

1-1-2007

# Intellectual property cases before the high court 2000 - 2007

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## Recommended Citation

van Caenegem, William, "Intellectual property cases before the high court 2000 - 2007" (2007). *Law Faculty Publications*. Paper 221.  
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## INTELLECTUAL PROPERTY CASES BEFORE THE HIGH COURT 2000 - 2007<sup>1</sup>.

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### INTRODUCTION

This short note provides some statistical background facts relating to the record of the High Court in intellectual property cases from 2000-2007. Brief notes on each case follow, in chronological order. The notes focus on legal issues, and offer a modest critique in some cases. The facts of each case are not restated in detail.

### A HIGH RATE OF SUCCESSFUL APPEALS TO HIGH COURT IN IP CASES

Between *Nike* in 2000 and *Burge v Swarbrick* in 2007 the High Court handed down 14 intellectual property related decisions<sup>2</sup>. Five of the fourteen matters related to patents law; four to copyright; two to breach of confidence; and 1 each to trade marks, designs and PBR/PVR's. In all the matters heard in full, except *Firebelt* and in *Maggbury*, the appeal was ultimately allowed. This represents a much higher success rate before the High Court in IP matters than in all matters as a whole<sup>3</sup>. In the same period, 17

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<sup>1</sup> My thanks go to Josh Underhill, law student at the Faculty of Law, Bond University for his invaluable help with research for this article.

<sup>2</sup> One of those matters, *The Grain Pool of WA v The Commonwealth* was before the Court on a question reserved concerning the intellectual property power of the Commonwealth (section 51(18) of the Constitution). Two matters, *Maggbury Pty Ltd v Hafele Australia Pty Ltd* and *Concrete Pty Limited v Parramatta Design & Developments Pty Ltd* are substantially concerned with contractual issues, but also have implications for the subsistence, licensing and/or infringement of intellectual property rights. In *Australian Broadcasting Corporation v Lenah Game Meats Pty Ltd* the Court examined the putative tort of breach of privacy under Australian law, with some consideration given to the nature and outer limits of the action for breach of confidence. The complete list is: *Campomar Sociedad, Limitada v Nike International Limited* [2000] HCA 12 (9 March 2000); *The Grain Pool of WA v The Commonwealth* [2000] HCA 14 (23 March 2000); *Kimberly-Clark Australia Pty Ltd v Arico Trading International Pty Ltd* [2001] HCA 8 (15 February 2001); *Australian Broadcasting Corporation v Lenah Game Meats Pty Ltd* [2001] HCA 63 (15 November 2001); *Maggbury Pty Ltd v Hafele Australia Pty Ltd* [2001] HCA 70 (13 December 2001); *Firebelt Pty Ltd v Brambles Australia Ltd* [2002] HCA 21 (23 May 2002); *Aktiebolaget Hassle v Alphapharm Pty Limited* [2002] HCA 59 (12 December 2002); *Lockwood Security Products Pty Ltd v Doric Products Pty Ltd* [2004] HCA 58 (18 November 2004); *Network Ten Pty Limited v TCN Channel Nine Pty Limited* [2004] HCA 14 (11 March 2004); *PolyairPolyaire Pty Ltd v K-Aire Pty Ltd* [2005] HCA 32 (16 June 2005) (and *Polyaire Pty Ltd v K-Aire Pty Ltd [No 2]* [2005] HCA 41 (11 August 2005); *Stevens v Kabushiki Kaisha Sony Computer Entertainment* [2005] HCA 58 (6 October 2005); *Concrete Pty Limited v Parramatta Design & Developments Pty Ltd* [2006] HCA 55 (6 December 2006); *Lockwood Security Products Pty Ltd v Doric Products Pty Ltd* [2007] HCA (23 May 2007); *Burge v Swarbrick* [2007] HCA 17 (26 April 2007). Crowe QC has published a useful account of *all* IP cases dealt with by the courts in the 10-year period from 1996 – 2005 which provides useful background as to the frequency and nature of IP litigation in general in Australia: see 'Trends in intellectual property litigation' [2007] 69 *Intellectual Property Forum* 24.

<sup>3</sup> For instance, in 2000, 48% of appeals heard were allowed and 52% dismissed, and in 2006 45% allowed and 55% dismissed.

intellectual property cases were refused special leave<sup>4</sup>. Of these 10 were patent cases, four copyright, two trademarks, one a PVR/PBR case and one involved designs as well as trademarks<sup>5</sup>. All these applications were from decisions of the Full Court of the Federal Court.

From the fact that all but one of the appeals from the Full Court was successful, one might infer that the High Court and the Full Federal Court are constantly at odds over IP law. But the fact that special leave is most commonly refused must qualify any such inference. Of the 17 refusals in IP matters in the relevant period, 11 referred to lack of prospects of success, 4 to endorsing the court below, 2 to the case not being appropriate to test a principle and 2 to the principle not requiring appeal to the High Court<sup>6</sup>. Thus in a majority of cases the refusal of special leave implied an endorsement of the Full Federal Court's approach<sup>7</sup>.

Nonetheless the High Court has frequently taken a different approach to the Full Federal Court<sup>8</sup>. The brief survey of all the IP matters heard in full by the High Court illustrates the variety of matters considered across the IP spectrum. Not all concerned the

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<sup>4</sup> The cases refused special leave are: *Copyright Agency Limited v The University of Adelaide & Ors* (S12/2000); *Koninklijke Philips Electronics NV & Anor v Remington Products Australia Pty Limited* (S175/2000); *Azuko Pty Ltd & Anor v Old Digger Pty Ltd* (A35 of 2001); *Stack & Anor v Davies Shephard Pty Ltd & Ors* (B41 of 2001); *Wilson v Australian Copyright Council* (S151 of 2002); *Boehringer Ingelheim International GmbH v The Commissioner of Patents* (M66 of 2001); *Ineos Fluor Holdings Limited v E I Dupont De Nemours and Company & Anor* (S334 of 2002); *Desktop Marketing Systems Pty Ltd v Telstra Corporation Limited* (M85 of 2002); *New England Biolabs Inc v F Hoffman-La Roche AG* (S325 of 2004); *Fresenius Medical Care Australia Pty Ltd v Gambro Pty Ltd & Anor* (S597/2005); *Pfizer Overseas Pharmaceutical & Ors v Eli Lilly and Company & Ors* (M150/2005); *Cultivaust Pty Limited v Grain Pool Pty Limited & Ors* (A58/2005); *Merck & Co v Arrow Pharmaceuticals Limited* (S244/2006); *Pfizer Corp & Ors v Commissioner of Patents & Anor* (S487/2006); *Grant v The Commissioner of Patents* [2007] HCATrans 126; *BP plc v Woolworths Limited* [2007] HCATrans 249; and *Cooper v Universal Music Australia Pty Ltd & Ors & E-Talk Communications Pty Limited trading as Comcen Internet Services & Anor v Universal Music Australia Pty Ltd & Ors* (S40/2007). A decision on the special leave application in the *Cadbury v Darrell Lea* case is currently reserved.

<sup>5</sup> *Koninklijke Philips Electronics NV & Anor v Remington Products Australia Pty Limited*, see above 4.

<sup>6</sup> One could not be ascertained.

<sup>7</sup> The majority is narrow – as pointed out above 17 applications for special leave were dismissed whereas 14 were granted. As to Special Leave applications in general see David O'Brien, *Special Leave to Appeal*, Queensland Supreme Court Library, 2<sup>nd</sup> ed (2007). In some cases it might have been preferable to have the High Court explicitly endorse the lower court's approach after full consideration: for instance, in *Telstra v Desktop Marketing*, *Grant v The Commissioner of Patents*, *Merck v Arrow*, and arguable *BP v Woolworths*, although *Cadbury v Darrell Lea* may indeed prove the more appropriate vehicle for consideration of colour trade marks.

<sup>8</sup> Two further observations here: first, the fact that the panel of judges from which the Full Federal Court is constituted is so large, makes it difficult to generalise about its approach as a Court: for instance, in terms of judges on the Full Federal Court bench for the IP decisions refused special leave, one sat on 6 out of 17, a few other judges sat on 3 and a large number sat on 1 and 2. Secondly, any identifiable difference in approach may simply be attributable to the different position of each court in the adjudicative hierarchy, without much more being able to be read into it. Not only in the narrow sense of the rules of *stare decisis*, but also in the broader sense of how an ultimate Court of Appeal may conceive of its legitimate role and approach. A final court of appeal might be expected to have a broader perspective, and feel more confident in straying from the most literal interpretation of statutory terms. Ten out of the cases heard by the High Court were concerned with statutory interpretation.

interpretation of recently introduced or amended statutory provisions, some revisiting or settling longstanding issues or controversies. The survey also illustrates how far apart the Full Court and the High Court have been on some issues. The most commonly considered issue was inventiveness in patents law.

## HIGH COURT IP DECISIONS SINCE 2000

The notes below concerning the various IP cases heard in full by the High Court appear in chronological order.

*Campomar Sociedad, Limitada v Nike International Limited* [2000] HCA 12 (9 March 2000), appeal from the Full Court of the Federal Court allowed; joint reasons of Gleeson CJ, Gaudron, McHugh, Gummow, Kirby, Hayne and Callinan JJ<sup>9</sup>. This case concerned both registered trade marks law and passing off. The single judgment emphasises that trade marks law requires a balance to be struck between competing interests and does not grant *absolute* rights to trade mark owners. A broad-ranging discussion of core issues touches upon dilution-theory in Australian trade mark law, the importance of free and open communication relating to cultural symbols, concurrent use, coexistence of identical or substantially identical marks, and also the competing interests in registered and common law marks. The Court notes that the 1955 Trade Marks Act altered the balance in favour of protecting the commercial value and exploitation interests of trade mark owners, over the public interest in preventing consumer confusion and deception. The Act accepted that some degree of deception and confusion will be inherent in the register, as for instance illustrated by the registered user and honest concurrent user provisions (permitting identical trademarks for identical goods or services to be on the register simultaneously but subject to conditions).

But such provisions of the Act were at apparent odds with the main provision at issue in the case, section 28 which prevented registration, and together with section 22 also continuation on the register of a mark “the use of which would be likely to deceive or cause confusion”<sup>10</sup>. But the Act did not in fact prohibit “continued registration of trade marks which were substantially identical or deceptively similar and regulated the rights of those proprietors *inter se*”<sup>11</sup>. Having established that the construction of section 28 had to be approached “not from a vantage point which abhors the prospect of any such deception or confusion.<sup>12</sup>”, the Act “should not be strained” to avoid the prospect of any such deception or confusion between marks. Logically the Court then had to accept that in some circumstances the statutory rights of a registered proprietor could be restricted by the availability of relief in passing off (or section 52 TPA) against him<sup>13</sup>. A registered trade mark owner could not in all circumstances answer an action by another registered owner of the same mark or at common law, by saying “Deception or no deception I am

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<sup>9</sup> See Patricia Loughlan, 'The Campomar Model of Competing Interests in Australian Trade Mark Law' (2005) 27(8) *European Intellectual Property Review* 289-293

<sup>10</sup> Section 28 Trade Marks Act 1955 (Cth),

<sup>11</sup> *Campomar* at AUSTLII [53].

<sup>12</sup> *Campomar* at AUSTLII [56].

<sup>13</sup> *Ibidem* at [57].

entitled to do it because that is my registered Trade Mark”<sup>14</sup>. Further section 28 required and permitted of only a *prospective* inquiry at the time of the application for registration, and not of secondary or continuing operation as if it prescribed conditions for the *continued* registration of the mark. Thus only their wrongful entry onto the register at the time of registration could result in the removal of the Campomar’s Nike marks (used in relation to perfume), but due to the limited reputation of Nike International in Australia at the time of registration their entry at the time was not wrongful. However, even though the requirement that the use of the marks was likely to deceive or cause confusion under section 28 had no continuing operation, the registration of the mark by Campomar was no bar to a claim in passing off or under section 52 of the Trade Practices Act for the use of that mark even in relation to goods for which it was registered.

In relation to the application of section 52, the question of the proper role of the “erroneous assumption-doctrine” arose. The Court held that it was to be approached against the background that the section requires a sufficient nexus between the conduct complained of and the misconception that has arisen in the minds of consumers. The level of abstraction at which this question will have to be answered will be higher where the representation complained of is directed at a class or grouping of consumers rather than specific identified ones. There is no strict “erroneous assumption doctrine” in Australian law, which dictates that intervention of an erroneous assumption (eg in relation to brand extension, the assumption that whatever goods a certain brand appears on, the mark owner must be behind it) between conduct and misconception *necessarily* destroys causation. Rather the key lies in the rule that the *reasonable or ordinary* member of the class is the standard of liability; if the misconceptions or self-deceptions said to have arisen to cause the state of confusion are “properly to be attributed to the ordinary or reasonable members of the classes of prospective purchasers” then they may destroy the necessary nexus. If the assumptions were “not only erroneous but extreme and fanciful”, then they could not be taken into account<sup>15</sup>. Therefore the fact that there may always be *some* member of the public who thought there was a connection between a brand and totally different goods, was not enough to establish liability. In this case the assumptions of witnesses that emerged from their evidence, as to the extension of the Nike International brand into sports fragrances (which was what the Campomar Nike mark was registered for) was not capricious or unreasonable, since it was based on their observation of the extension by another sporting goods manufacturer ‘Adidas’, into ‘sports fragrances’.

This judgment of the Court is notable for its clear and useful analysis of the subtleties inherent in the registered trade marks system, in particular in relation to the 1955 Act. It is a useful reminder of the requirement for balance in the trade marks law in an age in which brand owners demand ever greater protection against any kind of attenuation of the supreme position of certain brands. This is significant in the context of the present battles

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<sup>14</sup> Ibidem at [65], quoting from Buckley LJ’s judgment in *In the matter of an Application to Register a Trade Mark by Lyle and Kinahan Ltd* [1907] 24RPC 249.

<sup>15</sup> Both in *Campomar* at AUSTLII [105].

over shape and colour marks<sup>16</sup>. The judgment also clarifies the approach to the ‘erroneous assumption’ doctrine in section 52 (which the court said had no equivalent life under passing off), by bringing it into line with underlying principles rather than allowing it to develop an unrestrained life of its own.

*The Grain Pool of WA v The Commonwealth* [2000] HCA 14 (23 March 2000); joint reasons of Gleeson CJ, Gaudron, McHugh, Gummow, Hayne and Callinan JJ, allowing the appeal; separate judgment of Kirby J agreeing to the orders proposed in the joint reasons). In this matter the Court dealt with a question reserved as to the validity of the *Plant Variety Rights Act 1987* (Cth), and the *Plant Breeder's Rights Act 1994* (Cth) which replaced it. Does the PBR/PVR legislation concern matters falling within the intellectual property power (section 51 (xviii)) of the Commonwealth Constitution? For obvious reasons as at 1900 no explicit reference was made to plant variety rights or plant breeder’s rights. However, Australia has since become a signatory to the UPOV Convention concerning plant variety rights, so the legislation could rest upon the external affairs power<sup>17</sup>. But the Court chose to proceed by first considering the intellectual property power. It restated the general principles applicable to constitutional characterisation and construction. A question involving the IP power had arisen with respect to the Circuit Layouts Act 1989 in *Nintendo Co Ltd v Centronics Systems Pty Ltd*<sup>18</sup>, where it had been held that section 51 (xviii) permitted legislation granting rights in any ‘products of intellectual effort’. The other precedent case on the IP power was the well-known Union Label case: *Attorney-General for NSW v Brewery Employés Union of NSW*<sup>19</sup>, the High Court here expressing support for the dissenting judgment of Higgins J in that case. The Court pointed out that “[...] it would be expected that what might answer the description of an invention for the purpose of s 51(xviii) would change to reflect developments in technology”<sup>20</sup>. Allowance had to be given to the “dynamism which, even in 1900, was inherent in any understanding of the terms used in s 51(xviii)”<sup>21</sup>. The Court also emphasised that the state and nature of intellectual property law was not wholly resolved or static as at Federation: “[G]iven these cross-currents and uncertainties in the common law and statute at the time of federation, it plainly is within the head of power in s 51(xviii) to resolve them. It also is within power, as the legislation upheld in Nintendo demonstrates, to determine that there be fresh rights in the nature of copyright, patents of inventions and designs and trade marks.”<sup>22</sup> Inevitably the question became focussed on analogies with patents law, in particular the central requirements of novelty and inventiveness. As to inventiveness, at Federation this was not a separate

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<sup>16</sup> Eg between BP and Woolworths over the colour green; Cadbury and Darrell Lea over purple; see also the controversy in relation to the Guylian trade mark registration for chocolate shells; and most recently Nestle’s desire to trade mark a representation of a cup of coffee.

<sup>17</sup> The International Convention for the Protection of New Varieties of Plants (known as the UPOV Convention; in Australia’s case, the Convention of 2 December 1961, as revised at Geneva on 10 November 1972 and on 23 October 1978). The external affairs power is based in s 51 (xxix) of the Constitution.

<sup>18</sup> (1994) 181 CLR 134.

<sup>19</sup> (1908) 6 CLR 469.

<sup>20</sup> *The Grain Pool* at AUSTLII [18].

<sup>21</sup> *Ibidem* at AUSTLII [23].

<sup>22</sup> *Ibidem* at AUSTLII [41].

statutory requirement for patentability or ground for opposition or revocation; the differentiation between novelty and inventiveness only came about later. Further, inventiveness had not been inherent in the concept of a patent ever since the Statute of Monopolies: sufficient ingenuity attributable to the applicant was not in fact central, for a number of reasons. First, something stumbled upon accidentally or without any recognition of its underpinning science was perfectly patentable; secondly, importation of a foreign invention had for a long time been sufficient to warrant the grant of a monopoly in England. The legislator could allow such patents even now if it wished. As to novelty, the PVR/PBR legislation under consideration required it in various forms, so nothing could turn on that. There was some argument about product and process inventions that had little substance; as to the nature of the rights conferred, the fact that the PBR/PVR legislation incorporates substantial limitations on the rights of the grantee did not put it at fundamental odds with the law regarding patents for inventions: “It was well settled before 1900 that conditions or provisos might be attached to the patent grant, and that failure to observe them could lead to revocation of the patent in any action for a writ of scire facias”<sup>23</sup>. One such condition established by the time of Federation was the proper revelation of the working of the invention.

Kirby J published separate reasons, while ultimately agreeing with the ultimate conclusions of the other judges and with much of their reasoning. He focussed more on the Union Label case, and his reasons for taking a different approach to the majority in that case. The essence of his reasoning was that the terms ‘patents for inventions’ should be given a contemporary meaning rather than the meaning as at Federation: “Because what is under scrutiny is the grant of a lawmaking power for the future, designed to extend to possibilities difficult or impossible to conceive at the time of the grant, what is committed to the Federal Parliament under s 51(xviii) is not the class of particular patents but the whole subject of lawmaking on patents of inventions”<sup>24</sup>.

The Court’s approach in this case was arguably consistent with a view of intellectual property as a body of rules, whose contours are not static, and which must remain flexible and adapted to scientific and technological evolution; there are echoes of NRDC in this approach<sup>25</sup>. Apart from being concerned with intellectual property, the case elucidates and confirms a number of significant principles of constitutional construction.

*Kimberly-Clark Australia Pty Ltd v Arico Trading International Pty Ltd* [2001] HCA 8 (15 February 2001), appeal from the Full Court of the Federal Court allowed<sup>26</sup>. The judgment delivered was the judgment of the court: Gleeson CJ, McHugh, Gummow,

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<sup>23</sup> Ibidem at AUSTLII [78].

<sup>24</sup> Ibidem at AUSTLII [119]. Kirby J explained why the basis for his separate reasons as being the fact that the approach taken by the majority in the Union Label Case was now open to question; he preferred the minority view of Higgins J. Interestingly the joint reasons made no reference to this point, seemingly treating the case as having already been overturned, perhaps in Nintendo. They said that “an appropriate approach to the interpretation of s 51(xviii) is that appearing in what was then the dissenting judgment of Higgins J”, at AUSTLII [19], perhaps implying but not further expressly referring to the fact that at the outset of The Grain Pool case, it was no longer the dissenting view.

<sup>25</sup> *National Research Development Corporation v Commissioner of Patents* (1959) 102 CLR 252.

<sup>26</sup> The Full Court consisting of Wilcox & Branson JJ (majority) and Tamberlin J (minority).

Hayne and Callinan JJ. The High Court overturned the finding of patent invalidity of the Full Court; the sole issue before the Court was sufficiency in terms of section 40 of the Patents Act 1990(Cth). The case dealt with the seemingly elementary question whether to determine if an invention was fully described as required by section 40, regard had to be had to both the claims and the body of the complete specification. The Court pointed out that the relevant section indicates “that the specification must be read as a whole and that reference to the claims may dispel ambiguity or uncertainty from the body of the specification concerning the description of the invention”<sup>27</sup>. There were a number of supportive earlier decisions. This part of the decision reads like an object lesson in the basics of patent law; from a reading of the High Court judgment alone one could be forgiven for wondering how the majority of the Full Federal Court could have arrived at a different view.

The High Court was equally blunt in its assessment of the majority’s identification of the addressee of the specification. Again this part reads as a lecture on patent law basics: the addressee for the purpose of this question is the skilled addressee armed with the common general knowledge, not the ignorant person the Full Court called in aid. Therefore an element that would be obvious to a skilled addressee to make the invention work need not be expressly referred to: here the element was the use of fluid pervious (ie permeable, there was some banter about the odd word ‘pervious’ during the special leave hearing) material in the construction of diapers. The Full Court, or at least the majority, was also criticised for not having addressed remaining grounds for appeal, which created a difficult situation upon its findings on the ground which it did address being reversed by the High Court.

*Australian Broadcasting Corporation v Lenah Game Meats Pty Ltd* [2001] HCA 63 (15 November 2001); appeal from the Full Court of the Supreme Court of Tasmania allowed<sup>28</sup>. Gleeson CJ allowed the appeal, as did Gummow, Hayne, Gaudron J, and Kirby JJ. Callinan J dismissed the appeal. This case may arguably not belong in this list of IP matters, since it was primarily concerned with a putative tort of invasion of privacy. Nonetheless an argument was made calling for an extension of the action for breach of confidence to cover the kind of fact situation that gave rise to the action; there were some English cases in this areas that the Court usefully dealt with. But ultimately it left the law relating to breach of confidence undisturbed; in other words, the Court did not support extending the action for breach of confidence to cover situations where information that was not secret or private to the conventionally required degree was obtained by trespass. The constraints inherent in the action for breach of confidence were reiterated, its

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<sup>27</sup> See [2001] 207 CLR 1 at 13.

<sup>28</sup> The separate judgments delivered resulted in reasons running to 107 pages or so (in the Austlii version). Gummow and Hayne JJ’s reasons run to some 15 pages, Kirby J about the same, Callinan J 30 pages or so, with some 30 pages of footnotes in toto. Gleeson CJ’s judgment was shorter (13 pages), Gaudron J expressed her agreement with Gummow and Hayne and added comments in a few paragraphs concerning the grant of injunctions



traditional parameters and boundaries effectively confirmed. Lindsay and Stewart have published instructive pieces on this case<sup>29</sup>.

*Maggbury Pty Ltd v Hafele Australia Pty Ltd* [2001] HCA 70 (13 December 2001); appeal from the Court of Appeal of Queensland dismissed in a joint judgment of Gleeson CJ, Gummow and Hayne JJ; Kirby and Callinan JJ separately dissenting. This was predominantly a contract case but with some implications regarding dealings with confidential information. It concerned a contract under which information was to pass from the originator of a new-fangled ironing board to a company (Hafele) potentially interested in its commercialisation. The relevant clause subjected information which was to pass to Hafele to a contractual restraint on its future use, but was in its terms not confined to confidential or secret information only. The term thus amounted to a perpetual restraint on Hafele regarding the use of certain information about the ironing board, which would persist even after that information had entered the public domain. The majority held that the provision therefore amounted to a general restraint of a kind that offended against public policy: every other competitor in the relevant market would be able to benefit from the information once it was public, but not Hafele. The decision affirms the primacy of public policy considerations over contractual autonomy in this area of the law in the eyes of the majority. However, Callinan J in his dissenting judgment espoused the opposing view, that when well informed parties freely enter into a bargain (here not to use certain information) they should be held to it and not be able to rely on a public policy argument conveniently arrived at to escape their contractual obligations some time down the track<sup>30</sup>.

*Firebelt Pty Ltd v Brambles Australia Ltd* [2002] HCA 21 (23 May 2002), joint reasons of Gleeson CJ, McHugh, Gummow, Hayne and Callinan JJ's. This is the only appeal from the Federal Court dismissed by the High Court. It concerned inventiveness of a petty patent. One issue was the construction of section 7 of the Patents Act 1990, and in particular how to properly take into account the common general knowledge and certain items of prior art information; this aspect is dealt with below in the context of the more recent High Court case dealing with the same broad issue, *Lockwood No 2*. The invention here consisted of a combination of known integers, and the relevant question was whether it was obvious "to place those integers in the interactive combination claimed in the Petty Patent"<sup>31</sup>. The Court held that it was not wrong of the trial judge to accept the evidence of a person who described himself as an inventor, as to the obviousness of the combination. Such evidence is "not always likely to be helpful", as is also the case with evidence of prior research and experiments (so-called secondary evidence), or evidence by the inventor of the invention at issue. But it is not inadmissible; in any case, the line between an inventor and a skilled technician was said not always to be easy to draw, and somebody describing himself as an inventor may also engage in

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<sup>29</sup> See Lindsay D, 'Protection of privacy under the general law following *ABC v Lenah Game Meats Pty Ltd*: where to now?' [2002] PLPR 45; and Stewart D, 'Protecting privacy, property and possums: *Australian Broadcasting Corporation v Lenah Game Meats Pty Ltd*' [2002] FedLRev 6.

<sup>30</sup> See also van Caenegem W, 'Intellectual property law and innovation', Cambridge University Press (2007) at 44, 59; and van Caenegem W, Murdoch University eLaw Journal Vol 14, No 2, 2007, p 279 "Mobility of Creative Individuals, Trade Secrets and Restraints of Trade".

<sup>31</sup> *Firebelt* at AUSTLII [39].

more technical work. Furthermore the evidence of commercial success tendered by the patentee was very ‘exiguous’, in that it appeared not to be directed at the commercial success of the claimed invention. More and better evidence will be required to establish that commercial success is actually connected or the result of the incorporation of a patented invention into a commercial product. The Court has repeatedly issued warnings about the limited value of secondary evidence (of considerable research and experiment, of a recognised problem that remained unresolved for a long time, of commercial success, of immediate copying etc.). In this it echoes similar warnings emanating from superior courts in other jurisdictions<sup>32</sup>.

*Aktiebolaget Hassle v Alphapharm Pty Limited* [2002] HCA 59 (12 December 2002), appeal from the Full Court of the Federal Court allowed; joint reasons of the majority Gleeson CJ, Gaudron, Gummow and Hayne; separate but concurring reasons of Callinan J, dissenting judgment of Kirby J. This matter also concerned inventiveness, but under the 1952 Patents Act. In relation to patents granted under that Act, opponents can only draw on information included in the ‘common general knowledge’ at the relevant time to establish obviousness, and not on specific items of prior art information that fall outside it<sup>33</sup>. However, although the scope of the ‘common general knowledge’ was discussed in this case<sup>34</sup>, the principal issue was how to go about answering the core obviousness question. The Court reiterated that even in relation to a combination patent the ultimate question was simply whether the invention as claimed was ‘very plain’. In contrast with the Full Court’s view, it was not correct to ask, where an inventor had been faced with multiple possible ways of solving a problem, whether each integer of a combination was worth trying<sup>35</sup>. The question was not whether each integer was obvious, but whether the *combination* was obvious. In this the High Court rejected the English approach which mandates, firstly, formulating the invention in terms of a problem/solution, and secondly inquiring whether it would be worthwhile to try each integer of the combination to overcome the recognised problem<sup>36</sup>. The Court preferred the US approach.

Interestingly the High Court adhered to the 3M approach as to inventiveness of combination patents of this kind, and also did not relax the concept of the ‘common general knowledge’ under the 1952 Act to permit the inclusion of any specific items of information at all<sup>37</sup>. As is further discussed below, the 1990 Act amended the law to allow some such specific or individual pieces of information not part of the common

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<sup>32</sup> In *Glaverbel SA v. British Coal* [1995] RPC 155 the Court of Appeal poured cold water on the relevance of secondary evidence, being only evidence in aid and often evidence that not too much can be read into.

<sup>33</sup> This did become permissible with the introduction of the 1990 Act, and even more so with subsequent amendments that took effect in 2002. See section 7(3) of the Patents Act 1990 (Cth); and further below.

<sup>34</sup> In particular the question whether the result of routine literature searches could be included within that body of knowledge (see further below in the context of the 1990 Act).

<sup>35</sup> Here how to formulate omeprazole (ie coat a tablet of it) so that it could pass through the stomach into the small intestine, where it was most effectively delivered, without being dissolved.

<sup>36</sup> If the skilled addressee would have found it worthwhile to try what the inventor had done, then the claimed invention is obvious in the UK; this against a background in that jurisdiction of the prior art relevant to inventiveness being all information made available to the public before the priority date, ie the same as for novelty.

<sup>37</sup> 3M: *Minnesota Mining and Manufacturing Co v Beiersdorf (Australia) Ltd* [1980] HCA 9; (1980) 144 CLR 253.

general knowledge to be put forward in an attack on inventiveness. Later amendments have taken the law even further from the test applicable to 1952 patents, to allow those individual items to be combined or ‘mosaiced’, if a person skilled in the art could, before the priority date of the relevant claim, be reasonably expected to have combined them. Kirby J in his dissenting judgment rejected the notion that there was a divergence on this point between English and Australian law and approved of the obvious-to-try approach. However, in the Lockwood cases this theme of the divergence between Australian and UK/European law in relation to various patents law issues returns (Kirby J did not sit in either Lockwood No 1 or No 2).

*Lockwood Security Products Pty Ltd v Doric Products Pty Ltd* [2004] HCA 58 (18 November 2004), appeal from the Full Federal Court allowed; joint reasons of Gleeson CJ, McHugh, Gummow, Hayne and Heydon JJ. In this case (*Lockwood* No 1) the High Court dealt with fair basing. The parties later returned to the High Court in relation to the same patent, but on inventiveness: *Lockwood* No 2 is dealt with below. Fair basing as required by section 40 of the Patents Act 1990 (Cth) has two manifestations: first, a complete application must be fairly based on a provisional application, in the sense that the complete application cannot claim the priority date of the provisional, if what is revealed in the former differs from what was described as the invention in the latter. Secondly, by virtue of section 40(3) ‘[T]he claim or claims must be clear and succinct and fairly based on the matter described in the specification’<sup>38</sup>. This requirement was at issue here. Fair basing has caused some disquiet in patent circles, because of a perception that it is one of those legalistic issues that is approached with excessive technicality by the courts, undermining patents on form rather than substance<sup>39</sup>. Here as in some of the other patents cases discussed, the High Court attempts to reconnect with basic principles and wash away some of the trying complications that have emerged over time. The Court recites in a strikingly vigorous way what is *not* the right way to go about fair basing issues: “*Erroneous principles. The comparison which s 40(3) calls for is not analogous to that between a claim and an alleged anticipation or infringement. It is wrong to employ “an over meticulous verbal analysis”[76]. It is wrong to seek to isolate in the body of the specification “essential integers” or “essential features” of an alleged invention and to ask whether they correspond with the essential integers of the claim in question*”<sup>40</sup>.

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<sup>38</sup> The language of specifications (and applications) can be a little confusing, principally because the terms ‘complete specification’ sometimes include the claims and sometimes not. As the Court explains in *Lockwood* at AUSTLII [49]: ‘Section 40(2) deals with the “complete specification”, that is, with a document which concludes with the claims defining the invention (s 40(2)(b)), and in which the material preceding the claims is commonly called the “body of the specification”, or the “specification” for short.’

<sup>39</sup> See Drummond D (Mr Justice Drummond of the Federal Court), ‘Are the Courts Down Under Properly Handling Patent Disputes’ (2000) 42 Intellectual Property Forum 10; see also Kimberlee G. Weatherall K, Jensen P, ‘An Empirical Investigation into Patent Enforcement in Australian Courts’, IPRIA Working Paper No 07/05; and published in the Federal Law Review (2005) Volume 32. The latter article establishes that apart from novelty and obviousness, fair basing was the most common ground for invalidity over the period investigated (1997-2003). Concerning fair basing in *Lockwood* see also McBratney A, ‘The problem child in Australian patent law: “fair” basing’ (2001) 12 AIPJ 211; and McBratney A, ‘Does the fair basing “problem child” escape *Lockwood*?’ (2005) 4 AIPJ 210.

<sup>40</sup> *Lockwood* at AUSTLII [68].

The Court acutely voices its criticism of the conflation of fair basing and obviousness questions that happened in the court below: a claimed invention can stand or fall on fair basing alone. Issues that arise under section 18 (1)(b) of the Act relating to novelty and inventiveness, should not be introduced into fair basing; and the only thing relevant to the question of fair basing is the specification's content<sup>41</sup>. The Court gives an expansive account of the history and proper construction of the requirement of fair basing in section 40. But it also offers trenchant criticism of the Full Court and the trial court on this matter of illegitimate conflation of the different issues: Wilcox J, Branson J and Merkel J, and then also the trial judge, are picked off one by one for their conflation of fair basing with other issues, as is Blanco-White, the leading English authority whose claim that fair basing and obviousness overlap is accused of having led various judges down the garden path. It is striking how emphatically the Court returns to its affirmations in *Aktiebolaget Hassle* concerning the divergence with UK patents law. In this area, the reasoning in United Kingdom cases is no longer relevant or applicable in Australia; in other areas of patents law as well, notably obviousness, the United Kingdom and Australia have grown apart; and "[T]he courts of Australia [are not] bound by what the European Patent Office says, and do not regard it as "jurisprudence"."<sup>42</sup>. The same can not only be said for UK cases, but also for commonly cited UK authorities such as BlancoWhite's, *Patents For Inventions* (5<sup>th</sup> ed, 1983).

On the particular question in *Lockwood* concerning the respective treatment of broad principles and specific embodiments in patent applications, the Court said that if a broad new principle is identified in the specification then claims can extend to any embodiment of it, even if only a single one is given in the specification. However, if the specification does not reveal a new principle but for instance a new combination of integers, then it would be normal to restrict the claims to the actual embodiment described.

*Network Ten Pty Limited v TCN Channel Nine Pty Limited* [2004] HCA 14 (11 March 2004), appeal from the Full Federal Court allowed; joints reasons of McHugh ACJ, Gummow and Hayne JJ; separate judgments of Kirby J and Callinan J dismissing the appeal. In this copyright case a surprisingly unexplored question arose. Part IV of the Copyright Act 1968 (Cth) concerns 'subject matter other than works', or so-called 'neighbouring rights', *inter alia* films but also television broadcasts. Part IV subject matter copyright subsists separately. It normally has a technical aspect, is complex in that it attracts the input of individuals with varying skills in the making, and is usually costly to produce, at least to a commercial standard. Copyright is owned by the maker, by and large the investor, and not an author, and no originality in the sense of Part III is required; broadcasts also need not be in material form, so that the capture or recording of a live broadcast can constitute an infringement of copyright. As to the core question under Part IV, the Full Federal Court held that the statutory language inescapably demanded the somewhat surprising conclusion that "each visual image capable of being observed as a separate image on a television screen and accompanying sounds" constituted a television

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<sup>41</sup> It is common for multiple grounds of invalidity to be relied on in patent cases. In that context also the High Court stressed the importance of keeping the various grounds of invalidity under the Act separate and distinct, even though the same facts may be relevant to different grounds.

<sup>42</sup> *Lockwood* at AUSTLII [66].

broadcast under the Act<sup>43</sup>. This meant that any reproduction, even of the smallest part of a television program, constituted the reproduction of a *substantial* part, whereas in all other areas of the copyright law this conclusion required careful consideration focussed on the quality of any part taken.

Only the question of fair dealing then remained to be considered in any detail. The majority in the High Court referred to this conclusion as inconvenient and improbable, and neither required by the copyright context nor the particular wording of the Act. The majority instead equated a television broadcast under the Act with a television program, leaving open the question as to whether certain discrete segments, items or stories in a compendious program would each amount to a television broadcast or not. Well-established principles would then apply to determine what amounted to a substantial part, but this and the fair dealing questions were matters to be remitted to the Federal Court. The majority's view really represented the only workable solution to the problem, although there was some merit to the argument that what was rewarded by the grant of a television broadcast copyright was not contents but the technical skill and investment required to put together a technologically based product. The real difficulty facing the Court revolved around the textual issues of interpretation of various provisions (too complex to go into here) which arguably compelled a different conclusion, and the extent to which any judge could depart from it. Kirby J's statement concluding his judgment reflects this: "I have repeatedly obeyed the rule of the purposive construction of legislation. However, its application is always subject to textual limits. Sometimes the propounded construction would exceed those limits. This is such a case."<sup>44</sup>

Interestingly in that light, although the more permissive approach (often advocated as appropriate in copyright cases) ultimately won out in the High Court, in the end taking the Full Court and the High Court decisions together, a majority of judges opted for a more textual approach: Sundberg, Finkelstein and Hely JJ of the Federal Court plus Kirby and Callinan JJ of the High Court, as against McHugh, Gummow and Hayne JJ of the High Court, ie five against three. Also the majority in the High Court was obviously thin, three to two. Therefore, despite the tenor of what was said above, it is as well to reproduce here the final paragraph of Callinan J's judgment, to fully air that side of the argument: "Nothing turns, in my opinion, upon any perceived differences between the quality or nature of the copyright afforded by the Act to television broadcasts and other copyright holders. It was and was intended to be a new and unique right. The medium is very different from others. To exploit it, different and perhaps more expansive infrastructures, fees, techniques and resources are required. The industry is, and has always been in this country, a highly competitive, and, as this case shows, a highly commercialised one. There may have been good reason for the legislature to single it out for special treatment. It is for the Court to give effect to the language of the Act and not to speculate about that."<sup>45</sup>

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<sup>43</sup> See *Network Ten* at AUSTLII [8].

<sup>44</sup> *Ibidem* at AUSTLII [105].

<sup>45</sup> *Ibidem* at AUSTLII [155].

*PolyairPolyaire Pty Ltd v K-Aire Pty Ltd* [2005] HCA 32 (16 June 2005) (and *Polyaire Pty Ltd v K-Aire Pty Ltd* [No 2] [2005] HCA 41 (11 August 2005), appeal from the Full Federal Court allowed; joint reasons of McHugh, Gummow, Hayne, Callinan and Heydon JJ. This decision concerns a fundamental but surprisingly unsettled issue under the 1906 Designs Act, which will continue to be relevant as long as pre-Designs Act 2003 designs remain on the Register. Under the 1906 Act an impugned design might be so close to the registered design as to constitute an ‘obvious imitation’; if not it may still be actionable if it amounts to a ‘fraudulent imitation’. Whereas a finding of obvious imitation is based on a comparison of the two designs alone, ‘fraudulent imitation’ requires additional evidence of actual derivation from the registered design. The issue before the Court was whether the term ‘fraudulent’ in this particular context required some proof of dishonest concealment by the copyist. The Court’s stance favours the design owner: the requirement of fraud is satisfied even in the absence of any intention to deceive. All that has to be shown is that the design was knowingly derived from a registered design and the changes made were not sufficient to take it outside the scope of the registration. Thus even if there were good reasons to make those changes, other than disguising derivation (for instance functional imperatives) there may still be a fraudulent imitation.

This significant victory for registered design owners mirrors the strengthening of their position under the new Designs Act 2003 (Cth), albeit that under that Act the threshold test for registration has been significantly strengthened (by requiring distinctiveness as well as novelty). The High Court’s solution also accords with common sense, in that under the Full Court’s approach it would often be very difficult to generate the kind of evidence that would meet the threshold test for fraudulent imitation.

*Stevens v Kabushiki Kaisha Sony Computer Entertainment* [2005] HCA 58 (6 October 2005), appeal from the Full Court of the Federal Court allowed; joint reasons of Gleeson CJ, Gummow, Hayne and Heydon JJ; separate reasons of McHugh J and of Kirby J, all allowing the appeal. In this case the new circumvention provisions in the Copyright Act were at issue (section 116AK ff), but also questions concerning reproduction in computer RAM of copyright material. Mr Stevens, although represented by Counsel before the Full Federal Court, appeared in person on the application for special leave<sup>46</sup>. However, on legal points the bench (Gummow, Kirby and Heydon JJ) engaged exclusively with Mr Catterns QC, appearing for Sony. The exchanges between Mr Stevens and the bench were directed at ensuring that if special leave were granted, he would be represented, since the question was technical, one of importance and one on which the Court would require assistance from both ends of the Bar table. At the appeal hearing Mr Stevens was represented by experienced counsel; however, two Senior Counsel and a junior also appeared as ‘amici curiae on behalf of the Australian Digital Alliance Limited and the Australian Libraries Copyright Committee’<sup>47</sup>.

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<sup>46</sup> See *Stevens v Kabushiki Kaisha Sony Computer Entertainment & Ors* [2004] HCATrans 273 (6 August 2004).

<sup>47</sup> See ‘Representation’ in the headnotes to *Stevens*, AUSTLII version.

The provisions under the Copyright Act, which are aimed at bolstering the technological self-help measures copyright owners deploy against infringement (so-called 'technological protection measures'; below TPM), are indeed new in two ways: in the sense that they are recently introduced; and also in the sense that they are a considerable departure from anything known in the Act or copyright law both domestically and internationally before<sup>48</sup>. The Court had to decide whether a measure that merely inhibited or deterred the making of unauthorised reproductions was a TPM<sup>49</sup>. By majority it adopted a narrow construction, requiring that a measure must directly *prevent* the making of copies to amount to a technological protection measure as statutorily defined<sup>50</sup>. This balanced approach, which can accommodate concerns about the potentially anti-competitive effects of the broader interpretation adopted by the Full Federal Court, has been vindicated by subsequent amendments<sup>51</sup>.

The other issue at stake in this case was reproduction in RAM of either a computer program or a cinefilm incorporated in the Sony games CD-ROM's. If playing a game generates transitory copies in computer RAM, then the TPM at issue *does* directly prevent the making of a copy, even on the narrower construction preferred by the majority, with the obvious consequence that the modchips supplied by Mr Stevens would be circumvention devices. Copyright in a computer program, a literary work in Part III, is only infringed if it is reproduced in material form. The definition of 'material form' in the Copyright Act as it then stood, required some form from which the copy could in turn be reproduced. Since the copies made in RAM during the playing of the game were ephemeral electrical impulses, that was not possible in the ordinary course of events. However, proceeding on the alternative basis that the games were cinematograph films, and the concept of copying (rather than reproduction) in Part IV not having the same material form requirement, the question became one of substantiality alone. But since on this issue Sony had not provided sufficient evidence below, "[I]n the circumstances as they arose at trial, Sony failed to lay the necessary evidentiary basis for a finding in its favour on substantiality."<sup>52</sup>

Interestingly enough the Copyright Act was amended in a number of ways after this decision was handed down, as a consequence largely of the signing of the Free Trade Agreement with the United States. The definition of material form in relation to Part III was amended now to read "material form" , in relation to a work or an adaptation of a

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<sup>48</sup> 'Before' in the sense of in the past, but more specifically before the Copyright conventions of the mid-nineties.

<sup>49</sup> The modchips Stevens supplied made it possible to play non-authenticated games CD-ROM's on the Sony games console.

<sup>50</sup> The fact that certain authentic code sequences had to be present in the games CD-ROM's to make them playable on the Sony Playstation games console, merely rendered it less attractive to acquire infringing or imported copies of the games software.

<sup>51</sup> On the broad interpretation TPM's could potentially be used to protect territorial price discrimination between perfectly legitimate substitute products from the same copyright owner, something the Commonwealth government had spent many years trying to prevent with its legislation removing parallel importation restrictions. In the initial hearings the ACCC had intervened to submit that the broad interpretation would prohibit the making of back-up copies as provided for by section 47C of the Copyright Act.

<sup>52</sup> *Stevens* at AUSTLII [98].

work, includes any form (whether visible or not) of storage of the work or adaptation, or a substantial part of the work or adaptation, (whether or not the work or adaptation, or a substantial part of the work or adaptation, can be reproduced)<sup>53</sup>; further, the use as opposed to merely the supply of a circumvention device can now also constitute an infringement, although that change has necessitated the insertion into the Act of some complex exceptions.

*Concrete Pty Limited v Parramatta Design & Developments Pty Ltd* [2006] HCA 55 (6 December 2006), appeal from the Full Federal Court allowed, separate reasons of Gummow ACJ, joint reasons of Kirby and Crennan JJ; separate reasons of Hayne J and of Callinan J, all allowing the appeal. Here there was a joint venture between two parties to purchase land, obtain development approval, build units in accordance with it and then sell them, the proceeds to fall to each party on a 1/3 to 2/3 basis. In fact the joint venture fell apart after development approval was obtained and before units were built or sold. It was when trustees for the sale of the site proposed to sell the land with the attendant approval to Concrete, that the dispute about copyright in the development plans arose, Parramatta demanding additional royalties for the use of the plans by the purchasers. The facts in the case were quite particular and did not disclose a standard arms length architectural contract concerning the plans (artistic works) to be used to obtain planning approval. Rather, Parramatta, an architectural design company closely associated with one of the joint venture companies, had brought the plans into the venture for the purpose of it obtaining planning approval for the site. There was a split between members of the Court concerning whether the freedom of the appellant Concrete to use the approved architectural plans, was to be determined as a matter of obligations arising under a relationship of mutual trust and confidence between the joint venture parties, or by operation of an implied term in a contract between client and architect.

Gummow J dealt with it as a matter of obligations between joint venturers rather than a question of implied copyright licenses between architect and client (along *Beck v Montana Constructions Pty Ltd*<sup>54</sup> lines). Hayne J agreed with Gummow J that the use by Concrete of the plans to build the approved units once it had acquired the land was to be resolved on the basis of the obligations of trust and confidence that the participants to the venture owed each other. If Parramatta denied consent for the use of the plans by Concrete it was pursuing its own interests in conflict with the interests of the other joint venture participants, which it could not do. However, Kirby and Crennan JJ in their joint reasons dealt with the matter as one of implied copyright licenses relating to contracts for the production of architectural plans. Alternatively the question of whether the right to build to the approved plans passed with the land could be dealt with on the basis of non-derogation from grant, but that was not an option the Justices felt they needed to investigate further since they found an implied license existed in favour of the purchaser. The consent was implied from the nature of the agreement between the joint venture partners. The owners had sought architectural plans for the purpose of obtaining development approval, which ran with the land for a period of five years. An earlier sale

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<sup>53</sup> Copyright Act 1968 (Cth) section 10 (1); see also section 10 (5) and (6) in relation to Part IV subject matter.

<sup>54</sup> [1964-65] NSW 229.



of the land did not extinguish the implied consent, and “[F]urther, an owner who sells (or does not oppose the sale of) the land, with the benefit of the development consent, must be taken to be passing on the benefit of the implied consent it holds to the purchaser, such conduct being within the ambit of the implied consent which the owners originally received from the architect as explained above.<sup>55</sup>”

Callinan J also approached the matter largely on the basis of analysing the terms of the joint venture agreement; more specifically, what the terms were under which the joint venturer had supplied the plans for the joint venturers’ joint purpose. Those terms included that they were not going to be paid for the architectural service “to secure the consent of the other joint venturers and to maximize the return to all”<sup>56</sup>. The building of the units had been authorized by them (see section 15 of the Copyright Act) and the implied license that this constituted extended to a purchaser of the land as well, as had been found in earlier cases. Because of the complexity and uniqueness of the facts, and diversity of approaches in the various judgments it is perhaps difficult to state firmly what the case means for copyright law. Nonetheless, it is probably correct to say that the use of architectural plans that formed the basis of planning approval, by a subsequent purchaser of the land, will be permitted in the absence of express terms to the contrary. Arguably this is not so because of a term implied into the agreement for sale of the land with planning approval, but because of a term implied in or expressed in the agreement between the original owners of the land and the architect, and then adhering to the land when it is sold.

*Lockwood Security Products Pty Ltd v Doric Products Pty Ltd* [2007] HCA (23 May 2007), appeal from the Full Federal Court unanimously allowed with joint reasons. This matter concerned inventiveness under section 7 of the Patents Act, in relation to a front door lock which newly combined a number of known features of lock mechanisms. By virtue of section 7, when assessing inventiveness regard can be had to the common general knowledge and certain individual pieces of information. The High Court proceeded on the basis that only if the trial court holds that in the light of the common general knowledge *alone*, a claim is not obvious, is it necessary to objectively determine whether any particular piece of information is of a kind which “could...be reasonably expected to have [been] ascertained, understood and regarded as relevant to work in the relevant art” (section 7(3)) by a person skilled in the relevant art (section 7(2)). If so then the question of obviousness is repeated, but this time through the eyes of the PSA armed with the CGK *and* the selected pieces of prior art information. The High Court held only a particular piece of information “which a person skilled in the relevant art could be expected to have regarded as relevant to solving a particular problem or meeting a long-felt want or need as the patentee claims to have done[.]” can be taken into account. In other words only information relevant to the particular problem the invention sought to overcome, not all information relevant to the broader art. In this case therefore, information concerning design of all sorts of locks other than rim-mounted front door house locks (eg locks for storeroom doors) could not be taken into account. Only information concerning design of front door locks was judged to have been ascertained,

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<sup>55</sup> *Concrete Pty Ltd* at AUSTLII [95].

<sup>56</sup> *Ibidem* at AUSTLII [164].

understood and treated as relevant by a person skilled in the art could be taken into account. The relevancy requirement of section 7 thus acts as an important filter in relation to individual pieces of information that may be used to undermine a patented invention on the basis of lack of inventiveness.

*Burge v Swarbrick* [2007] HCA 17 (26 April 2007), appeal from the Full Court of the Federal Court allowed, joint reasons of Gleeson CJ, Gummow, Kirby, Heydon and Crennan JJ). In this case a very longstanding difficulty resulting from the copyright/designs overlap provisions in section 74 ff of the Copyright Act was at issue. Because of its potential to avoid the overlap defence, copyright owners have often sought to expand the boundaries of the excepted category of ‘works of artistic craftsmanship’. Other than in cases such as this, or maybe also where underlying two dimensional copyright works can not be put in evidence before the court, this category has little attraction about it, since the usually equally applicable alternative categories of artistic works have less onerous threshold requirements<sup>57</sup>. Here the question was whether the plug for a yacht, produced as part of the prototyping/manufacturing process, could be classed as a work of artistic craftsmanship. The High Court held that this depended on the degree of artistic quality of the work; in the case before it there was not sufficient quality. This approach is unfortunate for two main reasons: first, it makes it very hard to predict outcomes, since where on a scale of ‘artistic-ness’ a given work will fall is a matter of fine and maybe personal judgment. Secondly, it ignores the real difficulties that may result from extending the content of this class in this manner, potentially to include prototypes or works produced as an integral part of a manufacturing process. These are not inherently works of artistic craftsmanship, since they are themselves not crafted to appeal to the eye of a consumer. They are also often not made as part of a process of designing-in-the-making, a critical characteristic, in my view, of works of artistic craftsmanship; rather they are made on the basis of pre-existing sketches and drawings in 2D format. The High Court’s approach also appears to be a sudden departure, arguably not demanded by the authorities. This is the one case considered here where the approach of the Full Federal Court is in my view to be preferred.

## CONCLUSIONS

In many of these cases, as one might expect from a court of ultimate appeal, the High Court seeks to resolve matters by reference to underlying principles. However, in the area of IP, the Court’s quest for greater clarity by reference to principle is not always assisted by the legislator’s frequent amendments of legislation. The High Court’s task is also complicated by the fact that in various areas two different sets of rules, and sometimes principles, are relevant, depending on when a particular statutory right was obtained – see for instance in designs and in patents law.

One aspect of the Court’s approach after 2000 has been its willingness to forge an independent jurisprudential path. That combined with the UK’s rapprochement with European law and Australia’s greater emphasis on local policy analysis has pointed us away from UK doctrine and jurisprudence. The drawback is perhaps less homogeneity

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<sup>57</sup> See section 10 of the Copyright Act, definition of ‘artistic work’.

with the laws of important trading partners, but policy development adapted to local economic conditions is of course beneficial. On a final note, the High Court's view of intellectual property law does seem suitably nuanced, recognising the balance of interests that must be reflected in its rules and application, whether of trade marks, copyright or patents law.