

INTELLECTUAL PROPERTY REPORTS
134 PART 1

TABLE OF CASES REPORTED

- Carlisle Homes Pty Ltd (ACN 106 263 209) v Tick Homes Pty Ltd (620 818 180)
(FCA — Murphy J) (2018) **134.118**

[LexisNexis AU](#) | [Lexis Advance](#)

- Fresh Venture Group Pty Ltd v Box Corporate Food Services Pty Ltd
(IP Aust — B Irgang) (2018) **134.142**

[LexisNexis AU](#) | [Lexis Advance](#)

- Idenix Pharmaceuticals LLC v Gilead Sciences Pty Ltd (ACN 072 611 708)
(FCA— Full Court) (2017) **134.1**

[LexisNexis AU](#) | [Lexis Advance](#)

- Jushi Group Co Ltd (a company registered in the People’s Republic of China) v OCV
Intellectual Capital, LLC (a company registered in the United States of America)
(EWCA Civ — Full Court) (2018) **134.156**

[LexisNexis AU](#) | [Lexis Advance](#)

- Live Entertainment Investments III Pty Ltd v The Education Group Pty Ltd
(IP Aust — A Richards) (2018) **134.131**

[LexisNexis AU](#) | [Lexis Advance](#)

- Sanofi v Amgen Inc (IP Aust — S D Barker) (2018) **134.150**

[LexisNexis AU](#) | [Lexis Advance](#)

- Singtel Optus Pty Ltd v Optum Inc (No 2) (FCA — Davies J) (2018) **134.112**

[LexisNexis AU](#) | [Lexis Advance](#)

- Voxson Pty Ltd (ACN 005 291 458) v Telstra Corporation Ltd (ACN 051 775 556) (No 10) (FCA — Perram J) (2018) **134.99**

[LexisNexis AU](#) | [Lexis Advance](#)

CUMULATIVE TABLE OF CASES REPORTED

Intellectual Property Reports

Carlisle Homes Pty Ltd (ACN 106 263 209) v Tick Homes Pty Ltd (620 818 180) (FCA — Murphy J) (2018) **134.118**

Fresh Venture Group Pty Ltd v Box Corporate Food Services Pty Ltd (IP Aust — B Irgang) (2018) **134.142**

Idenix Pharmaceuticals LLC v Gilead Sciences Pty Ltd (ACN 072 611 708) (FCA — Full Court) (2017) **134.1**

Jushi Group Co Ltd (a company registered in the People's Republic of China) v OCV Intellectual Capital, LLC (a company registered in the United States of America) (EWCA Civ — Full Court) (2018) **134.156**

Live Entertainment Investments III Pty Ltd v The Education Group Pty Ltd (IP Aust — A Richards) (2018) **134.131**

Sanofi v Amgen Inc (IP Aust — S D Barker) (2018) **134.150**

Singtel Optus Pty Ltd v Optum Inc (No 2) (FCA — Davies J) (2018) **134.112**

Voxson Pty Ltd (ACN 005 291 458) v Telstra Corporation Ltd (ACN 051 775 556) (No 10) (FCA — Perram J) (2018) **134.99**

CASES JUDICIALLY CONSIDERED IN THIS PART

- Australian Broadcasting Corporation v O'Neill (2006) 227 CLR 57; 229 ALR 457; [2006] HCA 46, followed 134.118
- Apotex Pty Ltd v Cipla Ltd [2017] FCA 1627, distinguished 134.118
- AstraZeneca AB v Apotex Pty Ltd (2014) 226 FCR 324; 312 ALR 1; 107 IPR 177; [2014] FCAFC 99, distinguished 134.1
- Austin, Nichols & Co Inc v Lodestar Anstalt (2012) 202 FCR 490; 287 ALR 221; [2012] FCAFC 8, applied 134.112
- Beadcrete Pty Ltd v Fei Yu (t/as Jewels 4 Pools) [2012] FCA 1091, applied 134.99
- Beecham Group Ltd v Bristol Laboratories Pty Ltd (1968) 118 CLR 618; [1968] ALR 469, followed 134.118
- Beloit Technologies Inc v Valmet Paper Machinery Inc [1995] RPC 705, considered 134.156
- CA Henschke & Co v Rosemount Estates Pty Ltd (1999) 47 IPR 63; [1999] FCA 1561, considered 134.131
- Cantarella Bros Pty Ltd v Modena Trading Pty Ltd (2014) 254 CLR 337; 315 ALR 4; 109 IPR 154; [2014] HCA 48, applied 134.142
- Clarendon Homes (Aust) Pty Ltd v Henley Arch Pty Ltd (1999) 46 IPR 309; [1999] FCA 1371, considered 134.118
- Clark Equipment Co v Registrar of Trade Marks (1964) 111 CLR 511; [1965] ALR 344, applied 134.142
- Domino's Pizza Enterprises Ltd v Precision Tracking Pty Ltd [2016] APO 13, applied 134.150
- Dr Reddy's Laboratories (UK) Ltd v Eli Lilly and Co Ltd [2010] RPC 9; [2009] EWCA Civ 1362, considered 134.156
- Eagle Homes Pty Ltd v Austec Homes Pty Ltd (1999) 87 FCR 415; 161 ALR 503; 43 IPR 1; [1999] FCA 138, considered 134.118
- Generic Health Pty Ltd v Bayer Pharma Aktiengesellschaft (2014) 222 FCR 336; 314 ALR 91; 106 IPR 381; [2014] FCAFC 73, applied 134.99
- H Lundbeck A/S v Norpharma SpA [2011] RPC 23; [2011] EWHC 907 (Pat), considered 134.156
- Henley Arch Pty Ltd v Lucky Homes Pty Ltd (2016) 120 IPR 317; [2016] FCA 1217, considered 134.118
- Hills Industries Ltd v Bitek Pty Ltd (2011) 214 FCR 396; 90 IPR 337; [2011] FCA 94, considered 134.112
- Hughes v Western Australian Cricket Association Inc (1986) 19 FCR 10; 69 ALR 660, applied 134.112
- InterPharma Pty Ltd v Hospira, Inc (No 3) [2017] FCA 1536, distinguished 134.118
- Kimberly-Clark Australia Pty Ltd v Arico Trading International Pty Ltd (2001) 207 CLR 1; 177 ALR 460; [2001] HCA 8, applied 134.1
- Lockwood Security Products Pty Ltd v Doric Products Pty Ltd (2004) 217 CLR 274; 212 ALR 1; [2004] HCA 58, applied 134.1; explained 134.1
- Murray Goulburn Co-operative Company Ltd v New South Wales Dairy Corporation (1990) 17 IPR 269, distinguished 134.112
- Pfizer Products Inc v Karam (2006) 219 FCR 585; 237 ALR 787; 70 IPR 599; [2006] FCA 1663, applied 134.142
- Proctor v Kalivis [2009] FCA 1518, applied 134.99
- Re Synthon's Patent [2006] RPC 10, considered 134.156
- Shord v Commissioner of Taxation (No 2) [2018] FCAFC 27, applied 134.112
- Sigma Pharmaceuticals (Australia) Pty Ltd v Wyeth (2011) 119 IPR 194; [2011] FCAFC 132, distinguished 134.1

(Continues on p iii of cover)

CASES JUDICIALLY CONSIDERED IN THIS PART — *continued*

Smith & Nephew Plc v Convatec Technologies Inc [2015] RPC 32, explained 134.156
SW Hart & Co Pty Ltd v Edwards Hot Water Systems (1985) 159 CLR 466; 61 ALR 251; 5 IPR 13,
considered 134.118

Tamawood Ltd v Henley Arch Pty Ltd (2004) 61 IPR 378; [2004] FCAFC 78, considered 134.118
Telstra Corporation Ltd v Phone Directories Company Pty Ltd (2015) 237 FCR 388; 328 ALR 247;
116 IPR 207; [2015] FCAFC 156, applied 134.142
TOSHIBA/Thickness of Magnetic Layers [1990] EPOR 267, distinguished 134.156

Ultraframe (UK) Ltd v Eurocell Building Plastics Ltd [2004] 1785 EWHC (Ch), considered 134.156
UNILEVER/Washing Composition [1992] EPOR 501, distinguished 134.156

Wu v Li [2015] FCAFC 109, applied 134.112

STATUTES, RULES, ETC CITED IN THIS PART

COMMONWEALTH

Evidence Act 1995	
s 69	134.99
s 147	134.99
Federal Court Act 1976	
s 43	134.112
Federal Court Rules 2011	
r 34.50	134.99
Intellectual Property Practice Note (IP-1)	
.	134.99
Patents Act 1990	
s 40(2)	134.1
s 40(3)	134.1
s 210(1)	134.150
s 210(4)	134.150

Patents Regulations 1991	
reg 3.12	134.1
Telecommunications (Interception and Access) Act 1979	
s 5	134.99
s 5G	134.99
s 6	134.99
s 7	134.99
s 63	134.99
Trade Marks Act 1995	
s 41(3)	134.142
s 41(4)	134.142
s 52	134.142
s 92(4)(b)	134.112, 134.131
s 101(2)	134.112
s 101(3)	134.112, 134.131

INDEX OF CASES IN THIS PART

COPYRIGHT

Building plans — Allegation of copying house plans — Infringement — Objective similarity — Access to plans: *Carlisle Homes Pty Ltd (ACN 106 263 209) v Tick Homes Pty Ltd (620 818 180)* 134 IPR 118

EVIDENCE

Experimental evidence — Leave to admit experimental evidence where no compliance with Rules — Whether prejudice to respondent — Patents — Process description — Cross-examination of person verifying process description — Telecommunications — Intercept of communication passing over a telecommunications system — Whether evidence unlawfully obtained — Evidence — Hearsay — Webpages — Whether admissible as business records: *Voxson Pty Ltd (ACN 005 291 458) v Telstra Corporation Ltd (ACN 051 775 556) (No 10)* 134 IPR 99

PATENTS

Novelty — Claim including numerical limits — Claim referring to prior art — Numerical ranges in claim and prior art overlapping — Relevance of “serious contemplation” principle stated by European Patent Office — Prior art does not disclose each and every possible combination encompassed by generic disclosure of range — Skilled person would not understand prior art as such — No rule of law prior disclosure of numerical range carries implicit disclosure skilled person may choose any value within range: *Jushi Group Co Ltd (a company registered in the People’s Republic of China) v OCV Intellectual Capital, LLC (a company registered in the United States of America)* 134 IPR 156

Opposition — Request for production of documents — Whether documents are likely to be of substantial relevance to matter — Request refused: *Sanofi v Amgen Inc* 134 IPR 150

Sufficiency — Patent for pharmaceutical compound and method to treat hepatitis C virus — Whether real and reasonably clear disclosure of claims — Common general knowledge — Fair basis — External fair basis — Internal fair basis — Utility — Novelty: *Idenix Pharmaceuticals LLC v Gilead Sciences Pty Ltd (ACN 072 611 708)* 134 IPR 1

Validity — Construction — Claim including numerical limits — Claim referring to prior art — Numerical ranges in claim and prior art overlapping — Claim setting out prior art as comparative example — Proper use of prior art in construction of claim: *Jushi Group Co Ltd (a company registered in the People’s Republic of China) v OCV Intellectual Capital, LLC (a company registered in the United States of America)* 134 IPR 156

PRACTICE AND PROCEDURE

Costs — Court’s discretion to award costs — apportionment of costs: *Singtel Optus Pty Ltd v Optum Inc (No 2)* 134 IPR 112

REMEDIES

Interlocutory injunction — Arguable prima facie case made out — Balance of convenience against grant of injunction — Damages an adequate remedy — Usual undertaking as to damages provided — Prejudice to new business — Application dismissed: *Carlisle Homes Pty Ltd (ACN 106 263 209) v Tick Homes Pty Ltd (620 818 180)* 134 IPR 118

TRADE MARKS

Non-use — Removal for non-use — Exercise of discretion regarding removal for non-use — Relevant date to assess: *Singtel Optus Pty Ltd v Optum Inc (No 2)* 134 IPR 112

Opposition — Distinctiveness — Acquired distinctiveness — Insufficient evidence: *Fresh Venture Group Pty Ltd v Box Corporate Food Services Pty Ltd* 134 IPR 142

Opposition — Distinctiveness — Inherently adapted to distinguish — Commonly used terms — Not inherently adapted: *Fresh Venture Group Pty Ltd v Box Corporate Food Services Pty Ltd* 134 IPR 142

Removal — Non-use — Application for removal — Registrar’s discretion to permit registration to stand despite non-use — Whether discretion should be exercised — Potential for confusion if trade mark removed: *Live Entertainment Investments III Pty Ltd v Education Group Pty Ltd* 134 IPR 131

Scope of services — Whether use established for broad or narrow scope: *Singtel Optus Pty Ltd v Optum Inc (No 2)* 134 IPR 112

WORDS AND PHRASES

“badge of origin”: *Fresh Venture Group Pty Ltd v Box Corporate Food Services Pty Ltd* 134 IPR 142

(Continues on p vi of cover)

INDEX — *continued*

WORDS AND PHRASES — *continued*

- “**balance of convenience**”: *Carlisle Homes Pty Ltd (ACN 106 263 209) v Tick Homes Pty Ltd (620 818 180)* 134 IPR 118
- “**causal connection**”: *Carlisle Homes Pty Ltd (ACN 106 263 209) v Tick Homes Pty Ltd (620 818 180)* 134 IPR 118
- “**comparative example**”: *Jushi Group Co Ltd (a company registered in the People’s Republic of China) v OCV Intellectual Capital, LLC (a company registered in the United States of America)* 134 IPR 156
- “**insufficient evidence**”: *Fresh Venture Group Pty Ltd v Box Corporate Food Services Pty Ltd* 134 IPR 142
- “**natural justice**”: *Sanofi v Amgen Inc* 134 IPR 150
- “**numerical limits**”: *Jushi Group Co Ltd (a company registered in the People’s Republic of China) v OCV Intellectual Capital, LLC (a company registered in the United States of America)* 134 IPR 156
- “**numerical range**”: *Jushi Group Co Ltd (a company registered in the People’s Republic of China) v OCV Intellectual Capital, LLC (a company registered in the United States of America)* 134 IPR 156
- “**objective similarity**”: *Carlisle Homes Pty Ltd (ACN 106 263 209) v Tick Homes Pty Ltd (620 818 180)* 134 IPR 118
- “**ordinary meaning of trade mark**”: *Fresh Venture Group Pty Ltd v Box Corporate Food Services Pty Ltd* 134 IPR 142
- “**production of documents**”: *Sanofi v Amgen Inc* 134 IPR 150
- “**serious contemplation**”: *Jushi Group Co Ltd (a company registered in the People’s Republic of China) v OCV Intellectual Capital, LLC (a company registered in the United States of America)* 134 IPR 156
- “**substantial relevance**”: *Sanofi v Amgen Inc* 134 IPR 150