

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

Date/Time	Wednesday, 20 October 2021, 10.30am – 12.00pm
Location	Video conference only
Apologies	John Landells, FB Rice Andrew Brown, QC Thomas Huthwaite, Baldwins

Participants

MBIE / Intellectual Property Office of New Zealand (“IPONZ”)	Other
Steffen Gazley, Hearings Manager (Chair)	Sheena Wheeldon, Wheeldon Legal
Cat O’Donnell, Principal Hearing Case Officer	Elena Szenticyani, NZIPA
Dylan Packman, Senior Stakeholder Engagement Advisor	Kate Duckworth, Kate Duckworth Intellectual Property
Monique Cardy, Personal Assistant (Minutes)	Richard Watts, Simpson Grierson
Samantha Carr, Senior Hearings Case Officer	Garry Williams, Richmond Chambers
George Wardle, Senior Policy Advisor, Corporate Governance and Intellectual Property Policy	Ian Finch, James and Wells
Julia Maclean, Associate Hearings Case Officer	Clive Elliott, Shortland Chambers
Meg Bradley, Associate Hearings Case Officer	Nick Holmes, Davies Collison Cave, IPTA
	Greg Arthur, NZLS
	Lauren Royers, (for Jenni Rutter), Dentons
	David Herman, IPTA
	Marcus Caulfield, IPTA

Agenda

Topic	Speaker
Welcome	Steffen Gazley
Review of previous meeting action points	Steffen Gazley
Action	Status

Oct/Nov 2020 TFG – Review the High Court page limits for written submissions, to inform Patents submission page limits.	On agenda
Oct/Nov 2020 TFG – Provide feedback on Practice Guideline 1 in relation to the key considerations outlined in the TFG Summary guide.	
Share information on proposed Hearings Office Business Objectives with members.	On agenda
Rephrase wording when unable to attend short notice hearings.	Complete
Review the prehearing directions on the timeframes to file submissions	No change for now – average timeframe between hearing date being scheduled and hearing is 1-2 months. If hearing scheduled longer in advance parties can request variation
The Hearings Office will collate tips on managing electronic bundles for the next TFG	On agenda
Notify stakeholders of the date that documents filed on patent proceedings will become publicly available.	In progress
Simplify confidential evidence guidelines and reduce steps as discussed and provide indication that the treatment of confidential evidence should be resolved prior to the relevant evidence deadline.	Complete
Update costs guidelines to include consideration of submissions when determining if proceedings are substantially identical.	Complete
Publish guidelines relating to amendments requested during patent proceedings.	Complete
Hearings Office to report on time to issue decisions at next TFG.	On agenda
Hearings Office update	Steffen Gazley
<p>High level management changes</p> <ul style="list-style-type: none"> • Simon Gallagher will be seconded to the Consumer Protection Team. • Karen Bishop will be acting National Manager of IPONZ and Rebecca James will be acting National Manager, in the meantime. At this stage, we expect Karen will be joining us in November. <p>Recruitment</p>	

- The Hearings Office (“The Office”) appointed Virginia Nichols as a new Assistant Commissioner in June.

Enhancements

- The Hearings Scheduler will be launched by the end of October. The changes will not impact the user experience, but will streamline scheduling of in person hearings.
- The Office has implemented a new business objective that proceedings from filing to the end of the appeal period will be a median time of 30 months or less.
- The Shortlist trial has been extended until June 2022.

Hearings Office Statistics

- A presentation was displayed to the meeting. The following points were highlighted:

Filing volumes:

- Trade mark oppositions filed are following the trends we have seen with trade mark filings. It is expected there will be an increase in numbers, as the trade mark filing numbers increase.
- Trade mark revocation volumes are also beginning to increase.
- Patent proceedings are continuing the trend of mostly examination hearings.

Average time to schedule a hearing:

- The vast majority of cases waiting to be heard, are from 2021.
- Scheduling timeframes have improved to 9 months, which has reduced from 13 months around the same time in 2020.
- A new Assistant Commissioner and case management system investment (scheduler) is expected to assist this further.
- 66.7% more hearings were held in the year 20/21 compared to 19/20.
- Some scheduling pressure has come from a higher than usual number of cases ready for their hearing (at least double historical averages). While it is unclear whether this will be sustained the Office is investigating what further resourcing is needed. It was added that there are several logistical factors, such as the hearing type, the complexity of the hearing and obtaining agreement from both parties, which impact the time taken for a hearing.
- The members noted that the time taken to schedule a hearing is not commercially viable. Members also noted the issue has existed for some years and did not consider the situation to be satisfactory.
- The intention is to schedule a hearing the moment it is ready to be heard and the Office is making changes and improvements, to achieve this goal. The Office continues to put significant investment and resources to achieve its published objectives.
- Further data will be shared at the next TFG in April 2022.

Issuing of decisions:

- It was noted that some decisions were taking between 6-12 months to issue. There are various reasons for this including the COVID-19 pandemic and case complexity. The number of these cases continues to reduce with only 8 now older than 6 months with some further decisions due to be issued in October.

- It was added that whilst we are seeing positive changes, decisions should be issued within three months. Members raised concerns around the efficiency of decisions being drafted 10 months after the Hearing. The members requested more information as to the measures put in place to reduce delays.
- Older cases are actively managed by the Hearings Manager and/or Principal Hearings Case Officer. The current caseload of a Hearings Officer is taken into account when allocating future hearings. Cases now have a more detailed complexity review carried out, before the case is assigned to an Hearings Officer, to ensure that the more complex cases are spread across the team. Further improvements to decision templates are also planned.

Policy update

George Wardle

IP Laws Amendment Bill

- IP laws Amendment Bill: now aiming for release of exposure draft March/April next year. However, this is contingent of finalisation of drafting by Parliamentary Counsel Office.

Review of Trans-Tasman Patent Attorney Regime

- Trans-Tasman patent attorney registration regime review: waiting necessary approvals to release a joint consultation paper with IP Australia. Hope to release in early November.
- In the process of developing the terms of reference for the review with Ngāti Toa and Te Puni Kokiri.

UK FTA negotiations

- UK FTA negotiations: announcement on an Agreement in Principle was released on Thursday 21 Oct. Information about the Agreement in Principle and intellectual property laws available on the website of the Ministry of Foreign Affairs and Trade.

EU FTA negotiations

- EU FTA negotiations: working toward substantial political conclusion by the middle of Nov. There are still significant issues to be resolved, including access to the EU market for NZ exporters and EU demands on geographical indications and term extension for patents and data exclusivity periods for pharmaceuticals, veterinary medicines and agricultural chemicals.

Copyright Act Review

- Remains paused.

Stakeholder Engagement update

Dylan Packman

Business Continuity Plan update

- When our case management system is unavailable for an extended period, a banner will display at the top of our website, advising alternative ways to meet deadlines and secure filing dates. We have recently added a new page to our website that we will link to from the banner when our case management system is unavailable. This new page goes into more detail than we can fit in the notification banner and provides

information on how to interact with us outside the case management system when the case management system is unavailable. This helps ensure we receive all the information needed to meet a deadline or secure a filing date.

Facts & Figures and Reporting

- IPONZ have received feedback that members would like updates from IPONZ between TFG meetings. Members were invited to provide feedback on what they would like to be updated on, so we can make this available on the website.
- At this stage, IPONZ are considering filing volumes, backlogs and pendency times, anticipated milestones legislative & services changes, such as tentative consultation dates etc, dates of proposed events/meetings.

Other updates

- A minor update to the hearings guidelines has been published on the website.
- Further updates to hearings at short notice content published online last week.

Shortlist initiative	Cat O'Donnell
<ul style="list-style-type: none"> • The Shortlist trial has been extended until 30 June 2022. • There has been a small uptake of this initiative since the trial began, with three trade mark proceedings placed on the list at the parties' request. These cases had all obtained a hearing date within three months. • In five further proceedings, one party requested the matter be placed on the shortlist while the other party did not give their consent. In these proceedings, the request to be placed on the shortlist was made by the applicant/owner and consent withheld by the opponent/applicant. • Seven paper proceedings have also been placed on the shortlist by the Office. The hearing of these proceedings do not take priority over those which are on the shortlist at the parties request. • It would be useful to know why parties are not opting to be on the shortlist, so the Office can work to mitigate those concerns and increase uptake. • Members noted that the incentive for the Shortlist initiative, was to utilise otherwise wasted hearings slots, however, it appears that this is not being used in the way it was intended, and cases seem to be jumping the queue. The Office confirmed that the short list has been utilised for vacated hearings. • There was some concern around how the shortlist could continue, without impacting the backlog of decisions waiting to be issued once the Assistant Commissioner has a queue of work. With the low number of cases currently on the shortlist this is not currently an issue. • The Office noted that the queue generally functions on a first in, first to be heard basis, but there will be some variation with consideration for the complexity and needs of the case. For instance, interlocutory hearings are usually allocated as quickly as possible to ensure the overall proceeding is not delayed. • The meeting discussed whether the Office should focus on prioritising the simple cases for a period, to clear the backlog, however, that is likely to impact the time taken to hear the more complex cases. There were mixed thoughts on this from the Members. They were invited to provide feedback on their preference, outside of the meeting. 	

Electronic bundles	Sam Carr
<ul style="list-style-type: none"> • The office has implemented the use of electronic common bundles for some hearings. • Please ensure that bundles are filed as a single document. • If there is evidence with a large amount of exhibits, please bookmark the exhibits as well as the pleadings and body of the evidence. If the bundle is clearly categorised and easy for the Assistant Commissioners to navigate. • Members were invited to give feedback and share any other tips and tricks which may be relevant. 	
Requirements for statutory declarations witnessed overseas	Cat O'Donnell
<ul style="list-style-type: none"> • The Office will raise potential defects in the witness attestation if they are identified. However, the onus remains on the filing party to ensure that the information provided in the evidence meets the legislative standard and is accurate. • Where a defect is raised by a Case Officer, the standard practice will be to halt the proceeding for one week to enable the issue to be resolved. • Acceptance of the evidence in the proceeding by a Case officer should not be taken as a determination of the admissibility of the evidence. Issues pertaining to the admissibility of evidence will be considered by an Assistant Commissioner at the substantive hearing. • Where a Case Officer has raised a potential defect with the witness attestation and the filing party chooses not to amend the evidence filed, the evidence will be accepted and the proceeding recommenced. • A person who can witness a statutory declaration overseas differs depending on whether the document is declared in a Commonwealth country or not, further information on these requirements were outlined in the Discussion Guide. 	
Page limits on patent submissions	Cat O'Donnell
<ul style="list-style-type: none"> • As discussed in previous Technical Focus Group meetings, the Office has considered possible page limits for submissions filed in patent proceedings. • The purpose of introducing page limits, as required in trade mark proceedings, is to encourage parties to file focused and relevant submissions. This ensures efficiency both for the Hearings Office and Counsel. <p>Proposed page limits</p> <ul style="list-style-type: none"> • Upon review of the average length of submissions filed in patent proceedings this year, the Office proposes the following page limits for submissions: <ul style="list-style-type: none"> ○ Interlocutory hearings: 10 pages ○ Examination hearings: 20 pages ○ Revocation/Opposition/other proceedings: 50 pages • Counsel may request a direction from the Assistant Commissioner hearing the proceeding to increase these limits in cases where this is likely to be required (i.e. due to the proceedings' complexity). 	

- Exceeding these page limits without first obtaining such a direction from the Assistant Commissioner will likely result in increased costs against the filing party.
- Members did not provide any feedback on the proposed page limits so these will be added to the pre-hearing directions. Members were still invited to provide feedback on the above proposal.

Any Other Business

Members

- The next meeting will be scheduled for April 2022

Close of Meeting

Summary of action points

Hearings Office to continue to provide scheduling and decision data at the next TFG

Members to provide feedback on the follow:

- What it would be useful to include on the Facts and Figures page of the website
- Idea of prioritising simple cases to clear backlog
- Patent Proceedings page limits