

Hearings Office (“the Office”)

Technical Focus Group (“TFG”) Meeting Minutes

Date/Time	5 May 2021, 10.30am
Location	Ministry of Business, Innovation and Employment (“MBIE”) 25 The Terrace, Wellington
Room	L04 04M
Apologies	Greg Arthur, Clifton Chambers, representing NZLS Richard Watts, Simpson Grierson Clive Elliot, Shortland Chambers Garry Williams, Richmond Chambers

Attendees

Intellectual Property Office of New Zealand (“IPONZ”)	Other
<p>Steffen Gazley, Hearings Manager (chair)</p> <p>Cat O’Donnell, Principal Hearing Case Officer</p> <p>Tanya Carter, Acting Stakeholder Engagement Manager</p> <p>Monique Cardy, Personal Assistant IPONZ (minutes)</p> <p>Tanya Carter, Stakeholder Engagement Manager</p> <p>Samantha Carr, Hearings Case Officer</p> <p>Julia Maclean, Associate Hearings Case Officer</p> <p>Meg Bradley, Associate Hearings Case Officer</p>	<p>Kate Duckworth, Kate Duckworth Intellectual Property</p> <p>Sheana Wheeldon, Quay Chambers, representing NZLS</p>
	Video Conference
	<p>Nick Holmes, IPTA</p> <p>Ian Finch, James & Wells</p> <p>Andrew Brown, QC</p> <p>Elena Szentivanyi, NZIPA</p> <p>Marcus Caulfield, IPTA</p> <p>Thomas Huthwaite, AJ Park</p>

Item	Speaker
Welcome	Steffen Gazley
Review of previous meeting action points	Steffen Gazley
Action	Status
Look into updating the Office procedures around calling Counsel to coordinate suitable times for hearings, prior to sending the scheduling letter.	Complete. The team tried this and experienced mixed results. This means that it will not be rolled out further. However, giving more notice to parties, is having a noticeable positive impact on scheduling hearings.
Keep note of which cases can be heard at short notice to utilise maximise available hearing dates.	Complete. IPONZ has begun a short notice trial.
A list of scheduled hearings should be publically available.	IPONZ are planning to get this online by end of June 2021.
Include the date of the hearing in the decisions of the assistant commissioners.	Complete.
Circulate Ziploc guidance to TFG members.	Complete.
Review the High Court page limits for written submissions, to inform Patents submission page limits.	In progress.
Consider whether re-examination would be possible, following the withdrawal of patent opposition proceedings, under s 96. Let members know outcome and ensure this is included in the proposed guideline.	Complete. Situation is going to happen rarely so no guidance required at this time.
Provide feedback on Practice Guideline 1 in relation to the key considerations outlined in the TFG Summary guide.	In progress.
Hearings Office update	Steffen Gazley
Recruitment <ul style="list-style-type: none"> • Cat O'Donnell has been permanently appointed as a Principal Hearings Case Officer. • The Hearings Office is seeking approval for a further Assistant Commissioner for Trade Marks and is hoping to fill the position by the end of June 2021. • Julia Maclean and Meg Bradley have joined the team as Associate Hearings Case Officers. 	

Hearings venue

- In-person hearings will now be held at Pastoral House, 25 The Terrace, Wellington.

Enhancements

- The enhancement notifying both parties that correspondence has been lodged on the case, has been implemented.
- The team are responding to 95% of procedural correspondence, within 15 working days.
- The Office will be reviewing their business objectives and is looking at introducing a new objective which will focus on measuring the time taken for the entire duration of the proceeding.

IPONZ Statistics

- Trade Mark opposition filings have started to increase again. This is not unexpected given the increased trade mark filing volumes. Trade Mark revocation filings continue to decrease.
- Patent oppositions are declining, this is expected due to a reduction in 1953 Act applications and a long standing dispute between two parties being largely resolved. However, a high number of patent examination hearings are being requested.
- The average number of hearing fees paid have doubled since 2019, which is a reflection of the increased number of hearings scheduled.
- It was noted that the overall number of hearings scheduled in 2020 had increased to 49 from 2019 when 35 were scheduled.
- The average time taken to schedule a hearing is 12 months. This is expected as a handful of older cases had their hearing date scheduled. It is also positive that the number remained steady despite the disruptions in 2020.
- 1 in 4 hearings were vacated between November 2020 and April 2021. The Office will continue to monitor this as it does contribute to scheduling delays. The short notice trial may assist to ensure less hearing dates are lost.

Short notice fixtures

Cat O'Donnell

- At the previous Technical Focus Group members discussed their interest in IPONZ maintaining a record of proceedings which can be heard at short notice to maximise the availability of the Assistant Commissioners and fixture slots. This proposal was put forward as an option to assist with reducing the current backlog of cases to be heard.
- The trialling of this system will run from 1 April 2021 to 30 September 2021. At this point the Office will review the effectiveness of the trial. The meeting were encouraged to pass on their feedback and suggestions.
- It was noted that parties to a proceeding can opt to be on the shortlist, at the point where the case has become ready to be heard.
- The minimum notice period for the Office to notify the parties that their proceeding has been allocated a fixture date is 20 working days. However, a shorter notice period may be provided, subject to agreement from both parties and whether submissions had been filed.

- Members welcomed the initiative. There was some discomfort around the stated ramifications of failing to accept a proposed short notice hearing date. It was agreed that this point could be rephrased to avoid deterring parties from going on the list.
- The meeting discussed the inequity of timelines for submissions in general proceedings. Whilst the responding party has 1 week, the other party gets 1 month. In the courts, both get an equal amount of time to prepare submissions. It was further noted that, all of the work for a hearing is prepared very close to the hearing despite there being months before a hearing is scheduled. The Hearings Office agreed to look into the possibility of an earlier timeframe for both parties' submissions, and more time for the responding party after receiving the initiating party's submissions.

Case Management update

Steffen Gazley

- The team are working to get the hearings scheduler system in place in July 2021. The functionality allowing parties to set their availability will come later.
- Work on case management enhancements has paused for the time being. Once the scheduler is implemented, the Office will be working to incorporate some of the case management improvements.
- The Hearings Office confirmed that there was otherwise no changes to practice around case management and parties could continue to request one. The Hearings Office would also still refer cases to case management if required to progress the proceeding.

Electronic bundles

Sam Carr

- The Office will transition to the use of electronic bundles from 1 July 2021.
- From 1 July, the Assistant Commissioner hearing the case will determine whether a hard copy of the bundle is required. It is expected that for more complex cases, a physical copy of the bundle will be requested from the parties. Unless you are requested to do so, please do not provide a hard copy bundle.
- The Hearings Office does not consider it necessary for the documents to be hyperlinked. Paginating and bookmarking the bundle is sufficient. Paginating and bookmarking will be required for all electronic bundles.
- A hard copy of the bundle of authorities will no longer need to be couriered in.
- Attendees agreed that this seems more intuitive with how IPONZ operate.
- There will be an opportunity to provide further feedback on this process, at the October Hearings TFG.

Visibility of documents for proceedings under the Patents Act 1953 and Patents Act 2013

Cat O'Donnell

- The visibility of documents on patent proceedings falling under the scope of the Patents Act 2013 ("the Act") is being reviewed by the Office.
- Documents filed in future under the Patents Act 1953 will also be taken into consideration. Historic 1953 Act cases will not be included.
- Currently, all documents filed on patent proceedings default to "private", excluding decisions of the Commissioner. This means that these documents are only visible to the Office and the parties to the

proceeding. However, the Act requires that the documents be open to public inspection, including documents filed on related proceedings.

- The Hearings Office will be defaulting all of these document to be publically available. The date for this change will be advised shortly.
- The Office will seek to avoid release of any confidential documents and will review previously submitted documents before opening them up to public inspection.
- Counsel will be able to label information as confidential evidence, when uploading the document to the IPONZ Case Management System, in the same way as trade mark proceedings.
- It was further noted that the Australian Office make declarations publicly known, but exhibits have to be requested separately for release, at a cost.

Practice guideline updates

Cat O'Donnell

Confidential evidence

- Currently, if parties are unable to reach an agreement as to the treatment of confidential evidence, a Case Management Conference will be set down for the matter to be reviewed by an Assistant Commissioner.
- The Office intends to provide more options for resolution than just a Case Management Conference noting that agreement as to the treatment of confidential evidence should be a straightforward discussion between the parties.
- The updates to the Practice Guidelines incorporate an option for the Office to make a proposed decision on issues relating to the confidential evidence, as an alternative avenue for resolution. If a party considers they are adversely affected by the decision they may request an interlocutory hearing.
- The meeting suggested that steps 2 and 3 of the practice guideline could be combined into one step and parties should reach agreement about confidential evidence prior to their evidence deadline. The Office will look to incorporate this stance in letters or the Practice Guidelines.
- It was confirmed that the guideline should be updated and the Hearings Office will amend it to reflect discussion around combining steps 2 and 3 and noting that agreement around confidential evidence should be obtained prior to the evidence deadline.

Halt Guidelines

- Currently, if a halt lapses without any response being received from the relevant party, the Office will set a further deadline of one month for next step in the proceeding to be completed. The proposed changes put the onus on the party who has been given that deadline to complete that step or file an extension of time request.
- It was noted that this practice unnecessarily delays proceedings by granting the requesting party a de facto extension, in addition to the halt already provided. This discourages the requesting party from completing the required step before the deadline of the halt lapses.
- The Office proposed to update the guidelines, so that where the set deadline has expired during the course of a proceeding halt, the new deadline for the relevant task will align with the date the halt is specified to

end. If a set deadline expires after the period in which the proceeding is halted, the party is required to complete this step and is expected to do so by or before the original deadline.

- The meeting discussed the proposal to remove the 1 month period and there was some apprehension. There were concerns about situations where a party may be blindsided by settlement negotiations falling over close to the relevant deadline. This would leave a party with minimal time, if any, to complete the next step.
- It was noted that in Australia, timelines don't stop but halts become a basis for an extension. The group noted this had issues, and our practice shouldn't necessarily follow this.
- The Hearings Office does not intend to progress the guideline in its current form and will instead do a comprehensive review of the halt practice and discuss findings for possible guideline updates at a future TFG.

Costs awards for multiple proceedings

- The Office is looking to establish a practice around how costs will be awarded in instances where a decision is issued in relation to multiple proceedings, which are substantially identical.
- The Office has noted that the current system could be improved to recognise the administrative costs of filing multiple proceedings, by raising the costs award (excluding disbursements) by 20%. This is similar to the model adopted by IP Australia.
- Parties will still have the opportunity to file submissions on costs.
- It was noted that the decision around what constitutes "substantially identical" should also include the submissions filed (in addition to pleadings and evidence).
- It was agreed that the guideline should be implemented with submissions added when assessing whether the proceedings are substantially similar.

Amendments during the course of patent proceedings

- The finalised guidelines for amendments during the course of patent proceedings were presented to members.
- Questions were put to members at the previous TFG for feedback on outstanding issues. The Office has now confirmed its position on these points following the feedback received.
- Upon receipt of an amendment request by the Office, the proceedings will be halted and the opponent/applicant given 10 working days to file submissions commenting on that request. The opponent/applicant will not be entitled to engage with the patent examiner considering the requests thereafter.
- The opponent/ applicant for revocation is entitled to be heard or appear at a hearing in relation to the amendment of a complete specification during proceedings. However, the Office envisages this need will rarely arise.
- It was agreed the guideline should be implemented.

Next meeting	Steffen Gazley
<ul style="list-style-type: none"> Will be scheduled for October - November 2021. 	
Any other Business	
<ul style="list-style-type: none"> The meeting were encouraged to provide specific information when requesting an extension due to the impacts of Covid-19. This is not intended to be onerous but the request should provide specific reasons why the step could not be completed, e.g. lockdown restrictions in the prevent access to premises etc. A member voiced their concerns around the delay in the issuing of decisions. The Hearings Office is working on improving this and noted that the recruitment of an Assistant Commissioner in the coming months, should improve timeliness. Information on progress will be discussed at the next TFG. 	
Close of Meeting	
Summary of Action Points	
Action	
Share information on proposed Hearings Office Business Objectives with members.	
Rephrase wording when unable to attend short notice hearings.	
Review the prehearing directions on the timeframes to file submissions	
The Hearings Office will collate tips on managing electronic bundles for the next TFG.	
Notify stakeholders of the date that documents filed on patent proceedings will become publically available.	
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.	
Update costs guidelines to include consideration of submissions when determining if proceedings are substantially identical.	
Publish guidelines relating to amendments requested during patent proceedings.	
Hearings Office to report on time to issue decisions at next TFG.	