

## IPONZ Hearings TFG - 20 October 2021

<p><b>1. Attendees</b>  <b>IPONZ / MBIE:</b> Steffen Gazley; Cat O'Donnell; Sam Carr; Julia Maclean; Meg Bradley; Monique Cardy; Dylan Packman; George Wardle; Virginia Nicolls;</p> <p><b>NZ profession:</b> Greg Arthur; Sheana Wheeldon; Garry Williams; Kate Duckworth; Thomas Huthwaite; Ian Finch; Richard Watts; Elena Szentivanyi; Lauren Royers (in place of Jenni Rutter);</p> <p><b>AU profession:</b> David Herman; Nick Holmes; Marcus Caulfield</p>	
<p><b>2. Review of previous meeting action points</b>  Largely done / covered below</p>	<p style="text-align: center;"><b>Steffen Gazley</b></p>
<p><b>3. IPONZ and Hearings Office update</b>  Simon Gallagher on secondment, replacement from mid-November will be Karen Bishop, in interim Rebecca James in acting role.</p> <p>Virginia Nicholls seconded on fixed term contract from Principal Trade Mark Examiner role to Hearings Office until 24 June 2022.</p> <p>Now FTE team of 9 in HO.</p> <p>Launching online hearings scheduler.</p> <p>New business objective - from start to finish hearings process to take 30 months - currently average of 37 months.</p> <p>Hearings shortlist trial extended to end June 2022.</p> <p>Proceedings statistics - see attached - average delay for hearing following request is 10 months - aim to be 4 months.</p> <p>Steffen recognised need for more Hearings Officers but need to ensure have support and other resources before appoint any more. Looking at hiring in late 2020 / early 2021.</p>	<p style="text-align: center;"><b>Steffen Gazley</b></p>

<p><b>4. Policy update</b></p> <p>(a) IP Laws Amendment Bill Bill with Parliamentary Council Office - exposure draft expected early 2022.</p> <p>(b) Plant Variety Rights Bill Before Select Committee - report due in House in next week or two.</p> <p>(c) TTIPAB Review Delayed - hopefully approval to release joint discussion paper in a week. Six week consultation period.</p> <p>(d) Ka Mate Haka Attribution Act MBIE in discussions with Ngāti Toa.</p> <p>(e) FTAs UK - agreement in principle expected very soon (released 21 October). EU - last round of negotiations in June and in hiatus since. EU has agreed to step up negotiations.</p> <p>(f) Copyright Act review Paused.</p>	<p><b>George Wardle</b></p>
<p><b>5. Stakeholder engagement update</b></p> <p>Business continuity plan - IPONZ will use banners on website if any system outage with link to dedicated page.</p> <p>Facts and figures - IPONZ publish filing statistics and will update quarterly - <a href="https://www.iponz.govt.nz/about-iponz/facts-and-figures/">https://www.iponz.govt.nz/about-iponz/facts-and-figures/</a> - feedback requested.</p>	<p><b>Dylan Packman</b></p>
<p><b>6. Shortlist initiative</b></p> <p>Trial extended to 30 June 2022. Only three matters put on list at parties' request. Five other parties requested matter be added to list but other party (the initiator of the proceedings) did not consent. IPONZ is also using any freed up hearing time for on paper decisions.</p> <p>Hearing held within 2 ½ months compared with current 10 month average.</p>	<p><b>Cat O'Donnell</b></p>
<p><b>7. Electronic bundles</b></p> <p>Seems to be working well. File as a single document. Bookmark declarations and exhibits.</p>	<p><b>Sam Carr</b></p>

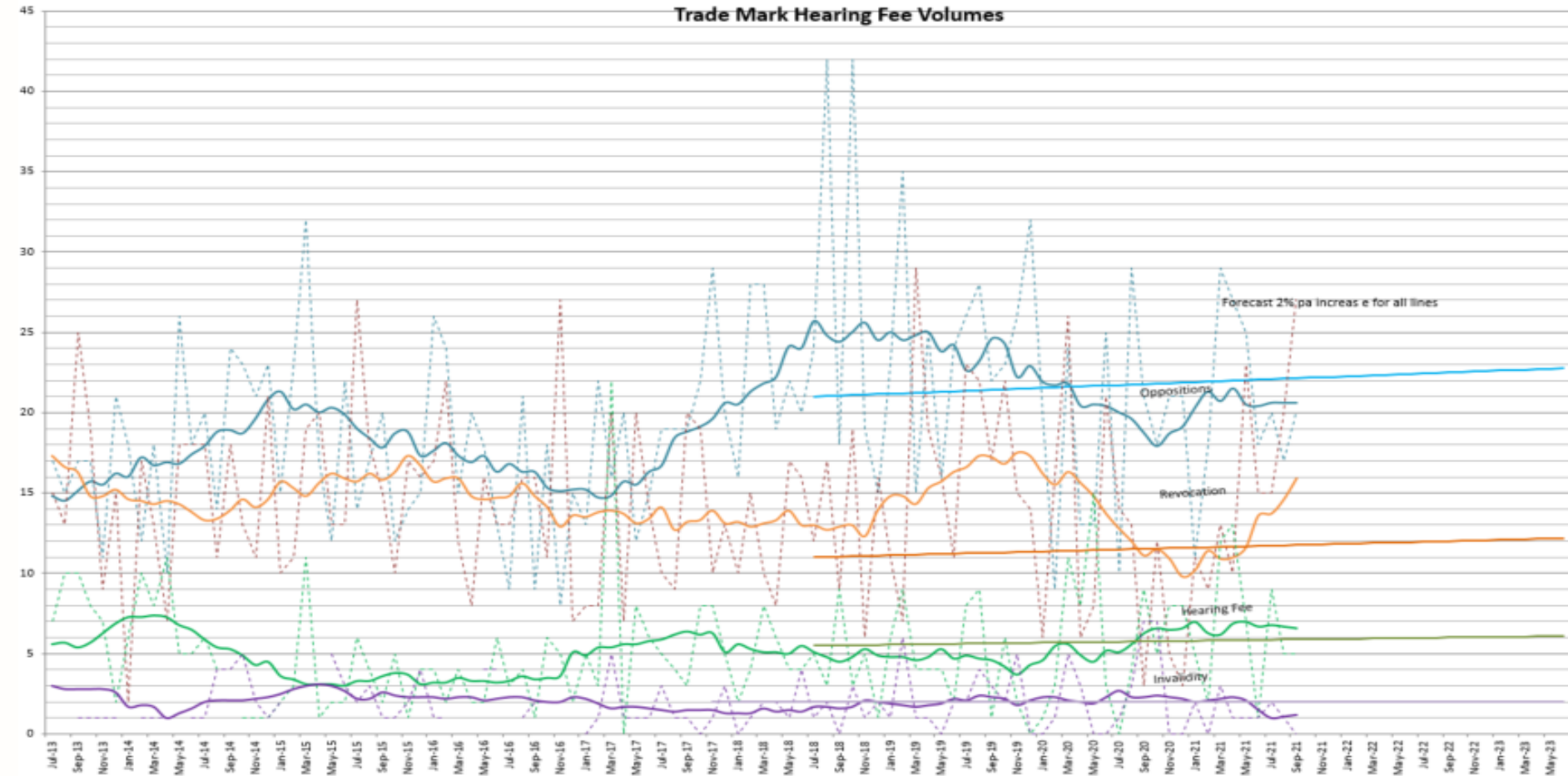
<p><b>8. Requirements for statutory declarations</b>  Hearings Office will raise issue if noted but will be dealt with by Assistant Commissioner at hearing.</p> <p>Practice update coming.</p>	<p><b>Cat O'Donnell</b></p>
<p><b>9. Page limits on patent submissions</b>  See meeting papers.</p>	<p><b>Cat O'Donnell</b></p>
<p><b>10. Next meeting</b>  Elena suggested that TFG meets more regularly and/or have formal inter-meeting process. Steffen sated that meeting twice a year was sufficient for them and that can have emails in between for matters as required.</p>	<p><b>Steffen Gazley</b></p>
<p><b>Meeting closed</b></p>	

# Hearings Office update – Technical Focus Group

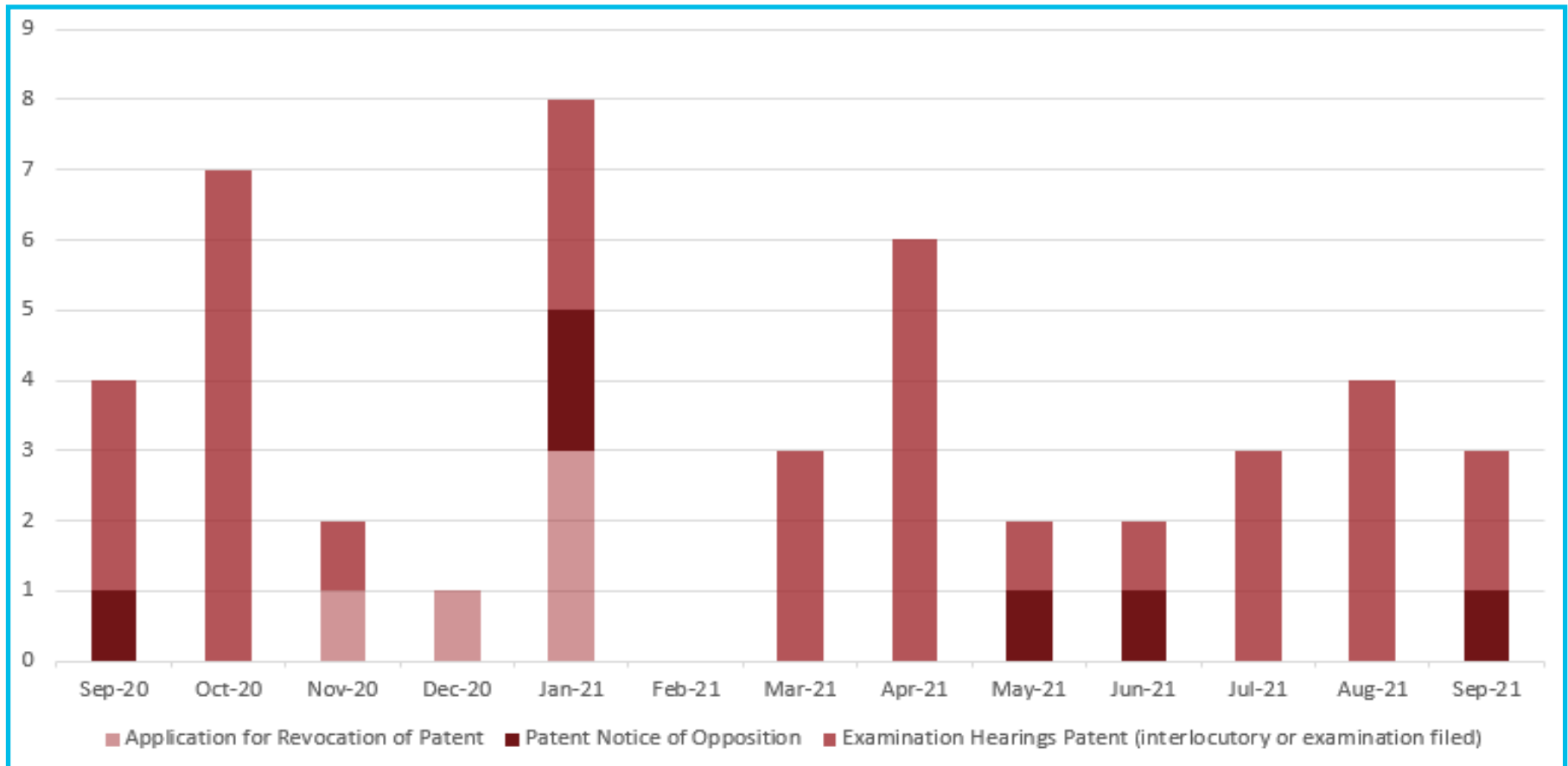
October 2021

## TM Hearings filing volumes per month

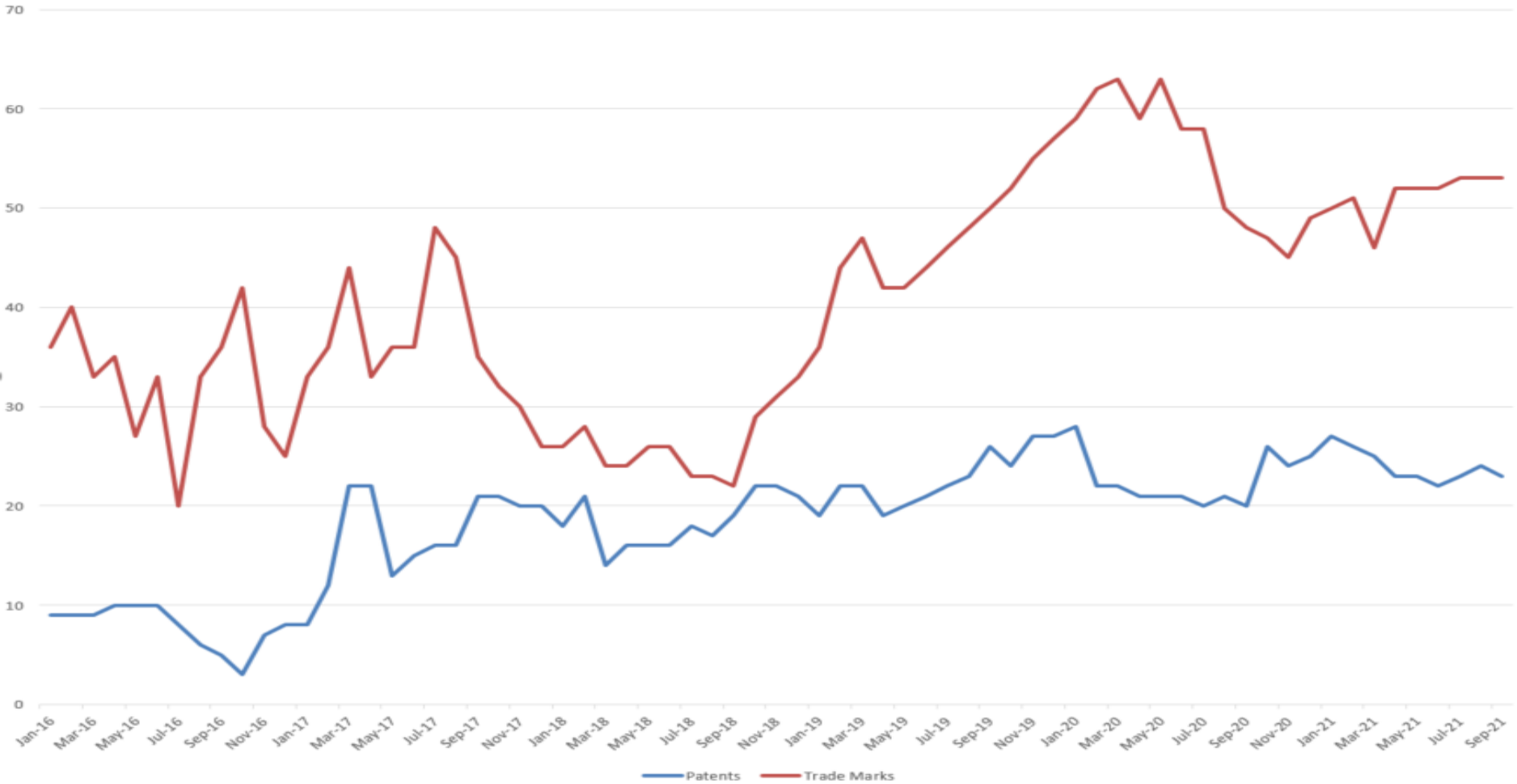
Trade Mark Hearing Fee Volumes



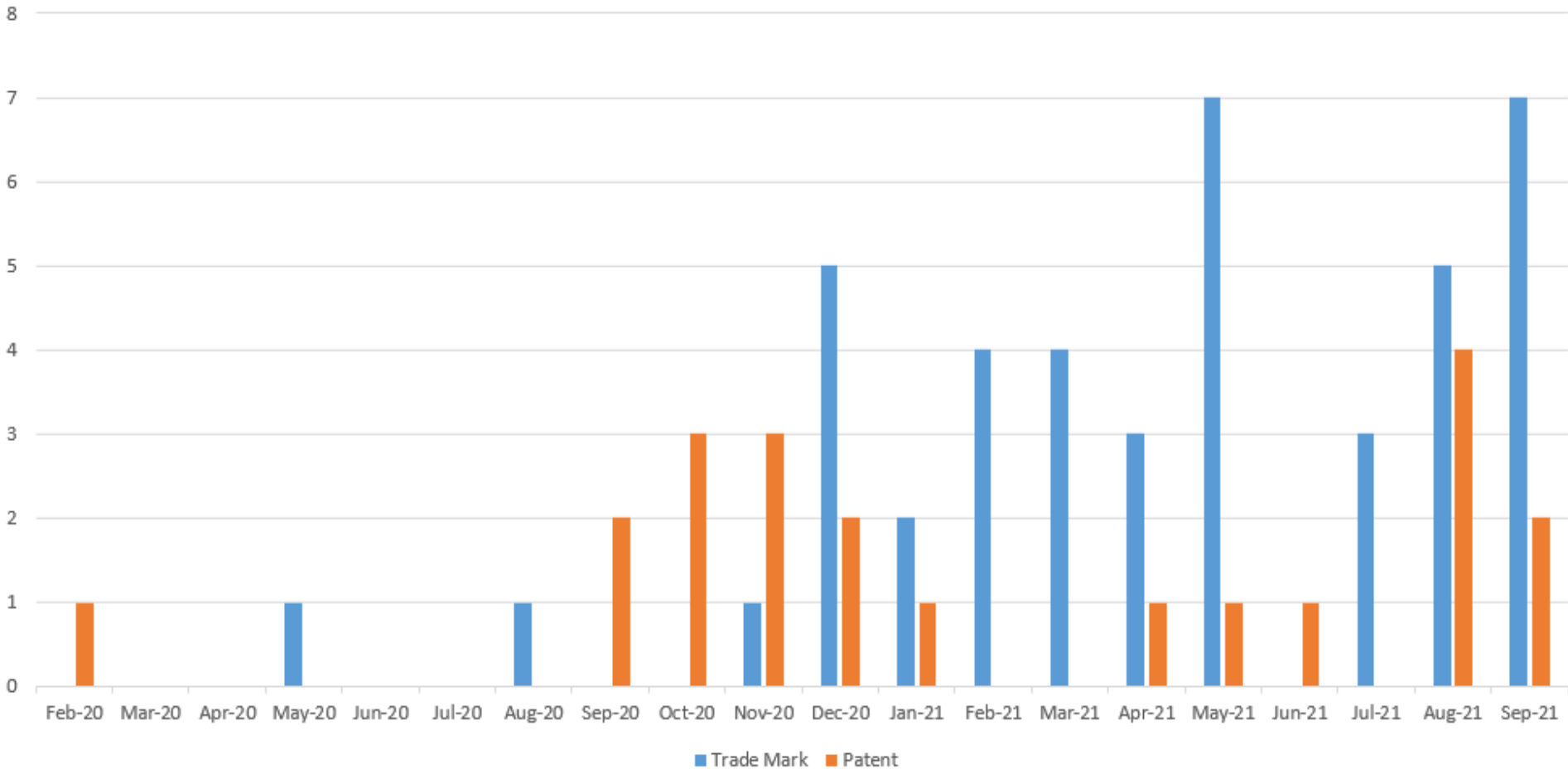
## Patent proceeding filings



### Total cases awaiting a hearing

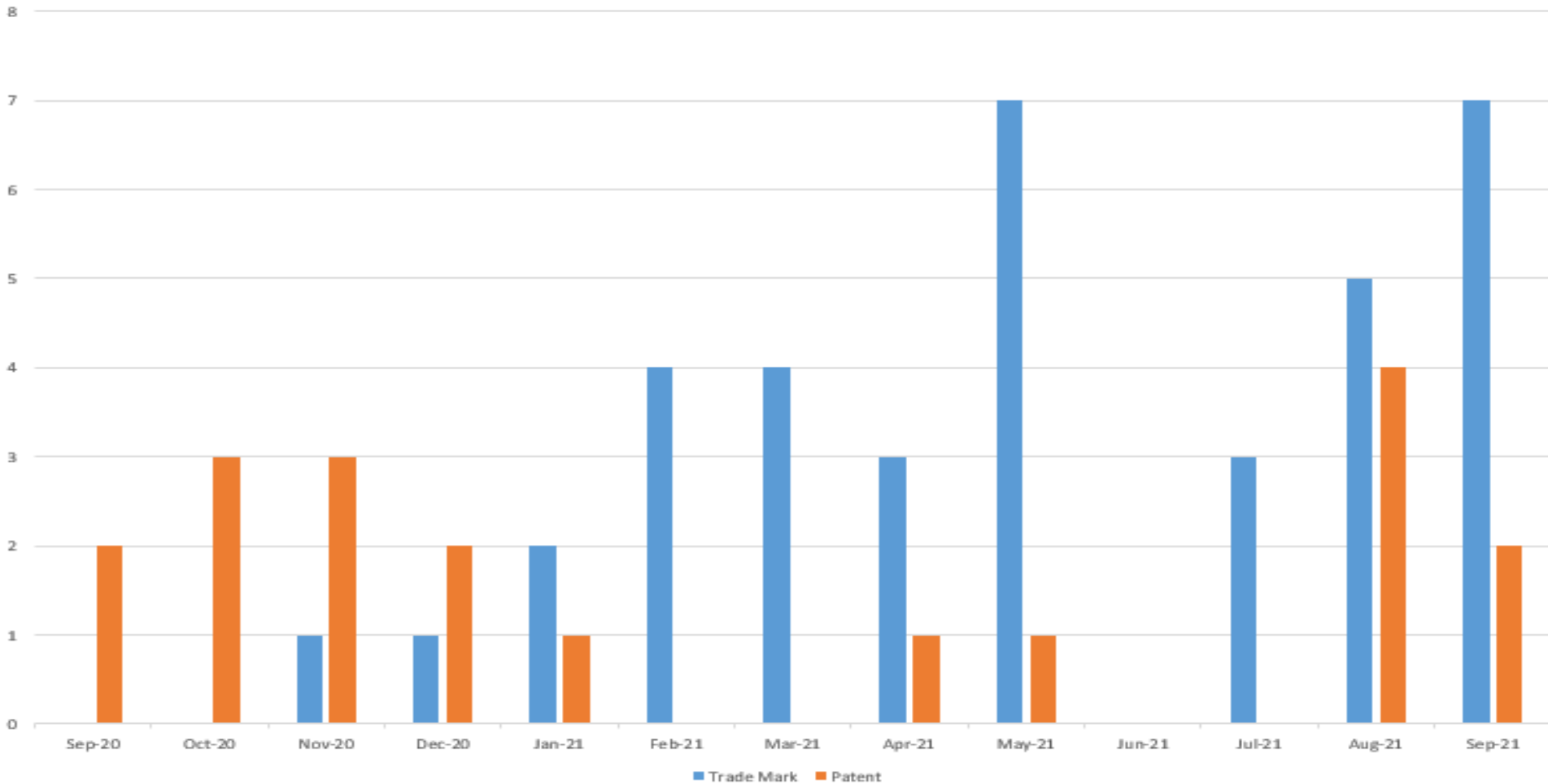


## Cases awaiting hearing by date ready to be heard





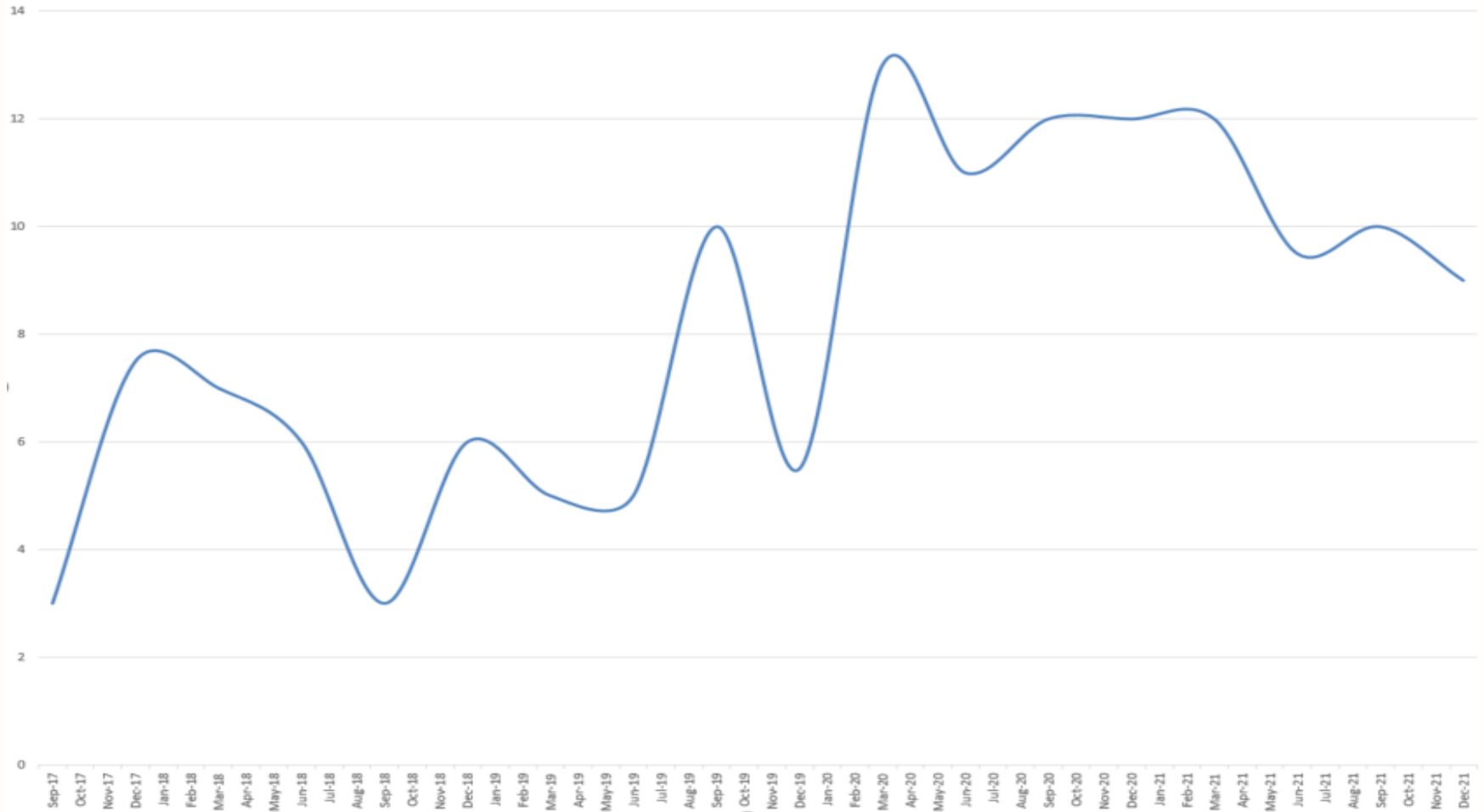
### Cases ready to be heard awaiting hearing date allocation



## Total hearings held

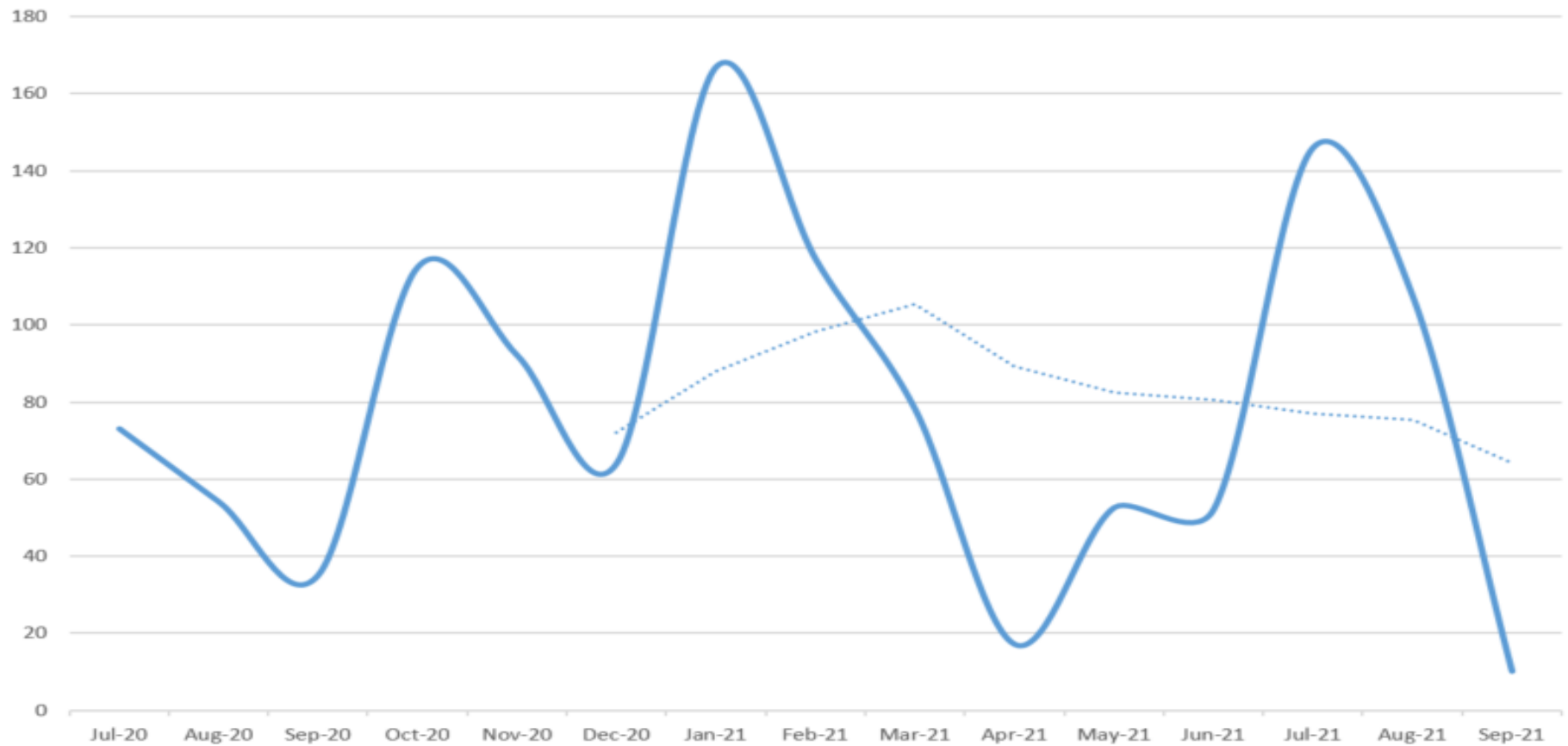
Type	2019	2020	2021 YTD
Trade Marks	31	42	35 (42)
Patents	4	7	14 (16)
<b>Total</b>	<b>35</b>	<b>49</b>	<b>49 (58)</b>

Average time to schedule hearing (months)

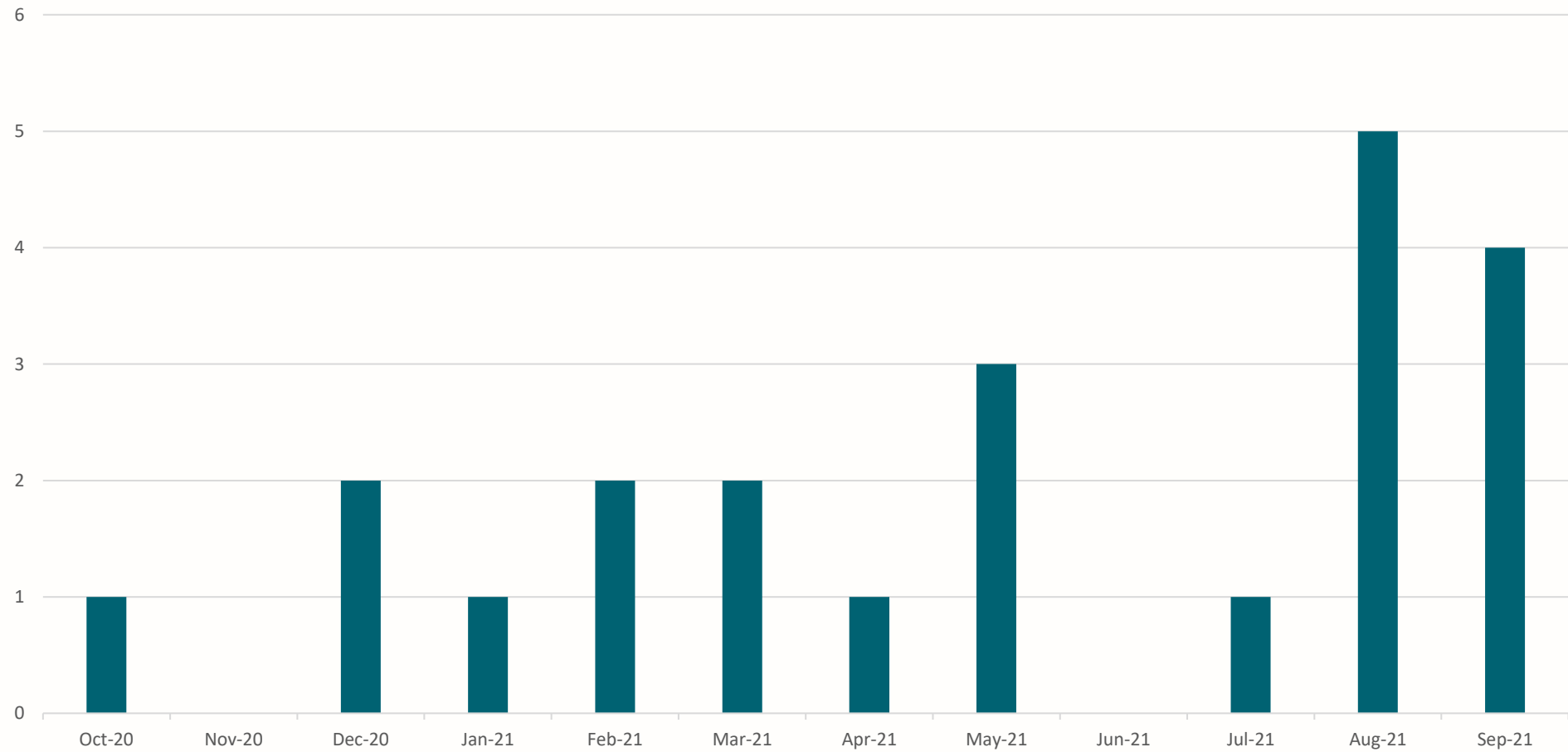


## Time to issue decision

Median time (working days) with 6 month moving average



### Cases awaiting decision by hearing date





**NEW ZEALAND  
INTELLECTUAL  
PROPERTY OFFICE**

# Hearings Technical Focus Group

**20 October 2021**



**MINISTRY OF BUSINESS,  
INNOVATION & EMPLOYMENT**  
HĪKINA WHAKATUTUKI

New Zealand Government

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## Trial of back-up fixtures to be heard at short notice

The trial of a shortlist for fixtures to be heard at short notice commenced in April 2021.

### Uptake of the trial

#### Trade Marks

There has been a small uptake of this initiative since the trial began with three proceedings placed on the list at the parties' request.

In five further proceedings, one party requested the matter be placed on the shortlist while the other party did not give their consent. In all of these proceedings the request to be placed on the shortlist was made by the applicant/owner and consent withheld by the opponent/applicant.

Seven papers proceedings have also been placed on the shortlist by the Office. We note that the hearing of these proceedings do not take priority over those which are on the shortlist at the parties request.

#### Patents

Two patent proceedings have been placed on the shortlist and are yet to be allocated fixture dates.

### Effectiveness of trial

The proceedings placed on the shortlist at the request of the parties have all been heard or had fixtures allocated. Details of these fixtures are as follows:

<b>Proceeding type</b>	<b>Date added to shortlist</b>	<b>How to be heard</b>	<b>Date heard</b>	<b>Time elapsed between placement on the shortlist and fixture date</b>
Invalidity (undefended)	22 April 2021	Applicant: written submissions	30 June 2021	2.2 months
Opposition	18 May 2021	Opponent: written subs Applicant: papers	14 July 2021	1.8 months
Opposition	21 June 2021	Opponent: appearing Applicant: papers	12 October 2021	3.6 months



In addition, a papers proceeding placed on the shortlist on 19 May 2021 at the initiative of the Office was heard on 30 June 2021.

The current median timeframe for a proceeding not placed on the shortlist to be heard is 10 months.

#### **Availability on shortlist**

The office notes that the upfront filing of submissions for proceedings placed on the shortlist in combination with the recent appointment of a fixed term Assistant Commission has enabled the expedited fixture dates.

Of the five hearings vacated since April 2021 the Office had notice of less than 20 working days. Shortlisted cases were unable to be allocated in these circumstances.

The Office was able to successfully allocate a hearing date for a shortlisted proceeding in the one instance where more than 20 working days' notice was provided.

#### **Extension of trial**

The trial for of back-up fixtures to be heard at short notice will be extended until **30 June 2022**.

## Update on electronic bundles at hearings

We recently started implementation of the use of electronic common bundles for some hearings.

### Requirement for a hard copy of the common bundle

At this point in time, whether a hard copy of the common bundle is required is at the Assistant Commissioner's discretion.

We have found that the more complex the case/the higher the volume of evidence, the more likely a hard copy of the common bundle will be required alongside the electronic version.

### Observations

We provide a brief update on some of our findings to date:

- When a hard copy of the common bundle is required, the volumes can be double sided.
- We reiterate the need for the common bundle to contain an index, be bookmarked and paginated. In relation to the bookmarks, all pleadings and evidence with each individual exhibit should be bookmarked. It is extremely time consuming for the Assistant Commissioners to navigate these documents when they are not bookmarked.
- For the electronic bundle, if one volume exceeds the size volume to be uploaded to the IPONZ case management system, then the bundle should be split into volumes and uploaded individually.
- It is not necessary for all evidence to go into the bundle, in particular, when there has been a large volume of evidence filed. Parties could consider putting the body of the statutory declaration or affidavit being referred to, but otherwise limit the common bundle to the exhibits, documents, or parts of documents that will be referred to and relied on.
- If possible, it would be preferable that the documents (including hearing submissions) be run through a program to make them text searchable. We understand that this will not work for all documents, particularly evidence, but doing so would allow Assistant Commissioners to search and/or copy and paste text from the hearing submissions and/or evidence.

### Feedback

The Office welcomes feedback from members regarding the use of electronic bundles, or any other tips and tricks which may be relevant.

## Requirements for statutory declarations witnessed overseas

The recent decisions of *Leiyang Zhu v Shanghai Yunzheng Catering Management Co Ltd* [2021] NZIPOTM 14 and *Zhengtao Jian v Pit Viper LLC* [2021] NZIPOTM 21 consider the legislative requirements for Statutory Declarations.

In particular, the decisions outline the information to be provided by witnesses of evidence declared in foreign jurisdictions, as well as who has authority to witness statutory declarations outside of New Zealand.

### Who can witness a statutory declaration?

A person who can witness a statutory declaration overseas differs depending on whether the document is declared in a Commonwealth country or not.

#### Statutory declarations declared in Commonwealth countries

A declaration made in a Commonwealth country other than New Zealand must be made before:<sup>1</sup>

- a Judge;
- a Commissioner of Oaths;
- a notary public, a Justice of the Peace; or
- any person authorised by the law of that country to administer an oath there for the purpose of a judicial proceeding, or before a Commonwealth representative, or before a solicitor of the High Court of New Zealand.

#### Statutory declarations declared in non-Commonwealth countries

A declaration made in a country other than a Commonwealth country must be made before:<sup>2</sup>

- a Commonwealth representative;
- a Judge;
- a notary public; or
- a solicitor of the High Court of New Zealand.

### Statement of position of person witnessing evidence should be provided

Further to the Assistant Commissioner's decision in *Leiyang Zhu v Shanghai Yunzheng Catering Management Co Ltd*<sup>3</sup> and the [IPONZ Practice guidelines on Evidence](#), the statement of position of the person witnessing the evidence should be provided.

The omission of this information will likely result in the evidence being deemed inadmissible by an Assistant Commissioner.

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<sup>1</sup> [s 11\(1\) Oaths and Declarations Act 1957.](#)

<sup>2</sup> [s 11\(2\) Oaths and Declarations Act 1957.](#)

<sup>3</sup> [2021] NZIPOTM 14 at [26]

### Office approach when reviewing evidence

As a courtesy, Hearings Case Officer's will raise potential defects in the witness attestation if they are identified. However, the onus remains on the filing party to ensure that the information provided in the evidence meets the legislative standard and is accurate.

Where a defect is raised by a Case Officer, the standard practice will be to halt the proceeding for one week to enable the issue to be resolved.

Acceptance of the evidence in the proceeding by a Case officer should not be taken as a determination of the admissibility of the evidence. Issues pertaining to the admissibility of evidence will be considered by an Assistant Commissioner at the substantive hearing.

Where a Case Officer has raised a potential defect with the witness attestation and the filing party chooses not to amend the evidence filed, the evidence will be accepted and the proceeding recommenced.

### *Appeal of Zhengtao Jian v Pit Viper LLC [2021] NZIPOTM 21*

A notice of appeal was filed with the High Court in relation to the *Pit Viper* decision on 17 September 2021. The appeal contests that the Assistant Commissioner erred in her decision that it was not fair and reasonable to allow Pit Viper LLC to amend the defect in its evidence.

The decision of the High Court may provide further clarification to IPONZ practice so we will be monitoring this outcome.

## Page limits for submissions filed in patent proceedings

Further to the action item raised at the previous Technical Focus Group, the Office has considered possible page limits for submissions filed in patent proceedings.

The purpose of introducing page limits, as required in other legal forums, is to encourage parties to file focused and relevant submissions. This ensures efficiency both for the Hearings Office and Counsel, which in turn reduces client costs.

### **Proposed page limits**

Upon review of the average length of submissions filed in patent proceedings this year, the Office proposes the following page limits for submissions:

Interlocutory hearings: 10 pages

Examination hearings: 20 pages

Revocation/Opposition/other proceedings: 50 pages

Despite the proposed page limits, Counsel may request a direction from the Assistant Commissioner hearing the proceeding to increase these limits in cases where this is likely to be required (i.e. due to the proceedings' complexity).

Exceeding these page limits without first obtaining such a direction from the Assistant Commissioner may result in increased costs against the filing party.

### **Feedback sought**

The Office seeks feedback from TFG members regarding the proposed page limits.