

IPTA

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Patents Act 2013

- Will come into force on 13 September 2014 (Saturday) so effective start date will be 15 September 2014

Patent Hearings – S 208

- **Hearing before exercise of Commissioner's discretion**
- (1) The Commissioner must not exercise any of the Commissioner's discretionary powers under this Act or any regulations adversely to any applicant or other party to a proceeding before the Commissioner without giving the person a reasonable opportunity of being heard in the prescribed manner.

Patent Oppositions

- Section 93 – Patent Oppositions
 - If the grant of a patent is opposed, the Commissioner must:
 - Give an opportunity to the parties to be heard before deciding the case; and
 - Consider whether any of the grounds are established on the ***balance of probabilities***
 - ***The standard of proof now codified***

More Power to the Commissioner

- In the case of an opposition under the new Act, the Commissioner can also take into account and decide a ground of opposition whether or not the ground has been relied upon by the opponent.
- The ground decided upon must be a ground under S92 (opposition grounds)

More Power to the Commissioner

- “The IPONZ hearing officers will consider the prior publication ground not pursued at the hearing. The reason for this is that the prior art in itself is evidence.”

– *personal communication Assistant Commissioner Popplewell*

Evidence before the Commissioner

209 How to give evidence to Commissioner in proceedings

- (1) **Evidence must be given by affidavit or statutory declaration** (unless the Commissioner directs otherwise)

- (2) However, the Commissioner may—
 - (a) **take oral evidence** instead of, or as well as, the affidavit or declaration; and
 - (b) **allow a witness to be cross-examined on the witness's affidavit, declaration, or oral evidence.**

- (3) The statutory declaration may be used before a court in any appeal instead of evidence by affidavit and, if used in this way, has all the same incidents and consequences as evidence by affidavit.

Evidence before the Commissioner

- **211 Issuing of summons by Commissioner**
- (1) The Commissioner may issue a summons to a person requiring that person to attend a hearing before the Commissioner and to do all or any of the following matters:
 - (a) give evidence;
 - (b) give evidence under oath;
 - (c) produce documents, things, or information, or any specified documents, things, or information, in the possession or control of that person that are relevant to the hearing.

Evidence before the Commissioner

- On the whole the evidence prepared is “generally pretty good”

*personal communication Assistant Commissioner
Popplewell*

Other powers of Commissioner

- Commissioner may award costs – section 212
- Commissioner may require security for costs – section 213

Regulations – what will they bring?

Objectives are:

- a That the regulations around proceedings are simple and transparent for parties
- b Proceedings in the Hearings Office run smoothly and efficiently
- c That the hearing process is fair to all
- d That the regulations provide sufficient powers
- e That timeframes are set appropriately

Regulations – what will they bring?

A case management system (CMS)

- the patent CMS will most likely be equivalent to that seen with the case management system that applies for trade marks

The CMS gives the Commissioner the ability to set a timetable and even set a hearing date

Regulations – what will they bring?

Procedure timeframes

It is recognised that the evidential steps in patent proceedings are more demanding than the timeframes for trademark matters, so it is proposed that the periods for evidential steps in patent proceedings be extended as follows:

Regulations – what will they bring?

	1954 Regulations	Proposed
Initiating party's evidence in chief	2 months from filing Counterstatement	4 months from filing Counterstatement
Respondents evidence in chief	2 months from initiating party's evidence in chief	4 months from initiating party's evidence in chief
Evidence strictly in reply	2 months from respondent's evidence in chief	3 months from respondent's evidence in chief

Extensions – what is proposed?

- Procedure timeframes can usually be extended, but because of the extended periods above it is likely that the extension of time provisions will be tightened.
- Notwithstanding the likely tightening for access to extensions, they will still be available for up to three months in “reasonable” circumstances and thereafter in “exceptional” circumstances.

Regulations –what will they bring?

- The Commissioner will still have the power under the Case Management System to halt the proceedings, where, for example, the parties are in settlement negotiations
- The Commissioner will also have the power to request better and clearer particulars, so the other side knows the case against them

Regulations –what will they bring?

- The original discussion document released by IPONZ stated that the Commissioner will be empowered to “require parties to use best endeavours to agree on the handling of confidential information”
- *“It is hoped the new regulations will provide the Commissioner with the power to make appropriate directions as to how confidential information is to be treated, if the parties themselves cannot agree on a confidentiality regime.”* NZLS submission

Regulations –what will they bring?

- It is expected that a case management conference will be called when the evidence is complete
 - Define the grounds that will be relied upon by the opponent
 - Specify dates for exchange of submissions (probably sequential exchange – cf HCR)
 - To deal with any challenges to admissibility of evidence
 - Allocation of a hearing date

New Practice Guidelines

- As noted by the IP committee of the NZLS, the finer detail around the Case Management System, such as pre-hearing conferences to whittle down proceedings and prior art, exchange of submissions and scheduling will be best dealt with by clear practice guidelines.
- The hearings office plans to take up the offer made by NZLS to work with them to develop these practice guidelines. It is expected that IPONZ will also work with the patent technical focus group in developing these guidelines.

New Cost Guidelines

- The hearings office also plans to introduce new cost guidelines
- These cost guidelines will include implications for parties who abandon grounds, or prior art at the substantive hearing, having put the other side to the expense of preparing evidence to defend it.
- It is also expected that the scale of costs will be updated.

New Assistant Commissioners

- The hearings office plans to recruit more assistant commissioners
- It is hoped that the assistant commissioners will hear both trade mark and patent cases
- IPONZ hopes that the new case management system will allow them to stay on top of their workload

Hearing format

Hearings have become less formal (the “Australians are not as formal” – Assistant Commissioner Popplewell)

Used to be a type of court room layout. Now it is more of a meeting around a table layout.

The proceeding of the hearing is still formal.

The opponent leads off followed by the applicant and then the opponent strictly in reply. On rare occasions (usually when opponent leads evidence not strictly in reply) the applicant will get a further opportunity to follow up.

Hearing format

- Interjections are permitted as long as reasonable and are on point
- Clients are welcome to attend the hearing
- Cross-examination of witnesses occurs occasionally, typically only for grounds like “obtaining”
- Cross-examination will be approved ahead of the hearing and the Commissioner will usually subpoena/summon the witness

Things to avoid – part 1

- Raising new issues at the hearing – springing surprises on the other side
- Providing written submissions to the other side and hearing officer the night before the hearing
- Amendments – there is a tendency to leave the introduction of these too late

- *personal communication Assistant Commissioner Popplewell*

Things to avoid – part 2

Bringing in evidence that is not strictly in reply (one hearing on the substantive matters of an opposition that was set down for 2 days was postponed after 2 hours because the evidence that had been filed only days before the hearing was not strictly in reply)

IPONZ perhaps has a role to play in ensuring evidence is strictly in reply.

personal communication Assistant Commissioner Popplewell

Things to avoid – part 3

- It is important that the Statement of Case should include enough information to make sure you don't have a problem with “new issues” being raised later on.

personal communication Assistant Commissioner Popplewell

Thank you

- Acknowledgements
- Simon Pope – IPONZ hearings officer manager
- Bruce Popplewell – Assistant Commissioner of Patents

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