

Authorised Version

Supreme Court (Intellectual Property) Rules 2016

S.R. No. 107/2016

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Authorised Version

STATUTORY RULES 2016

S.R. No. 107/2016

Supreme Court Act 1986

Supreme Court (Intellectual Property) Rules 2016

The Judges of the Supreme Court make the following Rules:

Order 1—Preliminary

1.01 Title and object

- (1) These Rules constitute Chapter VIII of the Rules of the Supreme Court and are entitled the Supreme Court (Intellectual Property) Rules 2016.
- (2) The object of these Rules is to re-make the Rules that constitute Chapter VIII of the Rules of the Supreme Court, regulating proceedings in relation to intellectual property.

1.02 Authorising provisions

These Rules are made under section 25 of the **Supreme Court Act 1986** and all other enabling powers.

1.03 Commencement, revocation and savings

- (1) These Rules come into operation on 25 October 2016.
- (2) The Supreme Court (Intellectual Property) Rules 2006¹ are **revoked**.
- (3) The Supreme Court (Intellectual Property) Rules 2006, as in force immediately before the commencement of these Rules, continue to apply to a proceeding in the Court commenced before the commencement of these Rules as if these Rules had not been made.

1.04 Application of these Rules

These Rules apply to—

- (a) any intellectual property case commenced in the Court on or after 25 October 2016; and
- (b) an application made under Rule 2.02 to enter a proceeding in the List and to a proceeding so entered.

1.05 Application of Chapter I

Chapter I of the Rules of the Supreme Court and the general practice of the Court apply in relation to a proceeding to which these Rules apply except so far as is otherwise provided by—

- (a) these Rules; or
- (b) any Act or regulations made under any Act.

1.06 Definitions

(1) In these Rules—

Advance Australia Logo Protection Act means the Advance Australia Logo Protection Act 1984 of the Commonwealth;

Circuit Layouts Act means the Circuit Layouts Act 1989 of the Commonwealth;

Commissioner means—

- (a) in relation to proceedings under the Patents Act, the Commissioner under that Act;
- (b) in relation to proceedings under the Designs Act, the Registrar under that Act;
- (c) in relation to proceedings under the Trade Marks Act, the Registrar under that Act; and

(d) in relation to proceedings under the Olympic Insignia Protection Act, the Registrar under the Designs Act;

Copyright Act means the Copyright Act 1968 of the Commonwealth;

Court expert means a person who has been appointed as an independent expert under Rule 10.01(1);

decision includes a direction given or determination made by the Commissioner or Secretary;

Designs Act means the Designs Act 2003 of the Commonwealth;

expert includes any skilled person whose opinion on a question relevant to any issue in dispute in a proceeding would be received by the Court;

intellectual property case means—

- (a) a proceeding for the infringement, or the determination of the validity, of—
 - (i) a patent granted under the Patents Act or the Patents Act 1952 of the Commonwealth;
 - (ii) a trade mark registered under the Trade Marks Act;
 - (iii) a design registered under the Designs Act;
 - (iv) EL rights allegedly subsisting under the Circuit Layouts Act;
 - (v) the design of a logo provided for by the Advance Australia Logo Protection Act;

- (vi) a protected design provided for by the Olympic Insignia Protection Act; or
- (vii) copyright allegedly subsisting under the Copyright Act;
- (b) an application, appeal or other proceeding under a subject Act, whether or not joined with any other claim or cause of action;
- (c) a proceeding seeking the protection or exploitation of confidential information;

List means the Intellectual Property List compiled by the Prothonotary;

Olympic Insignia Protection Act means the Olympic Insignia Protection Act 1987 of the Commonwealth;

Patents Act means the Patents Act 1990 of the Commonwealth;

RedCrest means the electronic case management system known as "RedCrest" as in operation in the Court from time to time;

Secretary means the Secretary referred to in the Patents Act;

subject Act means the Advance Australia Logo Protection Act, the Circuit Layouts Act, the Copyright Act, the Designs Act, the Olympic Insignia Protection Act, the Patents Act or the Trade Marks Act, as the case requires;

Trade Marks Act means the Trade Marks Act 1995 of the Commonwealth.

- (2) An expression used in these Rules that is also used in a provision of a subject Act under which, or in relation to which, a proceeding is taken has, for the purposes of that proceeding, the same meaning in these Rules as it has in that provision.

Order 2—Intellectual Property List

2.01 Judge of the Court to control List

- (1) A Judge of the Court shall be in charge and shall have control of the proceedings in the List.
- (2) Subject to any directions of the Judge and to paragraph (3), the powers of the Court in relation to a proceeding in the List shall be exercised only by the Judge.
- (3) The powers of the Judge in relation to a proceeding in the List may be exercised by another Judge of the Court—
 - (a) if the Judge requests the other Judge to do so; or
 - (b) if, in special or urgent circumstances, that other Judge thinks fit to exercise them.

2.02 Entry into Intellectual Property List

- (1) The writ, originating motion, originating process in Form 5F of Chapter I, summons, or other document commencing an intellectual property case may, at the option of the plaintiff, be marked with the words "Intellectual Property List" and, upon the filing of a document so marked, is taken to be entered in the List.

Note

See Rule 28A.01(1) of Chapter I (electronic filing in RedCrest).

- (2) A party to an intellectual property case in which the document commencing it has not been marked in accordance with paragraph (1) may, within 14 days after appearance, apply to the Judge for an order entering the case in the List and the Judge shall make an order entering the case in the List unless satisfied that there are good reasons for not making such an order.

- (3) In any other proceeding, any party or the Commissioner may apply to the Judge for an order entering the proceeding in the List and the Judge may make an order entering the proceeding in the List if satisfied that there are good reasons for making such an order.

Note

See Rule 28A.01(2) of Chapter I (electronic filing in RedCrest).

2.03 Removal from List

The Judge may at any time order that a case in the List be removed from the List.

Note

See Rule 28A.01(3) of Chapter I (electronic filing in RedCrest).

2.04 Directions

- (1) The Judge may, at any time, give any directions for the conduct of the proceeding which the Judge thinks conducive to its effective, complete, prompt and economical determination.

Note

Where a proceeding is commenced by electronic filing of the originating process in RedCrest under Order 28A of Chapter I, a date for a first directions hearing will be allocated automatically and included in the originating process. See Form 5F of Chapter I.

- (2) Without limiting paragraph (1), the Judge may make orders with respect to—
- (a) the defining of the issues by pleadings or otherwise;
 - (b) any amendment of pleadings;
 - (c) any counterclaim;
 - (d) particulars;
 - (e) discovery and inspection of documents;

- (f) admissions of fact or of documents;
- (g) the joinder of parties;
- (h) the mode and sufficiency of service;
- (i) interrogatories;
- (j) the inspection of any property or thing;
- (k) the filing and service of affidavits;
- (l) the disclosure of reports of experts;
- (m) the filing and exchange of signed statements of evidence of intended witnesses and their use in evidence at the hearing;
- (n) the making of any experiment, test or report;
- (o) the appointment of a Court expert under Order 10 of these Rules;
- (p) defining and limiting the issues to be tried, restricting the number of witnesses and otherwise ensuring that the case is disposed of expeditiously;
- (q) documents prepared by the parties;
- (r) the place, time and mode of hearing;
- (s) the giving of evidence at the hearing, including whether evidence in chief of witnesses shall be given orally or by affidavit or affirmation;
- (t) costs.

2.05 Reference in pleadings to published document

Where a party refers in a pleading to any published document (including a book) that party shall, after the pleading is served, make available to any other party to the proceeding who so requests a copy of each such published document or part of that document on which that party relies.

Order 3—Attendance by Commissioner

3.01 Attendance by the Commissioner

The Commissioner may attend and be heard in any intellectual property case, but is not a party to the case unless the Judge otherwise orders.

Order 4—Proceedings under the Patents Act

4.01 Application

This Order applies to proceedings under the Patents Act other than an appeal from a decision of the Commissioner.

4.02 Application for amendment of a patent

- (1) An application for an order under section 105(1) of the Patents Act may be made only after the plaintiff has given to the Commissioner a notice of intention to apply for the order.
- (2) The Judge may give directions with respect to the publication by the plaintiff of an advertisement that states—
 - (a) the identity of the proceeding in which an application under section 105(1) of the Patents Act will be made;
 - (b) the particulars of the amendment sought;
 - (c) the plaintiff's address for service; and
 - (d) the requirement that a person intending to oppose the application who is not a party to the proceeding shall, not later than 28 days after publication of the advertisement, give written notice of that intention—
 - (i) to the Commissioner; and
 - (ii) to the persons who are parties to the proceeding.
- (3) If the Judge orders the publication of an advertisement under section 105(2) of the Patents Act, the Commissioner shall publish the advertisement in the Official Journal (within the meaning of the Patents Act) once, unless the Judge otherwise orders.

- (4) A person who gives notice under paragraph (2)(d) is entitled to be heard in opposition to the application, subject to any direction of the Judge as to costs.
- (5) The application may be instituted by filing a summons in the relevant proceeding.
- (6) A copy of the summons, together with a copy of the patent, patent request or complete specification, as appropriate, showing in ink of contrasting colour the amendment sought, shall be served on—
 - (a) the Commissioner;
 - (b) each party to the proceeding; and
 - (c) each person who has given notice under paragraph (2)(d).
- (7) On the hearing of the summons, the Judge may give any direction the Judge thinks fit for the conduct of the proceeding, including a direction—
 - (a) requiring the applicant to give to each party or other person who opposes the application a statement of the grounds relied on for the amendment;
 - (b) requiring a party or other person opposing the application to give to the applicant a statement of the grounds relied on in opposition to the amendment;
 - (c) determining that the summons will be heard at trial with the relevant proceeding or separately and, if separately, fixing the date for hearing the summons;
 - (d) determining the manner in which evidence will be given and, in the case of evidence by affidavit, fixing the times within which the affidavits shall be filed and served.

4.03 Particulars of infringement

- (1) In an infringement proceeding under section 120(1) of the Patents Act, a copy of the writ and any statement of claim shall be served on—
 - (a) each defendant;
 - (b) the Commissioner; and
 - (c) if the applicant is an exclusive licensee, the patentee.
- (2) Particulars of the infringements complained of—
 - (a) shall give at least one instance of each type of infringement alleged; and
 - (b) shall specify which of the claims of the complete specification of the patent are alleged to have been infringed.
- (3) A defendant who seeks to rely on a defence under section 144(4) of the Patents Act shall give particulars of—
 - (a) the date of, and the parties to, any contract on which the defendant intends to rely for the defence; and
 - (b) the provision of the contract that the defendant alleges is void.

4.04 Grounds of invalidity

- (1) A party who disputes the validity of a patent shall, by the pleading in which the party disputes such validity, set out—
 - (a) the grounds of invalidity on which that party relies; and
 - (b) the material facts relied on in support of each ground.

- (2) If a ground relied on is based on information contained in a document or arises through the doing of an act, the pleading shall specify—
- (a) in the case of a document—
 - (i) the time when, and the place where, the document is alleged to have become publicly available; and
 - (ii) whether the whole or some part of it and, if so, which part of the document is relied on;
 - (b) in the case of an act—
 - (i) the name of the person alleged to have done the act;
 - (ii) the period in which, and the place where, the act is alleged to have been done;
 - (iii) a description that is sufficient to identify the act; and
 - (iv) if the act relates to an article, apparatus or machinery, whether the article, apparatus or machinery exists and, if so, where it can be inspected.
- (3) If—
- (a) one of the grounds of invalidity relied on is that the invention so far as claimed in any claim of the complete specification of the patent is not useful; and
 - (b) it is intended, in connection with that ground, to rely on the fact that an example of the invention which is the subject of any such claim cannot be made to work, either at all or as described in the specification—

the pleading shall identify each such claim and state that fact and shall identify each such example, specifying the respect in which it is alleged that it does not work as described.

- (4) Any party served with a pleading as provided by paragraph (1) shall, unless the Judge otherwise orders, file and serve on each other party to the proceeding an answer to the pleading.
- (5) Except by leave of the Judge, evidence is not admissible in proof of a ground of invalidity in relation to which the requirements of paragraphs (1), (2) and (3) have not been satisfied.

4.05 Compulsory licences and revocation of patents

- (1) Notwithstanding any other provision of these Rules or of Chapter I of the Rules of the Supreme Court, an application under section 133(1), 134(1) or 138(1) of the Patents Act and any statement of claim, originating motion, summons or affidavit in support shall be served—
 - (a) on the patentee; and
 - (b) as a further defendant, on any person who claims an interest in the patent as exclusive licensee.
- (2) Any statement of claim, originating motion, summons or affidavit in support referred to in this Order shall comply with Chapter 12 of the Patents Regulations 1991 of the Commonwealth.
- (3) An application for leave under section 137(4) of the Patents Act may be made by summons in the proceeding.

Order 5—Proceedings under the Trade Marks Act

5.01 Application

This Order applies to proceedings under the Trade Marks Act other than an appeal from a decision of the Commissioner.

5.02 Particulars of infringement

In a proceeding for infringement of a registered trade mark, particulars of the infringement shall—

- (a) specify the manner in which the trade mark is alleged to have been infringed; and
- (b) give at least one instance of each type of infringement alleged.

5.03 Grounds of invalidity

- (1) A party who disputes the validity of the registration of a registered trade mark shall, by the pleading in which the party disputes such validity, set out—
 - (a) the grounds of invalidity on which that party relies; and
 - (b) the material facts relied on in support of each ground.
- (2) Any party served with a pleading as provided by paragraph (1) shall, unless the Judge otherwise orders, file and serve on each other party to the proceeding an answer to the pleading.
- (3) Except by leave of the Judge, evidence is not admissible in proof of a ground of invalidity in relation to which the requirements of paragraph (1) have not been satisfied.

Order 6—Proceedings under the Designs Act

6.01 Application

This Order applies to proceedings under the Designs Act other than an appeal from a decision of the Commissioner.

6.02 Particulars of infringement

In a proceeding for the infringement of a registered design, particulars of the infringement shall—

- (a) specify the manner in which the design is alleged to have been infringed; and
- (b) give at least one instance of each type of infringement alleged.

6.03 Grounds of invalidity

- (1) A party who—
 - (a) applies under section 74, 79(2) or 93 of the Designs Act for the revocation of the registration of a design; or
 - (b) applies under section 120 of the Designs Act for rectification of the Register; or
 - (c) disputes the validity of a registered design—shall, by the pleading in which the party makes that application or disputes such validity, set out the grounds for revocation or rectification or of invalidity on which that party relies and the material facts relied on in support of each ground.
- (2) If a ground relied on is based on information contained in a document or arises through the doing of an act, the pleading shall specify—

- (a) in the case of a document—
 - (i) the time when, and the place where, the document is alleged to have become publicly available; and
 - (ii) whether the whole or some part of it and if so which part of the document is relied on;
- (b) in the case of an act—
 - (i) the name of the person alleged to have done the act;
 - (ii) the period in which, and the place where, the act is alleged to have been done;
 - (iii) a description that is sufficient to identify the act; and
 - (iv) if the act relates to an article, apparatus or machinery, whether the article, apparatus or machinery exists and, if so, where it can be inspected.
- (3) Any party served with a pleading as provided by paragraph (1) shall, unless the Judge otherwise orders, file and serve on each other party to the proceeding an answer to the pleading.
- (4) Except by leave of the Judge, evidence is not admissible in proof of a ground for revocation or rectification or of invalidity of which particulars have not been given.

6.04 Compulsory licences

In a proceeding for the grant of a compulsory licence under section 90 of the Designs Act, particulars of the application shall—

- (a) specify the products embodying the design which have not been made in Australia, to the extent that is reasonable in the circumstances of the case;
- (b) specify the country, if practicable, in which each product is made; and
- (c) state the acts, facts, matters and circumstances intended to be relied on to show that—
 - (i) the registered owner of the design has given no satisfactory reason for failing to exercise the exclusive rights in the design; and
 - (ii) the applicant has tried for a reasonable period, without success, to obtain from the registered owner of the design an authorisation to do, on reasonable terms and conditions, any of the things (specifying which) referred to in section 10(1)(a) to (e) of the Designs Act in relation to the design.

Order 7—Proceedings under the Copyright Act

7.01 Application

This Order applies to proceedings under the Copyright Act.

7.02 Particulars of infringement

In a proceeding for infringement of copyright, particulars of the infringement shall—

- (a) specify the manner in which the copyright is alleged to have been infringed;
- (b) give at least one instance of each type of infringement alleged; and
- (c) specify whether the whole or some part and, if so, which part of the work or other subject matter is alleged to have been infringed.

Order 8—Proceedings under the Circuit Layouts Act

8.01 Application

This Order applies to proceedings under the Circuit Layouts Act.

8.02 Particulars of infringement

In a proceeding for infringement of EL rights, particulars of the infringement shall—

- (a) specify the manner in which it is alleged the EL rights have been infringed; and
- (b) give at least one instance of each type of infringement alleged.

Order 9—Proceedings under the Olympic Insignia Protection Act

9.01 Application

This Order applies to proceedings under the Olympic Insignia Protection Act other than an appeal from a decision of the Commissioner.

9.02 Particulars of infringement

In a proceeding for infringement of the monopoly in a protected design, particulars of the infringement shall—

- (a) specify the manner in which the design is alleged to have been infringed; and
- (b) give at least one instance of each type of infringement alleged.

9.03 Grounds of invalidity

(1) A party who—

- (a) applies under section 12(9) of the Olympic Insignia Protection Act for the rectification of the Register; or
- (b) disputes the validity of a protected design under the Olympic Insignia Protection Act—

shall, by the pleading in which the party makes that application or disputes such validity, set out the grounds for rectification or of invalidity on which that party relies and the material facts relied on in support of each ground.

(2) If a ground relied on is based on information contained in a document or arises through the doing of an act, the pleading shall specify—

- (a) in the case of a document—
 - (i) the time when, and the place where, the document is alleged to have become publicly available; and
 - (ii) whether the whole or some part and, if so, which part of the document is relied on;
- (b) in the case of an act—
 - (i) the name of the person alleged to have done the act;
 - (ii) the period in which, and the place where, the act is alleged to have been done;
 - (iii) a description that is sufficient to identify the act; and
 - (iv) if the act relates to an article, apparatus or machinery, whether the article, apparatus or machinery exists and, if so, where it can be inspected.
- (3) Any party served with a pleading as provided by paragraph (1) shall, unless the Judge otherwise orders, file and serve on each other party to the proceeding an answer to the pleading.
- (4) Except by leave of the Judge, evidence is not admissible in proof of a ground for rectification or of invalidity in relation to which the requirements of paragraphs (1) and (2) have not been satisfied.

Order 10—Appointment of Court expert

10.01 Court expert

- (1) In any proceeding in the List which in the opinion of the Judge involves a question for an expert witness, the Judge may, at any time on the application of a party or on the Judge's own motion, appoint an independent expert—
 - (a) to inquire into and report on a question of fact or of opinion (not involving questions of law or construction); or
 - (b) to provide a demonstration for the Court.
- (2) The Judge may appoint Court experts in respect of different subject matters and this Order applies to each appointment.
- (3) A Court expert shall be a person agreed between the parties but, failing agreement, shall be nominated by the Judge.
- (4) The question or the instruction submitted or given to the Court expert, failing agreement between the parties, shall be settled by the Judge.

10.02 Report by Court expert

- (1) A report by a Court expert shall be made in writing to the Court and shall, together with such copies as the Judge directs, be provided to the Judge.
- (2) A copy of the report shall be forwarded by the Prothonotary to each party.
- (3) Any report made by a Court expert shall, insofar as it is not accepted by all parties, be treated as information furnished to the Court and shall be given such weight as the Court thinks fit.

10.03 Cross-examination of Court expert on report

- (1) A party may, within 14 days after receipt of a copy of the report or within such further time as the Judge directs, apply for leave to cross-examine the Court expert on the report.
- (2) The Judge may, on an application under paragraph (1), make an order for cross-examination of the Court expert—
 - (a) at the trial; or
 - (b) before such person and at such time and place as the Judge directs.

10.04 Conduct of experiment or test

- (1) If the Court expert is of the opinion that an experiment or test (other than an experiment or test of a trifling character) is necessary to enable the Court expert to report in a satisfactory manner, the Court expert—
 - (a) shall inform the parties; and
 - (b) shall, if possible, make an arrangement with them as to—
 - (i) the expenses involved;
 - (ii) the persons to attend; and
 - (iii) other relevant matters.
- (2) If the parties are unable to agree on any matter, that matter shall be settled by the Judge.

10.05 Further report

The Judge may, at any time, direct a Court expert to make a further or supplementary report.

10.06 Remuneration of expert

- (1) The remuneration of a Court expert shall be fixed by the Judge and shall include—
 - (a) a fee for making the report and a fee for any further or supplementary report (including the cost of an experiment or test under Rule 10.04 where the parties are unable to agree on the fee); and
 - (b) a fee for each day on which the presence of the Court expert is required either in Court or before such person as is referred to in Rule 10.03(2)(b).
- (2) The parties shall be jointly and severally liable to pay the remuneration so fixed without prejudice to the question by whom it shall be ordered to be paid as part of the costs of the proceeding.
- (3) The Judge may require any party to give security for the remuneration of the Court expert.

Dated: 25 August 2016

M. L. WARREN, *C.J.*
CHRISTOPHER MAXWELL, P.
R. S. OSBORN, J.A.
DAVID F. R. BEACH, J.A.
S. G. E. McLEISH, J.A.
ELIZABETH HOLLINGWORTH, J.
ANTHONY CAVANOUGH, J.
JACK FORREST, J.
JAMES JUDD, J.
PETER VICKERY, J.
TERRY FORREST, J.
KARIN EMERTON, J.

Supreme Court (Intellectual Property) Rules 2016
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Order 10—Appointment of Court expert

CLYDE CROFT, J.
JOHN R. DIXON, J.
C. MACAULAY, J.
KATE McMILLAN, J.
GREG GARDE, J.
G. J. DIGBY, J.
JAMES D. ELLIOTT, J.
T. J. GINNANE, J.
MELANIE SLOSS, J.
JOANNE CAMERON, J.
MICHAEL McDONALD, J.
JANE A. DIXON, J.
A. J. KEOGH, J.
MAREE KENNEDY, J.

Endnotes

- ¹ Rule 1.03(2): S.R. No. 163/2006. Reprint No. 1 as at 2 April 2015.
Reprinted to S.R. No. 47/2014.