

HEARINGS TECHNICAL FOCUS GROUP

5 December 2017

10.30am-1.00pm

MBIE Building, 15 Stout Street

Room G.07

Present

Simon Pope (IPONZ), Heidi Benson (IPONZ), Emma Kelly (IPONZ), Matt Currie (IPONZ), John Landells (IPTA), Nick Holmes (IPTA), Kate McHaffie (AJ Park), Thomas Huthwaite (Baldwins), Ian Finch (James & Wells), Richard Watts (Simpson Grierson), Dan Winfield (Duncan Cotterill), Sheana Wheeldon (NZLS), Barbara Sullivan (NZIPA), Greg Arthur (NZLS), Gary Williams (Barrister), Jessica O’Kane (IPONZ)

Invitees for this meeting

Mark Kelly (Barrister & Commercial Mediator)

Apologies

Andrew Brown QC (NZLS)

Minutes

August Minutes agreed.

Actions

No.	Action	Comment
1	Hearings Office to arrange a farewell function for Assistant Commissioner Popplewell, and invite HTFG members.	
2	Update and publish the pre-hearing directions.	
3	Draft proposed content for Hearings Office letters advising of mediation as an option, and mediation web content, for further review by	

	HTFG members.	
4	Length of submissions – Hearings Office to look at Court of Appeal requirements, and discuss further with Assistant Commissioners.	
5	Update practice guidelines to provide discretionary deadlines for pleading amendments to reduce delays for minor amendments.	

Agenda

1. Introductions

1.1. Simon Pope welcomed attendees.

2. Hearings Office updates

2.1. Ingrid Bayliss is on secondment, and Vanessa Horne is acting IPONZ National Manager for the next 3-6 months.

2.2. The Assistant Commissioner conference was held in November – agenda items discussed included the proposed updated costs award schedules, the proposed hearings directions being co-developed with the HTFG, the IP Omnibus bill, and ways to improve hearings scheduling.

2.2.1. Up to a third of scheduled hearings vacate close to the hearing date, often due to settlement between the parties. Due to the requirement to provide at least one month's notice of a hearing date for an attended hearing, it is difficult to schedule another hearing quickly.

2.2.2. The Assistant Commissioners have agreed to over-schedule hearings on the basis that not all scheduled hearings proceed. This will also shorten the wait times for hearings, and enable more cases to be heard.

2.3. Assistant Commissioner Popplewell has announced his retirement. He started his career with the Patent Office in 1963 rising to the position of Commissioner of

Patents, he subsequently retired and started a second career hearing cases as an Assistant Commissioner, which he did with distinction for a further 21 years. He leaves a body of patent decisions that will continue to be his legacy for many years to come. A farewell function for him will be arranged.

- 2.4. The decision of *MAN Truck and Bus AG v Shaanxi Heavy-Duty Automobile Co Limited* [2017] NZHC 282 was discussed.
- 2.5. The pre-hearing directions are almost complete, and an update will be made regarding the hearing day options.

3. Promoting mediation as an alternative option

- 3.1. The proposal to promote mediation as an alternative dispute resolution option is part of the broader IPONZ Business Plan. The purpose of this discussion is to investigate with HTFG members the most appropriate way to do this.
- 3.2. Intention is to promote mediation as an alternative option to parties, and not prescribe mediation as a mandatory step. This is consistent with Australia's approach.
- 3.3. The members agreed that this was most suitable for our local circumstances.
- 3.4. Mark Kelly discussed mediation, and noted the increase in mediation worldwide, and that IP disputes are increasing – sensible practice to promote mediation. Noted that it does not need to be mandatory.
- 3.5. The members agreed that the logical time to promote mediation was after the parties' pleadings had been filed so the parameters of the dispute were established. This could be achieved by adding some comments into the standard Hearings Office letter after pleadings to the effect that the "Parties may wish to consider mediation as a possible option" with a link to relevant website content about mediation, including the process for requesting a halt in the proceedings to allow for mediation and a link to AMINZ accredited IP mediators.

4. Practice for Patent Examination Hearings

- 4.1. The Hearings Office noted that there was an increase of patent examination hearings, particularly under the new 2013 Act. Due to the increase and current structure of the Hearings Office, it was time to consider how patent examination hearings should be run.
- 4.2. The benefit of having a representative of the Patent Examination team was discussed – for example, if present at a hearing they would be able to answer any technical questions regarding the subject matter or provide clarification on the objections.
- 4.3. It was noted that other jurisdictions have input from an examiner. Practices in the US and UK were discussed.
- 4.4. The wording of the Patents Act does not provide for a clear mechanism where an Assistant Commissioner can seek clarification from an examiner on a technical point.
- 4.5. Discussion of doing an interim decision, which would allow an Assistant Commissioner to make a direction, and provide the Applicant with a deadline and opportunity to propose amendments. It is unclear whether the Act allows for this, and it is whether this is the right solution.
- 4.6. It was noted that New Zealand sits outside what would appear to be normal practice elsewhere.
- 4.7. It was agreed that IPONZ would need to be very clear on the role of examiner, so if they overstep as advocate, Applicants have a direction to point to.
- 4.8. The process needs to be designed so that the examiner's objections are clear, and the Applicant knows the full scope of their objection. The Assistant Commissioner also needs to know that they are looking at the same issue, and be able to question the examiner and Applicant on the technical issues.

- 4.9. It was agreed that this issue needs to be considered further, and to also take guidance from other countries.
- 4.10. It was noted that the process can be difficult when only the Assistant Commissioner and Applicant are involved, and there are issues over a technical issue.

5. Restriction on length of submissions

- 5.1. The Assistant Commissioners have suggested that the pre-hearing directions include a requirement that submissions should be no more than 30 pages with 1.5 line spacing.
- 5.2. It was agreed that this would be investigated and considered further, as to whether this should be a requirement. Hearings Office to check the Court of Appeal requirements and discuss further with the Assistant Commissioners.

6. Minor pleading amendments

- 6.1. Current practice was discussed – 1 month is provided for comments on pleadings amendments, even for minor clerical errors.
- 6.2. It was agreed that this period should be shortened to allow for less time for minor amendments, to ensure more efficient hearings process, and that hearings are not delayed unnecessarily.

7. Any other business

- 7.1. Minutes of previous meeting were approved.
- 7.2. If possible, IPONZ to combine Assistant Commissioner Popplewell's farewell with the next meeting. IPONZ to also consider inviting other members from NZIPA for the farewell.