

HEARINGS TECHNICAL FOCUS GROUP

29 August 2017

10.30am-1.00pm

MBIE Building, 15 Stout Street

Room G.07

Present

Simon Pope (IPONZ), Emma Kelly (IPONZ), Heidi Benson (IPONZ), Matthew Currie (IPONZ), Marcus Caulfield (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).

Invitees for this meeting

Gary Williams (by telephone link)

Jacqueline Sheppard (MBIE Policy)

Apologies

Andrew Brown QC (NZLS)

John Landells (IPTA)

Minutes

Minutes agreed / not agreed.

Actions

No.	Action	Comment
1	Hearings Office to finalise Pre-hearings / Case Management directions for approval at next meeting. Members to provide suggested wording for one outstanding direction that was still to be agreed.	Make further minor suggested changes and look to finalise at next meeting.
2	Hearings Office to forward the proposed	A further consultation process with

	updates to costs schedules to IP Policy for review.	other stakeholders may be required before final approval.
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Agenda

1. Introductions

- 1.1. Simon Pope, Emma Kelly, Heidi Benson, Matthew Currie, Jacqueline Sheppard, Kate McHaffie, Thomas Huthwaite, Ian Finch, Dan Winfield, Sheana Wheeldon, Barbara Sullivan and Greg Arthur.
- 1.2. Nick Holmes, Marcus Caulfield, Richard Watts and Gary Williams via teleconference
- 1.3. Apologies from John Landells and Andrew Brown QC

2. Hearings Office updates

- 2.1. MBIE Policy gave an update to members about the upcoming Regulatory Systems Bill and IP Omnibus Bill. A draft of the Regulatory Systems Bill will be released by the end of 2017. A discussion document will be released early 2018 for the IP Omnibus Bill. Members were invited to contribute their suggestions and comments to the Hearings Office as this is a great opportunity to make improvements to our legislation.
- 2.2. Assistant Commissioner Aldred issued her first decision, which is available on NZLII.
- 2.3. Assistant Commissioner Alley is away on parental leave.
- 2.4. The first decision under the Patents Act 2013 was released in July. This decision looked at the new higher standard of support for claims in patent specifications. Members seemed to agree there were no surprises in this decision given the New Zealand provision was based on the United Kingdom equivalent, for which there were already a number of established authorities.

- 2.5. A recent decision of Assistant Commissioner Alley *NZME. Publishing Limited v Trade Me Limited* [2017] NZIPOTM 22 was discussed because there were some interesting obiter comments regarding the requirements to establish a valid claim to ownership.
- 2.6. The Hearings Office advised it had implemented the new practice on costs awards which had been agreed at an earlier meeting. Under the new practice, if a proceeding comes to an end without a decision of the Commissioner, for example where a party has withdrawn from the proceeding, the Hearings Office will write to the parties to enquire if the successful party will be seeking costs.
- 2.7. IPONZ joined the Global Patent Prosecution Highway.
- 2.8. IPONZ is one of the first NZ registers to incorporate New Zealand Business Number (NZBN) into our case management system.
- 2.9. The Geographical Indications regime is now in force and running smoothly.
- 2.10. IPONZ has relocated to its new offices. However, the reception for IPONZ remains the reception in the main MBIE building on Stout Street.
- 2.11. The Hearings Office worked with NZIPA to create a process for the incorporation of IP firms. This is now available on our website.

3. Case management / pre-hearing directions

- 3.1. Standard pre-hearing directions were agreed to with the following amendments:
 - 3.1.1. Direction 1: Member noted that, while it is appropriate to raise evidentiary issues at this stage, issues with pleadings should have been addressed earlier.

- 3.1.2. Direction 2: The Hearings Office will only offer alternative hearing dates if there are “good” reasons why a party is unable to attend the previously offered dates. Members requested that counsel availability be a consideration in scheduling. The Hearings Office assured members it would continue to do its best to accommodate counsel. However, due to other scheduling constraints this flexibility was limited.
- 3.1.3. Direction 3(4): Members previously requested that the parties and Assistant Commissioner work from the same common paginated bundle of pleadings and evidence where possible. Members agreed to provide suggested wording to set out process for doing this. It was noted that we will be incorporating a disbursement for the bundle in our new costs scales - \$150.
- 3.2. Member suggested that a hearing fee could also be required for hearings on the papers filed. This suggestion will be discussed with Assistant Commissioners at the upcoming Hearings Office Conference and put forward for consideration in the IP Omnibus Bill if feedback is favourable.

4. Review of costs schedule/s

- 4.1. Members considered proposed updated costs schedules put forward by the Hearings Office for consideration. Members agreed that the scales should, where possible, not be out of step with those in the Australian Hearings Office and High Court costs schedules. It was noted that the overriding purpose of the schedules was to provide certainty for parties about what costs they could incur and that they shouldn't be set too high as to create a barrier to access of the Tribunal. It was also noted that in some areas in the future, for example filing evidence, it may be appropriate for the IPONZ scale to be higher than Australian Office given the more formal evidential requirements in IPONZ hearings.
- 4.2. The daily rate for a hearing will increase from 4.5 hours to 5.5 hours to align with the High Court.

- 4.3. Members agreed that, given the new requirement for parties to provide a common bundle of pleadings and evidence, a disbursement of \$150.00 should be added to the scale to cover this.

5. Evidence Guidelines update

- 5.1. The guidelines regarding service of confidential evidence have been updated to reflect current Hearings Office practice. When confidential evidence is served the parties will be given an initial one month to confirm service of the evidence. If this is unsuccessful the parties will then be set a further one month to use their best endeavours under regulation 35C to come to an agreement. This allows more time for the parties to come to an agreement without the intervention of the Hearings Office.
- 5.2. New guidelines advising of the risks and implications of counsel giving their own evidence in a proceeding were agreed to. Members agreed that counsel should not be giving evidence in a proceeding, particularly of a contentious nature.

6. Requesting a hearing during patent examination (2013 Act)

- 6.1. Sections 6, 7 and 8 of the Examination Process page in the Patents Guidelines have been updated to clarify the timing and process for requesting a hearing during examination. This update was as a result of a members' request for clarification from the last meeting.

7. Any other business

- 7.1. Member raised a question regarding payment of hearing fees where proceedings are consolidated. Hearings Office confirmed that multiple hearing fees were required due to the wording of the governing regulation to ensure that all formality requirements were met.

8. Agenda items agreed for next meeting

- 8.1. Mediation
- 8.2. Patent examination hearings