



INTELLECTUAL PROPERTY PRACTICE NOTE (IP-1)

National Practice Area Practice Note

1. INTRODUCTION

1.1 This practice note sets out arrangements for the management of intellectual property cases within the National Court Framework (“NCF”). It:

- (a) is to be read together with the:
 - Central Practice Note (CPN-1), which sets out the fundamental principles concerning the NCF of the Federal Court and key principles of case management procedure. The Central Practice note is an essential guide to practice in this Court in all proceedings; and
 - *Federal Court of Australia Act 1976* (Cth) (“**Federal Court Act**”) and the *Federal Court Rules 2011* (Cth) (“**Federal Court Rules**”), including Division 34.3 of the Federal Court Rules;
- (b) takes effect from the date it is issued and, to the extent practicable, applies to proceedings whether filed before, or after, the date of issuing;
- (c) is intended to set out guiding principles for the conduct of these proceedings but is not intended to be inflexibly applied; and
- (d) applies to all intellectual property matters. However, practitioners should also familiarise themselves with general practice notes that operate across National Practice Areas (“NPAs”) and may apply to this NPA. See the further practice information listed at Part 13 of this practice note.

2. OVERVIEW AND DEFINITION

2.1 The Intellectual Property NPA and its Sub-areas of Patents and Associated Statutes, Trade Marks and Copyright and Industrial Design, comprises any proceeding relating to:

- a patent granted under the *Patents Act 1990* (Cth) (“**Patents Act**”);
- a trade mark registered under the *Trade Marks Act 1995* (Cth);
- copyright under the *Copyright Act 1968* (Cth);
- a registered design / design under: the *Designs Act 2003* (Cth), the *Advance Australia Logo Protection Act 1984* (Cth), or the *Olympic Insignia Protection Act 1987* (Cth);
- eligible layout rights under the *Circuits Layout Act 1989* (Cth);
- plant breeders’ rights under the *Plant Breeder’s Rights Act 1994* (Cth);

- a geographical indication or other term registered under the *Wine Australia Act 2013* (Cth); and
 - other proceedings under those statutes.
- 2.2 In an appropriate case, a proceeding under the *Administrative Decisions (Judicial Review) Act 1977* (Cth) and the *Judiciary Act 1903* (Cth) that relates to a decision made under any of the above legislation or associated regulations may be allocated to the Intellectual Property NPA.
- 2.3 The Intellectual Property NPA also includes any proceeding for the tort of passing off or any analogous claim for false or misleading conduct under the Australian Consumer Law or like legislation involving intellectual property matters. However, not all proceedings involving passing off or misleading conduct claims and the like will necessarily be allocated to this NPA. A proceeding may be more appropriately allocated to another NPA (such as the Commercial and Corporations NPA) because of the substantive issues in the proceeding.
- 2.4 A description of the nature of each Intellectual Property NPA Sub-area is available on the Court's website. The judges dealing with the work in the Sub-areas are listed on the Court's website.

3. URGENT APPLICATIONS

- 3.1 Parties and their representatives should familiarise themselves with the information regarding urgent originating and interlocutory applications in the Central Practice Note.

Urgent Originating Applications

- 3.2 In each registry there will be a designated General Duty Judge to whom urgent applications will be referred. If an urgent application is brought related to the Intellectual Property NPA and the General Duty Judge is not an Intellectual Property NPA Judge, the Court will arrange, where appropriate, to have the urgent application referred to an Intellectual Property NPA Judge.

Urgent Interlocutory Applications

- 3.3 Urgent (and non-urgent) interlocutory applications should be brought to the attention of the docket judge (or the provisional docket judge / list judge as the case may be) who has the responsibility for hearing or case managing the proceeding at the time of the filing of the interlocutory application.
- 3.4 If, after approaching the chambers of the docket judge, it is clear that the docket judge is uncontactable or otherwise clearly unavailable to hear the urgent interlocutory application within the timeframes relevant to that application (eg. the judge is on extended leave and the matter requires immediate attention), then the urgent interlocutory application should be brought to the immediate attention of the relevant duty judge in the same manner as with urgent originating applications.

3.5 Contact information for applications to the General Duty Judges is available on the Court’s website from the [Daily Court List webpage](#) and the [Duty Judge Contact webpage](#).

4. COMMENCING PROCEEDINGS

4.1 Subject to the matters set out in the [Central Practice Note](#) and clarified below, the [Federal Court Rules](#) and forms apply to the commencement of proceedings in this NPA.

4.2 Parties should consider whether the flexible procedures for the commencement of proceedings or the filing of tailored pleading material set out in the [Commercial and Corporations Practice Note \(C&C-1\)](#) may be appropriate to utilise in proceedings in this NPA, including the “concise statement” method of commencing proceedings (see generally [Parts 6 and 8 of the Central Practice Note](#) and [Parts 5 and 8 of the Commercial and Corporations Practice Note](#)).

4.3 When commencing proceedings in this NPA the applicant / appellant should ensure that, in addition to any material required to be filed by the [Federal Court Rules](#), and at least 7 days prior to the first case management hearing (or earlier if the docket judge so requires), copies of the following documents are filed and served:

- any patent upon which the applicant sues;
- any trade mark registration or certificate of registered design upon which the applicant sues;
- any patent application which is the subject of the appeal;
- any application for a registered trade mark or application for a registered design that is the subject of the appeal;
- any written record of the decision (including any reasons) the subject of the appeal.

Request for Expedition (previously “Fast Track”)

4.4 As noted in the [Central Practice Note](#), where it is appropriate to do so, parties may seek an expedited or truncated hearing process and a tailored or concise pleading process in any proceeding.

4.5 The former Fast Track mechanisms permitted parties to seek a quicker or truncated hearing process than usually available and to use more informal pleadings than usual. The Fast Track procedure, or other effective and commercially sensible methods of commencing or expediting a proceeding or introducing informal pleadings processes, remain open to the parties in this NPA.

4.6 If a Fast Track or other expedited proceeding process is appropriate, the Court will attempt to provide a judge who has the necessary time available to devote to an expedited process and hearing. The parties should make plain at the time of filing any request for a truly expedited procedure and hearing.

4.7 The parties should otherwise make plain at the first case management hearing any request for an informal or abbreviated pleadings process. With respect to the first case management hearing see paragraphs 5.4 and 5.5 below.

5. CASE MANAGEMENT – GENERALLY

5.1 Parties and their representatives should familiarise themselves with the guiding case management information set out in Part 8 of the Central Practice Note. This practice note should always be read with the Central Practice Note.

5.2 Case management will have a strong emphasis on the quick, efficient and as inexpensive as practicable disposition of each matter (see Parts 7 and 8 of the Central Practice Note). The key objective of case management is to reduce costs and delay so that there is/are:

- fewer issues in contest;
- effective use of expert evidence;
- in relation to those issues, no greater factual investigation than justice requires; and
- as few interlocutory applications as necessary for the just and efficient disposition of matters.

5.3 The Court recognises that proceedings in this NPA will vary in complexity and that there may need to be different approaches applied to case management, alternative dispute resolution and costs.

Case Management Hearings

5.4 Case management hearings are integral to case management. The aim of case management hearings is to identify the genuine issues in dispute between the parties at the earliest possible stage. At the first case management hearing, the parties should address, and the Court will consider, the following:

- (a) the Case Management Imperatives as set out in paragraph 8.5 of the Central Practice Note;
- (b) whether all appropriate parties have been joined and whether any cross-claim is to be made;
- (c) the appropriate directions for the further identification of the factual and legal disputes, if necessary;
- (d) in patent proceedings, whether the patentee intends to apply to amend the patent and the way in which experts are introduced to the patent and the prior art. Additionally, whether, given the nature of the relevant technology, it requires a tutorial and if so, whether the tutorial should be by way of a primer (see paragraph 6.6 and following below), expert written evidence, or a tutorial at the commencement of the proceeding;

- (e) in trade mark proceedings, whether survey evidence will be sought to be adduced;
- (f) in copyright proceedings, whether subsistence and/or ownership of the copyright is disputed; and
- (g) questions arising relevant to the particular proceeding in the Sub-area case management sections set out in Parts 6 and 7 of this practice note.

5.5 The parties' legal representatives will be expected to attend a case management hearing soon after the filing of the originating application and be in a position to assist the Court in achieving the overarching purpose by, in particular, identifying the real issues in dispute, and formulating pre-trial steps that will enable those issues to be determined efficiently and economically.

6. CASE MANAGEMENT – PATENTS

Approach to Case Management

- 6.1 Patent litigation often gives rise to complex scientific or technical issues and proceedings involving such issues may require intensive case management to ensure that the proceeding is conducted efficiently and not complicated by irrelevant or academic issues or unnecessary evidence with respect to matters that are, or should be, agreed and which cannot be expected to influence the resolution of the real issues in dispute.
- 6.2 The Court will seek to employ procedures or steps that obviate the need for potentially wasteful steps in attempting to prove a party's case. For example, although in some cases there may be no alternative to carrying out experiments directed to establishing whether an invention as claimed is infringed by an accused product, method or process, or whether an invention, as claimed, has been anticipated by a disclosure made in a prior art document or by a prior art act, in many cases alternative procedures or steps will be available.
- 6.3 For instance, if experiments or other technical or scientific investigations have been carried out and have been used or are intended to be used in other proceedings in other jurisdictions where corresponding claims in corresponding patent specifications are in suit, the Court should be informed of this fact with a view to exploring the ways in which those experiments or other investigations can be used in the proceeding before the Court to avoid unnecessary duplication.
- 6.4 There are also provisions of the *Evidence Act 1995* (Cth) ("**Evidence Act**") that may be particularly useful in a proceeding that involves technical issues including s 190 (waiver of the rules of evidence) and s 192A (advance rulings and findings).
- 6.5 The parties are also expected to have an understanding of the particular provisions of the *Patents Act* that apply having regard to any applicable transitional provisions in the *Patents Act* or any amending Act (eg. the *Intellectual Property Laws Amendment (Raising the Bar) Act 2012* (Cth)).

Agreed Primer

- 6.6 In an appropriate case, the Court will order that the parties produce an agreed primer explaining the technical background to the invention claimed in the specification in suit.
- 6.7 The purpose of the primer is not only to inform the Court of the relevant technical background and to place it in the position of the person skilled in the art at relevant times, but also to focus the attention of the parties on those questions and issues that are truly contentious so that the parties' preparation of evidence can be directed to those questions and issues alone. In this way, the preparation of evidence can be streamlined so as to focus on matters in dispute and to avoid prolix and otherwise unnecessary evidence. This approach should also provide savings in terms of ultimate legal costs and court hearing time at trial.
- 6.8 It is desirable that the primer be produced at an early stage of the proceeding and be of a scope that informs all technical questions that are to be raised, whether those questions relate to the infringement or the validity of the claims in suit. The primer should be expressed in language that explains this background as simply as the circumstances of the case permit. It may be that, because of the scope or complexity of the technical background, or for other acceptable reasons, the primer will require amendment from time to time and/or cannot be completed until expert evidence has been filed. However, in an appropriate case, the parties may be required to produce the primer, or a considered draft thereof, before the filing of expert evidence so that the objectives referred to in paragraph 6.7 can be achieved.
- 6.9 The primer should also include an agreed description of the common general knowledge at the relevant priority date(s). Where there are contentious facts, they should be identified and the differences between the parties fairly and succinctly explained so that findings, as necessary, can be made at trial.
- 6.10 In the normal case, the Court would not expect any explanation of the relevant technical background to involve contentious facts. If, however, there are contentious facts, those facts should be identified and the differences between the parties fairly and succinctly explained so that findings, as necessary, can be made at trial.

Agreed Glossary of Key Terms

- 6.11 In an appropriate case, it may also be desirable for the parties to prepare, either as a separate document or as part of the agreed primer, an agreed glossary of key technical terms.

Parties' Position Statements on Infringement

- 6.12 In an appropriate case, a party who alleges patent infringement may be required to provide a "Position Statement on Infringement" which concisely states the facts and matters relied upon in support of such an allegation, including by reference to the particular integers of any claim alleged to have been infringed.

6.13 Similarly, a party who is alleged to have infringed a patent may be required to provide a Position Statement on Infringement which concisely states the facts and matters relied upon in answer to the allegation of infringement, including whether it involves a legal question (eg. where there is an issue as to the proper construction of a claim) or a factual question (eg. whether a product or process is within a claim properly construed). In most cases, it will not be acceptable for a respondent who is already apprised of the applicant's case, merely to assert that the applicant is "put to proof" in the absence of a clear articulation by the respondent of why it says it does not infringe.

Description of Product, Method or Process

6.14 Further, where infringement is in issue, the parties should consider whether the alleged infringing party should provide a product description, or method or process description, in respect of the accused product or the accused method or process, so as to avoid the need for experiments or other scientific or technical investigations and/or to obviate or minimise the scope of any application for discovery.

6.15 Such a description, if appropriate, must be unambiguous in its terms and sufficiently detailed so as to properly address the allegations pleaded by the opposing party or parties. The description must be verified by a person who is personally acquainted with the facts to which the description relates and contain an acknowledgement that it is a true and complete description of the product or the method or process in question. The verification should also contain an acknowledgement by the person involved that he or she may be required to attend Court in order to be cross-examined on the contents of the description. Further, the party providing the description may be required to prove it at trial.

6.16 Alternatively, the Court may require the alleged infringing party, in an appropriate case, and where the party has the means of knowledge available to it, to file a precise and sufficiently detailed statement identifying the respects in which, and stating the reasons why, according to that party, the accused product or the accused method or process does not infringe the invention as claimed.

Agreed Statement or Table

6.17 The Court may also require the parties to file an agreed statement or table ("**table**") that delineates the scope of the dispute with respect to the infringement and/or validity of the claims in issue, especially if there is a large number of such claims.

6.18 Such a table should clearly indicate what implications a holding in relation to one claim has for any other claims that are in issue. For example, the respondent may accept that if claim 1 is infringed, then some or all other claims will also be infringed and, if so, the table should make this clear.

6.19 In relation to validity, the table should also indicate whether, and to what extent, the applicant and/or the respondent accept that the validity of some or all dependent claims will turn on the decision given in relation to the independent claims. Of course, the position will often vary depending on what ground of invalidity is asserted (eg. lack of novelty as

opposed to obviousness) but this is a matter that should also be made apparent from the table.

Validity

- 6.20 In cases in which the validity of a patent claim is in issue the Court will expect to be informed at an early stage of the proceeding whether there is any dispute in relation to the priority date of any claim. In particular, the Court may wish to know on what basis it is contended that a claim is or is not (as the case may be) entitled to the priority date asserted by the patentee and what implications a deferral of the asserted priority date has for the validity of the claim.
- 6.21 In cases in which it is contended that a claim of a patent is invalid for lack of inventive step the patentee may wish to rely on “secondary indicia” of inventiveness (eg. commercial success). If the patentee seeks to rely upon “secondary indicia” of inventiveness it should inform the Court of that fact at the earliest opportunity. The Court may require that relevant facts or matters be pleaded or particularised so that the other party is provided with an adequate opportunity to address the issue by evidence.
- 6.22 Where a party alleges that an invention as claimed is not novel by reason of a prior documentary disclosure, the party must only rely on those documents which, after due consideration, can properly be advanced as novelty-destroying disclosures. In most cases this could not be done without a party’s legal representatives having first undertaken an analysis of the claims in suit and any prior disclosure which is said to be novelty-destroying.
- 6.23 In an appropriate case, the Court may require a party who asserts that a claim is invalid for lack of novelty to file and serve a statement or table that includes an analysis that identifies the relevant parts of any documentary disclosure relied upon by the party and/or which identifies (by reference to the integers of the claim in suit) those parts of the documentary disclosure or, in the case of a non-documentary disclosure, those parts of any apparatus or other physical object, which are relied upon.
- 6.24 The parties should agree on a paginated bundle of the relevant prior art documents to which their evidence can then be directed without annexing or exhibiting the documents to the witnesses’ affidavits or statements.

Appointment of Court Expert, Referee or Assessor

- 6.25 Where infringement is in issue, the parties should also give consideration to the possibility of applying to the Court for the appointment of a Court expert pursuant to Part 23 of the Federal Court Rules, a referee pursuant to s 54A of the Federal Court Act, or an assessor pursuant to s 217 of the Patents Act. Appointment of a Court expert pursuant to Part 23 or a referee pursuant to s 54A may be particularly apt in cases raising questions requiring scientific testing or analysis of products or processes (eg. if there is an issue as to whether the accused product has the physical properties, dimensions or other characteristics required by a claim).

7. CASE MANAGEMENT – TRADE MARK, COPYRIGHT AND INDUSTRIAL DESIGN CASES

- 7.1 In the normal case, a proceeding for trade mark infringement, copyright infringement or registered design infringement should not require intensive case management. In most cases there will not be any need for discovery except where it directly relates to proof of copying, knowledge or intention by or on the part of the party alleged to have infringed or other specific topics directly relevant to an issue in the proceeding. However, the Court is unlikely to make an order requiring extensive discovery unless satisfied that it is necessary for the just disposition of the proceeding.
- 7.2 In some cases (eg. passing off) it may be necessary for a party to establish that it has a reputation in a name, mark or get-up (including at a particular date). This can give rise to significant expense and delay if a party chooses and/or is required to prepare voluminous reputation evidence without adequately exploring other ways of proving the relevant reputation in a more efficient and less costly way (see for example, ss 50, 190 or 191 of the Evidence Act).
- 7.3 Discovery of documents relevant to reputation will in most cases be unnecessary. In cases where an order for limited discovery of documents relevant to reputation may be justified, usually it will not be appropriate to seek such an order until after the filing of written evidence.

8. ALTERNATIVE DISPUTE RESOLUTION

- 8.1 The Court expects that parties will always seek an early resolution of the proceeding and that they will consider the alternative dispute resolution (“ADR”) options available under relevant provisions of Part VI of the Federal Court Act and Part 28 of the Federal Court Rules, including mediation. Parties should be familiar with those provisions and the guiding ADR information set out in Part 9 of the Central Practice Note.
- 8.2 The thoughtful and creative use of ADR techniques (including confidential conferences) for both substantive and procedural issues should be recognised by the parties as potentially very important in resolving or streamlining the running of intellectual property cases.
- 8.3 The Court may refer a matter to mediation at any stage of a proceeding with a view to resolving the entire proceeding or particular issues that have arisen in the proceeding. This includes referral to a registrar with specialist skills acting as mediator. The Court expects the parties to consider what orders may be made by the Court at the case management hearing to facilitate effective ADR processes, including the exchange of without prejudice material, targeted brief discovery and other relevant information.

9. DISCOVERY

- 9.1 To the extent that discovery may be necessary within this NPA, parties should consider any matters set out earlier in this practice note concerning discovery and the guiding discovery information set out in Part 10 of the Central Practice Note before making any request for discovery.

10. EVIDENCE AND WITNESSES

10.1 The management of lay and expert evidence is particularly important for the effective case management of intellectual property proceedings. Parties and their lawyers should be familiar with the guiding evidence and witness information set out in Part 11 of the Central Practice Note.

Expert Evidence

10.2 Parties intending to rely on expert evidence at trial are expected to consider between them and inform the Court at the earliest opportunity of the best way to efficiently manage and adduce expert evidence, including such matters as the use of joint-reports, concurrent evidence, and how evidence may best be given (orally or in writing) and so on.

10.3 Detailed guidance on these matters, including guidelines for expert witnesses, is set out in the Expert Evidence Practice Note (GPN-EXPT) with which parties should be familiar.

Survey Evidence

10.4 The admissibility of surveys is always a matter for the judge to determine.

10.5 When inappropriately prepared or managed, the use of surveys can be a burdensome and costly process for the parties and the Court and may be of questionable utility in proving an applicant's claim.

10.6 Parties and their lawyers should take particular note of the requirements and information set out in the Survey Evidence Practice Note (GPB-SURV) if they wish to rely upon survey evidence in a proceeding within this NPA.

11. ANY FURTHER INTERLOCUTORY STEPS

11.1 Parties and their lawyers should be familiar with the guiding interlocutory steps information set out in Part 12 of the Central Practice Note (see also paragraphs 3.3 to 3.5 of this practice note regarding any urgent interlocutory applications).

11.2 Prior to filing any interlocutory application, excluding any genuine *ex parte* applications, parties are expected to confer for the purpose of cooperating and avoiding, wherever possible, the need for intervention of the Court.

11.3 Parties should consider whether it is necessary to file an interlocutory application or, in the alternative, to seek a case management hearing.

12. PRE-TRIAL CASE MANAGEMENT HEARING

12.1 A pre-trial case management hearing will generally be held prior to the scheduled trial date, with the lawyers involved in the case and, if appropriate, the parties attending. The parties are expected to have considered and discussed between them any further orders that may be necessary to achieve the most efficient trial process.

12.2 Parties and their lawyers should be familiar with the pre-trial case management hearing information set out in Part 13 of the Central Practice Note.

- 12.3 In particular, in preparation for the pre-trial case management hearing, the parties' lawyers should have given consideration to and agreed, if possible, on the following:
- (a) the preparation of an agreed statement of issues;
 - (b) whether there should be a conference between experts (if this has not already taken place) and, if so, the questions to be addressed by them at any conference and in their joint-report;
 - (c) the names of witnesses required to attend for cross-examination;
 - (d) the order in which witnesses are to be called (including whether any evidence should be given concurrently);
 - (e) notification of objections to evidence; and
 - (f) the preparation of court books, tender bundles and a Joint-Exhibit List.
- 12.4 The Joint-Exhibit List is to have numbered exhibits and will attach and describe (in brief form) each exhibit and a statement of its relevance. The judge will examine the list with the parties and discuss with them any perceived issues or concerns. The judge may require the parties to seek leave to tender at trial any exhibit that is not on the Joint-Exhibit List.

13. FURTHER PRACTICE INFORMATION AND RESOURCES

- 13.1 This practice note relates to all intellectual property matters. However, additional requirements relevant to this NPA exist in other practice notes and information. Of particular relevance to this NPA in relation to evidence are the [Expert Evidence Practice Note \(GPN-EXPT\)](#) and the [Survey Evidence Practice Note \(GPN-SURV\)](#). These practice notes and all of the Court's practice notes are available on the Court's website.
- 13.2 In addition, further practice and procedure information and resources for this NPA can be found on the Court's Intellectual Property NPA "homepage".
- 13.3 Further information to assist litigants, including a range of helpful guides, is also available on the Court's website. This information may be particularly helpful for litigants who are representing themselves.

Enquiries and Contact Information

- 13.4 General queries concerning the practice arrangements in the Intellectual Property NPA should be raised, at first instance, with your local registry. If a registry officer is unable to answer your query, please ask to speak to the NCF Coordinator in your local registry. Contact details for your local registry are available on the Court's website.

J L B ALLSOP
Chief Justice
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