



## FEDERAL CIRCUIT COURT OF AUSTRALIA

Federal Circuit Court of Australia  
Commonwealth Law Courts  
305 William Street  
Melbourne Vic 3000

Telephone: (03) 8600 4450  
Facsimile: (03) 8600 4445

### MEMORANDUM

TO	Bar Associations and Law Societies
FROM	Adele Byrne
DATE	21 August 2018
SUBJECT	Federal Circuit Court – National Intellectual Property Practice Direction

See attached *Practice Direction No 1 of 2018* which sets out arrangements for the management of intellectual property matters in the Federal Circuit Court and applies nationally. *Practice Direction No 1 of 2017* which applied only in respect of intellectual property filings in the Melbourne Registry is revoked.

As highlighted in the Practice Direction all intellectual property matters filed in the Court are docketed to Judge Baird.

Wherever possible the first case management hearing/directions hearing, will take place within three weeks of the filing of the application and will flexibly organise the interlocutory steps in the proceedings so that the proceeding may be conducted as effectively and efficiently as possible.

The Court will take an active part in controlling the trial of an intellectual property proceeding. Prior to trial, the Court will ordinarily make directions that involve the parties preparing, filing and serving – (a) a chronology of relevant events; (b) an outline of the case (limited to three A4 double spaced pages); (c) contentions of fact and law; (d) a form of proposed orders.

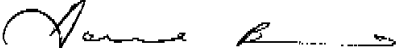
Cross examination will be controlled.

The judge will endeavour to ensure that the trial does not take longer than two days in the majority of cases.

If the parties agree and where the judge considers it appropriate to do so, the judge may conduct the trial entirely on the papers.

After the final hearing, a decision will be given, where practicable, generally within the month, and in urgent matters, within a week.

Yours sincerely,

  
Adele Byrne  
Deputy Principal Registrar

Enc



## FEDERAL CIRCUIT COURT OF AUSTRALIA

### *Practice Direction No 1 of 2018*

#### INTELLECTUAL PROPERTY PRACTICE DIRECTION

#### INTRODUCTION

1. This Practice Direction sets out arrangements for the management of intellectual property matters in the Federal Circuit Court (“the Court”).
2. The Practice Direction is intended to set out guiding principles for the conduct of intellectual property proceedings in the Court. The Practice Direction took effect on 1 July 2018 and applies nationally with respect to all intellectual property proceedings commenced in the Court after that date. *Practice Direction No 1 of 2017* which applied only in respect of intellectual property filings in the Melbourne Registry is therefore revoked from that date.
3. It is to be read together with the *Federal Circuit Court of Australia Act 1999* (Cth), the *Federal Circuit Court Rules 2001* (Cth), the *Federal Court of Australia Act 1976* (Cth) (*Federal Court Act*) and the *Federal Court Rules 2011* (Cth).
4. The *Federal Court Act* and the *Federal Court Rules* will apply where the *Rules* do not deal with a particular matter. Parties should be aware that the *Rules* apply certain intellectual property rules of the *Federal Court Rules*, in particular Divisions 34.2 and 34.3 of the *Federal Court Rules*.

#### JURISDICTION

5. The Court has jurisdiction to hear and determine civil disputes concerning copyright, designs, trade marks and plant breeder’s rights as set out below. The Court’s jurisdiction in these matters is concurrent with that of the Federal Court.
6. The Court can provide declaratory and injunctive relief, and award damages or an account of profits. There is no limit on the award of damages or taking of an account of profits, or on the ability of the Court to award additional damages. However, there is a limit of \$750,000 on damages in the Court’s consumer/ trade practices jurisdiction.

### ***Copyright Act 1968***

7. Under the *Copyright Act*, the following matters:

- All civil claims and matters under Parts V (except s 115A), VAA, and IX and s. 248J.

### ***Trade Marks Act 1995***

8. Under the *Trade Marks Act*, the following matters:

- Appeals from decisions of the Registrar of Trade Marks: ss 35, 56, 67, 83(2), 83A(8), 84A -84D and 104
- Infringement actions s 120-121 (see also 122-128), and under s 130
- Applications for relief from unjustified threats under s 129
- Decision on whether a person has used a trade mark under s 7
- Determining whether a trade mark has become generic: ss 24, 87 and 89
- Amendment or cancellation of registration under ss 85 and 86
- Revocation of registration by amendment or cancellation or entering a condition or limitation under ss 88 and 89
- Application for an order to remove a trade mark registration for non use: s 92(3), and on referral to the Court by the Registrar under s 94
- Application for rectification of the Register by order of the Court under s 181
- Variation of rules governing use of certification trade mark under s 182

### ***Designs Act 2003***

9. Under the *Designs Act*, the following matters:

- Appeals from Decisions of the Registrar of Designs: ss 28(5), 67(4), 68(6), 50(6), 52(7) and 54(4)
- Ability to make a determination of the entitled person during proceedings before the Court under s 53
- Infringement actions under ss 71-76
- Applications for relief from unjustified threats under ss 77-81
- Application for compulsory licences under ss 90-92
- Revocation of registration under s 93
- For Crown use provisions, provide a determination of the term of use of a design under s 98
- Application for a declaration by a court of any Crown use under s 101
- Application for the cessation of Crown use of a design under s 102
- Rectification of the Register under s 120

### ***Plant Breeder's Rights Act 1994***

10. Under the *Plant Breeder's Act*, the following matters:

- The Court has jurisdiction in respect of alleged infringements under this Act.

## ***Consumer Law***

11. The Court has jurisdiction with respect to claims under the following provisions of the *Competition and Consumer Act 2010* (formerly the *Trade Practices Act 1975*) and can combine these proceedings with proceedings in another area of its jurisdiction.
  - Section 46 (Misuse of Market Power)
  - Section IVB (Industry Codes)
  - Part XI (Application of the Australian Consumer Law as a law of the Commonwealth), and
  - Schedule 2 (Australian Consumer Law).

## **Associated Jurisdiction**

12. The Court has jurisdiction conferred in respect of matters not otherwise within its jurisdiction that are associated with matters in which the jurisdiction of the Court is invoked (s 18).
13. In broad terms, that section invests the Court with jurisdiction in a federal matter, even if it has not otherwise been given that jurisdiction, as long as that matter is associated with another federal matter over which the Court does have jurisdiction.

## **Transfer**

14. The Court also has jurisdiction to hear any matter within the jurisdiction of the Federal Court which the Federal Court transfers. The Court may transfer a proceeding to the Federal Court at the request of a party or of its own motion (Rule 8.2(1))

## **COMMENCING PROCEEDINGS**

15. Subject to any contrary advice below the *Federal Circuit Court Rules* and forms apply to the commencement of these proceedings.

## **National Practice Area - Intellectual Property**

16. The Court has established National Practice Areas (NPAs), consistently with those in the Federal Court of Australia. Intellectual property is one of the Court's NPAs. Once an application which falls within the Intellectual Property NPA is docketed to a Judge in the Intellectual Property NPA, it will generally remain with that Judge.

## **Forms**

17. Rule 4.01 outlines the general requirements for commencing a proceeding including the requirement to file an approved form of application supported by an affidavit. However, note the exception in subrule 4.05(2).
18. The Approved forms for intellectual property matters commenced in the Court are as follows:

### *Copyright*

Application under the Copyright Act

### *Trade Mark or Design or Plant Breeder's Rights*

For Applications (other than appeals) - Application - General Federal Law

For Appeals from decisions of the Registrar of Trade Marks or the Registrar of Designs *Notice of Appeal (Intellectual Property) - Federal Court form (92)*

### ***What else is filed?***

19. An affidavit or statement of claim or points of claim: see Subrule 4.05(1) and (2). If Part 2 of the *Civil Dispute Resolution Act 2011* applies to the proceeding, Division 4.2 of the *Federal Circuit Rules* requires that an applicant must file a genuine steps statement: see Rule 4.09.

### ***What is filed in response?***

20. An affidavit or defence or points of defence, see Subrule 4.05(3). Where an applicant has filed a genuine steps statement, the respondent must file a respondent's genuine steps statement: see Rule 4.10.

<http://www.federalcircuitcourt.gov.au/wps/wcm/connect/fccweb/forms-and-fees/court-forms/forms-approved/approved-forms-gfl>

### **Rules**

21. See above. In respect of intellectual property proceedings, the Court has applied Divisions 34.2 and 34.3 of the *Federal Court Rules* by way of Schedule 3 Part 2 of the *Federal Circuit Court Rules*.

### **Pleadings**

#### ***Points of claim or concise statement***

22. The grounds of an application must explain briefly the basis on which the orders are sought. In most instances the use of an application and affidavit will negate the need for pleadings but, where appropriate, points of claim will be ordered. In such instance an applicant may attach a pleading by way of points of claim. Such a pleading should observe the requirements of *Federal Court Rules*, Part 16, as identified in Schedule 3, Part 2 of the *Federal Circuit Court Rules* items 7 to 16. It should identify in summary form the material facts on which the applicant relies, but not the evidence by which those facts are to be proved. All necessary particulars must be given.
23. Parties should consider whether the use of a **concise statement** in support of an originating application should be used instead of points of claim or supporting affidavit. The purpose of a concise statement is to enable the applicant to bring to the attention of the respondent and the Court the key issues and key facts at the heart of the dispute and the essential relief sought from the Court. It should be

prepared in the nature of a pleading summons and may be drafted in a narrative form. If a concise statement is filed with the application, no further originating material in support (points of claim or affidavit) is required to be filed until the Court orders.

24. The concise statement should not exceed 5 pages (including formal parts). It will be plain, concise and direct. It will summarise:
- (a) the important facts giving rise to the claim; (b) the relief sought and against whom; (c) the primary legal grounds (causes of action) for the relief sought; and (d) the alleged harm suffered by the applicant, including, wherever possible, a conservative and realistic estimate or range of loss and damage.

### ***Defence and any cross-claim***

25. An affidavit or defence or, where points of defence are filed, points of defence: see Subrule 4.05(3). A respondent may file a cross-claim. In the ordinary course, orders will be made at the first case management hearing in relation to the filing of a defence or points of defence, and any cross-claim.
26. Where a concise statement is filed, the respondent may be required to file a concise statement in response, which may also be drafted in a narrative form.

### **Costs**

27. Schedule 1 of the Rules provide an events based costs regime however there is discretion to depart from this regime and a Judge may fix the amount of costs and disbursements payable. The Court may fix the maximum costs that may be recovered on a party/party basis.
28. If an order is made for costs to be paid in accordance with the scale of costs applied in the Federal Court then failing agreement costs may be referred for assessment in accordance with the Federal Court Rules.
29. Rule 21.03 provides that the Court may specify the maximum costs that may be recovered on a party and party basis and it is anticipated that this provision will be used by the Court in many matters dealt with in this list.
30. Further information on costs can be found on the website at:

<http://www.federalcircuitcourt.gov.au/wps/wcm/connect/fccweb/forms-and-fees/fees-and-costs/legal-costs-generalfederallaw/legal-costs-general-law>

### **Fees**

31. The fees are set out in Schedule 1 Part 2 of the *Federal Court and Federal Circuit Court Regulations 2012* and are generally less than those for the Federal Court.

32. A list of the current fees payable can be found on the website at:

<http://www.federalcircuitcourt.gov.au/wps/wcm/connect/fccweb/forms-and-fees/fees-and-costs/fees-gfl/fees-gfl>

## **CASE MANAGEMENT**

33. From 1 July 2018 all intellectual property matters filed in the Court are docketed to Judge Baird. Judge Baird generally sits in Sydney. Court appearances will be managed by video link and/ or telephone link when parties or their representatives are in differing locations.
34. The conduct of proceedings on the first court date is fully detailed in Rules 10.01 to 10.03. The first court return date will be a case management hearing unless the judge directs that a directions hearing will be conducted, or unless the applicant, when filing the application, indicates that the applicant does not require a case management hearing.
35. Wherever possible the first case management hearing/directions hearing, will take place within 3 weeks of the filing of the application.
36. The first case management hearing will flexibly organise the interlocutory steps in the proceedings so that the proceeding may be conducted as effectively and efficiently as possible. The Court may give directions, order the parties to mediation, fix a date for final hearing, conduct an interim hearing or finally determine the application. The purpose of the case management hearing is to formulate ways to manage the conduct of the proceeding so as to bring it to trial in a manner proportionate to the nature of the dispute, the financial position of the parties, the degree of complexity of the case, the importance of the case and the amount of money or issues in dispute.
37. The parties and their legal representatives are required to attend court and must have a good knowledge of the case. At the case management hearing the parties or their legal representatives must be prepared to engage in discussion with the judge about all aspects of the proceeding including factual and legal issues likely to require determination, procedural issues likely to arise and whether it is or is likely to be appropriate to make orders in relation to witness statements, expert evidence, discovery as well as cross examination of witnesses.
38. Ordinarily, the case management hearing will be conducted in an informal manner in open court.
39. Unless otherwise ordered, once orders are made at the conclusion of the case management hearing, the parties will not be permitted to rely on additional evidence or on discovery or on written submissions save in exceptional circumstances.

## **Mediation**

40. Mediation will be conducted by Registrars of the Court or the parties may utilise private mediators appointed under the schemes conducted by the Law Societies

or independent Bars of the respective State or Territory in which the proceeding was commenced, or otherwise as agreed by the parties.

## **Trial**

41. The Federal Circuit Court is a trial court and it is intended that proceedings be conducted expeditiously.
42. The Court will take an active part in controlling the trial of an intellectual property proceeding. Prior to trial, the Court will ordinarily make directions that involve the parties preparing, filing and serving – (a) a chronology of relevant events; (b) an outline of the case (limited to three A4 double spaced pages); (c) contentions of fact and law; (d) a form of proposed orders.
43. Cross examination will be controlled.
44. Where objection is taken to any affidavit material, parties are expected to privately confer in advance of the hearing with a view to discussing and resolving the objections, making appropriate amendments to the relevant affidavit material. Save in exceptional circumstances, the Court will not permit significant amounts of court time to be devoted to the hearing and determination of evidentiary objections.
45. Where time can be saved, the parties should reduce openings and final addresses to written form.
46. The judge will endeavour to ensure that the trial does not take longer than two days in the majority of cases.
47. If the parties agree and where the judge considers it appropriate to do so, the judge may conduct the trial entirely on the papers.
48. After the final hearing, a decision will be given, where practicable, generally within the month, and in urgent matters, within a week.

## **URGENT APPLICATIONS**

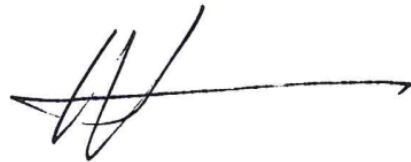
49. Urgent IP matters including interlocutory injunctions, *Anton Piller* orders and orders in the nature of *Norwich Pharmacal* relief may be sought to alleviate the effects of alleged infringements.
50. Part 5, Rules 5.01 to 5.03 deal with urgent applications and the manner in which they can be brought before the Court.
51. An application to deal with an urgent matter is to be accompanied by a draft of the order sought and can be made on the initiating application or any form approved for use in the Court.
52. In an urgent case where service on the respondent is not possible, on application the Court may make an order until a specified time or until further order.

53. Evidence on urgent applications shall be by way of affidavit or orally with the leave of the Court. Rule 5.03 details the information that is required by the Court in dealing with urgent applications.

**ENDING A PROCEEDING EARLY**

54. Pursuant to Rule 13.01 a party may discontinue an application or a response by filing a notice of discontinuance in accordance with the approved form.
55. A party discontinuing an application or part of an application may be liable for costs. Rule 13.02.

W Alstergren

A handwritten signature in black ink, consisting of a stylized 'W' followed by a horizontal line that ends in an arrowhead.

Chief Judge  
Federal Circuit Court

20 August 2018