

## Hearings Office Technical Focus Group (“TFG”) Meeting Minutes

<b>Date/Time:</b>	Wednesday, 5 May 2022, 10.30 – 11.30am
<b>Location:</b>	Ministry of Business, Innovation and Employment (“MBIE”) 15 Stout Street, Wellington Central, Wellington 6011 <b>Room G.15</b>

### Participants

MBIE / Intellectual Property Office of New Zealand (“IPONZ”)	Other
Samantha Carr, Senior Hearings Case Officer	Elena Szentivanyi, NZIPA
Gaby Cowcill, Hearings Office Manager	Ian Finch, James & Wells
Virginia Nichols, Assistant Commissioner	Greg Arthur, New Zealand Law Society
Julia Maclean, Associate Hearings Case Officer	Marcus Caulfield, FB Rice
Steffen Gazley, Manager – International Programme	Jenni Rutter, Dentons Kensington Swan
George Wardle, Senior Policy Advisor	Thomas Huthwaite, AJ Park
Natasha Storey, IPONZ Team Coordinator	Gary Williams, Richmond Chambers
	Aparna Watal, Baker McKenzie
	Nick Holmes, Davies Collison Cave

### Agenda

Topic		Speaker
Welcome		<i>Gaby Cowcill</i>
Review of Previous Meeting Action Points		<i>Gaby Cowcill</i>
Owner	Action	Status
IPONZ	Provide scheduling and decision data at TFG	Done
Members	Feedback on any useful information to include on the Facts and Figures website.	No feedback received; closed as an action, however IPONZ remains

		receptive to feedback.
Members	Feedback on idea to prioritise simple cases to improve pendency. There was some further discussion of this in the meeting, however no clear consensus was reached.	Closed; IPONZ will monitor pendency & revisit if require.
Members	Feedback on Patent Proceedings page limits	No feedback received; closed.
<b>IPONZ Update</b>		<b>Gaby Cowcill</b>
<p>Hearings information was sent out with the agenda, headlines included:</p> <ul style="list-style-type: none"> <li>- We have recently made 5 permanent appointments in the Hearings team, including 4 Assistant Commissioners; we have some vacancies remaining.</li> <li>- 51 cases awaiting a hearing (29 Trade Mark cases, 22 Patent cases)</li> <li>- Median time for a hearing to be scheduled: 9 months</li> <li>- Median time to issue a decision after a hearing: 33 working days.</li> </ul> <p>At the meeting, Gaby confirmed the newly-appointed Assistant Commissioners: Ruvini Rendle, Virginia Nichols, Warren Coles &amp; Simon Reeve.</p> <p>For one of the vacancies, this may be offered as a 6-month secondment opportunity into a Principal Hearings Case Officer role at IPONZ – please get in touch with Gaby with any expressions of interest.</p>		
<b>MBIE Policy Team Update</b>		<b>George Wardle, MBIE</b>
<p><u>Free trade negotiations</u></p> <p>NZ-UK FTA signed in March 2022. It contains a number of intellectual property commitments including:</p> <ul style="list-style-type: none"> <li>• 20-year copyright term extension within 15 years of the agreement entering into force.</li> <li>• Small expansion of performer’s property rights in sound recordings under section 174B of the Copyright Act 1994 requiring their consent to play sound recording in public.</li> <li>• Implementation of an artist’s resale rights regime (being led by the Ministry of Culture and Heritage).</li> <li>• Reasonable efforts to join the <i>Hague Agreement Concerning the International Registration of Industrial Designs</i>.</li> </ul> <p>Negotiations on the EU-NZ FTA are continuing with the aim of reaching substantial political conclusion by end of June 2022.</p> <p><u>Copyright Act review</u></p> <p>Remains paused for the time being. No timeframe for a decision on when work on the review would recommence.</p> <p><u>IP Laws Amendment Bill</u></p>		

Not a priority for the Minister of Commerce and Consumer Affairs to progress this Parliamentary term. We are investigating whether any of the amendments in the Bill might instead be able to be progressed through a Regulatory Systems Improvement Bill.

Members voiced their significant concern and dissatisfaction with the delay in progressing the IP Laws Amendments Bill.

**Extensions of Time on Patent Proceedings**

*Ian Finch, JAWS*

Members' comments were sought on an observation that extensions of time in relation to patent proceedings under the 2013 Act are being granted without any justification for the inability to meeting the initial statutorily defined deadline, and an understanding that this may not have been the intention of the legislative change from the 1953 Act.

In particular, a concern that opponents are receiving the statutory 3 months from publication + 1 month extension (without the applicant's consent) to file a notice of opposition, without any justification as to why the deadline can't be met. The Office's approach appears too lenient.

Members generally spoke in support of this observation, suggesting that whilst extensions may be commonly needed when proceedings reach the counterstatement and evidence phases, a full and frank disclosure of why an extension is needed should be provided. Overall, the threshold for obtaining an extension should be higher.

IPONZ sought clarification that the relevant provisions being discussed were regulations 93 and 161, and the basis for requiring reasons or justification. This was suggested as the 'may' in regulation 93 and threshold of 'reasonable' in reg 161.

The meeting agreed an **action on IPONZ** to review the current published guidelines and any changes which may be needed to request a full and frank disclosure from applicants, and so provide sufficient justification for an extension. Ian kindly agreed to assist with this.

**Visibility of Patent Proceedings**

*Gaby Cowcill,  
IPONZ / NZLS*

This was previously discussed in May 2021, with the proposal that from a specified date the Hearings Office will default to setting all future documents as open to public inspection unless Counsel label information as confidential, in the same way as Trade Mark proceedings, and will review previously submitted documents before opening them up to public inspection.

Implementation has been delayed because IPONZ identified a further risk around copyright, for example where journal articles are provided.

IPONZ sought feedback on continuing to work on this issue (noting that it requires resource allocation), on a proposed solution that copyright material be provided as a separate document, and the comfort level of shifting the burden of identifying confidential material onto those providing the documents.

Members were in favour of continuing to allocate resource to this issue, noting that the current alternative (requesting documents under OIA) sometimes added to delays and extensions of time in hearings cases.

Members felt that labelling copyrighted material as 'confidential' would be a mis-description, and that splitting PDFs or separating out copyrighted material was undesirable as it may be burdensome to the profession. Members brought attention to sections 59 and 61 of the Copyright Act which may exempt IPONZ in this regard.

IPONZ also noted that it could review requests to make specific documents OPI on a case-by-case upon request, without needing an OIA.

The meeting agreed an **action on IPONZ** to continue to seek resolution of this issue in the general case.

<p><b>Electronic Documents at Hearings</b></p>	<p><i>Elena Szentivanyi, NZIPA</i></p>
<p>Members' comments were sought on an observation that requests for printed copies of hearing documentation (submissions, evidence, and case bundles) were still frequently received, when Office guidelines require parties to submit all documentation electronically (bookmarked and paginated).</p> <p>IPONZ confirmed that this largely came down to Assistant Commissioner's preferences, but that printed documents were the exception rather than the rule. IPONZ also noted the variation in quality of electronic documents received, and that is also time consuming for ACs to bookmark the documents if not done properly. A shift to a fully electronic process means ACs may need to send back documents which are not of appropriate quality.</p> <p>After some discussion, members agreed an <b>action on IPONZ</b> to review current electronic document requirements, noting that higher standards may need to be enforced to encourage a shift towards using electronic documents. As an interim measure, IPONZ will also allow double-sided printing.</p>	
<p><b>Confidentiality Guidelines</b></p>	<p><i>Greg Arthur, QC NZLS</i></p>
<p>Member's comments were sought on proposed amendments to the Office's Confidential Evidence guidelines, brought by the NZLS IP Committee. The purpose of the amendments was to facilitate quicker resolution over classification of evidence as confidential (noting that it would not be classified so in court).</p> <p>Members generally spoke in agreement with the proposed amendments. IPONZ queried the rationale behind including justification for confidentiality in the non-confidential evidence, and noted it might be more suitable for this to be in the cover letter. With this minor alteration, the proposal generally found agreement amongst the membership.</p> <p>Gaby noted she would need to check that this addressed feedback from ACs, but otherwise the meeting agreed an <b>action on IPONZ</b> to update the published guidelines including the amendments.</p>	
<p><b>Evidence Information Sheet</b></p>	<p><i>Sam Carr, IPONZ</i></p>
<p>In response to observing an increase in inadmissible evidence, IPONZ had prepared an evidence information sheet on which members' feedback was sought.</p> <p>This is a short form version of the information available online. This was drafted for private applicants who are representing themselves in proceedings, and for attorneys who may not be familiar with issues pertaining to evidence.</p> <p>Members generally supported the initiative, but queried the absolute stance taken on evidence and evidence-in-reply not being considered in advance of the substantive Hearing. Members noted that there may be exceptional circumstances which require this to be dealt with prior to the substantive hearing.</p> <p>The meeting noted an <b>action on IPONZ</b> to amend the Information Sheet to reflect and provide flexibility for cases with exceptional circumstances, but otherwise supported IPONZ in this initiative.</p>	
<p><b>Any Other Business</b></p>	<p><i>Gaby Cowcill</i></p>

### Non-represented litigants

Elena raised a query on whether IPONZ gave preferential treatment to private litigants, giving a recent example involving IPONZ allowing amended pleadings multiple times.

IPONZ confirmed that the same requirements and expectations apply to all customers, but noted that it may offer additional support to non-represented litigants. The meeting discussed some alternative options such as an optional form to help non-represented litigants provide the required information, similar to IP Australia's approach, or a link to an example of the documentation needing to be supplied (real or mock-up).

IPONZ requested more time to consider this feedback, and come back to members with some proposals next meeting.

### Date for next 2022 TFG meeting

Members expressed a preference for 3 meetings per year. The date of the next meeting was agreed as Thursday 1<sup>st</sup> September.

### Summary of Action Points

Owner	Action	Status
IPONZ	Review the current published guidelines on patent extensions of time, with a view to raising the threshold of justification needed to obtain such extensions.	
IPONZ	Continue work on making patent proceedings documents open for public inspection.	
IPONZ	Encourage use of electronic bundles; review current electronic document requirements for any changes needed to ensure ACs receive high-quality electronic documents.  Where printing is necessary in the interim, allow double-sided printing.	
Gaby/IPONZ	Check the amended proposals to the Confidential Evidence guidelines satisfies AC's feedback; publish the amended guidelines.	
Sam/IPONZ	Amend the Evidence Information Sheet to provide flexibility for cases with exceptional circumstances, before adopting initiative.	
IPONZ	Consider how best to manage unrepresented litigants to address the perception of preferential treatment.	

### Close of Meeting