

Locutus

THE NEWSLETTER OF INTELLECTUAL PROPERTY LAW, STATUTORY DECEPTIVE
CONDUCT AND FRANCHISING LAW.

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Welcome to Locutus

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Locutus is a newsletter of current news, recent cases, and practice decisions.

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TS Production LLC v Drew Pictures Pty Ltd [2008] FCA 1110

Issue: The most appropriate forum to determine issue of copyright infringement in a film. Held: Given the first publication of the Film in the United States, the substantial exploitation of the Film in that country, that United States law clearly provides for joint ownership of copyright in motion pictures, that the declarations sought by the plaintiffs are available under United States law, and that that law governs ownership and infringement issues, the United States court is the most obvious and natural form in which to litigate the claims. Great importance attached to the fact that United States law will apply to the ownership as well as the infringement and relief issues.

PATENTS

Austal Shipping Sales Pty Ltd v Stena Rederi Aktiebolag [2008] FCAFC 12

Issue: whether use of “substantial portion” and “narrow waisted bulb” invalidated the patent because of lack of clarity.

IGT v Aristocrat Technologies Australia [2008] FCA 994

Issue: invalidity claim. Appeal allowed.

Sherman v Commissioner of Patents [2008] FCA 1026

The applicant appealed from the decision of the delegate under s 60(4) of the Patents Act.

Issue: Commissioner submitted that in an appeal to the Federal Court under s 60(4) of the *Patents Act*, the Act permitted all of the material which had been before the delegate in the opposition hearing to be tendered as evidence without reference to restrictions that might otherwise have been imposed by the *Evidence Act*. Alternatively, the Commissioner sought a direction pursuant to s 190(3) of the *Evidence Act* that the provisions of that Act relied upon by the applicant not apply on the ground that the application of those provisions would cause or involve unnecessary expense or delay. The Commissioner relied also upon ss 60 and 75 of the *Evidence Act* in response to the applicant's reliance upon s 59.

Commissioner's submission that the provisions of the *Evidence Act* do not apply in relation to material that was before the delegate rejected by the court. The admission of that evidence is regulated by the *Evidence Act* in the normal way.

Occupational and Medical Innovations Ltd ACN 091 192 871 v Retractable Technologies Inc [2008] FCA 1102

Issue: interpretation of sections 124 – 127 of the *Patents Act 1990* dealing with applications for non-infringement declarations.

TRADE PRACTICES ACT 1974 (CTH)

Golden Sands Pty Ltd v Excel Quarries Pty Ltd & Anor [2008] VSC 276 (25 July 2008)

Issue: Whether failure to disclose existence and contents of certain expert reports misleading or deceptive conduct.

PRACTICE & PROCEDURE

Aussie Traveller Pty Ltd v Fiamma SPA [2008] FCA 1080

Issue: application for leave to serve originating process outside Australia [O8 r2]. Claim of patent infringement by exportation into Australia. Existence of a prima facie case: held Court must have material before it from which inferences are open and which, if translated into findings of fact, would support the relief claimed: see [12].

Walker v Body Logic Resources Pty Ltd [2008] FCA 1086

Issue: security for costs where applicant resident outside Australia: section 56 and O28 r3. Security granted.

O'Sullivan v Parkin [2008] FCAFC 134

Issue: nature of discovery, "fishing": O15 r8.

Optiver Australia Pty Ltd v Tibra Trading Pty Ltd [2008] FCAFC 133

Issue: Preliminary discovery: O 15A r6.

Former employees set up rival business. Applicant believed that they were using applicant's software in their new business. At first instance held that applicant had reasonable cause to believe that it may have a right to obtain relief but requirements of Order 15A r 6 not satisfied because applicant had enough information for it to plead its case. Leave to appeal granted and appeal allowed. Court applied *St George Bank Ltd v Rabo Australia Ltd* (2004) 211 ALR 147 at [26] where it was held that the right question is whether the applicant has enough information to allow it to make a decision as to whether to commence proceedings (including on considerations of costs and risk).

Alphapharm Pty Ltd v H Lundbeck A/S (No 2) [2008] FCA 1036

Issue: meaning of "costs following the event". Costs order made on a broad issues basis, but "event" in each proceeding taken into account.

Held: Section 43 of the *Federal Court of Australia Act 1976* (Cth) gives the Court a broad discretion to award costs. In *Hughes v Western Australian Cricket Association (Inc)* (1986) ATPR 40-748, Toohey J stated (at 2):

- a) Ordinarily, costs follow the event and a successful litigant receives his costs in the absence of special circumstances justifying some other order: *Ritter v. Godfrey* (1920) 2 K.B. 47.
- b) Where a litigant has succeeded only upon a portion of his claim, the circumstances may make it reasonable that he bear the expense of litigating that portion upon which he has failed: *Forster v. Farquhar* (1893) 1 Q.B. 564.
- c) A successful party who has failed on certain issues may not only be deprived of the costs of those issues but may be ordered as well to pay the other party's costs of them. In this sense, "issue" does not mean a precise issue in the technical pleading sense but any disputed question of fact or of law: *Cretazzo v. Lombardi* (1975) 13 S.A.S.R. 4 at 12.
- d) Even if "the event" is easily identified, it will not always be just that costs follow the event: see *Bowen Investments Pty Ltd v Tabcorp Holdings Ltd* (No 2) [2008] FCAFC 107. The notion of costs following the event is not straightforward in the present case.

And finally...

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