

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

Date/Time:	Wednesday, 15 October 2025, 10:00am – 12:00pm
Location:	Ministry of Business, Innovation & Employment 15 Stout Street, Wellington Central, Wellington 6011 Room G.17
Video conference details:	Click here to join the meeting
Apologies:	Lauren Hudson, Manager Business Delivery Aparna Watal, Halfords / IPTA

Participants

MBIE / Intellectual Property Office of New Zealand (“IPONZ”)	TFG Members
Craig Tolson, Principal Hearings Case Officer Emma Stares, Principal Hearings Case Officer Gillian Sharp, Manager CGIPP	Clive Elliott, Shotland Chambers Elena Szentivanyi, Henry Hughes Garry Williams, Richmond Chambers Ian Finch, James and Wells Jason Wach, James and Wells Jenni Rutter, Dentons Kate Duckworth, Kate Duckworth IP / NZLS Marcus Caulfield, FB Rice Nick Holmes, Davies Collison Cave Richard Watts, Simpson Grierson Thomas Huthwaite, AJ Park Victoria Argyle, AJ Park / NZIPA

Agenda

Time	Topic	Speaker
10:00 am	Welcome	Emma Stares
Opening welcome and karakia		

	Review of Previous Meeting Action Points	Emma Stares
Action		Status
IPONZ to circulate more detailed statistics relating to time frames to members.		Completed
IPONZ to consider providing guidelines on costs in opposition proceedings where both parties are partially successful.		In progress – absorbed into review of scale of costs
IPONZ to consider how to manage the potential impact on clients of correspondence issued on regional closed days.		Completed – raised with Policy; will be managed via practice for now
	MBIE Policy update	Gillian Sharp
IP Laws Amendment Bill Work on finalising the drafting of the Bill has continued. Subject to Ministerial approval, we are hoping to release an exposure draft next year prior to seeking Cabinet approval to introduce the Bill into Parliament. Patents Amendment Bill Currently being considered by select committee and they are due to report back early next year.		
	IPONZ update	Emma Stares/Craig Tolson
Recruitment Two new Hearings Officers will join the team by the end of November: Cat O'Donnell and Rosa Gould. Cat was previously a Principal in the hearings team for a number of years. Rosa is coming from the trade marks exam team. This will increase the number of decision makers in the trade marks space from four (two part-time and two full-time) to six. Fees review As mentioned last TFG, IPONZ is undertaking a review of all fees. IPONZ has developed several fee proposals as a result of its analysis. Consultation on any fee proposals is subject to Cabinet approval, and Cabinet has yet to consider this, so there isn't a timeline for the consultation process yet. IPONZ IT platform upgrade ("Aurora project") Also as discussed last meeting, a major upgrade to IPONZ's online systems is underway and will be progressively rolled out over the next two years. IPONZ is targeting the release of the new version for designs in mid-January. IPONZ expects to roll out trade mark services before the end of 2026 with patents and PVR to follow in 2027. Some firms may be contacted to update their organisation and user setups to ensure a smooth transition. See webpage https://www.iponz.govt.nz/about-iponz/iponz-platform-upgrade/ for project updates and feedback.		

Statistics

Service delivery timeframes

Hearings decisions are being issued in an average of 64 working days, with 70% issued within the 3-month target.

The time between a case being ready for a hearing, and being allocated a hearing date, is on average 8 months, with 53% scheduled within the 6-month target.

The median total proceeding length is 16 months.

99% of procedural correspondence is issued within 15 working days.

A more detailed break-down of time frames by proceeding type was circulated pre-meeting.

Proceeding volumes

Patents proceedings initiated remain steady with most being examination hearing requests, followed by oppositions to grant. Cases are allocated a hearing date very soon after becoming ready to be heard.

Trade marks proceedings initiated remain high. Oppositions to grant are beginning to trend upwards, following a corresponding upward trend in trade mark acceptances beginning mid-2024.

Trade marks 'pipeline'

The trade marks queue of cases ready to be heard has held fairly steady since Jan 2024. As of the meeting date there were 50 cases ready and waiting for a hearing. 33 were waiting to be scheduled and had been waiting a mean of 5 months. 17 were scheduled and waiting for a hearing, having waited a mean of 4 months to be scheduled and with a mean of 3 months between allocation and hearing date.

Since Jan 2024 an average of 3.0 trade marks hearings were held per month and 2.9 trade marks decisions were issued per month. This is with two full time and two part time trade marks decision makers.

Decision volumes

In 2025 to date, 20 trade marks and 9 patents decisions have been issued.

Members noted the high case load held by members of the profession and the greater number of judgements issued per decision maker in higher courts. Member suggested the number of hearings per decision maker could be increased to 2 per month.

IPONZ noted that decision makers are doing significantly more than hearing cases and writing decisions.

Member suggested that the profession work with the Office to provide training to decision makers.

Several members mentioned AI tools as a possible way for decision makers to increase efficiency.

IPONZ noted that the number of trade marks decisions issued is expected to increase in the longer term as the two new trade marks decision makers complete their training and begin issuing decisions.

	Procedural matters for discussion	All
Naming the Commissioner as respondent on appeals The Commissioner seeks to be named as a respondent in all appeals of patent and trade mark hearings decisions. It would save IPONZ time and expense if parties named the Commissioner as a respondent in the first instance when filing a notice of appeal. As per HCR 20.9A(1), decision-makers must be named as respondents to appeals unless they exercised a “purely adjudicative function”. IPONZ considers that the Commissioner possesses regulatory/public interest functions under the Acts and that these are carried forwards by each decision. <i>Member requested that IPONZ publish guidelines on this.</i> Default confidentiality rules and model undertakings The Law Society’s IP Law Committee (the Committee) requests that IPONZ develop model confidentiality undertakings, which could be published and operate as default undertakings in both trade mark and patent proceedings. The reason is that time is lost as parties try to agree on confidentiality orders and terms. Also, one side may delay responding/agreeing to “buy time”. IPONZ is moving forward on this item. The Law Society’s IP Law Committee has offered to provide redacted copies of suitable undertakings, which the team will work from to produce draft model undertakings. IPONZ will also develop its guidelines on the approach to be taken when parties cannot agree on confidentiality undertakings. <i>Member stated the confidentiality rules should apply to PVR and Designs as well. IPONZ responded that the guidelines would be general and would apply across all proceeding types.</i> <i>Members expressed interest in reviewing any guidelines before publication.</i> <i>Member raised concerns around model undertakings and a ‘default’ approach when parties cannot agree because of the ‘case-by-case’ nature of proceedings. IPONZ responded that the model undertakings will be an optional starting point, not compulsory.</i> Standardising the bundle format The Committee requests clearer rules around the format required for hearing bundles and bundles of authorities. For example: whether hyperlinking is required; whether a hard copy is required. The reason for the request is that current guidance is limited. Hyperlinking is time consuming and expensive. If not required, directions saying so would help keep costs down. IPONZ has drafted amended guidelines which were circulated to the members prior to the meeting. These will be published on the website in due course. <i>Member provided feedback that hyperlinks are very useful and suggested a general rule that hyperlinks be the default, with an option to request to file an electronic bundle without hyperlinks if cost is an issue.</i> <i>Member provided feedback that requiring a specific page size within electronic bundles may not be compatible with websites which typically are provided as a single long run on screen capture. IPONZ agreed to remove the specific page size restriction.</i>		

Review of IPONZ costs scale

The Committee requests a review of the IPONZ costs scale.

The reason for the request is that the scale appears to be set too low. The last review and increase was in December 2018. Low exposure to scale costs risks incentivising parties to run weak arguments with little downside.

IPONZ has initiated the project and is drafting a plan and timeline. The Office has had an information-gathering meeting with IP Australia. The Committee has offered to provide confidential examples of actual costs of the various stages of proceedings

Several members commented that looking to Australian practice may have limitations, for example in Australia costs are only awarded when a decision is made. Member suggested UK costs practice may be a more useful guide.

Clive noted that his paper “Recalibrating IPONZ’s practice” outlines powers that would allow the decision maker very wide discretion to deviate from scale costs.

Member commented that parties were not commenting in their submissions on the matter of costs and as a result the decision makers were defaulting to scale costs.

Earlier allocation of hearing dates

The Committee requests a change to the current practice of allocating hearings: that hearings be allocated after all evidence has been filed, ideally 8-12 months out from the hearing date. Suggestion of following the High Court practice of double or triple booking fixtures to allow for inevitable settlements.

The reason for the request is that hearings are most often allocated 2-3 months before the hearing date. This relatively ‘late’ allocation causes difficulties for counsel, solicitors and patent attorneys due to existing fixtures or major deadlines in the High Court. Earlier allocation would assist with efficiency and ease of planning.

Certain resource limitations mean allocating dates 8-12 months out is likely not feasible. IPONZ will work towards 6 month out allocation.

Two members commented that a greater concern was the lag between a proceeding being ready to be heard and a date being scheduled, not the time between scheduling and the hearing itself. They queried why a case could not be scheduled immediately once ready.

IPONZ responded that there is a backlog of cases to be heard and cases are scheduled from the front of the queue. There is a limit to how far out the cases could be allocated due to the limited number of decision makers. The addition of two new trade marks decision makers will help with the scheduling backlog.

Another member noted that if a case needed to be heard sooner parties could agree to have it added to the shortlist.

Parties not providing valid email addresses when serving pleading documents

IPONZ is aware of the issue where a party files a pleading document without providing to a valid email address. This creates potential complications for the other party in terms of service obligations and the possibility of negotiation.

IPONZ can mitigate issues around service of documents but recognises this does not help with the issue of party-to-party communications.

	Any other business	
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IPONZ will send options for the next Hearings TFG date to the members.

Member requested greater spacing between the different TFGs, with at most one in a given week.

11.10am

Close of meeting

Summary of Action Points

Owner	Action	Status
IPONZ	Consider publishing guidelines on the naming the Commissioner as respondent in appeals of Hearings decisions.	In progress
IPONZ	Develop model confidentiality undertakings and guidelines on approach when parties cannot agree	In progress
IPONZ	Finalise and publish updated guidelines on the format of bundles	In progress
IPONZ	Review the scale of costs	In progress
IPONZ	Circulate proposed date for next TFG	In progress
Members	Send agenda items for the next TFG	In progress