



Patents

Trade Marks

IP Research

Designs

Legal Services

Issue 27 • March 2015



Medical Device
Innovation update

3



Growth at Phillips
Ormonde Fitzpatrick

2



Copyright woes:
a tale of two cities

5



How distinct are
foreign word trade marks?

9



Editorial

Chris Schlicht,
Partner



Welcome to the March edition of *Inspire!*

This is an exciting time for Phillips Ormonde Fitzpatrick, as the POF Group has recently joined with a boutique IP practice in Adelaide, Dibbens Intellectual Property. This growth marks a strategic step forward for POF, as we continue to expand and strengthen our professional capabilities and service offering to clients (page 2). In addition, Associate, Marine Guillou, has recently been recognised as one of Australia's top five experts in anti-counterfeiting by the World Trademark Review 1000 (page 12).

IP Australia recently released their comprehensive report on *Australian Medical Devices: A Patent Analytics Report*. Alyssa Grabb provides a summary of IP Australia's key findings, including information about where Australia sits among the 48 countries analysed, collaboration trends, key areas of innovation and technology diversity (page 3).

Helen Kavadias takes a look at the recent decision *Modena Trading Pty Ltd v Cantarella Bros Pty Ltd*, in which the High Court of Australia found that Cantarella's trade marks CINQUE STELLE and ORO are inherently adapted to distinguish coffee and coffee-based beverages from the goods of other persons. This decision is important as it helps clarify the approach to be taken in assessing the distinctiveness and registrability of foreign word trade marks (page 9).

Margaret Ryan considers copyright issues on social media that may arise in respect of content – with a particular focus on Facebook, Twitter and LinkedIn. In this article, Margaret discusses what can be subject to copyright, website terms and conditions, infringing copyright and who owns a social media account (page 4).

Also in this edition, Annette Rubinstein compares copyright laws in France and Australia (page 5), Mark Williams discusses technology from film and television that has come to life (page 10), and Russell Waters takes a look at a recent trade mark case where the issue of fame and notoriety were considered in relation to a trade mark application (page 7).

We hope you enjoy this edition of *Inspire!*, and we welcome any questions or comments on any of the issues covered.

Growth at Phillips Ormonde Fitzpatrick

We are delighted to announce that Dr Justin Dibbens (pictured) and his boutique IP practice, Dibbens Intellectual Property, has joined Phillips Ormonde Fitzpatrick. This growth marks a strategic step forward for POF, as we continue to expand and strengthen our professional capabilities and service offering to clients.

POF is widely regarded as one of the leading intellectual property firms in Australia. Our professionals have a broad range of technical expertise in biotechnology, chemistry, physics, ICT, engineering and medical technology. We understand that our clients expect a high level of technical expertise and excellent service, and in the changing landscape, we believe this expansion will enable us to add further value to our clients' portfolios.

Dibbens Intellectual Property has a deep understanding of all aspects of intellectual property from protection to commercialisation. The firm's Principal, Dr Justin Dibbens, has specialist expertise in the life sciences having worked in this field for over 15 years. Justin also has a PhD in Biochemistry/Molecular Biology from the University of Adelaide.

Like POF, Dibbens Intellectual Property takes a holistic approach to intellectual property which

acknowledges that capturing, protecting and enforcing IP rights is just one aspect of the overall commercialisation journey. Justin has assisted numerous clients in the commercialisation of IP rights, and has expertise in the area of technology transfer gained during his time in the university sector.



Graham Cowin, Managing Partner of POF says, "This is an exciting time for intellectual property, and we have been looking at ways we can add further value to our clients' businesses. This move strengthens both our technical and commercial expertise. We look forward to supporting our clients through additional knowledge, increased resources and continuing to provide commercially effective and pragmatic advice."

We are excited about this new venture and welcome the opportunity to provide further support and value to our clients.





IP Australia releases **Medical Device Innovation Report**

Alyssa Grabb, Partner

In January 2015, IP Australia released their report *Australian Medical Devices: A Patent Analytics Report*. We have summarised the key findings of the report in this article.

The study identified 139,170 Patent Cooperation Treaty (PCT) applications filed globally in the medical devices area with a priority date between 2001 and 2012. Of these applications, 2,706 had an Australian inventor. The United States dominated medical device patenting with nearly half of the PCT applications analysed having an inventor from the USA.

The analysis revealed that over the period studied, Australia generated around 2% of the global medical device inventions based on inventor participation. This ranked Australia 13th worldwide.

Of the 48 countries analysed, 14 were considered to have a specialisation in medical devices. Of these countries, Australia ranked 8th.

The majority of Australian medical device inventions originated from New South Wales (50%), followed by Victoria (21%), Queensland (12%) and South Australia (6%). This correlates with the location of medical device companies across Australia with 55% located in NSW, 24% in VIC and 12% in QLD.

Geographical coverage

The 2,706 Australian-originating PCT applications analysed gave rise to 10,812 'national phase' applications, of which 3,397 have led to granted patents. The most popular national phase filing countries were the USA, Australia, the European Union, Japan, China and Canada. These may be regarded as countries having favourable markets for medical device products as well as a favourable attitude to intellectual property rights.

Collaboration

Over the period studied, the number of Australian inventions involving a foreign inventor varied between 13% and 24%. USA, Germany and the United Kingdom supplied the largest number of collaborating inventors to Australian inventions. China ranked 8th for collaboration, with Australia ranking ahead of Sweden, Canada, France and Singapore. Research entities were the most collaborative of all the applicants considered in the study.

Key areas of innovation

As part of IP Australia's analysis, keywords in the title and abstract were used to visually map hotspots of innovation. This revealed the areas of most prolific Australian medical device development to include:

- > Syringe development
- > Vision, eye and lens-related innovation



- > Implants including implantable joints and prostheses
- > Surgical and orthopaedic devices
- > Catheters and cardiac inventions
- > Dental devices
- > Electromedical and diagnostics including magnetic and ultrasound imaging and implantable neurostimulation
- > Computer-related medical inventions, and
- > Tissue engineering and cardiac inventions.

Diversity

The Commonwealth Scientific and Industrial Research Organisation (CSIRO) was the applicant demonstrating the greatest diversity of innovation, with applications filed in areas including:

- > Telemedicine
- > Polymeric coatings and tissue sealants
- > Dry aerosol delivery
- > Microwave-based and acoustic energy-based blood flow monitoring
- > Image processing
- > Motion and mobility monitoring, and
- > Alzheimer's assessment.

Publicly funded research and innovation

The top five medical device filing universities during the period studied were:

1. University of Queensland
2. University of Sydney
3. Queensland University of Technology
4. Monash University, and
5. University of New South Wales.

The report also shows strong collaboration links between the universities and also with other research organisations, as well as private companies.

IP Australia's report is comprehensive and informative and demonstrates that a lot of understanding about the networks and nature of an industry can be obtained by looking at patent data.

For more information on medical devices innovation, please contact Alyssa Grabb.

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Copyright implications for Social Media and Internet Service Providers

Margaret Ryan, Special Counsel

The number of users on social media is staggering. At present, there are 1.15 billion Facebook users¹, 218 million monthly active Twitter users², and 300 million LinkedIn users³. It is clear that social media is now an integral part of a business' marketing strategy, but how do intellectual property laws relate to this relatively new form of mass communication?

This article will focus on three social media platforms: Facebook, Twitter and LinkedIn.

The main types of material posted in social media are text, photos, artwork and videos. Copyright is the main intellectual property right that is relevant to these materials. Copyright protects the form of expression, not the ideas. Thus, an article on the internet about US President Obama does not prevent another person writing a different post about Obama. It merely prevents a copying of the same words or arrangement as the first article.

What can be subject to copyright?

Many ordinary works such as business letters, labels and advertisements have been protected by copyright. Therefore copyright is likely to subsist in much of what is posted on social media, especially photographs, artwork and videos. One main exception is the very short post, which is especially an issue on Twitter, which has a 140 character limit for tweets. To determine whether copyright may subsist in a tweet, or other short post on another platform, one must look to the tests for subsistence of copyright. The work must:

- > Not be copied from something else;
- > Have some minimal level of literary skill, and
- > Not be too insubstantial.

In *Fairfax Media Publications Pty Ltd v Reed International Books Australia Pty Ltd* (2010) 88 IPR 11, it was held that certain newspaper headlines (some consisting of 32 characters) were too short to constitute copyright works, although the Court left open the possibility that more substantial headlines could be protected by copyright. Thus many posts and tweets on social media may not be subject to copyright although many longer posts, and perhaps some tweets, will be. The character limits on LinkedIn and Facebook are much higher and their longer posts are likely to be subject to copyright.

Website terms and conditions

In Facebook, LinkedIn and Twitter, the author of each post retains the copyright. However, their terms and conditions provide for a very broad



licence to each of the social media platforms to use the post without compensation in a generally unlimited way.

New terms and conditions for LinkedIn came into effect on 23 October 2014. This introduced a new term to the effect that LinkedIn will not include a person's content in third party advertisements without their consent. However, LinkedIn reserves the right to place advertisements near the person's contents.

It is possible that this new term of LinkedIn had its genesis in a dispute between Facebook and five of its users, who alleged that Facebook had shared the 'likes' of five users of certain advertisers – the users' names and photographs – in sponsored stories to endorse products without their consent.⁴ Presumably as a result of this dispute Facebook's Data Use Policy says:

When we deliver ads, we do not share your information (information that personally identifies you, such as your name or contact information) with advertisers unless you give us permission.

In addition Facebook's Advertising Guidelines, addressed to advertisers, dated 4 June 2014 say:

You may use information provided directly to you from users if you provide clear notice to and obtain consent from those users ...

Infringing copyright

Whether you infringe a third party's copyright when uploading material to a social network depends on the source of the material. If it is your material and you own the copyright, there is obviously no infringement. If a business commissioned the material, one needs to look at the terms of the contract or the purpose for which the material was made. The copyright in

commissioned artwork and photographs will be owned by the artist/photographer unless there is an agreement to the contrary, and they may only be used for the purpose for which they were commissioned. However, the position is the reverse with commissioned videos.

Sharing text on social media is an accepted part of social media and to do so would not be an infringement of copyright unless the text comes from a third party source. However, one does not know where other material attached to a post came from and there is the risk of infringement.

If the material is copied from somewhere else, there will usually need to be permission. In *Tylor v Sevin* [2014] FCCA 445 (26 February 2014), Ms Sevin, a travel agent, copied a photograph of Hawaii from the internet and used it on her website without permission. The photographer sued and Ms Sevin was ordered to pay \$23,850 plus interest, whereas if she had paid a licence fee, it would have cost her \$1,850.

Hyperlinking to other material on the internet will not amount to copyright infringement, as illustrated in *Universal Music Australia v Cooper* (2005) 150 FCR 1. However, this case held that if the material was already infringing copyright, the hyperlink may amount to an authorisation of that infringement. So if Ms Sevin's website had hyperlinked to the photograph of Hawaii, and assuming that the image was to be found on a legitimate website, she would not have been liable. The difficulty is in knowing whether an image or artwork has been posted legitimately.

Who owns a social media account?

Followers and contacts of a social media account can be numerous and also represent

significant value. A critical issue is therefore who owns the actual account and its followers? This issue was raised in a dispute in the United States between Phonedog and Kravitz.⁵ In this case, Kravitz worked for Phonedog and maintained its Twitter account. During his time with the company, he amassed 17,000 followers. He then left Phonedog's employment, changed the account handle and continued to use the account. Phonedog subsequently filed a law suit attempting to remedy the situation.

If the Phonedog v Kravitz case had happened in Australia there would be two potential areas of legal protection:

- > confidential information, and
- > the employment contract.

The password on the account may be confidential, and information on the account (such as contacts or followers) may be confidential depending on privacy settings. A public list of followers is not confidential. Therefore confidential information may provide some protection.

Alternatively, for staff who are dealing with a company's social media accounts, it should be a term of their employment that the social media accounts are those of the employer, and their duties in relation to the accounts should be set out. There should also be an obligation to cease using the accounts on termination of employment.

However, these causes of action, whilst giving a potential remedy against an ex-employee, may not prevent the problem from arising. Practical measures of protection are undoubtedly the best. More than one person in the office should know the social media passwords. Once an employee with access has left, the password should be changed to lock that person out.

While copyright law overlays social media, it can often be disregarded. However to do so may mean that you are at the end of a letter of demand.

Please contact us if you have any questions about this issue.

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- 1 jeffbullas.com
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- 4 <https://www.truthinadvertising.org/facebook-privacy-settlement-terms-dispute>
- 5 http://en.wikipedia.org/wiki/PhoneDog_v._Kravitz

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Copyright woes: a tale of two cities

Annette Rubinstein, Partner

What's the difference between the Eiffel Tower in Paris and the Melbourne Arts Centre Spire in Australia?

Aside from the iconic status, romantic connotations, historical significance and about 196 metres in height, perhaps the most unexpected difference is the fact that you can take a photograph of the Melbourne Arts Centre at night without infringing copyright, but the same cannot be said for the Parisian icon. According to the official website of the Société d'Exploitation de la Tour Eiffel, although the Eiffel Tower, built in 1889, is no longer protected by copyright, the illumination of the tower at night is "subject to authors' rights", which are infringed by night photography.

Why the difference?

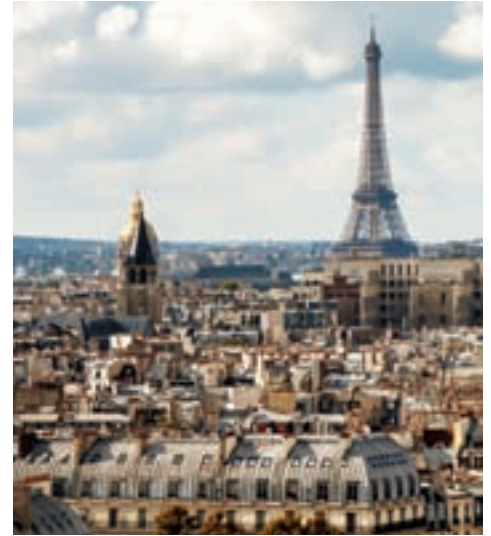
Copyright law is national. When you make a copy of a work, whether you infringe copyright depends on the law of the country where you make the copy. Buildings are regarded as artistic works for the purpose of both French and Australian copyright law. To take a photo of the illuminated Eiffel Tower, the photographer would have to be in France (leaving satellite images out of the equation) and the digital photo recorded on the camera would be a copy made in France. French copyright law would apply, and unlike the law of most European countries, it does not permit the taking of photographs of buildings in public places without the consent of the owner of copyright in the building. Therefore the act of taking a photo of the tower is a breach of copyright.

If the photographer of the illuminated Eiffel Tower flies to Australia with the camera, and on arrival uses the digital image to make copies of the photograph, those copies will be made in Australia, and Australian law will apply. In this case, there would be no breach of copyright.

The Australian Copyright Act

In Australia, s 66 of the *Copyright Act* states that the copyright in a building is not infringed by the making of a painting, drawing, engraving or photograph of the building, or by the inclusion of the building in a film or in a television broadcast. Section 68 permits the publication of the images protected by section 66. Without s 66, it would be difficult to take an outdoor photograph in a built up area without risking infringement of copyright.

Sections 66 and 68 only apply to buildings, not to artistic works on the surface of the buildings (sculptures in public places are treated like buildings by section 65 of the *Copyright Act*). For this reason, it is a bad idea to use photographs of Melbourne's vibrant street art for commercial purposes without the consent of the artist.



However, s 67 of the *Copyright Act* permits the inclusion of a reproduction of any type of indoor or outdoor artistic work in a film or television broadcast, provided the reproduction is incidental to the main subject of the film or broadcast.

Section 73 of the *Copyright Act* states that the copyright in a building (or the architectural plans for it), is not infringed by a reconstruction of the building. If the Melbourne Arts Centre Spire should burn down (and it has caught fire in the past as a result of a firework malfunction!) it could be rebuilt without fear of copyright infringement, even if the State of Victoria did not own copyright in it under s 176 of the *Copyright Act* as a work made under the direction of the Crown.

2D vs 3D

The protection for images of buildings is restricted to two dimensional images. It is an infringement of copyright to make a three dimensional model of a building that is within copyright without the permission of the owner of the copyright. This leads to some interesting issues.

Would a cake in the shape of the Melbourne Arts Centre infringe copyright in the building? Hopefully the legal adage *de minimus non curat lex* – the law is not concerned with trifles – would be applied to other sweet treats.

If you have any questions relating to copyright, please contact Annette Rubinstein.

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Civil penalties under the new Franchising Code of Conduct

Margaret Ryan, Special Counsel

On 1 January 2015 a new Franchising Code of Conduct (the Code) was introduced. It applies to all conduct on or after 1 January 2015. If a franchise agreement has been entered into after 1 October 1998, but before 1 January 2015, the new Code still applies with certain exceptions. If such a franchise agreement is transferred or varied on or after 1 January 2015, the entire Code will then apply.

The new Code has made substantial changes to the law of franchising. This article looks at one aspect – the introduction of a new penalty regime which commences from 1 January 2015. The new penalty regime will apply even if the franchise agreement was entered into before 1 January 2015.

Civil penalties under the Code

The Code contains 24 provisions which, if breached, can result in a civil penalty (a fine is imposed but it is not a criminal offence). The maximum penalty is 300 penalty units (\$51,000). The Australian Competition and Consumer Commission (ACCC) enforces these provisions.

As an alternative to prosecuting a breach of the Code, the ACCC can issue infringement notices, which must be issued within 12 months of the alleged contravention. In order to issue an infringement notice, the ACCC must have reasonable grounds to believe that a person has contravened a civil penalty provision of the Code.

An infringement notice is supposed to be a cheap and easy solution to an infringement. It imposes a penalty of 50 penalty units (\$8,500) for a corporation, or 10 penalty units (\$1,700) for an individual, and is payable within 28 days. Payment of the notice does not amount to an admission of liability. However, paid infringement notices are kept on a searchable public register on the ACCC website. If the recipient fails to pay the notice, the ACCC may take it to court for the alleged contravention.

Of the 24 civil penalty provisions, only two can be breached by both the franchisor and the franchisee:

- > Breach of the obligation to act in good faith, and
- > Failure to attend a mediation.

All the rest involve breaches by the franchisor (or, in certain cases) an associate.

Act in good faith

An express obligation to act in good faith is newly introduced to the Code. Its definition refers to unwritten law (judge-made case law),



although some guidance is given. The Code provides that a court can have regard to:

- (a) whether the party acted honestly and not arbitrarily, and
- (b) whether the party cooperated to achieve the purposes of the franchise agreement.

The obligation to act in good faith cannot be excluded. Nonetheless the obligation does not prevent parties acting in their legitimate commercial interest. Failure to give an option to renew or failure to extend a franchise agreement does not amount to lack of good faith on the part of the franchisor.

For a breach of the obligation of good faith to incur a penalty, and for the ACCC to be able to issue an infringement notice with respect to an alleged breach, seems strange as case law does not have a clear definition of good faith. It may well be that a judge will know a breach of the obligation of good faith when he/she sees it.¹ However, franchisors and franchisees will need more guidance than that. The ACCC has posted in its Franchisor Compliance Manual to be found on its website some questions to be asked when considering whether there has been a breach of the obligation of good faith:

- > Have you been honest with the other party?
- > Have you considered the other party's interests?
- > Have you made timely decisions?
- > Have you consulted with the other party regarding proposed changes?
- > Are you imposing any conditions on the other party that aren't necessary to protect your interests?
- > Where a dispute has arisen, have you attempted to resolve the dispute (either

directly with the other party, or through mediation)?

- > Are you acting for some ulterior purpose?²

The obligation to act in good faith applies not only to the franchisee and franchisor but also to persons who propose to be a party to a franchise agreement. However their lack of good faith is not subject to a civil penalty.

Many of the remaining civil penalty provisions relate to the information required to be provided by the franchisor as outlined below:

- > Obligation to create a disclosure document complying with the Code and provide it upon request (subject to a grace period until 31 October 2015 for existing disclosure documents, although if existing documents are misleading they would be subject to potential remedies for misleading and deceptive conduct);
- > Obligation to update the disclosure document within four months of the end of the financial year;
- > Obligation to give certain documents before the franchisee or prospective franchisee enters into the franchise or pays a non-refundable payment or renews or extends the scope of the franchise;
- > Obligation to give a copy of any lease or licence documents and details of related financial incentives;
- > Obligation to give copies of any other agreements that the franchisee or its associates must enter;
- > Obligation to have audited and provide annual financial statements of the marketing or other co-operative fund;
- > Obligation to provide certain financial information and other information required to be disclosed in clause 17;



5 Seconds of Summer's 15 minutes of fame

Russell Waters, Partner

- > Obligation to advise the franchisee whether the franchisor intends to extend the franchise agreement or enter into a new franchise agreement, including the obligation to advise the franchisee of its right to request a disclosure statement.

The franchisor is also subject to a civil penalty provision if it:

- > fails to repay consideration paid by a franchisee who terminates during the cooling off period;
- > fails to give a notice of intention to terminate that includes a reasonable opportunity to remedy the default;
- > terminates the franchise agreement in accordance with the agreement without the consent of the franchisee other than for breach unless the franchisor gives reasonable notice for the termination and reasons for the termination (except where termination is permitted under clause 29);
- > discloses a former franchisee's details to a prospective franchisee against the wishes of the former franchisee;
- > tries to influence a former franchisee either to make or not make a request that the former franchisee's details not be disclosed to a prospective franchisee;
- > attempts to restrict or impair a franchisee or prospective franchisee's ability to form an association or associate with other franchisees or prospective franchisees for a lawful purpose.

The imposition of these civil penalties is clearly aimed at better enforcement of the Code. Disgruntled franchisees can bring their grievances to the ACCC which can act swiftly by issuing an infringement notice rather than bringing full legal proceedings. For more serious breaches legal proceedings to recover a higher penalty may still be in order, and a failure to comply with an infringement notice may also result in legal proceedings.

If you have any questions about the Code, please contact Margaret Ryan.

References

- 1 Economic and Finance Committee, Parliament of South Australia, *Final Report – Franchises, Report No 65 (2008)* at 55, quoted in Terry, A. and Di Lernia, C. 'Franchising and the Quest for the Holy Grail: Good Faith or Good Intentions?', 33 (2009) *Melbourne Law Review*, 542 at 573.
- 2 Australian Competition and Consumer Commission Franchisor Compliance Manual, 8 December 2014, <https://www.accc.gov.au/publications/franchisor-compliance-manual>

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Andy Warhol is famous. Think Pop Art, Campbell's Soup, Marilyn Monroe, The Factory and Studio 54. One of the other things he is famous for is the statement: "In the future, everyone will be world-famous for 15 minutes."

Unfortunately, where a trade mark applicant is relying upon fame to obtain a registration, 15 minutes of fame may not be enough. This issue has been the subject of recent interest in an Australian trade mark application number 1556294 for the mark '5SOS' filed by One Mode Productions Limited. The application was for a range of goods and services associated with the musical group 5 Seconds of Summer, known to their fans as 5SOS (cue screaming teenage girls).

5SOS vs S.O.S

The application for the 5SOS trade mark was rejected due to similarity with a number of prior registrations for similar goods that also prominently featured the letters "SOS". After trying to overcome the objection by amending their statement of goods and services, One Mode Productions requested a hearing to overcome the Examiner's decision. The hearing was before Hearing Officer Iain Thompson.

After reviewing the authorities on deceptive similarity, the Hearing Officer turned to the evidence filed in support of the application and stated: "The name of this group is not notorious; apart from these proceedings I have not encountered the group and it is not suggested in the declaration that the group is notorious." He concluded that the prior SOS marks were deceptively similar to the 5SOS mark.

It has been reported that despite a number one album and more than five million Twitter followers, the Hearing Officer rejected the application "because he had not heard of the band". Actually, there is a bit more to it than that.

Honest concurrent use

Where a mark is rejected under s 44 *Trade Marks Act 1995* due to similarity to another mark, the applicant can rely upon its fame in the rejected mark to try to overcome the objection. This can be on the basis that the mark is so notorious that no-one would confuse it with another mark, even if that mark is only slightly different, so the marks cannot be considered "deceptively similar". This appears to be the approach taken by One Mode Productions Limited. It was argued on their behalf that fans referred to the 5SOS mark as "five soss", which would not be confused with the more familiar "S.O.S. (ess-oh-ess)". The Hearing Officer rejected this, finding that the pronunciation "five soss" depended upon a familiarity with the musical group 5 Seconds of Summer, and knowledge that this is how the abbreviation of their name was pronounced. There was apparently no evidence to show that the level of knowledge of the band was anything approaching that of the S.O.S. 'Save Our Souls' distress call.

It is also possible for a trade mark applicant to show that a mark should be accepted for registration over prior similar marks on the basis of honest concurrent use (s 44(3) *Trade Marks Act 1995*). This does not appear to have been attempted in this case, possibly because the band was only formed in 2011, so the period of use was relatively short. Whilst honest concurrent use does not have to be for any particular period, there must be sufficient use to show that the mark has acquired and will continue to acquire some reputation in Australia, and this evidence was apparently lacking.

Where evidence of fame is being considered, it is legitimate for an Examiner or Hearing Officer, in the absence of direct evidence on a point, to take his or her own knowledge into account (R.21.19 *Trade Marks Regulations 1995*). Unfortunately, whilst 5 Seconds of Summer undoubtedly have considerable popularity amongst the fans who have nominated each band member as 'Fittest Boy on the Planet' in the 'We Love Pop Awards', (who knew?), that fan base does not appear to extend to Trade Marks Office personnel.

So, where does this leave us?

- > If you are going to rely upon the fame of your mark before the Trade Marks Office, don't assume the Examiner or Hearing Officer will have any prior knowledge of your "world-famous" brand before reviewing the application.
- > Make sure that if your mark is famous, and you do file evidence, the evidence shows just how famous your mark is. It is also important to show that the mark is famous *in Australia*; your five millions Twitter followers may all live in the USA, which doesn't necessarily translate to fame or notoriety here.
- > Make sure that your fame relates to the mark in question. It's no use proving that 5 Seconds of Summer is a mega-famous boy band with a world-wide following (including in Australia) if the mark applied for is '5SOS', and there is no evidence associating that abbreviation with use *as a trade mark* on goods or services associated with the band.

5SOS was eventually accepted for registration, but only after the goods similar to those of the conflicting marks were deleted from the application.

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Could your Intellectual Property Licence be terminated under s 145 of the Patents Act?

Annette Rubinstein, Partner

A recent decision of the Full Court of the Federal Court of Australia has clarified the operation of s 145(1) of the *Patents Act 1990* (Cth). This provision permits either party to a contract relating to a licence to exploit a patented invention to terminate the contract on three months' written notice "at any time after the patent, or all the patents, by which the invention is protected at the time the contract was made, have ceased to be in force".

Section 145 and its earlier equivalents have been dormant in Australian patent legislation for the past century without a single reported decision of an Australian court interpreting the provisions since 1919. This is quite surprising in view of the dramatic consequences s 145 can have for both patent licensors and licensees.

The purpose of s 145

The purpose of s 145 is fairly clear; to prevent patentees obtaining a de facto extension of the patent term by requiring licensees to sign contracts which bind them to continued payment of royalties after the expiry of the patent. What is not clear is why the patentee is also given the right to terminate the licence, and how s 145 is intended to operate when the licence to the expired patent is combined in a single agreement with other rights, including the right to exploit other Australian or foreign patents, or other forms of intellectual property. This was the situation before the court in the *MPEG LA* case.

The use of the licence

The licence in this case was for a "patent pool" of patents relating to the MPEG-2 Standard, which is the standard for the compression of raw digital video and audio data to allow it to be encoded and decoded for use on CDs and DVDs, and for digital transmission. The licensor was the administrator of the patent pool, and the licence stated that it allowed the exploitation of three types of products. These were "MPEG-2 Encoding Products" (digital recorders that comply with the MPEG-2 Standard), "MPEG-2 Packaged Medium" (e.g. CDs and DVDs) and "MPEG-2 Decoding Products" (anything that could play back MPEG-2 compliant digital data, such as Blu-ray players and set top boxes). Some products, such as Personal Video Recorders, fell into all three categories. The licence was worldwide, and royalties were assessed on a global basis, making separation of the obligations in relation to specific patents impossible.



MPEG LA, LLC v Regency Media Ltd

At first instance, in *MPEG LA, LLC v Regency Media Ltd* [FCA 2014 180] the trial judge rejected the licensee's argument that the subject matter of each Australian patent licensed by the agreement was a separate "patented invention", and therefore on the expiry of a single Australian patent, the invention claimed in it was no longer protected by a patent, and the licensee could terminate the entire licence agreement.

The trial judge preferred the licensor's argument that each of the three types of subject matter identified in the licence agreement was a "patented invention" for the purposes of s 145, and therefore the licence agreement could not be terminated until there were no Australian patents in force relating to at least one of these three "inventions". The weakness of this interpretation is its inconsistency with the way "invention is used throughout the Patents Act, and that it makes rights under s 145(1) dependent on the way the contract defines the subject matter of the licence (although s 145(2) states that the section applies despite anything to the contrary in the contract).

The Full Federal Court in the *Regency Media Pty Ltd v MPEG LA, LLC* [2014 FCAFC 183] rejected the trial judge's approach to "patented invention", preferring the licensee's argument that a "patented invention" in s 145(1) is the invention that is the subject of a licensed patent. However, this partial victory was not a triumph for the licensee. The Full Court accepted the licensor's argument (not raised at first instance) that s 23(b) of the *Acts Interpretation Act 1901* (Cth), which provides that words in the singular number include the plural unless the contrary intention appears, should be applied. Accordingly, the Full Court interpreted s 145(1) as meaning that the contract could not be terminated until all patents by which

the inventions to which the contract related had ceased to be in force. This meant that the licensee had improperly purported to terminate the licence agreement. Because the licensor had raised this point so late in the litigation, the licensee was ordered to pay only half of the licensor's costs of the appeal.

Minimising the effect of s 145

The best way to minimise the effect of s 145 on a licence that includes both Australian patents and foreign patents or other intellectual property is to have a separate licence for the Australian patents with a separate licence fee. It would be wise not to rely on severance clauses, as they might be rendered ineffective by s 145(2).

An interesting issue not addressed in this litigation is the effect of governing law and exclusive jurisdiction clauses. It seems likely that s 145 would be applied by Australian court to contracts not governed by Australian law, as it applies "despite anything to the contrary in the contract". There is a reasonable argument that an Australian court should not give effect to a foreign judgement against an Australian defendant enforcing a contractual claim under a contract validly terminated under s 145. It is less clear whether an American defendant in an American court could rely on termination under s 145 of a patent licence that was governed by the law of an American state, but included Australian patents.

Annette Rubinstein BA(Hons) LLB(Hons) is head of the commercial practice group. She specialises in competition and consumer law, confidentiality and trade secrets, and contract law. She negotiates and drafts agreements, and advises international clients on the adaptation of standard agreements to comply with Australian law. Annette is the author of the copyright chapter of the Law Handbook. annette.rubinstein@pof.com.au



High Court clarifies the distinctiveness of foreign word trade marks

Helen Kavadias, Senior Associate

On 3 December 2014, the High Court of Australia allowed an appeal against the Full Federal Court's decision in *Modena Trading Pty Ltd v Cantarella Bros Pty Ltd* and found that Cantarella's trade marks CINQUE STELLE and ORO are inherently adapted to distinguish the goods for which they were registered (i.e. coffee and coffee-based beverages) from the goods of other persons. The High Court ordered rectification of the Trade Mark Register to re-allow Cantarella's trade marks for ORO (which is Italian for 'gold') and CINQUE STELLE (which is Italian for 'five star').

Background

In the first instance proceedings in the Federal Court, Cantarella claimed that Modena had infringed its registrations for the trade marks CINQUE STELLE and ORO. Modena cross claimed that Cantarella's trade marks should be cancelled on the grounds that they were not inherently adapted to distinguish the goods for which they were registered under s 41 of the *Trade Marks Act (1995)* (Cth). Modena's cross claim failed, as did its defence that it had merely used the marks as an indication of quality.

However, Modena appealed to the Full Federal Court of Australia which allowed Modena's appeal, and held that Cantarella's trade marks CINQUE STELLE and ORO should be cancelled. Cantarella was successful in having the Full Federal Court's decision overturned by the High Court.

The High Court's decision

The majority of the High Court comprising Chief Justice Robert French and Justices Kenneth Hayne, Susan Crennan and Susan Kiefel, stated that the numerous decisions which considered words as trade marks under the 1905 Act and 1955 Act show that assessing the distinctiveness of a word commonly calls for an enquiry into the word's "ordinary signification" and whether or not it has acquired a secondary meaning.¹ Their Honours stated that determining the "ordinary signification" of a trade mark comprising of a word is just as important if the word is to be found in the dictionary of a foreign language. This is especially the case when there is a question as to the registrability of the word on the basis that the word makes a direct reference to the character or quality of the goods it applies to.

Further, the High Court referred to a number of authorities² on the question as to what is required for a word to qualify as an invented word, and in particular, the *Solio Case*³. The majority stated that although a word should be:

'... substantially different from any word in ordinary and common use ... [it] need not be wholly meaningless and it is not a disqualification that it may be traced to a foreign source or that it may contain a covert and skillful allusion to the character or quality of the goods'

Based on its review of the authorities, the majority stated that it is not the meaning of a foreign word as translated which is critical, although it might be relevant. What is critical, is the meaning conveyed

by a foreign word to those who will be concerned with the relevant goods, that is, anyone who buys, trades or consumes the goods.

As to whether words contain a reference to the relevant goods, the majority stated that this will depend on whether the words have an "obvious meaning" to "ordinary Englishmen".

At paragraph 59, the majority stated:

'The principles settled by this Court (and the United Kingdom authorities found in this Court to be persuasive) require that a foreign word be examined from the point of view of the possible impairment of the rights of honest traders and from the point of view of the public. It is the "ordinary signification" of the word, in Australia, to persons who will purchase, consume or trade in the goods which permits a conclusion to be drawn as to whether the word contains a "direct reference" to the relevant goods (prima facie not registrable) or makes a "covert and skillful allusion" to the relevant goods (prima facie registrable). When the "other traders" test from Du Cros is applied to a word (other than a geographical name or a surname), the test refers to the legitimate desire of other traders to use a word which is directly descriptive in respect of the same or similar goods. The test does not encompass the desire of other traders to use words which in relation to the goods are allusive or metaphorical. In relation to a word mark, English or foreign, "inherent adaption to distinguish" requires examination of the word itself, in the context of its proposed application to particular goods in Australia.'

As such, the majority of the High Court agreed with the approach taken by the primary judge, that is, the consideration of the "ordinary signification" of the words ORO and CINQUE STELLE in Australia. In this regard, the High Court referred to *Mark Foy's Ltd v Davies Coop & Co Ltd*⁴ (Mark Foy's Case) where the trade mark TUB HAPPY was found to be a registrable trade mark having no direct reference to the character or quality of cotton garments. In the Mark Foy's Case, the High Court had held that TUB HAPPY conveyed to the consumer only an overt and skillful allusive reference to goods, which was not "sufficiently tangible" to amount to a "direct reference" to the character or quality of cotton garments. Thus, in applying the Mark Foy's Case, the High Court held Cantarella's trade marks ORO and CINQUE STELLE were distinctive

for coffee, a commodity and a familiar beverage consumed by many because only a "very small minority" of English speakers in Australia would understand the meaning of the words ORO and CINQUE STELLE because the Italian language is not "so widely spread" that the words would be generally understood as meaning "gold" and "five stars".

Modena had not been able to show that the words ORO or CINQUE STELLE had been used by other traders of coffee products. Thus, the High Court found that Cantarella's trade marks ORO and CINQUE STELLE are sufficiently inherently adapted to distinguish the goods of Cantarella from the goods of other coffee traders.

In a dissenting judgment, Gageler J found that the evidence showed that "gold" and "five star" are ordinary English words which when "used in respect of goods or services, they signify quality". Justice Gageler agreed with Full Court in that the Italian equivalents of the words "gold" and "five star" were not inherently adapted to distinguish especially given that the goods are commonly associated with Italy, and often enough imported from Italy and sold to Italian speakers.

Implications

The High Court's decision has clarified the approach to be taken in assessing the distinctiveness and registrability of foreign word trade marks under section 41 (3). In particular, the test is not what the foreign words mean when translated into English but rather how they are understood by the target audience. The decision has expanded the possibility of trade mark registration of foreign words in Australia given that foreign word trademarks are to be considered through the construction of distinctiveness of inventive expressions as set in the Mark Foy's Case.

References

- Examples include *Thomson v B Seppelt & Sons Ltd* [1925] HCA 40; (1925) 37 CLR 305 at 312-313 per Isaacs J, 315 per Rich J; [1925] HCA 40; (1938) 61 CLR 149 at 160-161 per Rich J; [1938] HCA 67; Mark Foy's [1956] HCA 41; (1956) 95 CLR 190 at 201 per Williams J; Clark Equipment [1964] HCA 55; (1965) 112 CLR 537 at 555-557 per Kitto J ("Faulding").
- Solio Case* [1898] AC 571; *Phillippart v William Whiteley Ltd* [1908] 2 Ch 274; *Howard Auto-Cultivators Ltd v Webb Industries Pty Ltd* (1946) 72 CLR 175.
- Solio Case* [1898] AC 571.
- [1956] HCA 41.

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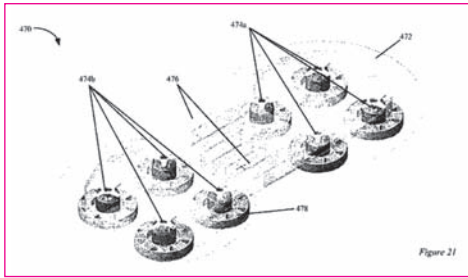


Dude, where's my hoverboard?

Mark Williams, Associate

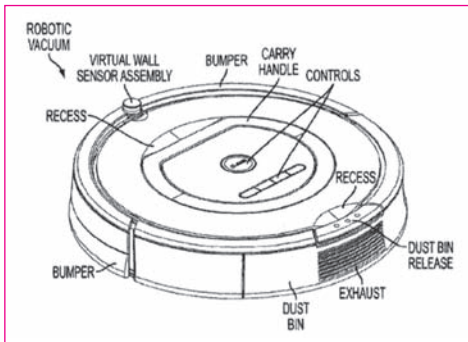
As patent attorneys, we are quite used to seeing new ideas and amazing innovations in all areas of technology. That said, a recent Kickstarter campaign for a real life version of the 'Hoverboard' which featured in the 1985 film *Back to the Future* got our office talking.

Surely no-one in the era of perms, powersuits and parachute pants could have anticipated that the 'Hoverboard' would be a real life proposition 30 odd years later? Which led us to thinking: what other technology from the world of film and television has come to real life?



US Patent Application for Hoverboard: "Magnetic levitation of a stationary or moving object".

The Jetsons (1962) – This space age cartoon which bore striking (but not at all deceptive) similarity to the Flintstones, featured flat screen televisions, video phones, household robots and robot vacuums. Although the Roomba Robot Vacuum is no match for Rosey the robot maid, the Mahru-Z robot maid (developed by the Korean Institute of Science and Technology) might well be. While we have all of these products now, sadly a flying car is for the most part still but a dream.



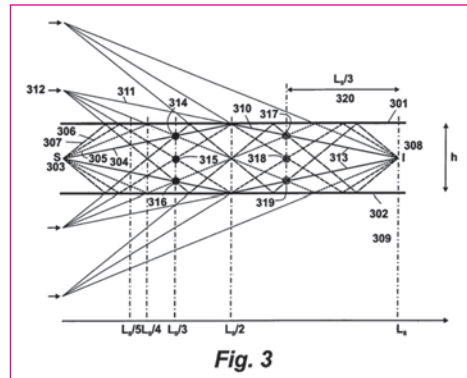
One of many patents by iRobot Corporation for the ROOMBA robot vacuum cleaner.

Star Trek (1966) – This classic series of both television and film features technology at every turn. The Star Trek communicator can be seen in the flip phone mobile telephones that became prominent in the late 1990s. The medical tricorder used by the cantankerous Dr McCoy to measure the vitals of patients now exists (albeit in a more limited form) as the Scandau™. 3D printers could well be seen to be a form of the Replicators used in Star Trek (which would replicate spare parts or hot beverages and hard

liquor). As to Star Trek's famous transporters, while scientists have transported data between two points via quantum entanglement, it's unlikely that we as humans will be teleporting around the planet anytime soon.

2001: A Space Odyssey (1968) – This masterpiece from director Stanley Kubrik famously features flat screen televisions, computer tablets and heuristics. In 2011, when Samsung and Apple were at loggerheads over Samsung's Galaxy Tablet – Samsung attempted to cite the tablet device seen in the film as prior art against Apple's design patent to invalidate it.

Star Wars (1977) – We cannot make mention of Star Trek without mentioning Star Wars. This iconic space adventure with ham fisted dialogue features the Death Star – a weapon capable of destroying a planet via a focused 'superlaser'. You may be horrified to know that Lockheed Martin have developed and patented a direct energy weapon which combines multiple laser beams into one high-power output beam. Thankfully, Lockheed Martin's well described patent specification would act as a suitable patent specification to assist a Luke Skywalker type character to destroy said 'Death Star'.



US Patent for Lockheed Martin's "Death Star" aka Method and apparatus to coherently combine high-power beams in self-imaging waveguides.

Blade Runner (1982) – This dystopian science fiction classic (featuring a timeless soundtrack by Vangelis and based on a short story by Phillip K Dick) is set in 2019 and tells the tale of genetically engineered 'replicants' who are 'retired' (aka destroyed/killed) when they are no longer useful. Everything from large scale digital signage for advertising, biometrics to multi-dimensional imaging systems is envisioned.

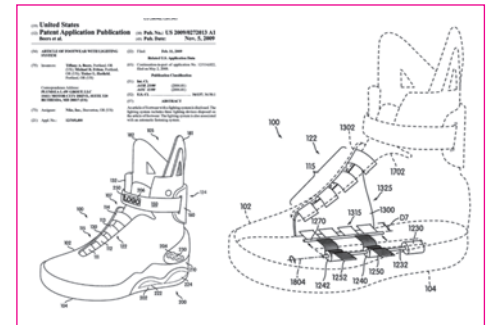
The Terminator (1984) – Another dystopian science fiction classic in which cyborgs have taken over planet Earth and a cyborg assassin travels back in time to dispose of the mother of an as yet unborn resistance fighter. The Terminator (aka T-800 Model 101) played by Arnold Schwarzenegger features a metal endoskeleton, and human flesh and hair on

the outside. Time travel features heavily in the Terminator film franchise, as various Terminator models travel back in time with a mission to protect or destroy. We are yet to achieve time travel – but perhaps if we could – Arnold Schwarzenegger would have rethought his decision to star in 1996's 'Jingle All the Way'.

RoboCop (1987) – This gem (not to be confused with the 2014 remake) features a human cyborg police officer armed with the task of cleaning up a crime ridden Detroit sometime in the future. RoboCop features an exoskeleton and prosthetic limbs. US defence contractor, Raytheon produce the XOS 2 Exoskeleton which increases human strength, agility and endurance capabilities of the person wearing it. Unfortunately, to borrow a famous line from the film, you cannot "buy that for a dollar". Not yet anyway.

Minority Report (2002) – This quality blockbuster (like *Bladerunner*, based on a Philip K Dick story), features a police force that stops crimes before they happen through mutated humans who can see into the future. Numerous scenes throughout the film have Tom Cruise gesticulating wildly on a multi touch interface which we now see in several multi-touch screens on phones, computers and tablets.

While we are still waiting for X-ray vision, time travel and teleportation, we can rest easy knowing that Marty McFly's Nike Powerlaces, now known as the Nike MAG will be available sometime in 2015.



US Patent for Nike Air MAG power shoelaces.

If you have developed any of these items or similar, our Electronics, Physics and IT (EPIT) patent attorneys would love to hear from you!

Mark Williams BCSE(Hons) MIP FIPTA is a Patent and Trade Marks Attorney with over ten years' experience in drafting and prosecuting patent applications. He specialises in the fields of electronic devices, electronic gaming machines, online transactions and payment systems, anti-virus software, business methods and mobile 3GPP/LTE standards.

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Australian Courts award additional damages for trade mark infringement

Marine Guillou, Associate

The Intellectual Property Laws Amendment (Raising the Bar) Act 2012, along with new section 126 of the Trade Marks Act 1995, provided the power to Courts to make an award for additional damages (also known as punitive damages) in respect of trade mark infringement.

This amendment brought the *Trade Marks Act 1995* into line with other intellectual property regimes such as the *Copyright Act 1968* and the *Patents Act 1990*. This article takes a look at two recent cases in which punitive damages were awarded in respect of trade mark infringement.

Halal Certification Authority v Scadilone

In *Halal Certification Authority Pty Limited v Scadilone Pty Limited* [2014] FCA 614, the Federal Court found a kebab wholesaler, Quality Kebabs, and two other kebab shops liable for trade mark infringement after supplying restaurants with meat certified as halal using certificates which included a logo registered by Halal Certification Authority Pty Limited without its permission.

The Halal Certification Authority sought a range of remedies opting for damages under the Trade Marks Act rather than an account of profits. In some cases, damages are calculated by reference to lost licence fees. The Court held that in this case it was unlikely that Quality Kebabs or the restaurants would have entered into a licensing arrangement. Accordingly, the Court held that there were no 'lost' licence fees. Moreover, there was no evidence to support the damages claim based on loss of value or reputation. The Court therefore only awarded the Halal Certification Authority \$10 nominal damages.

Fortunately for the Halal Certification Authority, the Court used its new powers to award \$91,005 in additional damages against Quality Kebabs. Various factors were taken into account in determining the amount of the additional damages, in particular the continued infringement after the notice, and the "arrogant attitude that he would continue getting away with his misconduct for as long as possible" of the Director of Quality Kebabs. The amount was assessed at 150 percent of the annual wholesale certification fee for the two years of the infringement.

Vertical Leisure and Anor v Skyrunner and Anor

In another case (*Vertical Leisure Limited & Anor v Skyrunner Pty Ltd & Anor* [2014] FCCA 2033),



the Federal Circuit Court awarded \$300,000 in additional damages as a punitive measure to reflect the flagrancy of the Respondents' conduct. The Respondents had been selling dancing poles and related materials, and reproducing the Applicants' X-POLE (stylised) trade mark and copyright in an instructional manual and DVD, as well as in brochures and images without the authority of the Applicants on various websites including eBay. The Respondents took no part in the proceeding. In default, the Court found that the Respondents had infringed Vertical Leisure's trade marks, copyright, and had engaged in misleading and deceptive conduct as well as passing off.

The Court noted there can be no "double dipping" and, "where damages are awarded under the Copyright Act, there can be no entitlement to damages for the same conduct for breaches of the Trade Marks Act, the Australian Consumer Law or passing off". As the Respondents did not participate in the proceedings, there was no evidence of the number of infringing products that had been sold to evaluate compensatory damages. However, the Court awarded \$94,800 as compensatory damages (\$44,800 in lost profit and \$50,000 for damage to reputation).

The award of \$300,000 additional damages was based on the flagrancy of the infringement, the continuing infringing conduct despite being

repeatedly put on notice, as well as the "need for deterrence to prevent similar infringements of trademark and copyright ... particularly so in the case of exercise equipment where if inferior products are sold consumers are at risk".

Finally, the Court noted that additional damages are of a punitive kind and therefore financial gain is unnecessary. Substantial award of additional damages was made to "mark the Court's recognition of the opprobrium attached to the defendants conduct".

The cases above illustrate the value of the Courts' power to award additional damages, especially where actual loss is difficult to establish.

If you have any questions relating to this topic, please contact us.

Marine Guillou LLM (Edinburgh University) is a Trade Marks Attorney who advises on trade mark searching, prosecution and enforcement including anti-counterfeiting programs and customs proceedings. Marine has worked as an in-house lawyer for the French Anti-counterfeiting Group, Union Des Fabricants, and as an anti-counterfeiting Area Manager for Société Bic. She also worked in the legal department for Renault. In 2015, Marine has been ranked as one of Australia's top five experts in anti-counterfeiting in the World Trademark Review 1000.
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Court decision clarifies the words “means for” in patent claims

Adrian Crooks, Partner

The recent Full Court decision in *Garford v DYWIDAG Systems*¹ has provided confirmation of how “means for” claim language should be construed in Australia.

Amongst the various appeal points raised was whether an earlier patent application filed by the patentee anticipated the claims of the patent in suit. Claim 1 of the patent was directed to:

An apparatus for manufacturing multi-strand rock bolts having spaced apart bulbs formed therein, characterised by a feed means for supplying a multi-strand cable from a rotatable supply reel ...

At first instance it was held that the earlier patent application did not anticipate this claim because it did not “disclose the presence and use of a rotatable supply reel as part of the apparatus that is described”.

On appeal, the Full Court identified the question to be answered as “whether claim 1 requires that the apparatus have a rotatable supply reel or that it merely be capable of receiving cable from a rotatable supply reel”.

In answering that question, the Court stated that:

A claim to an apparatus for a particular purpose is a claim to an apparatus that is suitable for that purpose ... To establish infringement of such a claim it is not

necessary for the patentee to establish that the apparatus is intended to be used for that purpose. The patentee need only show that the apparatus is suitable for that purpose.

The evidence established that the apparatus disclosed in the earlier application was suitable for use with a rotatable supply wheel and therefore anticipated claim 1.

The decision highlights the care which needs to be taken in using “means for” or equivalent language in patent claims.

Reference

- Garford Pty Ltd v DYWIDAG Systems International Pty Ltd* [2015] FCAFC 6

Adrian Crooks *BEng(Civil)(Hons) LLB LLM FIPTA* is a Lawyer and Patent and Trade Marks Attorney representing clients in a range of patent infringement matters, particularly in relation to engineering technologies. Adrian also regularly acts for Australian and overseas clients in opposition proceedings before the Patent Office. adrian.crooks@pof.com.au

Marine Guillou recognised as one of Australia’s top five anti-counterfeiting experts



Congratulations to POF Associate, Marine Guillou, who has been recognised as one of Australia’s top five experts in anti-counterfeiting by the World Trademark Review 1000.

The World Trademark Review (WTR) 1000 is a research directory that focusses exclusively on trademark practices and practitioners. In order to effectively identify and rank individuals, the WTR conducts extensive qualitative research including surveys and interviews with hundreds of legal practitioners and their clients involved in trademarks. Individuals are selected for inclusion if they receive sufficient positive feedback from market sources with knowledge of their practice and the market in which they operate.

Marine advises clients on trade mark searching and prosecution. She specialises in anti-counterfeiting programs, customs proceedings and training. Prior to immigrating to Australia, Marine worked as an in-house lawyer for the French anti-counterfeiting Group, Union Des Fabricants (Unifab) and as an anti-counterfeiting area Manager for Société BIC. She also worked in the IP Department of French car manufacturer Renault and in a patent and trade mark attorney firm in Paris.

Phillips Ormonde Fitzpatrick Lawyers senior litigator Greg Chambers said: “Marine is a key member of the POF Group. She has an outstanding knowledge of the workings of Customs and the counterfeit seizure programmes in Australia and overseas. Our clients appreciate her expertise and her detailed understanding of the legal options available to address the sale of counterfeit goods. Her advice and counsel are actively sought by the owners of leading global brands who value her specialist expertise.”

Well done Marine!

Dr Corrine Porter qualifies as a Patent and Trade Marks Attorney

Congratulations to our newest Patent and Trade Marks Attorney, Dr Corrine Porter, who officially registered on 4 December 2014. Corrine has been with POF for four years and is a member of POF’s Chemistry and Life Sciences team. Corrine’s areas of specialisation include protein chemistry, x-ray crystallography, biochemistry and pharmaceuticals.

Corrine was awarded a PhD in Biochemistry and Chemistry in 2006. Her PhD studies, undertaken at the University of Western Australia, focused on the structural basis for binding of a peptide inhibitor to proteins implicated in breast and gastric cancer. She then worked for six years as a postdoctoral research fellow at Monash University. Corrine’s research involved investigating the molecular mechanism of bacterial conjugation in the Gram-positive bacterium, *Clostridium perfringens*. This work was funded by an NHMRC training (Postdoctoral) fellowship.



Corrine says, “I look forward to continuing to work with some of the best innovators in Australia and overseas to gain valuable protection for their ideas.”

From everyone at POF, congratulations Corrine!

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