

Inspire



phillips ormonde fitzpatrick
intellectual property

Issue 45 • September 2019

Indigenous
art knock-offs
result in
\$2.3 million fine

Australia not
in Harmony™
with the US
on Diagnostic
Patents

Patentable Subject
Matter: Second
Bite of the Apple®
Sweeter than a
Cripps Pink®

Sony's Playstation
saved by the
“dates” in patent
infringement
claim

Welcome

Despite many attempts to try and harmonise Australia's intellectual property provisions with those of other jurisdictions, there are significant areas in which our laws continue to forge their own path.

As Leigh Guerin explains, Australian Courts have taken a similar approach to those in the US in relation to whether gene patents per se are directed to patentable subject matter. However as illustrated by the decision in *Sequenom v Ariosa*, the outcome may be different where a patent relates to the use of DNA related discoveries in diagnostic methods. The patentability of computer implemented inventions remains another vexed area of Australian patent law. Adam Pepper looks at the recent decision of the Commissioner in *Apple, Inc.*, where the Delegate sought to take a more "holistic point of view" when assessing the substance of the invention. This approach has some affinity with recent UK decisions,

but it remains to be seen whether the patent office's overall approach to determining the patentability of such invention will be endorsed by Australia's appeal courts. The decision in *ACCC v Birubi Art*, dealt with the correct identification of subject matter in a very different context. As Anita Brown reports, the competition watchdog took action against Birubi in relation to the sale of imitation Indigenous artworks which were made in Indonesia and painted by non-Indigenous artists. In imposing a penalty in excess of \$2 million, the Court noted the importance of the deterrent effect of such a fine, as well as the powerful evidence of economic, social and cultural harm

occasioned by the conduct. Also in this edition, Marine Guillou identifies strategies for brand owners to protect themselves against counterfeit goods, Jon Wright discusses the importance of careful drafting to the construction of patent claims and we say congratulations to a new Partner, Special Counsel and two Senior Associates.



Adrian Crooks, Partner
BEng(Civil)(Hons) LLB LLM FIPTA
✉ adrian.crooks@pof.com.au

"An ounce of prevention..." Protecting your brand at the border

Our anti-counterfeiting team took part in brand protection and detection training workshops in June this year.

The workshops were organised by The Department of Home Affairs in Cairns, Brisbane, Sydney, Melbourne, Adelaide, and Perth, and were offered to front line Australian Border Force (ABF) officers and recruits.

Phillips Ormonde Fitzpatrick Lawyers is the exclusive partner of the leading anti-counterfeiting organisation React, and many React members either attended or asked our firm to represent them. We presented on behalf of 10 different brands from various sectors including jewellery and fashion, consumer goods, toys and pharmaceuticals. The training sessions followed a market stall format and brand

owners/representatives were able to engage in discussions with the officers, talk about their products and provide officers with pointers to identify counterfeit goods. These brand protection and detection training workshops assist ABF officers with becoming more aware of the types of goods being copied and how to detect counterfeit goods. The training also informs ABF officers of the consumer safety risks associated with infringing goods being imported into Australia. Similar training sessions are organised on a regular basis, but are only opened to brand owners that have lodged a Notice of Objection at the time of the training. Notices of Objection are legal documents that allow the ABF to seize imported goods that infringe trade marks, copyright works or protected Olympic expressions. If your company does not have a Notice of Objection in place,

we highly recommend filing one to better protect your intellectual property rights. It is worth noting that the ABF is restricted to seizing suspected infringing goods that are covered by a valid Notice of Objection. Therefore, you will only be notified of a shipment of goods infringing your rights if there is a Notice in place. The list of all brand owners with a Notice in place is also available on the Australian Border Force website. Infringers may therefore target a brand not listed.



Marine Guillou, Senior Associate
LLM (Edinburgh University)
✉ marine.guillou@pof.com.au

Indigenous art knock-offs result in \$2.3 million fine

The Federal Court has sent a strong message to businesses who misrepresent the provenance of art and souvenirs as Australian Indigenous products, recently handing down a \$2.3 million fine to one Australian wholesaler. For business owners, this case is a reminder that product claims, including those that go to a product's provenance, must be able to be substantiated. A failure to do so could result in a consumer backlash, as well as significant fines.

Birubi Art Pty Ltd (Birubi) wholesaled around 50,000 souvenirs such as boomerangs, didgeridoos, message stones and bullroarers to retail outlets throughout Australia for more than two years.

In *ACCC v Birubi Art*¹, the Federal Court found that Birubi had made false and misleading representations in breach of s 29(1) and s 33 of the *Australian Consumer Law* (ACL) by misrepresenting:

- > that those souvenirs were hand painted by Australian Aboriginal persons; and
- > that some products were made in Australia when they were in fact made in Indonesia.

The products featured designs typical of Indigenous art and used words such as "Aboriginal Art", "genuine" and "Australia".

Shortly after the Federal Court decision in 2018, Birubi was placed into liquidation. The most recent decision² dealt with the penalty to be imposed on Birubi for its breaches of the ACL. In considering the appropriate penalty, the Court reiterated the principle that the purpose of civil penalties "is primarily if not wholly protective in promoting the public interest in compliance".

Noting that Birubi was in liquidation, Justice Perry considered that a penalty could still have an important deterrent effect even though it may not be recovered. The Court heard evidence from expert witnesses regarding the harm which can occur to Indigenous culture from fake Indigenous Australian art. It heard evidence:

- > that the total revenue generated by the Australian Indigenous visual arts sector is around \$300–\$500 million per annum;
- > that it is estimated between 10,000–14,000 Indigenous people are engaged in paid work in the sector, but that as many as a further 80,000 are not being paid for the work; and
- > of the dire employment situation for Indigenous Australians.

Justice Perry considered that "the deterrent effect is of particular importance in the present context given the economic, social and cultural harms to Indigenous Australians which may flow from businesses misrepresenting the provenance of art and souvenirs as Australian Indigenous art and artefacts".

In handing down the penalty, the Court stated that while there

“There is support throughout the sector for specific legislation to be introduced to protect the intellectual property rights of Indigenous artists.”

was no "specific evidence of loss or damage by particular individuals or communities, the evidence as to the potential for direct and indirect economic, social and cultural harm occasioned by conduct of this nature for Indigenous Australian artists and more broadly for Indigenous community is powerful".

The Indigenous art trade is booming in Australia. While this case provides some comfort to Indigenous artists, there is support throughout the sector for specific legislation to be introduced to protect the intellectual property rights of Indigenous artists.



Anita Brown | Partner

BA LLB MIPLaw GAICD

 anita.brown@pof.com.au

¹ *Australian Competition and Consumer Commission v Birubi Art Pty Ltd* [2018] FCA 1595

² *Australian Competition and Consumer Commissions v Birubi Art Pty Ltd (in liq)* (No 3) [2019] FCA 996

Australia not in Harmony™ with the US on Diagnostic Patents

The patent-eligibility of medical diagnostics in Australia remains unchanged following a recent decision of the Federal Court in *Sequenom v Ariosa*¹. While this decision does not change patent eligibility in Australia, it does demonstrate a decisive divergence between Australian and US courts when considering what constitutes a patentable invention.

As we have previously reported, in 2015 the High Court of Australia in *D'Arcy v Myriad Genetics* (Myriad)² followed the lead set by the United States two-years earlier and ruled that inventions directed to isolated nucleic acids – so called “gene patents” – were not eligible to be patented. Since the decision in Myriad, it has been speculated that Australia may also follow the United States’ lead and limit patent-eligibility for medical diagnostic inventions. However, the recent decision in *Sequenom v Ariosa* confirms that this is not the case.

Medical Diagnostic Patents in the US – A Brief History

In 2012, the US Supreme Court ruled in a case between Mayo Collaborative Services and Prometheus Laboratories Inc. (Mayo)³ that a patent relating to a method of optimising the efficacy of a treatment was not valid. The basis for the decision in Mayo was that the claims in question essentially covered a natural phenomenon, and the additional ‘well known’ features to the claims did not amount to anything significantly more than the natural phenomenon.

The Mayo decision immediately impacted the prosecution of life sciences related patents in the United States, particularly those concerning medical diagnostics. The rejection rate of medical diagnostic applications in the United States – on the basis that they were directed to non-patent eligible subject matter – increased from 7% to 35% in the month after

the decision. In subsequent years, the rejection rate further increased to 64%⁴. The decision in Mayo was also quickly applied by the lower courts in the United States. One of the early applications of Mayo was in relation to a patent directed to non-invasive prenatal genetic testing, which was licensed by Sequenom Inc.

Prenatal Testing – A Test of Patent-Eligibility

Traditional prenatal genetic screening involves invasive amniocentesis, cordocentesis or chorionic villus sampling whereby needle biopsies of amniotic fluid, cord blood or the chorionic villi of the placenta are taken during pregnancy. In 1998 it was first reported that cell-free fetal DNA circulated in the mother’s blood stream and that this DNA may be useful in non-invasive prenatal diagnostics⁵. This finding became the basis of the US patent 6,258,540 and the Australia patent 727919 (amongst others), that were ultimately licensed to Sequenom. Specifically, the first claim in US patent 6,258,540 recited:

A method for detecting a paternally inherited nucleic acid of fetal origin performed on a maternal serum or plasma sample from a pregnant

female, which method comprises: amplifying a paternally inherited nucleic acid from the serum or plasma sample and detecting the presence of a paternally inherited nucleic acid of fetal origin in the sample.

In comparison, the first claim of the Australian patent 727919 recited:

A detection method performed on a maternal serum or plasma sample from a pregnant female, which method comprises detecting the presence of a nucleic acid of foetal origin in the sample.

Ariosa entered the market in the United States in 2012 with a non-invasive prenatal test marketed under the name Harmony™. This test was in competition with Sequenom’s MaterniT21™ test which had entered the market in 2011. The Harmony™ test was subsequently licensed into Australia in 2015.

In 2013 the District Court for the Northern District of California⁶ considered if Ariosa’s Harmony™ test infringed Sequenom’s licensed US patent. This was further considered by the Federal Circuit Court in 2015⁷. Ultimately, it was determined that in view of the test set forth in Mayo, the claims of Sequenom’s patent were not directed to patent-eligible subject matter, and consequently the claims

¹ *Sequenom, Inc. v Ariosa Diagnostics, Inc.* [2019] FCA 1011.

² *D’Arcy v Myriad Genetics Inc* [2015] HCA 35.

³ *Mayo v. Prometheus*, 566 U.S. 66 (2012).

⁴ Chien, C. and Wu T. *Decoding Patentable Subject Matter*, 2018, Patently-O Patent Law Journal 1.

⁵ Lo, D. et al., *Quantitative Analysis of Fetal DNA in Maternal Plasma and Serum*, 1998, *American Journal of Human Genetics*, 62, pg. 768-775.

⁶ *Ariosa Diagnostics, Inc. v Sequenom, Inc.* No. C 11-06391 SI

⁷ *Ariosa Diagnostics, Inc. v Sequenom, Inc.*, 788 F.3d 1371



“
The Court determined that the detection of cell-free fetal DNA inherently involved human interaction and was therefore an ‘artificially created state of affairs’”

were not enforceable. In arriving at this decision the Court considered that the claims failed to encompass substantially more than a natural phenomenon, being the existence of cell-free fetal DNA in maternal blood.

Sequenom v Ariosa in Australia

In 2016, Sequenom commenced proceedings in the Federal Court of Australia alleging infringement of their Australian patent by Ariosa and its Australian licensees, while Ariosa cross-claimed for invalidity of the patent on several grounds, including that the claims were not directed to patent eligible subject matter.

In assessing if the claims in Sequenom’s Australian patent were directed to patent eligible subject matter, the Court considered Myriad which directed analysis of what

forms the “substance” of the claim. In essence the Court was asked to consider if the substance of the claims in Sequenom’s Australian patent was merely the discovery of a natural phenomenon, being the existence of fetal nucleic acids in the maternal circulatory system. Further, it was put to the Court that the claims merely resulted in information only and there was no ‘artificially created state of affairs’⁸, which has been a cornerstone of determining patent eligible subject matter since the NRDC decision in 1952⁹.

This argument was comparable to that affirmed in the equivalent litigation in the United States. In other words, Ariosa argued that due to the harmonious position taken between the Australian and the United States’ highest courts with regard to Myriad, Australia should similarly adopt the position of the US with regard to the

diagnostic claims in Sequenom’s Australian patent¹⁰.

Ultimately, the Court rejected Ariosa’s arguments, and determined that the detection of cell-free fetal DNA inherently involved human interaction and was therefore an ‘artificially created state of affairs’¹¹. The court concluded that Sequenom’s patent claimed a new and inventive application of the discovery of cell-free fetal DNA, and required human action to detect a DNA sequence of fetal, rather than maternal, origin.



Dr Leigh Guerin | Associate

BMedPharmBiotech(1st Class Hons) PhD MIPLaw

leigh.guerin@pof.com.au

⁸ *Sequenom, Inc. v Ariosa Diagnostics, Inc.* [2019] FCA 1011 at [397]

⁹ *National Research Development Corporation v Commissioner of Patents* (1959) 102 CLR 252

¹⁰ *Sequenom, Inc. v Ariosa Diagnostics, Inc.* [2019] FCA 1011 at [406]

¹¹ *Sequenom, Inc. v Ariosa Diagnostics, Inc.* [2019] FCA 1011 at [494]



Patentable Subject Matter: Second Bite of the Apple[®] Sweeter than a Cripps Pink[®]

While those in the ICT space wait with baited breath on the outcome of *Encompass Corporation v InfoTrack (Encompass)*, for guidance on the subject matter eligibility of computer-implemented inventions, a recent decision has perhaps softened the position of the Australian Patent Office (APO).

In *Apple, Inc.* [2019] APO 32 the Delegate of the Commissioner of Patents appears to have taken a 'holistic' approach in identifying the substance of an invention for manner of manufacture as it relates to computer implemented inventions. The decision follows the recent softening of practice at the UK IPO and suggests that the APO may take a less hard-line approach in future.

While not expressly excluded under Australian law, software

or methods that are implemented as computer software

or a related product are only patentable if what is claimed

'as a matter of substance' meets the requirements

for a manner of manufacture and in particular is not a mere scheme, abstract idea or mere information.

These principles rely on a number of recent judgments including *Research Affiliates*¹, which involved consideration of the UK Court of Appeal decision in *Aerotel v Telco Holdings*². *Aerotel* set out a well-known four step test for assessing subject matter eligibility, which in part required the Court to consider what an invention 'has really added to human knowledge' by looking at the 'substance' and not the form of the invention. Soon after, in Australia, *D'Arcy v Myriad Genetics*³ confirmed that the starting point for the resolution of the 'manner of manufacture' issue is the identification of what in 'substance' each relevant claim is for.

Relevant to the question of 'substance' is the definition of the invention which depends upon the

construction of the relevant claims read in light of the specification as a whole and the relevant prior art base. However, there is currently a lack of clarity about whether prior art can or should be taken into account when identifying the 'substance' during a manner of manufacture assessment.

For example, is the same prior art base taken into consideration when assessing manner of manufacture as is used

when assessing

inventive step?

Interestingly on the basis that identification of the substance of the invention is an issue before the Full Court in *Encompass*, Apple unsuccessfully sought to extend the filing of submissions until after the decision is handed down.

Despite pressing on, the Delegate does offer some guidance on assessing the 'substance' of an invention, highlighting the importance of not applying too narrow a view, particularly where the general tasks performed by the computer system may be external to the computer, or if the invention solves a technical problem related to the running of computers generally. Importantly, the Delegate offers at [74] that:

'...one should not immediately conclude that an application is not for a manner of manufacture just because it may fall, generally, within what typically constitutes excluded subject matter. Rather, an assessment of where the substance of the invention may lie should be approached,

with a holistic point of view.'

The idea of taking a holistic view largely follows *Rokt v Commissioner of Patents*⁴ (*Rokt*), where Robinson J cautioned against focusing on elements of an invention in isolation. *Rokt* recognised that the invention brought together a combination of new and known elements to form a working combination that had not previously been achieved, involving the use of computers in a way foreign to their normal use. In *Apple, Inc.*, the invention was directed to a method of reusing animation sequences, which was responsible for a number of benefits on known portable electronic devices.


Interestingly, this holistic approach is similar to that taken in the UK following the *Landmark Graphics*⁵ decisions. When applying the *Aerotel* test, the formulation of the contribution should not involve a forensic analysis, and a more holistic or flexible description of the contribution should be used. Relevantly, in a previous decision relating to the same application⁶, the Australian Delegate echoed this very sentiment expressed by the UK hearing officer in *Landmark Graphics*.

Apple, Inc. should provide some comfort to applicants in the ICT space, particularly where there is disagreement between the applicant and the APO as to identifying the substance of an invention. However, the bigger issue of whether considerations such as novelty, inventive step and common general knowledge should be conflated with the manner of manufacture test will need to wait until the Full Court hands down its judgment in *Encompass* hopefully later this year.



Adam Pepper | Patent and Trade Marks Attorney

BSc, BEng(Hons), GradCertSocSc, MIP

 adam.pepper@pof.com.au

“
The decision follows the recent softening of practice at the UK IPO and suggests that the APO may take a less hard-line approach in future.”

¹ *Research Affiliates LLC v Commissioner of Patents* [2014] FCAFC 150

² *Aerotel Ltd v Telco Holdings Ltd* [2007] RPC 7

³ *D'Arcy v Myriad Genetics Inc* [2015] HCA 35

⁴ *Rokt Pte Ltd v Commissioner of Patents* [2018] FCA 1988

⁵ *BL O/112/18; see also BL O/155/18; BL O/138/18; BL O/140/18; BL O/143/18; BL O/148/18; BL O/154/18*

⁶ *Apple Inc.* [2018] APO 54 at [71]



Sony's playstation saved by the “dates” in patent infringement claim

The recent Federal Court decision in *Pilkin v Sony Australia*¹ considered whether the amendment of a patent's claims resulted in deferral of the priority date of those claims and its bearing on infringement allegations. This decision highlights the importance of carefully considering the effect of claim amendments, particularly if infringement proceedings are being contemplated.

The case in question involved Mr Pilkin, who alleged that Sony Australia Limited, Sony Interactive Entertainment LLC, and Sony Interactive Entertainment Europe Limited (Sony parties) had infringed his innovation patent AU2010101517, which had a priority date of 7 September 2010, by offering for sale and selling the PlayStation console since 22 February 2012.

The Patent in Suit

The innovation patent was based on a PCT Application that entered National Phase in Australia on 11 July 2014 with amended claims. The national phase application was accompanied by a request for conversion of the standard patent application to an innovation patent application. The PCT Application was entitled "Touchpad Visual Display and Joystick Arrangement in an Electronic Device" and had a filing date of 7 September 2010 claiming priority from a Russian application filed on 5 October 2009.

The PCT application related to a user-friendly arrangement of a touch pad and/or a visual display and/or a joystick in electronic devices and was directed toward solving the problem of touchpads being placed on lateral sides of an electronic device thereby preventing a user of the electronic device from performing operations on the touchpad by the hand while holding the device.

The PCT application included specific references to locations of the joystick (*arranged on the rear side of the electronic device body, ... arranged partially on the rear side of the electronic device body, ... located on the lateral side surface of the electronic device body, ... joystick are made so as to move along the electronic device body, ... placed on the protective cover of a camera lens and/or the protective cover of a camcorder lens*).

Following amendment, the sole claim of the patent in suit read as follows:

1. An electronic device comprising:
 - > a body having a front side and a rear side,
 - > a touchpad arranged on the rear side,

> a visual display arranged on the front side, and
> a joystick;
wherein a visual display is a touch screen display, wherein a user of the electronic device through manipulations with the touchpad or with the joystick controls at least one virtual symbol displayed on said visual display.

As a result of the amendments, the innovation patent claim contained no reference to any specific location of the joystick or use of joystick in respect of the claimed arrangement.

The Arguments

The Sony parties relied on s 102(1) and s 114 of the *Patents Act* to argue that as a consequence of amendment of the claims, the patent encompassed matter that extended beyond that which was disclosed in the PCT Application as originally filed, and the amendment was therefore not allowable.

The Sony parties further argued that, in accordance with reg. 3.14 of the *Patent Regulations 1991* (Cth), the priority date of the patent should be 11 July 2014, i.e. the date on which the claims were amended, rather than the original priority date. Accordingly, the Sony parties argued that Mr Pilkin could not successfully make out a case for infringement since the console was introduced in the Australian market on 22 February 2012, i.e. prior to the deferred 11 July 2014 priority date.

Mr Pilkin responded that the amendments were merely to delete alternatives and did not add any matter to the complete specification as filed in Australia. He further argued that the location of the joystick was a non-essential feature, even in the PCT Application.

Deferral of Priority Date

Rares J construing claim 1 upon a reading of the PCT application as a whole, concluded that the joystick was an alternative to the touchpad and therefore not an essential feature. However, in arrangements that did require a joystick, the PCT application only provided description of the joystick being

arranged in locations other than the front of the electronic device. Therefore, a skilled addressee would have understood the joystick to be in a specific location other than the front of the device.

The complete specification did not disclose "unlimited or unqualified use of a joystick on the front of the device (or at any location)". By deleting references to locations of the joystick from the claim, its scope encompassed the joystick being used without any limitation as to location, including at the front of the device.

As a result, Rares J determined that the sole claim of the innovation patent should have a deferred priority date of 11 July 2014. As the alleged infringing console had been sold in Australia from a date earlier than the priority date of the claim, the patent could not be both valid and infringed. Mr Pilkin's case therefore had no reasonable prospect of succeeding and was dismissed.

“
By deleting references to locations of the joystick from the claim, its scope encompassed the joystick being used without any limitation as to location.”



Ann Gabriel | Trainee Patent Attorney

M.Eng., B.Tech.

✉ ann.gabriel@pof.com.au



A question

The Australian Federal Court was recently tasked with construing the meaning of the term “formed from” in the decision of Gram Engineering v Oxworks¹. The patentee (Gram) argued that “formed from sheet material” was broad language, and agnostic as to how the profile was introduced into the sheet.

The Patent

The Patent relates to fencing, and more specifically to fence elements - known as plinths - used at the base of a fence construction.

During the proceedings, Gram alleged that Oxworks’ product,

the “*ColourSmart Plinth*”, when considered alone and as used in its other product, the “*ColourSmart Fence*”, infringed the claims of the Patent which required the plinth to be formed from sheet material.

Oxwork refuted this allegation on the basis that since the plinth was manufactured from a material using an extrusion process, at no point during its manufacture was the material in sheet form.

The Product

In October 2016, Oxworks engaged the services of a company in China to manufacture the “*ColourSmart Plinth*” in accordance with the specifications of a steel plinth that appeared on Gram’s website. As the company was only able to manufacture such products using an extrusion process, Oxworks’ plinth had a much greater wall thickness than the steel plinth listed on Gram’s website.

Submissions

Gram submitted that Oxworks’ plinth infringed the claims of the Patent because when properly construed, Claim 1 (read as a whole and in the context of the body of the specification) used the phrase “*formed from sheet material*”, meaning a plinth formed from sheet material that is (i.e. being) profiled.

In particular, Gram submitted that Claim 1 was sufficiently broad to include a plinth that was formed from a sheet material that had a profile in it for the purpose described in the claim, which was to introduce stiffening formations along the length of the sheet. That is, Claim 1 was not limited to sheet material that was made from a flat piece of material as a starting point. Gram further submitted that Claim 1 would embrace a profiled sheet which was manufactured from a material not only by roll forming, pressing or the like, but also by moulding or extrusion.

¹ Gram Engineering Pty Ltd v Oxworks Pty Ltd [2019] FCA 689



of form

In reply, Oxworks submitted that their plinth did not infringe any claim of the Patent because it was not formed from sheet material. Rather, the plinth was formed in an aluminium extrusion process in which an aluminium billet was forced through a die and extruded in the final form of the plinth, which had a zig-zag cross-section.

Oxworks argued that the term “formed” in the integer “formed from sheet material”, was the past participle of the verb “form”, meaning “to shape”, and “from” was a preposition indicating a starting point. Thus, the phrase “formed from” was argued by Oxworks to mean “shaped from a starting point of” sheet material. In this respect, Oxworks submitted that Claim 1 was directed to a fence plinth that had been shaped from a flat piece of material, by introducing stiffening formations (and thus a non-flat profile) into the flat material. So construed, Oxworks’ plinth did not infringe Claim 1 because it was not formed from a flat sheet or a profiled sheet.

Decision

Robertson J considered that the ordinary meaning of the word, “sheet” does not necessarily infer that the material is flat, and that as such, it may have corrugations or profiles, as is the case when referring to profiled material in the building industry, such as corrugated sheeting.

In other words, his Honour took the view that the phrase “sheet material” in Claim 1 does not mean that the material is required to be flat and that “being profiled” is merely a description of the form of the plinth rather than something that is required to be done to a flat sheet to form the plinth. As such, his Honour determined that the phrase “formed from”, merely describes what the plinth is made out of.

His Honour concluded that even though Oxworks’ plinth was manufactured by an extrusion process, the plinth was relevantly “formed from”, in the sense of “made out of”, sheet material, and thus infringed the claims of the Patent.

This decision highlights the importance of careful drafting of a patent application to ensure that the claims are clearly and unambiguously defined and fully supported within the description by well-defined language for each of the terms used in the claims.



Jon Wright | Senior Associate

BSc (1st Class Hons) PhD MIP

jon.wright@pof.com.au

Latest firm developments

We are delighted to announce four new appointments effective from 1 July, 2019.

Congratulations to our new Partner, Special Counsel and Senior Associates.

Anita Brown – Partner

Anita Brown has been promoted to Partner in the Trade Marks team. Anita has been with POF since 2007 and develops strategies for protection, commercialisation and enforcement of intellectual property rights of both large and small Australian and foreign companies across a range of industries including life sciences, fashion, manufacturing, cleantech and information technology. Anita actively promotes the firm's trade mark expertise and acts for some of POF's key trade mark clients.

Mark Williams – Special Counsel

Mark Williams has been promoted to Special Counsel in the Electronics, Physics & IT team. Mark joined POF in 2002, and focuses on a diverse range of inventions, including electronic devices, mining and hardware, software, computer implemented inventions and electronic gaming machine systems. Mark represents some of the most notable clients in the Electronics, Physics & IT group. He plays a key role in the implementation of POF's social media strategy and was recently recognised by Lexology as the key legal influencer for Australasia.

Duncan Joiner – Senior Associate

Duncan Joiner has been promoted to Senior Associate in the Engineering team. Duncan joined POF's Engineering group in 2012 and works across a range of engineering technologies including mining, automotive, aerospace, materials and clean tech. Duncan works with many of the Engineering Group's most important clients. Duncan also assists a number of smaller SME clients in protecting and commercialising their inventions.

Helen McFadzean – Senior Associate

Helen McFadzean has been promoted to Senior Associate in the Electronics, Physics & IT team. Helen has been with POF since 2017. Since joining the intellectual property profession in 2009, she has successfully obtained patents, trade marks and designs for hundreds of businesses in Australia and overseas in a large number of technology areas. Helen acts for key clients in the Electronics, Physics & IT group. Congratulations to all of our new appointees!

Alyssa Telfer named in Managing IP's Top 250 Women in IP

We're delighted to congratulate Alyssa Telfer on her inclusion in Managing IP's Top 250 Women in IP for 2019, which recognises the leading female IP practitioners in private practice who have performed exceptionally for their clients and firms over the past year.

Alyssa has been a key member of POF's Electronics, Physics & IT team for over 18 years. As a Biomedical Engineer with a strong background in electronics and medical instrumentation, she has been conducive in establishing POF's Medical Technology team, and continues to provide exceptional strategic and business focussed service to her clients.

“

This is a fantastic achievement by Alyssa – it's a testament to her exceptional performance and reflects the quality of the relationships she has with her clients.”

Ross McFarlane,
Managing Partner

“

The lifeblood of our business is our outstanding people. On behalf of my fellow partners, I am delighted to celebrate Phillips Ormonde Fitzpatrick's continued success through the elevation of these highly talented attorneys/lawyers.

Ross McFarlane,
Managing Partner



phillips ormonde fitzpatrick
intellectual property

Contact us info@pof.com.au

Melbourne

Level 16
333 Collins St
Melbourne 3000
+61 3 9614 1944

Sydney

Level 19
133 Castlereagh St
Sydney 2000
+61 2 9285 2900

Adelaide

Level 5
75 Hindmarsh Sq
Adelaide 5000
+61 8 8232 5199

Geelong

108 Gheringhap St
Geelong 3220
+61 3 9614 1944