**HEARINGS TRADE MARKS FOCUS GROUP**

**Minutes of Meeting - 1 August 2016 – 10 a.m.**

Participants:

Simon Pope - IPONZ (Chair); Heidi Benson - IPONZ; Emma Kelly – IPONZ; Greg Arthur (representing NZ Law Society); Barbara Sullivan (representing NZIPA); Kate McHaffie; Thomas Huthwaite; Ian Finch; Dan Winfield

(by telephone) Richard Watts; John Landells and Nick Holmes (representing IPTA).

1. Introductions/expectations

Simon Pope introduced the IPONZ hearings team members present, and gave apologies for Helen Baxter. Heidi Benson has joined the team and works from 9 a.m. to 2 p.m. Monday to Thursday. Simon said that he was working with a very good team at the hearings office.

2. Hearings Office updates

Simon Pope reported:

*i) Hearing Officers.*

\* The current hearings officers are: Natasha Alley, Jane Glover, Victoria Casey, Bruce Popplewell and Alf Hazelwood.

\* Brian Thompson has retired as a hearings officer.

\* Victoria Casey QC has been appointed a hearing officer (and has issued 4 decisions to date).

\* IPONZ will soon start recruiting to replace Brian Thompson. Six would be the ideal number of hearing officers.

\* IPONZ is working towards a model where an Asst Commissioner can hear any type of case: patent, trade mark or design. This will make it easier to manage caseloads and for succession planning. To date Jane Glover has heard 4 patent cases, and Victoria Casey has a science degree.

\*John Landells asked about the life science expertise of hearing officers for patent cases. Simon Pope advised that if necessary IPONZ can bring in people with science expertise to help Asst Commissioners.

*ii) Business objectives for hearings office*

IPONZ objectives are:

\* to set a hearing date for a date within 65 working days from the time a matter is ready for a hearing. (Currently the timeframe is 6 months.);

\* to issue a decision within3 months of the hearing;

\* to improve hearing office reporting.

*iii)* *Systems issues at WIPO affecting oppositions to International Registrations*

Systems issues at WIPO had been affecting New Zealand trade mark oppositions. IPONZ reports the filing of a notice of opposition to WIPO which then serves a notice of provisional refusal on the trade mark applicant/rights holder. The date that triggers a response is the date of notification from WIPO. Because of delays in serving provisional refusals, to prevent any procedural unfairness, the Hearings Office will halt all NZD opposition proceedings until the rights holder has been served. An International Registration had been protected in New Zealand after an extension of time to oppose in New Zealand had been granted. (See further discussion under Halts in proceedings below, at 3. ii).)

*iv) Confidential documents*

All documents filed in opposition proceedings now default to private visibility. . All documents are visible to both parties. It is for the parties to identify what documents are confidential, load these using the new document type “confidential evidence”, and these documents will not be made visible to the other party in the proceeding until the filing party has confirmed to the Hearings Office that the documents have been served on the other party..

*v) ISOS certification*

IPONZ now has ISOS 9001/2015 certification. This applies to the Hearings Office practices and procedures also.

3. Overview of new hearings office practice guidelines

i) Heidi Benson demonstrated how to search for content relating to hearings on the newly-designed IPONZ website (go to \*Manage IP; \* Trade Mark Hearings Guidelines).

ii) Halts in proceedings and extensions of time:

\* Appropriate to apply to a halt to proceedings if parties are negotiating.

\* No halt will be granted unless a notice of opposition has been filed. The Hearings Office is advising parties who apply for extensions of time to oppose of this new requirement. Thisrequirement provides certainty and protection for the parties, and complies with Article 5 (2) (c) of the Madrid Protocol. If WIPO is not notified of an opposition within 7 months of the filing of a notice of opposition, it will not recognise the opposition proceeding or its outcome : A contracting Office *“ may, with respect to any given international registration, notify a refusal of protection after the expiry of the 18-month time limit, but only if….(ii) the notification of the refusal based on an opposition is made within a time limit of one month from the expiry of the opposition period and, in any case, not later than seven months from the date on which the opposition period begins.”* See <http://www.wipo.int/treaties/en/text.jsp?file_id=283484#P84_12571> )

\* The recommended action is to file a notice of opposition and an application for a halt at the same time. IPONZ aims to action requests for a halt in proceedings within two working days.

\* This practice is consistent with the requirements of the new Patents Act and follows patent proceedings under the old Patents Act (1953).

\* Requests for extensions of time on reasonable grounds are fairly routine and don’t require the consent of the other party.

iii) Evidence guidelines:

\* Comprehensive evidence guidelines, drafted by Asst Commissioner Natasha Alley, are now on the website. The guidelines did not represent a change of practice, and confirm that the standard of evidence in IPONZ proceedings is the same as applies in the High Court.

\* Helen Baxter had noted that evidence issues are frequently raised hearings. The guidelines should help overcome this problem.

\* Ian Finch raised the issue of parties filing what is really evidence in chief in the guise of evidence in reply (i.e. evidence that is not “strictly in reply”.

\* Greg Arthur said that benefit would be gained if people signalled objections to evidence before the hearing. This is a procedural matter. There could then be an interim hearing, or the objections could be dealt with before the substantive hearing on the day.

4. Practice regarding requests to revoke “expired but restorable” trade marks

Emma Kelly reported.

\*IPONZ has obtained a legal opinion that it is not possible to apply to revoke a trade mark registration that has expired but is restorable under section 60. The reason is that an “expired but restorable” trade mark does not meet the definition of “registered trade mark”.

\* An examiner could decide not to take an expired but restorable registered trade mark into account when examining a subsequent application – section 60(2). The examination team appear to be unwilling to do that.

\* Examiners can agree to an application being held in abeyance pending the expiration of the one-year post-renewal date period of a cited registration. This course is often not acceptable to trade mark applicants, who do not want their applications to be delayed.

\* There was discussion about the desirability of revoking section 60(2) and amending section 66 to include expired but restorable trade marks .

\* It was agreed that this is an unsatisfactory situation.

\* As requests under section 60(2) are an examination matter, the Hearings Office will forward the comments of the HTFG to the examination section for discussion in consultation with its Technical Focus Group.

\* IPONZ has identified this as a matter that requires regulatory attention, and it will be addressed in the next Regulatory Systems Bill

5. Review of costs schedule

Simon Pope introduced the proposal to increase costs awarded by hearings officers, and the discussion of the sample figures circulated before the meeting. (The omission of opponents’ expenses from the sample scale was an oversight.) After much discussion, the members of the profession present proposed that:

\* There should be one schedule only. It should have two bands (as under the High Court Rules). Generally patent matters would fall within Band 1 and trade mark matters within Band 2, unless the parties can demonstrate that the other band is appropriate. The band could be changed during proceedings if circumstances changed (such as a party abandoning a ground of opposition).

\* The scale costs currently awarded for evidence and hearing preparation are deficient.

\* The scale figures should be reflective of principle, and take into consideration the time involved at each step.

\* Expert evidence could be classified as an expense/ disbursement (as in the High Court).

\* The Hearings Office would seek feedback from the Assistant Commissioners at the upcoming Hearings Office conference, and will discuss with HTFG members at the next meeting.

6. Hearings facilities

\* Simon Pope reported that IPONZ is conducting a business case for a permanent, suitable hearings room. At present IPONZ is using MBIE facilities but has no priority. MBIE facilities are often booked months ahead. A recent two-day hearing had to be scheduled 5 ½ months in advance.

\* There have been complaints from counsel about the adequacy of some of the rooms being used in the Stout Street building.

\* MBIE has good video links from one office to the other. This does not apply for outside hearings.

\* It was suggested that the new facility should provide a table for each counsel, with physical space between, as well as facilities for hearing officers and clients. Power points should be available for counsel. As cross-examination is likely to become more frequent, there should be accommodation for witnesses as well.

7. Other business

\* Greg Arthur said that Andrew Brown, Clive Elliott and Sheana Wheeldon had expressed interest in participating in the discussions of the hearings trademark focus group.

\* Simon Pope said that IPONZ wanted to avoid a large unwieldy group. However, other people could participate in meetings if appropriate.

\* The next meeting would discuss case management. This is a weighty topic, and it may be beneficial to include other people such as those mentioned.

8. Next meeting

\* Agenda: possible items for the agenda for the next meeting are the schedule of scale costs; case management; and standard of pleadings.

\* Issues identified for the case management discussion included: When should case management conferences be convened (For all proceedings? At what stage?); exchange of evidence; exchange of submissions; and filing of amendments.

\* Simon Pope said that he would circulate a draft agenda early, and ask for contributions.

\* It is likely that the next meeting would be held in approximately two months time.

\* Frequency of meetings: Default position is two (2) per year.

The meeting closed at 11.30 a.m.