

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. It is authored by Carmen Champion Barrister-at-Law.

Past issues of LOCUTUS can now be accessed via www.fourstjames.com.au

NEXT SEMINAR: 16 September 2008

SEMINAR for in-house legal counsel and potential litigants.

FB Rice & Co, Patent & Trade Mark Attorneys and the members of Level 4, St James' Hall Chambers have organized a seminar to be held at 5.15pm on Tuesday, 16 September 2008.

The topic is “**There are ways to contain the cost of litigation! (or how to avoid being charged \$17,000 for yellow post-it notes)**”.

The speakers are Carmen Champion, Barrister and Janet McDonald, Barrister & Cost Consultant. The seminar will consider how litigation costs can be contained by the client, the right of the client to challenge the fees charged by its solicitor, and the costs that a client is entitled to recover if successful.

Persons wishing to attend need to notify David at clerk.4@stjames.net.au by 9 September 2008.

FRANCHISING

MASTER EDUCATION SERVICES PTY LIMITED v JEAN FLORENCE KETCHELL

HCA 27 August 2008.

The Court unanimously allowed the appeal. It held:

- a) That while failure to comply with clause 11(1) was a contravention of section 51AD of the *Trade Practices Act 1974 (Cth)* it did not result in the contract being void and unenforceable;
- b) The prohibition in section 51AD was directed to securing compliance by franchisors with industry codes and the consequence of contravention was the grant of remedies provided in Part VI of the *Trade Practices Act 1974 (Cth)*.

PATENTS

***Insta Image Pty Ltd v KD Kanopy Australasia Pty Ltd* [2008] FCAFC 1**

Matter of Interest: appellants contended that prior use of the invention included its use at motor-cross races. Discussion of meaning of “publicly available” at [121] – [126].

Held: invention had been made "publicly available" as required by s 7(1) of the *Patents Act 1990 (Cth)* at the race meetings.

DESIGNS

***Chiropedic Bedding Pty Ltd v Radburg Pty Ltd* [2008] FCAFC 142**

Issue: Court concerned with claim that design registration invalid for lack of novelty because mattress exhibited at furniture fair held in Melbourne. Consideration of section 47 of the *Designs Act 1906 (Cth)* which provides an exception for designs exhibited at certain exhibitions.

The appeal was allowed, the full court holding that the trial judge had erred in concluding that the fair was not an ‘official’ exhibition or an ‘international’ exhibition and therefore depriving the design of novelty.

CONFIDENTIAL INFORMATION

***Canterbury-Hurlstone Park RSL Club Ltd v Roberts* [2008] NSWSC 845**

Issue: Whether former director had disclosed confidential information about Board room deliberations – whether director refused to give undertakings not to disclose further – whether proceedings for injunction justified.

***Think Global Recruitment Ltd v Moultrie* [2008] NSWSC 869**

Application for interlocutory relief based on restraint clause relating to confidential information. Former employees joined competing recruitment company. Evidence that alleged confidential information publicly available. Clear breach of other restraints. Interlocutory relief refused because of issue of validity of restraints.

TRADE MARKS

***Neumann v Sons of the Desert SL* [2008] FCA 1183 (**

Appeal from a decision of a delegate of the Registrar of Trade Marks which dismissed an application opposing registration of a trade mark. The Delegate ruled that all evidence on behalf of the opponent as to oral or implied agreements governing joint ownership of the trade marks was irrelevant and inadmissible parol evidence because the August 2002 agreements were intended to be entire contracts that governed the ownership of trade marks by the parties and provided for joint ownership only of trade marks in Spain and the European Community. He, accordingly, held that there was no agreement, express or implied, in evidence as to the worldwide ownership of the opposed mark and dismissed the applicant’s opposition to the registration.

Held: appeal upheld.

See also for discussion of meaning of ‘contrary to law’ at [31] – [34] and the finding that the Delegate erred in relying on statements not in the form of declarations. The court stated:

“The Registrar is not bound by the rules of evidence but may inform himself or herself on any matter that is before him or her in any way that the Registrar reasonably believes to be appropriate.’... I agree with the applicant’s contention that the Delegate erred in relying upon that regulation to admit statements that were not in the form of declarations. Indeed, reg 21.17(1) expressly requires that ‘Evidence that is given in writing in any proceedings before the Registrar must be in the form of a declaration.’

TRADE MARK OPPOSITIONS/NON – USE APPLICATIONS

The Mentholatum Company v Innoxia Marks Limited [2008] ATMO 61 (13 July 2008)

This decision points to the importance of:

- a) Knowing the provision/s of the Trade Marks Act one is relying on;
- b) Referring to all possible grounds available to one. The judgement as to what ground or grounds to pursue should be made after all the evidence has been filed and served; and
- c) Reviewing the notice/application filed by the other side from the perspective of adding as a ground of opposition or ground of complaint the fact of non compliance with the Trade Mark Regulations.

COPYRIGHT

***Copyright Agency Limited v State of New South Wales* [2008] HCA 35**

Issue: whether the Full Court erred in finding that the State had a licence to reproduce certain survey plans and to communicate them to the public, independently of s 183 of the *Copyright Act 1968 (Cth)*. The issue was limited to the copying of registered survey plans and the terms upon which they may be communicated to the public. Uses made of the survey plans which are antecedent to the two uses in question were not the subject of any claim for remuneration or for the fixing of terms. The antecedent dealings were described as the dating and sealing of the plans and their registration.

CAL contended that s 183 is a statutory licence scheme leaving no room for the implication of a licence to copy the plans, or communicate them to the public.

The State submitted that, in the circumstances described above, it is not dependent on s 183 to except it from infringement because it has an implied licence, binding on the owners of copyright in the plans, to do everything that it is required to do under the statutory and regulatory framework which governs such plans. Implicit in the argument was the proposition that the State has free use of the plans under that implied licence.

The appeal was allowed.

And finally...

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