

## HEARINGS TECHNICAL FOCUS GROUP

7 March 2017

10.30am-12.30pm

MBIE Building, 15 Stout Street

Room G.07

### Present

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)

### Invitees for this meeting

Sheana Wheeldon (attending on behalf of NZLS)

Peta Bailey-Gibson (IPONZ)

### Telephone conference details

For members attending via telephone conference, please call XXXXX, then enter conference ID XXXX.

### Apologies

Greg Arthur (NZLS)

Barbara Sullivan (NZIPA)

### Minutes

Minutes agreed / not agreed.

### Actions

No.	Action	Comment
1	Next meeting to be organised for <b>TBC</b>	
2	Agenda for next meeting to be circulated by <b>TBC</b>	

## **Agenda**

### **1. Introductions:**

- 1.1. Simon Pope, Peta Bailey Gibson, Nick Holmes, Sheana Wheeldon, Dan Winfield, Thomas Huthwaite, Kate McHaffie, Ian Finch, Emma and Heidi.
- 1.2. Richard Watts and John Landells via teleconference.
- 1.3. Apologies from Barbara Sullivan and Greg Arthur.
- 1.4. Last meetings minutes agreed.

### **2. Hearings Office updates:**

- 2.1. World Trade Mark Report ranked IPONZ number one in the world for its systems. IPONZ thanked the members for their support and continued feedback that contributes to our constant enhancement programme.
- 2.2. IPONZ is moving out of the main MBIE building on Stout Street to new offices in Midland Park. However, the reception at the main MBIE Stout Street building will continue to serve as the reception desk for IPONZ. The new IPONZ offices do not have hearings rooms so we are still investigating alternative hearings rooms for Wellington.
- 2.3. IPONZ is now using the Companies Office in Auckland for any Auckland hearings.
- 2.4. Hearing Scheduling update – up to eight months for trade marks, less for patents.
- 2.5. Hearings team have been contributing to the development of the new Geographical Indications ('GI') hearing regulations.
- 2.6. Peta gave members an advanced viewing of the new GI content for the IPONZ website, and a demonstration of the online application process.
- 2.7. Update to frequently cited cases list from last meeting has now been posted on the website. The lists will be updated again shortly with hyperlinks to the cases where possible as suggested at last meeting.
- 2.8. IPONZ is updating its evidence guidelines to better cover counsel evidence and confidential evidence.
- 2.9. The Hearings Office thanked the members for all their kind words wishing our Senior Hearings Case Officer, Helen Baxter all the best in her retirement.

### **3. Case management / pre-hearing directions**

- 3.1. It was agreed that the best way to progress a case to a hearing was to use a combination of both:

- (1) standard pre-hearing directions; and
- (2) case management directions.

3.2. IPONZ noted that most suggestions of members could be dealt with by standard pre-hearing directions rather than case management, such as directing:

- A sequential exchange of submissions (10 & 5 days from hearing)
- Making parties confirm the length of hearing they require
- Requiring parties to identify any evidential or pleading issues prior to the hearing
- Requiring parties to identify any grounds they no longer intended to pursue at the hearing
- Requiring the parties to provide a common, paginated, bundle of authorities
- Requiring each party to provide a paginated bundle of documents

Only matters outside of these directions, or potentially matters identified as a result of these directions (such as whether there was a need for an interlocutory hearing to deal with evidential matters), would need case management.

3.3. For case management, it was agreed that there should be an expectation that counsel have instructions/authority to make agreements.

3.4. Bundle of legal authorities - initiating party starts preparing the common bundle and the second party can add any extra at 5 working days.

3.5. Indexed bundle of each parties evidence. It was suggested that everyone has the same copies. It was acknowledged that hearings run more smoothly when everyone is working from the same indexed bundle.

3.6. The possibility of using e-bundles was raised. The Hearings Office confirmed that it is in favour of heading in this direction.

#### **4. Review of costs schedule/s**

4.1. Prior to the meeting, the Hearings Office circulated a discussion document on the schedule of costs, which have remained unchanged for a number of years. A copy of the Australian schedule was also attached for reference purposes.

4.2. One approach proposed in the discussion document was to adjust costs in line with changes in the CPI. Some members noted that Legal costs had not tracked with CPI, so questioned this approach.

4.3. Some members also suggested significant increases to costs so they more accurately reflected the 'actual cost' of legal representation incurred by parties. However, the Hearings Office noted that the schedule of costs is not intended to reflect the 'actual costs' of parties. The overriding purpose of the schedule is simply to provide parties with some certainty as to the costs they could incur at the outset of proceedings to help them make an informed decision about initiating, or defending, proceedings.

- 4.4. The Hearings Office noted the tension between raising schedule costs, and the purposes of the IPONZ tribunal, which is to provide members of the public with a more accessible and cheaper forum than the courts for hearing IP disputes. It was therefore important that any increase in schedule costs did not adversely impact on the accessibility of the IPONZ tribunal.
- 4.5. Having focused on the various costs items, there was general agreement that it was mostly the evidence costs that were out of step and that needed to be increased. It was also agreed that there should be two separate costs schedules. One for patents and one for trade mark hearings to reflect the greater complexity of patent proceedings, and the need to file expert evidence to support most grounds in patent proceedings.
- 4.6. It was agreed the Hearings Office would suggest some base line suggestions for cost amounts for further discussion at the next meeting.

## **5. Practice on requesting costs awards (update)**

- 5.1. Members agreed on the Hearing Office's proposed wording for pursuing costs, which has been added to our standard letter template. This wording advises parties that once proceedings are withdrawn or concluded they have 1 month to request an award of costs – the Commissioner's current practice of not awarding costs unless requested remains.

## **6. Any other business**

- 6.1. Some questions were raised about IPONZ practice under the Patents Act 2013 for requesting an examination hearing when a response to a compliance report is due near the end of the 12 month s 71 examination period. The Hearings Office advised they had been working with the patents examination team to clarify this practice. In response, the patents examination team have now updated the content in their letter templates to advise applicants how they can request an examination hearing if applicants are near the end of the s 71 examination period. The examination team will also soon be updating the information in the examination manual to clarify the practice around this area.
- 6.2. Suggested future agenda item – hearings guidelines for post decision claim amendments. Another area to clarify is when claim amendments will be accepted during the course of proceedings.

## **7. Next meeting**

- 7.1. Finish off review of costs.
- 7.2. Look to conclude case management / prehearing directions.
- 7.3. Finalise process for requesting a patent examination hearing under the new Act.