

# MINUTES

<b>Title</b>	Hearings Office Technical Focus Group Meeting (“TFG”)
<b>Date/Time</b>	Wednesday 16 October 2019, 10.30am – 1.00pm
<b>Location</b>	Ministry of Business, Innovation and Employment (“MBIE”) 15 Stout Street, Wellington
<b>Room</b>	G16
<b>Apologies</b>	

## Participants

<b>MBIE / IPONZ</b>	<b>Other</b>
Steffen Gazley (IPONZ - Chair) Nigel Robb (IPONZ) Matt Currie (IPONZ) Samantha Carr (IPONZ) Tanya Carter (IPONZ) Cass Kinghan (IPONZ) Monique Cardy (IPONZ) Mark Luiten (IPONZ) George Wardle (MBIE Corporate Governance and Intellectual Property Policy Team)	Barbara Sullivan (Henry Hughes) Dan Winfield (Duncan Cotterill) Greg Arthur (Clifton Chambers) Ian Finch (James and Wells) John Landells (FB Rice) Marcus Caulfield (FB Rice) Sheana Wheeldon (Quay Chambers) Thomas Huthwaite (Baldwins) Gary Williams (Richmond Chambers)
<b>Attendance by Video Conference</b>	<b>Attendance by Teleconference</b>
n/a	Elena Szentivanyi (Henry Hughes) Richard Watts (Simpson Grierson) Nick Holmes (IPTA) Andrew Brown (QC) Kate McHaffie (AJ Park)

**Wednesday 16 October 2019**

Time	TOPIC	MBIE / IPONZ	Other
	<b>Hearings Office update (Powerpoint)</b>	Steffen Gazley	
	<ul style="list-style-type: none"> <li>• IPONZ displayed a Powerpoint presentation to the meeting, covering Hearings Office statistics, initiatives and priorities.</li> <li>• IPONZ provided an update on the recruitment for further Assistant Commissioners. Internal secondments are being used as cover until the roles are permanently filled. It is expected that the new Assistant Commissioners will start by the end of the year.</li> <li>• Members raised concerns regarding how long the recruitment process has taken and external opportunities for assistance were not being fully utilised.</li> <li>• IPONZ acknowledged the delay but advised that it was not looking externally as short term external appointments will often present a conflict which is not easy to manage. In addition permanent recruitment had commenced which would be progressed urgently.</li> <li>• Kate McHaffie raised the issue of the s 71 Patents Act 2013 time limitation. The Hearings Office recognises this is an issue and that the current work around is not ideal. This issue is under consideration in the IP Laws Amendment Bill.</li> <li>• IPONZ also provided an update on the current turnaround times for scheduling hearings and the time taken to issue a decision after the hearing. The current times are outside the Hearing’s Office business objectives and were a priority to address. IPONZ expects that once Assistant Commissioner recruitment is finalised along with proposed system enhancements we will see a steady improvement.</li> </ul>		
	<p><b>Actions:</b></p> <ul style="list-style-type: none"> <li>• IPONZ to continue to update on progress of improving the time it takes for a hearing to be held as well as the time it takes to issue a decision.</li> </ul>		
	<b>Minutes and action points of the previous meeting</b>	Steffen Gazley	
	<ul style="list-style-type: none"> <li>• The minutes from the previous TFG meeting, held on 30 April 2019 were approved by the meeting.</li> <li>• Guideline to how Māori Tikanga can be incorporated into hearings to be presented at the next TFG Complete - agenda item 4</li> <li>• Depending on the outcome of VC trials, guidelines for facility to be presented at next TFG Complete - agenda item 4</li> <li>• Guidance to be released on reducing the volume of evidence submitted including a recommended maximum Complete – live on website</li> <li>• IPONZ to continue work with the Patent Examination Team and MBIE Business Law to present a draft</li> </ul>		

proposal on the process of re-examination, with a view to present the draft at the next TFG.  
Complete – agenda item 5

- Date of revocation in trade mark non-use proceedings guidelines to be drafted and released  
On hold – appealed to Supreme Court
- IPONZ to liaise with other Intellectual Property Offices, currently utilising ADR/Mediation  
On track – agenda item 7

**Actions:**

- No actions to record.

**Hearing procedures**

[Steffen Gazley]

Attendees at hearings

- IPONZ reminded that the Hearings Office must be notified about who will be attending hearings, which is a requirement in the Pre-Hearings directions. New security measures at MBIE’s head office at Stout St, along with IPONZ Health and Safety requirements means it is not possible for a non-notified attendee to attend a hearing. The Hearings Office should be given a minimum of 48 hours’ notice of any changes or additions to ensure MBIE Stout St security can be informed.
- It is likely that any attendee who has not been notified will be refused entry and will not be able to attend the hearing.

**ACTIONS:**

- No actions to record.

**Proposed practice updates**

[Steffen Gazley/Nigel Robb]

Māori Tikanga

- IPONZ presented a guideline on the process parties to a proceeding can follow if they would like to incorporate Māori tikanga at the hearing.

Video-conferencing

- IPONZ presented a guideline to allow for the greater use of video-conferencing in hearings, which proposes making VC compulsory for examination/ex parte hearings and interlocutory hearings. This will greatly improve the timeframe for scheduling these types of hearings.
- Parties based outside of Wellington would also have the option to appear at any other hearing via video-conference.

- Elena added that it should be right of the client to appear in person, if that is their preference. IPONZ advised that there would have to be an exceptional circumstance before this was allowed.

#### Costs in uncontested proceedings

- Where a party has not taken an active step in a proceeding, an award of costs against them is unlikely to be granted. There are a range of reasons for not abandoning an application, but not defending it, in the face of an opposition. This is similar to the Australian approach. In IPONZ's view the default position is, if the case is a standard uncontested opposition, costs will not be awarded.

#### Amendments during patent proceedings (claims, pleadings or other documents)

- A rough draft of the proposed approach to dealing with amendments during the course of an opposition was presented. It is not intended that the other party can participate in the exchange between applicant and examiner, aside for the initial amendment proposal. They will also have the opportunity to seek to be heard on any decision to allow the amendment.
- The Hearings Office received some feedback on the language of the proposal. There was no consensus among the members to the proposal.
- The Hearings Office is proposing a timeframe of 20 days to allow for the applicant to address any issues from the proposed amendments, as well as 20 days for the opponent to comment on the amendment.

#### Actions:

- IPONZ to publish new guidelines for Māori tikanga at hearings, video-conferencing and costs in undefended proceedings.
- IPONZ to review the proposed guidelines relating to Amendments during patent proceedings, to discuss further at the next TFG.
- The review will consider:
  - The involvement of both parties in the process
  - Including examples of the amendment process
  - the documents that should be provided to the examiner and opponent
  - How non-statutory grounds of opposition being raised are to be dealt with.
  - Should claim amendments in an opposition be advertised?
- Further feedback from TFG members is required.

#### Patent re-examination / public interest decisions

[Nigel Robb]

- A draft flow chart depicting the intended process for dealing with abandoned oppositions was displayed to the meeting.
- The public interest, in not granting invalid patents, remains a key concern. The withdrawal of an opposition will not automatically result in the patent proceeding to grant.

- Where an opposition is withdrawn the office will consider whether to accept the application unconditionally or whether there is an issue that requires a public interest decision or re-examination.
- The Patent regulations do not address what happens when an opposition is withdrawn. There is UK authority to support the office approach.
- The public interest is being taken into account. It will be a faster way of proceeding for the patentee and avoid unnecessary hearings and associated costs.
- It was queried if the applicant should be given the opportunity to put the case forward. The current view is that they will get that chance on the re-examination process or should the case go to a public interest decision.

**Actions:**

- Hearings Office to update the hearings guideline.

**Extensions of deadlines (Nigel)**

- The Hearings Office is reviewing the leniency in granting extensions of time, and will be looking for more justification for extensions and halts. The aim is for the office to bring the current approach in line with the regulations and guidelines.
- The office will be expecting relevant tasks to be completed within the regulated time. However, it is recognised that this is not always possible.
- Parties will begin to see the office wanting more detail of the circumstances that make it reasonable to grant extensions of deadlines. It is expected the parties will provide details of, at least:
  - What steps have been taken during the regulated period to complete the task;
  - What has prevented the task being completed;
  - What needs to be done to complete the task;
  - When the task will be completed;
  - Any other relevant circumstances.
- A similar review of halt applications is being made. The Hearings Office will balance the interests of the parties, the desirability of resolving disputes without the need for a hearing, and the public interest in having matters resolved in a timely way.
- Halts will not be granted indefinitely. Detailed reasons will be required for the continuation of halts.

**Actions:**

- No actions to record.

**Alternative dispute resolution**

[Steffen Gazley]

- The Hearings Office has been in discussions with the WIPO Arbitration and Mediation Centre. Our intention is to work in conjunction with WIPO to deliver promotional content on the IPONZ website in early 2020.

**Actions:**

- No actions to record.

**Copying the other side**

[Steffen Gazley]

- Ian Finch raised that often the opposition is not notified when additional evidence is uploaded. The Hearings Office is exploring options to mitigate this problem, such as automatic notifications.
- System solution could be an appropriate mitigating measure, however, the requirement to copy in the opposition would remain due to amending this requirement requiring a regulation amendment).
- Additionally, the Hearings Office has been looking at letter template updates reminding parties of their obligations.
- The meeting expressed their preference for notifications, much like the system IP Australia currently use.

**Actions:**

- Hearings office to investigate a case management system enhancement to implement notifications when evidence is uploaded.
- The hearings office is to consider updating its precedent letters with a reminder to the parties.

**Law reform & policy update**

[Steffen Gazley]

- Regulatory Systems Bill was awaiting second reading.
- IP Law Amendment Bill
- Fees review – Patent and TM related fees update.

**Actions:**

- No actions to record.

**Any other business**

[Steffen Gazley]

- There was no other business to discuss.

**Actions:**

- No actions to record.

**Next Meeting:**

- Sheena noted that the next proposed HTFG date would clash with INTA. It was agreed that the next meeting be held in May 2020.

**Actions:**

- No actions to record.