

Hearings Office

Technical Focus Group (“TFG”) Meeting Minutes

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| Date/Time | 10.30am – 12.30pm, 21 October 2020 |
| Location | Ministry of Business, Innovation and Employment (“MBIE”) 15 Stout Street, Wellington |
| Room | G.06 |
| Apologies | John Landells, IPTA Marcus Caulfield, IPTA Clive Elliot, QC Sheana Wheeldon, NZLS |

Attendees

| Intellectual Property Office of New Zealand (“IPONZ”) | Other |
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| Steffen Gazley, Hearings Manager (chair) Cat O’Donnell, Acting Principal Hearing Case Officer Matthew Currie, Senior Hearings Case Officer Tanya Carter, Acting Stakeholder Engagement Manager Monique Cardy, Personal Assistant IPONZ (minutes) | Greg Arthur, NZLS Kate Duckworth, NZLS |
| | Video Conference |
| | Nick Holmes, IPTA Ian Finch, James & Wells Andrew Brown, QC Elena Szentivanyi, NZIPA Thomas Huthwaite, AJ Park Richard Watts, Simpson Grierson Marcus Caulfield, IPTA Garry Williams, Richmond Chambers |

| Item | Speaker |
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| Welcome | Steffen Gazley |
| Hearing Office Update | Steffen Gazley |
| <ul style="list-style-type: none"> • The meeting reviewed the actions from the previous TFG, which included the request for a schedule of upcoming hearings which had been provided to the members. The other was for Members to provide feedback on the electronic case files for hearings, which would be discussed late in the meeting. • A presentation was displayed to the meeting. It was noted that an average of 18 Trade Mark opposition cases had been filed over the last few months, which is a reduction overall. • With regards to cases waiting to be heard, the Trade Mark cases the team are making steady progress in reducing this number. There had been an increase in the number of examination hearing requests for patent applications because of the recent conclusion of the automated extension procedure. While this volume isn't expected to continue the hearings team will continue to monitor closely. • The Hearings Office have made steady progress with the number of hearings scheduled, targeting 6-8 hearings per month. It is expected that this number will continue to be sustained with increased capacity and the introduction of the automated scheduling tool. • Recruitment of a temporary Patents Hearings Case Officer is in progress and we are reviewing the possibility of hiring a Trade Marks Assistant Commissioner. • Cat O'Donnell is the acting Principal Hearings Case Officer. • It was asked how the average time to schedule a Hearing is calculated, IPONZ confirmed this was from when the evidence in reply was admitted by the Hearings Office. • The meeting discussed the current timeframes for issuing decisions, them being 5 months for a substantive decision and 2 months for other decisions, which seem excessive. It was noted that there is a target of 30 working days and the current turn-around time is expected to improve. • To further improve timeframes, it was suggested that the Hearings Office call counsel to coordinate an appropriate time for a hearings, before sending a letter. • The Hearings Office could make note of cases which can be heard at short notice, to utilise any scheduled hearing dates which become available due to cancelations. • The meeting discussed making the list of scheduled hearings available to the public. The Hearings Office intends to publish this information on its website shortly. • The members noted that when decisions are made by the Assistant Commissioner, they do not include the date of the hearing date, so we (applicant) can see the length of time taken to reach a decision. • The meeting discussed the Ziploc case and asked that the guidance be updated and circulated to the meeting. | |
| Stakeholder Engagement Update | Tanya Carter |

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| <ul style="list-style-type: none"> • A number of updates have been made to the facts and figures page of the website. The focus is more on trends, rather than specific information. Members were invited to provide Tanya with feedback on what they would like to see. • IPONZ are reviewing how we capture personal information, in light of the Privacy Act update. We will be asking our contacts what information they would like to receive from IPONZ. • It was noted that one of the major issues with contacting examiners was that examiners were unable to access their voicemails. This is an issue outside of IPONZ’s control, however, to try and mitigate this, the hearing case officers have been given work phones and their contact numbers are included in their email signatures. • The Stakeholder Engagement Team are working on the Year in Review publication. Which looks at annual stats and flagship activities, over the past year, as well as focuses for this coming year. More information will be released on this shortly. | |
| MBIE Policy IP Laws Amendment Bill | Steffen Gazley |
| <ul style="list-style-type: none"> • Cabinet has approved the policy decisions and drafting instructions are being prepared. • The Cabinet paper will be proactively released on the MBIE website in the next couple of weeks. IPONZ will let TFG members, and other stakeholders know when the paper is available. • At this stage it looks like an exposure draft will be available in March 2021, at the earliest. | |
| Practice Guidelines Updates | Cat O’Donnell |
| <p><u>Trade Mark Pre-Hearing Directions</u></p> <ul style="list-style-type: none"> • The Hearings Office provided guidelines in relation to the maximum amount of pages for submissions, for trade mark proceedings. This was to ensure the relevance of the material and avoid expending unnecessary time of parties, the office and Assistant Commissioners. • The Office received submissions exceeding 40 pages in a hearing being heard by written submissions only. The prehearing directions were unclear but intended to also apply in these cases. So the guideline amendment is to clarify regardless of being heard in person or by written submission, the page number is still 25. • The Hearings Office are considering whether a page limit for Patent submissions should also be included. Members mentioned a 50 page limit may be appropriate. • Some Members thought that 25 pages was insufficient if a number of grounds had been raised. IPONZ noted that the 25 page limit had been agreed by the TFG at its April 2019 meeting. For the vast majority of trade mark hearings 25 pages is more than sufficient. Should a case be exceptional and extra pages be required the Assistant Commissioner can consider whether this is appropriate at a Case Management Conference. | |
| Procedure following withdrawal of patent opposition proceedings | Matt Currie |
| <ul style="list-style-type: none"> • Traditionally, when an opponent in a patent opposition proceeding (or an applicant in a patent revocation proceeding) withdrew its case after having filed prior art documents, IPONZ’s standard practice was to pass the case to an Assistant Commissioner for a written decision in the public interest. | |

- The Patents Acts and Regulations give no clear guidance on the process to follow after a party elects to withdraw its case. UK case law, which had been relied on as providing a legal basis for public interest decisions, indicates that it should be open to the Office to consider whether to accept the withdrawal of an opposition without qualification or whether questions remain that should be considered further in the public interest.
- As discussed at previous TFG meetings, the Hearings Office intends on moving away from this as a default means of dealing with withdrawn patent proceedings.
- The proposal is that in almost all cases, given that the patent specification will already have been accepted by the Patents team, in either its advertised or amended form, applications will usually proceed to grant without the need for a full public interest decision.
- The Office will be releasing an email campaign and updating the website guidelines to provide further information about this change.

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| Amendments During Patents Proceedings | Cat O'Donnell |
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- The meeting discussed the revised guidelines, which were included in the TFG Summary Guide, circulated prior to the meeting, and can be summarised as follows:
 - Practice Guideline 1: Amendments during the course of a proceeding (Schedule C)
 - Practice Guideline 2: Request to amend pleadings (Schedule D)
 - Practice Guideline 3: Request to amend other documents during a proceeding (Schedule E)
- The key considerations are as follows:
- Should the opponent have standing to appear at a hearing requested by the applicant where an amendment is declined? Conversely, is the opponent entitled to request a hearing where an amendment has been approved?
 - Should the opponent be entitled to comment on amendments? If so, what timeframe would be appropriate to provide these comments?
 - Should the opponent be able to continue to engage with the patent examiner assessing the amendment, subsequent to their initial comments being made?
- In order to finalise the proposed changes to Practice Guideline 1, the members were invited to provide feedback on the areas of ambiguity identified above and provide feedback on the proposed updates by 23 November 2020.

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| Electronic Case Files - Case Management System | Matt Currie |
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- The Hearings Office is still reviewing possibility of electronic case file for use by Assistant Commissioners at hearings. This would not prevent parties from bringing their own hard copies of documents to hearing, but would preclude the need for them to print and courier an additional bundle to IPONZ.
- The Hearings Office does not intend on changing its current processes around preparation of hearing bundles unless an adequate alternative can be found, which is at least as effective as the current system.

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| Automatic Notification of Documents | Matt Currie |
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- Parties to proceedings will soon receive automatic email notifications upon the filing of any documents in a proceeding by the opposite side.
- An obvious area of concern is around the potential risk of confidential evidence being filled incorrectly and accessed by the opposite side.
- To minimise this risk, a notification will be included on the document upload screen, which will advise that any confidential documents need to be marked as confidential.
- If this error were to occur there are some questions around whether Regulation 33 requirement for evidence would still need to be served on the other side, despite evidence going to them.
- This change will not yet preclude the regulation 33 requirement for serving evidence on the other side, despite the automatic notification.
- This change is expected to be implemented in late 2020 or early 2021. Communications will be released closer to the time to notify users of this change.

IT Systems Updates

Steffen Gazley

- There has been a delay in the scheduled enhancements due to Covid-19. It is anticipated the automatic hearings scheduler will be rolled out by mid-2021.
- Electronic Hearings documents, mentioned by Matt above, by quarter 2 of 2021.
- The Hearings Office continues to work alongside WIPO to promote alternative dispute resolution process. More information and promotional material will follow in due course.
- Following the implementation of the letter template enhancements, the Hearings Office and the wider IPONZ team will be looking to update their letter templates, over the coming months.

Any other Business

- The meeting would be scheduled for April 2021.

Close of Meeting

Summary of Action Points

| Owner | Action |
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| IPONZ | Look into updating Hearings Office procedures to call Counsel and coordinate suitable times for hearings, prior to sending a letter. |
| IPONZ | Keep note of which cases can be heard at short notice, to utilise available hearing dates. |
| IPONZ | A list of scheduled hearings should be publically available. |
| IPONZ | Include date of the hearing in decisions of the Assistant Commissioner. |

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| IPONZ | Circulate Ziploc guidance. |
| IPONZ | Look at the High Court page limits for written submissions, to inform Patents submission page limits. |
| IPONZ | Consider whether following withdrawal of patent opposition proceedings (patents public interest decisions, would re-examination be possible under s96? Let members know outcome and ensure this is included in the proposed guideline. |
| Members | Provide feedback on Practice Guideline 1 in relation to the key considerations outlined in the TFG Summary guide. |