TITLE: **'The Intellectual Property jurisdiction of the Supreme Court of Victoria: Myth or Reality?'**

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EVENT: **Intellectual Property Society of Australia and New Zealand Dinner, at the Grand Hyatt in Melbourne**

AUTHOR: **The Honourable Justice Harper**

Mr McGowan's introduction was typically generous, as is your hospitality this evening. This is especially so since most of you are not here tonight simply because you want to get a good run when you appear in the Supreme Court's Intellectual Property List. Those who are not here solely for the company and the food are probably simply curious to know whether the list does or does not really exist.

In my job, one becomes tired of hearing nothing but the truth, the whole truth and nothing but the truth. But I am nevertheless bound tonight to give it to you straight. The truth is that the list does exist. The truth also is that it is small, and its prospects of pinching much work from the Federal Court are not much bigger. But it *is* there to provide a service. And it does have some things to offer. The organisers of tonight's event were kind enough to think that you might be interested to hear about them.

First, a spot of history and context. In the glory days before Victorian threw off its colonial status, the Supreme Court had jurisdiction in everything, subject only to appeals to Her Majesty's Privy Council. Intellectual property cases were then a small but significant part of the Court's work. In the 20 years between 1880 and 1900, for example, 45 or more intellectual property cases were reported in the Victorian Law Reports (compared to some 297 criminal cases reported for the same period). But the number of reported intellectual property cases must have been the mere tip of the iceberg, because for every reported case there is a much larger number that were not reported at all, or were reported elsewhere. Between 1910 and 1930, 28 intellectual property cases appeared in the authorised Victorian Reports. In the ten years from 1940 there was only one case. Since then, there have been less than five in any decade, except for the 1980's, when for some reason there was a quantum leap. Ten intellectual property cases were reported in the Victorian Reports in those ten years.

There were of course ample reasons why the founding fathers included section 51(xviii) in the Federal Constitutional. As Glen McGowan has reminded me, the problems of inter-colony enforcement of intellectual property rights were so obvious that the constitutional debates contain no expressions of doubt about the desirability of the Federal legislature having the power to make laws for the peace, order and good government of the Commonwealth with respect to copyright, patents of invention and designs, and trade marks. And so, since 1900, the Commonwealth Parliament has had that power. It has been drawn upon to enact the *Advance Australia Logo Protection Act* 1984, the *Circuit Layouts Act* 1989, the *Copyright Act*

1968, the *Designs Act* 1906, the *Olympic Insignia Protection Act* 1987, the *Patents Act* 1990 and the *Trade Marks Act* 1995.

As a prescribed court, the Supreme Court of Victoria has jurisdiction in respect of each of those Acts. What it does not have, of course, is what section 154 of the *Patents Act* confers exclusively on federal courts (the Federal Court and the High Court): jurisdiction to hear and determine appeals against decisions or directions of the Commissioner of Patents.

Much flows from section 154. Exclusive jurisdiction in an important area of patent work leads to the accumulation of expertise in that area. This spreads to other aspects of patent law and, more generally still, so as to cover the intellectual property field. Those who work in that field then tend naturally to think of the Federal Court as *the* court in which intellectual property disputes are resolved.

I have no quarrel with that, nor could I. I am not about filching work from colleagues whom I like and respect; and while some competition between courts is necessarily healthy, crude – or even subtle – attempts to invade the territory of another are not merely unseemly. They are improper.

It is nevertheless entirely appropriate that intellectual property practitioners be aware of all the options open to them. Fully informed choices can then be made. And the Supreme Court is, save for section 154 and equivalent provisions in other Commonwealth legislation, open for business. It is a generally available option.

It has, indeed, been available in more or less its present form since the Supreme Court Intellectual Property List was first established in 1976 (or so my spy in the form of Glen McGowan tells me - I have no personal recollection of this momentous moment). Its first judge was Fullagar J, generally assisted by Lyons QC for one side and whoever was lucky enough to be briefed for the other. Since Lyons had read with Fullagar, their joint domination of the list was frequently referred to as the "unholy alliance". But it only lasted until 1978. King J then took charge and remained so until his retirement in 1991. He was succeeded by Ashley J who in turn was succeed by me in 2000.

What is my intellectual property background? My proudest claim is that I read with Bruce Caine. Nominally, it was the other way around. But he taught me far more than I taught him. Indeed, since I was his second mentor (or "Master" as they called mentors in those days) and John Emmerson QC was his first, I learned a great deal from that leader of the jurisdiction albeit at second hand and without Emmerson being able to charge a fee. My only other claim to fame is that I was once junior to Lyons QC, instructed by John Dowling of Allens Arthur Robinson, in a patent case involving pharmaceutical drugs. It was, I think, the most lucrative junior brief I have ever had, though I have never forgiven either Lyons or Dowling for settling the case before trial.

Otherwise, my IP practice was modest although, as with most barristers who concentrated upon commercial work, some copyright, trade mark and passing off litigation was thrown in.

Some of my colleagues, of course, have had considerable experience, and have gained notable expertise, in a wide range of intellectual property litigation. Dodds-

Streeton J taught the subject for years at Melbourne University and practised in the jurisdiction at the Bar. Whelan J also has considerable experience, although not in patent cases. I have checked with Hollingworth J and her position is much the same as that of Whelan J. Their very extensive commercial practices included passing off, copyright and some trade mark work.

The philosophy of the list is, of course, that the Judge in charge not only manages the interlocutory processes but also sits as the trial judge. That is not say that if a case were best suited to the expertise of, say, Dodds-Streeton J, it could not be heard by her. The list will be operated with as much flexibility as the business of the Court allows while having regard to the absolute prohibition on improper "judge shopping".

What is the present state of the list? Presently there are nine cases in it. One raises some patent issues; the others are disputes over copyright and trade marks. While all have IP elements, all also raise issues, such as confidential information and s.52 type claims, that are not strictly within the "intellectual property" ambit. Entry into the list will most definitely not be decided upon fine points about the IP content of the dispute. If the case has a genuine IP element and justifies judge management and the other special consideration shown to cases in the list, it will generally be readily accepted as appropriate for inclusion.

I now turn to the institution of proceedings: the point at which the choice of the appropriate jurisdiction must be made. And here, at the threshold, the Supreme Court is certainly in a position to offer at least as much as any other court.

In this context, I should mention with a touch of nostalgia those days long gone when most judges' associates in most courts were neither charming, nor approachable, nor personable nor helpful. My Associate, Ms Samantha Loo has all the above admirable qualities, as well as enviable intelligence and experience. She represents a single point of entry for practitioners wishing to have their disputes litigated in the Intellectual Property List of the Supreme Court. Her telephone number is available on request. Just see her after dinner.

The list is a judge-managed list. This means that the equivalent of a docket system operates in relation to cases in the list. It means that interlocutory applications can be brought on very quickly indeed, and generally at a time and on a date convenient to all the practitioners involved. Orders by consent can generally be made on the papers. The rules are flexible, and are flexibly applied. Thus, orders for inspection, for discovery and for interrogation can be moulded to fit the particular case. Anton Piller orders and Mareva Injunctions are of course within the jurisdiction of the Court. Again, they can be moulded to fit the particular circumstances, with the necessary qualification that justice will always be administered in accordance with law.

The Court can, and will if special circumstances are shown, offer trial by jury. This is a point of distinction with the Federal Court. The Rules of the Supreme Court provide by r.47.02(1) that a proceeding commenced by writ and founded on contract or tort may be tried with a jury should the parties so elect. Although there is some dispute about whether passing off is properly classified as a tort, I accept the view implicitly expressed by Professor Fleming in *The Law of Torts* (9th edition 1998). That learned author there simply deals with this cause of action as without question falling within

the tortious sphere. In any event, r.4702(2) allows the Court to order that any other proceeding be tried with a jury.

I do not wish to overstate the significance of these Rules. I do, however, make the point that there may be cases, for example a passing off action, in which the credibility of the witnesses will be a real issue. In such cases, trial by jury might be at least as appropriate as trial by Judge alone. Juries in the United States commonly sit on IP cases.

Expert evidence is often of crucial importance in intellectual property cases. Here I think it is true to say that the Intellectual Property list is administered with as much flexibility as is available in the Federal Court. Of course, O.44 will apply. In its present – revised - form, that rule allows for such practices as "hot tubbing". In appropriate cases, therefore, the parties can expect that the evidence of experts will be dealt with in a way that best ensures an outcome that is consonant with the weight of expert opinion. In this context I refer also to what we fondly know as the "little green book": the *Commercial List Practice Note 2004*. Practitioners may take it that that guide will also serve as a general indication of the way cases will be managed in the Intellectual Property list. Of course, to the extent that different management is indicated, different management will be applied. At the same time, I will always bear in mind that no list should be managed purely in accordance with the idiosyncratic notions of the judge in charge. The Court appreciates that practitioners need to be able to anticipate what steps it will take, and when.
