



Patents Trade Marks Info Services Designs Legal Services

## Editorial

On 14 March 2013, POF held an evening function for staff of our Melbourne office as part of our 125th birthday celebrations. The staff gathered on the banks of the Yarra River for the above photo before the celebrations commenced at a nearby venue. The evening provided a terrific opportunity to celebrate the firm's history and for the speechmakers to recall many of the more humorous moments in the recent past.

Above that is the firm's official photo taken in 1907, in which one of the firm's founders, Edwin Phillips, is seated front and centre.

Whilst the rest of Edwin's staff look a little glum, there is a hint of a smile on Edwin's face. No doubt he felt a sense of confidence about the future of the firm he helped establish.

Shortly after our birthday celebrations, the Raising the Bar Act 2012 came into effect on 15 April 2013. On page 3, Karen Spark reviews a number of the procedural changes brought about by this legislation.

Our readers who are cricket fans will be familiar with the Bay 13 area at the Melbourne Cricket Ground. As Mark Williams discusses on page 7, Bay 13 is now a pending trade

mark application as well. Also included in this edition of *Inspire!* is a commentary by myself and Daniel McKinley on a recent Full Federal Court decision on the contributory infringement provision of Australia's Patents Act. This is an area of patent law that has recently been receiving quite a lot of attention in Australia.

I hope you enjoy the winter edition of *Inspire!*.

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## Google Revises Australian Adwords Policy

by Russell Waters

Earlier this year, the Australian High Court held that Google was not liable for misleading or deceptive conduct in allowing third party advertisers to use competitors' trade marks as keywords in Google Adwords advertisements. Following this decision, Google has changed its policy on Adwords advertising effective 23 April 2013.

Under the amended policy, Google will no longer investigate or restrict the use of trade mark terms in keywords used for Google Adwords advertisements, even if a trade mark complaint is received.

A 'keyword' is a term selected by advertisers to be linked to their Adwords advertisement that may be entered by a user looking for particular goods. The change in policy means that a trade mark owner must pursue action separately against each competitor who adopts a registered trade mark as a keyword, in order to prevent ongoing infringement. However, if the trade mark is used in the text of an advertisement, Google will still investigate and may enforce restrictions on use of the trade mark.

The recent change to the policy in Australia, (which also affects Brazil, China, Hong Kong, Macau, New Zealand, South Korea and Taiwan), brings the policy in Australia into alignment with the policy in other countries, creating a single global policy. Google originally introduced this policy in more than 100 countries back in 2009 and across Europe in 2010. Although there is clearly some history with the policy, the timing of the announcement after the High Court ruling creates the impression that that ruling was also a relevant factor in the change of policy in this jurisdiction.

Google's rationale for the new policy is that it enables shoppers searching for a particular brand to easily find competing brands, "similar to the way a shopper benefits when they see a variety of brands' products on a store shelf". This comparison is fair enough if a customer enters generic search term, for example 'running shoes', which would effectively be the equivalent of entering a department store sporting goods or footwear department in real life ('IRL'). The difference can be seen if a consumer has already researched the specific goods and enters brand A's store IRL with the intention of making a purchase, and is subsequently inundated with posters advertising another brand's goods. This is not something the customer would normally expect or want. Further, you would expect that brand A would not be pleased by such posters being placed in front of its store.

Trade mark owners will need to remain vigilant to ensure their trade marks are not being used by competitors as Google Adwords keywords. At the same time, traders should be aware that just because Google may not be liable for allowing them to use someone else's registered trade mark as a keyword, such use may still constitute misleading or deceptive conduct, and they may face an action from the ACCC or the trade mark owner for such use.

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## Raising the Bar – What's Next?

by Karen Spark

The *Intellectual Property Laws Amendment (Raising the Bar) Act 2012* and Regulations came into effect on 15 April 2013.

Earlier editions of *Inspire!* have detailed the substantive changes to Australian patent law and trade mark law. In this article, we look at some of the procedural changes that impact on how future actions with IP Australia will be transacted, and the timelines for doing so.

### Patents

- i. A request for examination must be filed within two months of the date of a Direction issued by IP Australia. At the time of requesting examination, a statement of entitlement to receive patent grant **must** be provided. Examination cannot be requested without such a statement.
- ii. The statement of entitlement must identify the applicant's entitlement to receive grant and to claim priority from the basic application(s). We recommend this information be provided to us at the time of filing or shortly thereafter, so a request for examination can be filed at any time without delay.
- iii. A request for examination must be filed no later than five years following filing of the application. Failure to request examination within this time frame will result in the application lapsing.
- iv. Where a standard patent application under examination claims an invention which has not previously been officially searched, a new official search fee may apply for applications filed on or after 15 April 2013. IP Australia has indicated that the requirement to pay the search fee will not be implemented immediately, and that they will announce later when the new fee will be applied.
- v. The deadline for obtaining acceptance of a patent application on which examination was requested after 15 April 2013, is 12 months from the date of the first examination report. It is important to note the deadline is an acceptance deadline and not a response deadline.

- vi. A notice of entitlement to rely on a deposit of a micro-organism or a copy of the deposit receipt must still be filed prior to acceptance of a patent application.
- vii. Re-examination of standard patents and innovation patents can now proceed on the basis of all substantive grounds considered during examination other than lack of unity. Previously, the only grounds for re-examination were lack of novelty and inventive/innovative step. The extended grounds for re-examination apply to all re-examination reports filed on or after 15 April 2013, regardless of when re-examination was actually requested.

### Oppositions

- i. Parties no longer need to serve evidence and documents upon each other. This applies to existing and new oppositions for patents, trade marks and designs.
- ii. All opposition evidence must be submitted to IP Australia electronically and in an approved form. Physical evidence will only be permitted to be filed in exceptional circumstances.
- iii. More rigorous Extension of Time requirements apply to evidentiary periods commenced on or after 15 April 2013. If you are involved in any opposition procedures now or into the future, we recommend that you discuss the new requirements with one of our attorneys.

Please contact us at [attorney@pof.com.au](mailto:attorney@pof.com.au) if you would like further information about any of the Raising the Bar changes or if you have any questions about how those changes will impact on future actions with IP Australia.

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## Terminating IP Agreements

by Margaret Ryan

Terminating an intellectual property (IP) agreement can be more complex than terminating more common commercial contracts. IP contracts deal with property – intellectual property. Thus the question arises as to what is to happen to that intellectual property upon termination. The agreement itself should provide for this or, if it does not do so explicitly, it may be implicit in the nature of the right granted – assignment or licence.

### Assignment vs licence

An assignment of intellectual property, such as a patent, trade mark, copyright or design, is a transfer of the ownership of the right. It is like selling a car – the original owner does not normally get it back again. This is not, however, a blanket statement. In relation to some IP agreements, such as some publishing agreements, there may be a reversion of rights even though the copyright has been assigned by the author, if, for example, the book is not being published.

A licence is quite different to an assignment. A licence is akin to renting a house. The tenant can use the house for their own purposes for the term of the lease or until the lease is terminated earlier, for example, for failure to pay rent. Similarly, the licensee can use the IP for the term of the licence and it usually pays licence fees and/or royalties instead of rent.

When an IP licence terminates, the licensee normally has to cease using the IP – cease selling the patented products or the trade marked goods etc. In a well-drafted licence from the licensee's perspective, there may be a sell-out period. This allows the licensee to sell its existing stock for a specified period or complete existing contracts.

### Consequences of continuing to use

A licensee under a terminated licence who ignores the obligation to cease using the IP does so at its peril. Once the licence is terminated and any sell-out period is over, further sales of the product become an infringement of the IP right. This was the fate that befell the former publisher of celebrity chef Bill Granger. The *Canberra Times*<sup>1</sup> reported that, after the publishing agreement ended, the publisher, Murdoch Books Pty Ltd, published two cook books under the Granger banner with a compilation of recipes from previous books whose publication had been authorised.

The matter settled with the publisher liable to pay Mr Granger 18.5% of past and future sums received for the compilation cookbooks in paper form, and 25% of sums received for electronic form, less the sum of \$60,363.24 that the publisher had already paid to Mr Granger.<sup>2</sup> This was presumably something like the royalty rate that Mr Granger would have received under his previous publishing agreement.

One of the main measures of damages in IP cases is the loss that the plaintiff has suffered. This usually takes one of two forms:

- (a) the profit on sales lost by the plaintiff – on the assumption that each sale made by the defendant is a sale lost to the plaintiff; or
- (b) a reasonable royalty on the sales by the defendant – on the assumption that the plaintiff would have been prepared to license its IP to the defendant for a price.

Each of the assumptions has to be proved to be correct by the plaintiff for it to recover on one or other of these bases.

There are other forms of compensation in an infringement of IP action that are not available in an action for breach of contract following the termination of an IP licence. In IP matters, the plaintiff has the option of claiming an account of profits<sup>3</sup>, which entitles it to recover the net profits made by the former licensee on its unauthorised sales. This is an alternative to damages and it is up to the plaintiff to choose which remedy would recover the most money. An account of profits would be preferable if the plaintiff cannot show that it has suffered a loss through the infringing activity.



In addition, currently under the Patents Act<sup>4</sup>, the Copyright Act<sup>5</sup> and the Designs Act<sup>6</sup>, the Court can award additional damages in certain circumstances. These circumstances are spelled out in the Patents and Copyright Acts as including the flagrancy of the infringement, the need for deterrence, the conduct of the defendant and the benefit that it gained from the infringement. On 15 April 2013, amendments to the Trade Marks Act came into effect, which allow a trade mark owner to recover additional damages as well.<sup>7</sup>

Under the Copyright Act<sup>8</sup> alone, a plaintiff may also recover conversion damages. These are in addition to other relief that may be obtained by the plaintiff, although conversion damages may not be awarded if the Court considers the plaintiff has already received a sufficient remedy under the Copyright Act. Under this head of damage, the court assumes the copyright owner is the owner of the physical articles embodying the copyright work, such as the infringing books. It then assumes that these have been stolen from the copyright owner and then allows the copyright owner to recover their value. This used to allow for a very high amount of damages. The Act has now been amended to reduce the damages by taking into account the defendant's expenses in producing the infringing articles and the importance of the copyright work to the infringing article (if it is only part of it).

However, the main remedy that a plaintiff usually seeks in an IP case, whether following the termination of a licence or not, is to stop the infringing activity. This is granted by a court in the form of an injunction.<sup>9</sup> This is ultimately not what Mr Granger obtained because he reached an agreement with his former publisher. The agreement allowed the continued sale of the compilation books to the mutual benefit of both.

Most IP cases, as with most other legal cases, settle before the matter goes to trial. This is the opportunity to reach an agreement which, although a compromise, meets the needs of both parties.

## A case in point – domain names

It is not uncommon for a former licensee to want to keep using the IP after the termination of its licence, as did Murdoch Books. Hopefully a letter of demand and some negotiation will resolve the situation. One matter where I acted related to the termination of a distribution agreement. A distribution agreement ordinarily includes a trade mark licence. In this case, the distributor had registered the licensed trade mark as a domain name. The ex-distributor did not cease using the domain name and failed to cancel or hand over the domain name to the trade mark owner. In Australia, the registrant of a domain name needs to sign a form to transfer the domain name, and if the ex-distributor is unwilling, this can be difficult.

A registered trade mark can be infringed by the use of a domain name in relation to a website selling goods or services for which the trade mark is registered (or similar goods), as the domain name is analogous to a shop front sign indicating the goods or services sold within.<sup>10</sup> If the licensee adopts a new domain name but continues to have the old domain name pointing to the new website, this can also be an infringement of the trade mark.<sup>11</sup>

In my matter, the domain name was handed over for a fee paid by the trade mark owner. Sometimes paying out the holder of a domain name is the simplest and least expensive option, rather than taking litigation. A well-drafted trade mark licence should state whether or not the licensee may use the trade mark in a domain name, business name, company name, Twitter or Facebook name, and should oblige this use to cease on the termination of the licence. The licence agreement can appoint the licensor as the licensee's attorney so the licensor can cancel these registrations when the licence is terminated.

The best protection against confusion at the end of an IP licence is to have a well drafted agreement that spells out what will happen in the event of termination. If, despite this, the ex-licensee breaches these terms and continues to use the IP, IP law has a variety of remedies that can be called upon to force this activity to cease and compensate the licensor.

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## Celebrating 125 Years – An Interview with Graham Cowin

**Phillips Ormonde Fitzpatrick's Managing Partner, Graham Cowin, talks about life at POF, how times have changed and guilty pleasures.**



### **When did you join POF and why have you stayed so long?**

I joined the firm on 18th August 1975 and stayed because I've enjoyed it.

I've had a very varied career, even though it's been in the one organisation, I've had a lot of opportunities here. I came from the Patent Office in Canberra and worked my way into different roles. I continued to see opportunities at POF that I didn't believe existed elsewhere.

### **What do you like best about POF?**

The people! Also the variety of work that's been available, but clearly it's the people who make this firm.

There's an incredible range of personalities and skills at POF, and for everyone to come together and work so collaboratively is quite an achievement. We've got scientists, engineers, chemists, biologists, lawyers and so on, all working with IT, HR, marketing, administration – all these different personalities, it's quite an eclectic mix!

### **What is the most interesting case/project you've worked on?**

Australian Court proceedings between two Japanese corporations involving numerically controlled machines. It was an expensive patent dispute relative to the Australian market for the machines, although the validity issue in the patent in suit was quite a simple one.

### **How has POF changed since you've been here?**

It's grown. It's evolved from one business unit into three – POF, POFL and IPO.

The way in which we handle work has also changed dramatically thanks to the digital revolution. When I started there were no computers, and we relied on hand written case registers and card systems for diary entries, and manual typewriters.

Finally, client expectations have changed. Whereas response times of days or even weeks used to be acceptable, clients now expect an almost immediate response. And thanks to the digital era we can meet that expectation.

### **What's your favourite invention of all time?**

1960's popular music, particularly pop rock. Elvis Presley and Bill Haley may have had early (business method) patents on a more pure form of rock, but the likes of The Beatles and The Rolling Stones avoided infringement and spawned a generation of musical evolution which continues 50 years later.

### **As a child, what did you want to be when you grew up?**

A house builder, a carpenter. I love timber – the smell and how it can be worked.

### **What's your guilty pleasure?**

Desserts. I have a real sweet tooth – not lollies or chocolates, but I always like ending a meal with dessert. A meal isn't finished until you've had dessert!

### **What are your hobbies? What do you do when you're not at work?**

Gardening, cars (classic and racing), being in the shed (everyone should have one).

### **What advice would you give to yourself if you were starting out at POF?**

"Take the opportunities that come along, you will grow from them."

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## Melbourne Cricket Club Applies for Bay 13 Trademark

by Mark Williams

The Melbourne Cricket Ground, commonly known as the MCG (sometimes shortened to the 'G' and occasionally referred to as 'the people's ground'), is one of the largest and most famous sports stadiums in the southern hemisphere. Its custodians, the Melbourne Cricket Club (MCC), is a club which was founded in 1838 and is one of the oldest sporting clubs in Australia.

Over the years, the MCC have sought trade mark protection for a number of trade marks relating to the ground:

Trademark	Class
	25 41 16, 28, 41
THE GEE	41
	16, 25, 28, 41, 42
 <i>The People's Ground</i>	16, 25, 28, 41, 42
<i>The People's Ground</i>	16 25, 28, 41, 42
	16, 25, 28, 35, 41, 42, 43
	16, 25, 28, 35, 41, 43

### Bay 13

Membership of the MCC is highly sought after in Melbourne and there is a long waiting list, currently 20+ years, to join. Full membership entitles members to entry into an exclusive part of the ground, the 'Members Reserve'. Dress standards apply and members must behave in a manner becoming to the club.

Directly opposite the Members Reserve is an area of the ground, known to most Australians as Bay 13, which is open to the general public and (during the summer at least) is bathed in sun for most of the day. This generally results

in what could best be described as 'overly refreshed' patrons. The origins of Bay 13 can be traced back to the early 1980s.

It would be fair to say that the behaviour of the patrons in Bay 13 is at odds with that of the patrons of the Members Reserve, with inebriation, Mexican waves and beer snakes par for the course.

### Trade Mark: Bay 13

Late in 2012, the MCC applied to register BAY 13 as a trade mark. The application is currently pending and the MCC have recently overcome at least one hurdle in achieving registration, namely the removal of an existing registration for a Bay 13 logo. This was filed by (we assume) some entrepreneurial Bay 13 enthusiasts in 2004.



*The removed Bay 13 mark*

Under the *Australian Trade Marks Act 1995*, trade marks which have not been used are vulnerable to removal for non-use. The successful removal of the Bay 13 logo for non-use by the MCC should clear the path for MCC's registration of BAY 13 as a trade mark.

Not surprisingly, the Melbourne Cricket Club has registered the mark in respect of paper products, clothing, games, entertainment and providing food and drink services.

It is worthwhile obtaining professional advice and preferably conducting regular intellectual property (IP) audits to ensure your organisation's trade marks are identified and protected before another party beats you to it.

If you wish to arrange for an IP audit or start any non-use proceeding against trade marks of others (or if your own trade marks have had non-use proceedings brought against them), please contact us.

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## Lost in Translation

by Anita Brown

The Italians are as famous for their coffee as Australians are for drinking it. So it is no surprise that many coffee brands carry a trade mark in the Italian language.

In the recent case of *Cantarella Bros Pty Limited v Modena Trading Pty Limited* [2013] FCA 8, Cantarella Bros, the company behind the *Vittoria* coffee label, successfully sued *Modena* for infringement of its registered trade marks ORO and CINQUE STELLE— Italian for GOLD and FIVE STAR.

Among the issues the court considered was whether ORO and CINQUE STELLE were inherently adapted to distinguish coffee products. This was a critical issue, because if the marks were found not to be inherently adapted to distinguish, the registrations would be invalid (assuming the marks were not found to have acquired distinctiveness through use) and the infringement claim would have failed.

Modena's argument was that as the English words GOLD and FIVE STAR were not inherently capable of distinguishing coffee products, the marks' foreign equivalents, ORO and CINQUE STELLE, were also not capable of distinguishing. In other words, the terms were descriptive or laudatory when applied to coffee products.

Whilst the court agreed the English words FIVE STAR and GOLD would not be distinctive when applied to coffee products, it asked the question whether ORO and CINQUE STELLE were validly registered.

Arthur J ran through a three-step test to apply in determining whether a foreign word was inherently capable of distinguishing. Incidentally, this test had been applied in a previous case concerning Cantarella Bros and the term GELATERIA.

The test involved determining whether:

1. The foreign language is well-known in Australia;
2. The translation provided is the most common meaning attributed to the word; and
3. The common meaning has an inherent capacity to distinguish (applying the tests required by s.41 of the *Trade Marks Act 1995* (Cth)).

Whilst noting this was a useful approach, Arthur J framed the relevant question as 'whether the particular words ORO and CINQUE STELLE are sufficiently well understood in Australia as meaning gold and five star'.

Despite evidence of the large number of Italian speakers and those of Italian birth in Australia, Arthur J was not persuaded the trade marks ORO and CINQUE STELLE would be generally understood in Australia as meaning GOLD and FIVE STAR. Cantarella Bros' marks were therefore considered to be inherently adapted to distinguish and valid.

Some interesting foreign marks that have been considered by the Australian Trade Marks Office and the courts are set out in the table below.

If you are concerned whether a foreign word can operate as a distinctive trade mark in respect of specified goods and services, you should ask your trade mark attorney for advice.

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Mark	Language	English meaning	Goods	Inherently adapted to distinguish
TARGA	Italian	Number plate, tablet or shield	Motor vehicles	No
LA DELIZIOSA	Italian	The Delicious	Various class 29 and 30 goods	No
	Japanese	Bread crumbs	Various class 29 goods	No
OOMO	Aboriginal	Choice	Wine and spirits	Yes
GELATERIA	Italian	Ice cream parlour	Machines including ice-cream making machines, gelato making machines and machines for making other iced confectionery	Yes, but only for machines for domestic use



## Target Australia – 100% Happy

by Michael Squires



Target is a household name in Australia. They're renowned for providing great quality and great value clothing, homewares, toys and entertainment, with products that are recognised for their durability, broad appeal and affordability.

Having grown to over 300 stores across metropolitan and regional Australia, Target still retains its National Store Support Office in Geelong, Victoria, where it first commenced business nearly 90 years ago. The original Target store was established in 1926 by George Lindsay and Alex McKenzie. Operating under the name Lindsay & McKenzie Pty Ltd, the small drapery store sold fabrics, manchester and furnishings. During these early years, Lindsay established a strong business policy, targeting 'half the profit' and 'twice the turnover.'

In 1957, Geoff Betts and John Wade identified the store's potential and growing success, and subsequently acquired the company with the vision of developing it into a state-wide business. Despite sharing its name with a US retail chain, Target has always been an Australian owned company, and is now part of the Wesfarmers group of companies.

A predecessor to Target's iconic 'Roundel' logo appeared for the first time on the Australian Trademark Register in December 1909. This was filed by Mark Foys Limited and registered for 'All articles of clothing and underclothing ... but excluding articles of clothing specifically intended to be worn while playing golf'. This, and several other 'Target' marks, were eventually acquired

by The Myer Emporium Limited, who had separately been building their own portfolio of 'Target' marks for different goods since the late 1920s.

Ownership of the portfolio was eventually transferred to Target Australia Pty Ltd in 1973. The logo is a regular and prominent feature of prime-time television advertising, with the logo having previously been used to form animated characters, 'morphing' into products from bras to briefs, babies to bicycles.

Target has collaborated with well-known fashion labels, identities, and celebrities such as Collette Dinnigan, Ksubi, Stella McCartney, Roberto Cavalli, Dita von Teese and Shane Warne, and in doing so has challenged the boundaries of its market position to create designer collections accessible to everyday Australians.

Today, Target trades online in addition to its many physical store locations. Over the years, Target has become an Australian retail icon, constantly adapting and moving with the times whilst maintaining its quality and accessibility.

POF has worked with Target to protect their intellectual property in Australia through the use of trade marks.

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## Infringement by Supply of Products

by Daniel McKinley  
and Chris Schlicht

The intention of section 117 of the Patents Act is to protect a patentee from infringement of their patent by a party who does not directly manufacture, import or sell a complete product that infringes the patent but, rather, who provides the means to another party to do so.

Furthermore, where end users are often consumers, it may not be practical for the patentee to pursue each consumer for acts of patent infringement. Section 117 is intended to provide an avenue to the patentee to pursue the supplier of the means of infringement, and stop it at its source.

Section 117(1) provides that 'if the use of a product by a person would infringe a patent, the supply of that product by one person to another is an infringement of the patent by the supplier', unless the supplier is the patentee or licensee of the patent.

Sub section 117(2) provides that a reference in section 117(1) to 'use' of a product by a person is a reference to:

- (a) if the product is capable of only one reasonable use, having regard to its nature of design – that use; or
- (b) if the product is not a staple commercial product – any use of the product, if the supplier had reason to believe that the person would put it to that use; or
- (c) in any case – the use of the product in accordance with any instructions for the use of the product, or any inducement to use the product, given to the person by the supplier or contained in an advertisement published by or with the authority of the supplier.

In the recent decision of *Generic Health Pty Ltd v Otsuka Pharmaceutical Co. Ltd and Bristol-Myers Squibb Company* [2013] FCAFC 17, the Full Federal Court considered the operation of the second limb of s117(2) – i.e. what constitutes a sufficient 'reason to believe' to enliven the operation of this provision.

The claim of the patent that was under consideration was directed to a method of treating a patient suffering from cognitive impairment caused by schizophrenia, and not to a method of treatment for schizophrenia itself. Further, it was limited to treatments where the patient had failed to respond to 12 named anti-psychotic drugs. The method involved the administration of the drug aripiprazole.

Generic Health Pty Ltd had obtained registration of a number of aripiprazole products on the Australian Register of Therapeutic Goods for three treatments, including for the treatment of schizophrenia. This included maintenance of clinical improvement during continuation therapy. This was the same indication for which the patent licensee, Bristol-Myers, had registered its medication.

In the first instance decision, the trial judge had granted an interlocutory injunction to prevent Generic Health Pty Ltd from dealing in its product. This was granted on the basis that the intended sale by Generic Health Pty Ltd of its product would infringe various claims of the patent, including the method of treatment claim under s117(1). The granting of the interlocutory injunction was reviewed by the appeal court.

“... to satisfy s117(2)(b), it is not sufficient if the supplier had reason to believe the person might put the product to the infringing use. There must be a reasonable belief of a significant likelihood that a person will put the product to that use ...”



There was evidence before the trial judge that cognitive impairment is associated with and is a symptom of schizophrenia, including chronic and treatment-resistant schizophrenia. Chronic schizophrenia is the outcome of the majority of those who suffer the illness. Further, aripiprazole is used as a medication for schizophrenics who fail to respond to antipsychotic drugs.

In the appeal, Generic Health Pty Ltd argued that the evidence did not rise above there being a prospect that doctors may use the product in the manner disclosed in claim 7. This was not enough to satisfy the criteria of s117(2)(b) that Generic Health Pty Ltd had reason to believe users would use its product in an infringing way.

The appeal court considered whether it is necessary to establish that Generic Health

Pty Ltd had reason to believe not only that the product might be used for an infringing use, but also that it would, in fact, be so used.

Bennett J concluded that to satisfy s117(2)(b), it is not sufficient if the supplier had reason to believe the person might put the product to the infringing use. There must be a reasonable belief of a significant likelihood that a person will put the product to that use.

The appeal court concluded, on the basis of the evidence, there was a reason to believe on the part of Generic Health Pty Ltd, that doctors would put its product to the claimed use. This was despite the fact that Generic Health Pty Ltd did not provide instructions to so use it (which is not a requirement of s117(2)(b) in any case). Furthermore, infringement was found although the product in question could be put to non-infringing uses.

In circumstances where a manufacturer is supplying a product that can be put to a number of uses, it can be difficult to decide whether such supply will constitute an infringement under the opposition of S117. Many factors are relevant in making such a determination, and POF can provide advice on all aspects of these matters.

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## New Recruits

**Phillips Ormonde Fitzpatrick is pleased to announce two new professionals – welcome to the team Scott and Annabella.**

### Scott Jamieson – Trainee Patent Attorney

Scott is the latest addition to our Sydney office. Scott majored in nanotechnology in his undergraduate degree obtained from the University of Western Australia, covering areas of materials science, chemistry and microscopy.

In his honours project, which he carried out at the Centre for Strategic Nano-fabrication, Scott looked at metallic nanoparticle production and carbon nanotube technology for use in fuel cells. After an internship at Perth Mint Refinery (formerly AGR Matthey), Scott made the leap to the east coast of Australia to undertake his PhD.

Working in the Chemical Sciences department at The University of New South Wales (UNSW), Scott's thesis investigated organic nano-materials for use in artificial muscle tissue and drug delivery. This project was completed at a number of world-class research facilities, including the ANSTO nuclear reactor at Lucas Heights in Sydney, the Australian Synchrotron in Melbourne, the Australian Institute of Bioengineering & Nanotechnology

at UQ in Brisbane and the Oak Ridge Nuclear Laboratories in Tennessee, USA. During his study, Scott was also employed as a technical assistant at the Biomedical Imaging Facility at UNSW where he made use of his expertise with high-powered, atomic-scale microscopes.

Scott has also completed a Graduate Certificate in Research Management and Commercialisation at UNSW, in which he focused on taking scientific discoveries from the laboratory to the market. He has attended many national and international conferences, and presented seminars to a range of audiences, including the largest in the chemistry field, the American Chemical Society Annual Meeting in Philadelphia, USA.

Scott says, "I've always wanted to stay at the forefront of science and technology, and working in patents at POF will keep me at the cutting edge."

Scott's other passions include riding and custom-building mountain bikes, travelling interstate and overseas to find the best trails.



Scott Jamieson



Annabella Newton

### Annabella Newton – Trainee Patent Attorney

Annabella has recently joined our Melbourne office as a trainee patent attorney in the Chemistry and Life Sciences team. Prior to joining POF, Annabella worked as a postdoctoral fellow in CSIRO's division of Materials Science and Engineering. During this time, she collaborated with the University of Melbourne on an organic chemistry project, applying continuous flow processing methods to the synthesis of bioactive small molecules. Annabella also worked with the University of Sydney on a project aimed at developing low energy/sustainable materials platform technologies that utilise renewable resources to produce bulk chemicals, intermediates, fine and specialty chemicals.

Annabella completed her undergraduate studies at the University of East Anglia in the UK, where she carried out a final year research project in organic synthesis and graduated with a Masters of Chemistry with Honours.

She went on to obtain a PhD, studying alkaloid natural product synthesis at the University of Nottingham. Her PhD research was sponsored

by AstraZeneca, and she spent four months working in their Process Chemistry team. After a short postdoctoral stint at Nottingham, Annabella relocated to Melbourne in 2010 and joined CSIRO.

Her work has been published in several high-impact journals and she is a web-writer for the Royal Society of Chemistry's *Organic & Biomolecular Chemistry* journal. She is also an active member of the Royal Australian Chemical Institute's Women in Chemistry and Bioactive Discovery & Development groups. Annabella is now undertaking further study at the University of Melbourne to obtain qualification as a patent and trade marks attorney.

Annabella says, "I'm delighted to be part of the POF team. It's very exciting to be able to combine my interests in chemistry and intellectual property and I'm very happy with my new role!"

Annabella enjoys running, travelling around Europe and Australia, and cooks a delicious traditional Sunday roast.



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