attendees regarding possible topics / events to be organised by the IPONZ Stakeholder Engagement team	Complete
11.	Next meeting to be organised for April 2019	Complete
12.	Minutes for meeting to be circulated for approval by week ending 12.10.18	Complete

Agenda

1. Introductions

- 1.1. Pleasantries were exchanged and the Chairperson thanked the participants for attending.

2. Hearings Office Update

- 2.1.** A Hearings Office update was provided which included:
 - 2.1.1.** Steffen Gazley started as Hearings Manager in November 2018.
 - 2.1.2.** Nigel Robb started as Principal Hearings Case Officer in February 2019.
 - 2.1.3.** Heidi Benson finished their role at the end of 2018.
 - 2.1.4.** Pip Gray will soon begin a six month secondment.
 - 2.1.5.** New Case Officers will join IPONZ from mid-May.
 - 2.1.6.** Commissioner Ross van der Schyff is on a secondment. In Ross' absence, Rob Rendle is acting General Manager for Business Integrity Services.
 - 2.1.7.** Simon Gallagher will continue as acting National Manager.
 - 2.1.8.** Rebecca James will continue as acting Trade Marks Manager.
 - 2.1.9.** Assistant Commissioner ("AC") resourcing and recruitment is underway.
 - 2.1.10.** AC Glover finished in April 2019 and AC Casey has completed all of her remaining cases. There are now two ACs, Natasha Alley and Wendy Aldred.
 - 2.1.11.** Due to resignations and the increasing number of filings and proceedings, IPONZ is reviewing the current AC model, including investigating whether ACs could be employed "in house". The aim is to advertise for this role in May/June.
 - 2.1.12.** It is intended that the average timeframe to have hearing heard will decrease from 5-6 months to 4 months. The hearings team is in the process of reviewing the hearings scheduling system in an attempt to streamline the current process. The scheduled system enhancements will allow for hearings to be scheduled more effectively, via the electronic IPONZ case management facility.

Hearings Procedures

3.

- 3.1.** The Chairperson provided the following hearings procedure updated to the meeting:
 - 3.1.1.** Māori Tikanga: anticipate a guideline will be presented at the next TFG. In the meantime, any request to incorporate Māori Tikanga at a hearing, can be accommodated. However, the Hearings Office should be notified in advance.
 - 3.1.2.** Due to availability of Assistant Commissioners, all hearings will need to be held in Wellington.
 - 3.1.3.** It is intended that video conferencing ("**VC**") will be utilised at hearings. The introduction of new video conferencing software means parties no longer have to be at MBIE premises in order to attend a hearing via VC. The Hearings Office will be trialling the new software shortly. Depending on the success of those trials, it is proposed new guidelines for this process will be presented at the next TFG. VC may become the default means to hear interlocutory and single

party hearings and an option for parties to attend a hearing, who are not based in Wellington.

4. Policy update

4.1. Warren Hassett from the MBIE Policy Department provided the following updates:

- 4.1.1.** The Regulatory Systems Bill includes amendments to IP Statutes and is now before the Select Committee.
- 4.1.2.** The IP Amendment Bill is with the Minister for lodgement with Cabinet. If approved, the consultation document will be released in May.

5. Proposed Practice Updates

5.1. Nigel Robb noted an update of the pre-hearing directions guideline is being proposed.

- 5.1.1.** Introducing directions on the length and format of submissions; and
- 5.1.2.** Introducing directions for the compilation of the common bundle of documents and decisions, as well as it being the parties responsibility for filing hard copies for the Assistant Commissioner prior to a hearing; and
- 5.1.3.** Requiring any evidential or pleadings issues to be clearly identified in a party's synopsis of submissions before a hearing.

5.2. It was noted the volume and relevance of evidence being filed is a continuing challenge for the Assistant Commissioners and the hearings office.

- 5.2.1.** The length of submissions was discussed and 20 pages considered by the members to be too short and may result in submissions with extensive footnotes or schedules being filed to circumvent any limitations.
- 5.2.2.** The consequence of not meeting the guideline requirements was also raised by members. The hearings office recognised that the proposed guidelines were not binding, unlike in the UK. The hearings office has an expectation that they will be complied with and if they do they resolve the issue additional options, such as reviewing the regulations would be considered.
- 5.2.3.** The timing of pleadings and evidential issues being raised was discussed and the hearings office will review what is said in its standard letters. The aim being that the parties and the Assistant Commissioners will have notice of there being an issue. It was noted that the Assistant Commissioner's do not have a hard copy of the frequently cited cases at the hearings and it would be useful if they did.

5.3. The hearings office is also investigating whether hearings should run fully electronically, similar to the electronic case books used at the Courts.

6. Patent re-examination and public interest decisions

6.1. The Hearings Office is looking at how the public interest is addressed in patent oppositions where the opponent withdraws the opposition. Traditionally the opposition has proceeded to a determination.

6.2. It is proposed that re-examination would address the public interest when an opposition is withdrawn. This would have the advantage for the patentee not having to wait for a hearing and then for a decision to be issued by an AC.

6.3. The Hearings Office will continue to consult the Patent Examination Team and MBIE Business Law Team with the view to present a draft proposal on how re-examination could work (under both 1953 and 2013 Acts) at the next TFG. In particular any regulatory impediments would be considered.

7. Date of revocation in trade mark non-use proceedings

7.1. Nigel Robb provided a brief update on recent ZIPLOC Court of Appeal decision. The Hearings Office had been notified that leave to appeal the decision has been submitted to the Supreme Court and were awaiting the outcome of this before drafting guidelines.

7.2. It was noted the pleadings in revocation for non-use applications can raise some issues in non-contested cases. The Hearings Office hopes to be in a position to provide an update at the next TFG.

8. Mediation

8.1. The Chairperson provided an update regarding the recent visit of Mr Eric Wilbers, Director of the WIPO Arbitration and Mediation Centre, for the WIPO Roving Seminars in Auckland, Wellington and Christchurch.

8.2. IPONZ will be investigating whether we can work more closely with WIPO in promoting ADR (“Alternate Dispute Resolution”) such as mediation. It is anticipated that IPONZ will have some website updates and small letter changes promoting mediation as an option for parties to consider and mediation ADR will continue to be a topic of discussion at future hearings technical focus groups.

8.3. The Chairperson said that IPONZ will liaise with other Intellectual Property Offices, where this service is currently offered, to understand their experiences and benefits this has provided.

9. Any other business

9.1. The Chairperson updated the meeting that IPONZ were in the process of updating their business objectives, one of which is that 80% of decisions will be issued within 30 days. IPONZ are considering updating the measure to a median time of 30 days, which would allow simple decisions to be dealt with more quickly and prevent more complex decisions from being delayed.

9.1.1. The meeting noted that further consideration of the most suitable measure was required.

9.2. A review of Hearing Case Officer duties, roles and processes is also being conducted to ensure that their time is being used most effectively.

10. Next meeting

10.1. It was agreed that the next meeting be scheduled for 16 October 2019.

Actions for the next meeting

No.	Action	Responsible
1.	Guideline to how Māori Tikanga can be incorporated into hearings to be presented at the next TFG.	IPONZ
2.	Depending on the outcome of VC trials, guidelines for facility to be presented at next TFG.	IPONZ
3.	Guidance to be released on reducing the volume of evidence submitted including a recommended maximum	IPONZ
4.	IPONZ to continue work with the Patent Examination Team and MBIE Business Law to present a draft proposal on the process of re-examination, with a view to present the draft at the next TFG.	IPONZ
5.	Date of revocation in trade mark non-use proceedings guidelines to be drafted and released	IPONZ
6.	IPONZ to liaise with other Intellectual Property Offices, currently utilising ADR/Mediation	IPONZ