

# EFFECTIVE, ORDERLY AND EXPEDITIOUS IP LITIGATION IN THE FEDERAL COURT OF AUSTRALIA

08 December 2016 | Australia

Legal Briefings - By **Sue Gilchrist** and **Anna Vandervliet**

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The Federal Court of Australia has recently issued a new Intellectual Property Practice Note which provides litigants and practitioners with an opportunity to improve the conduct of IP cases in the Court.

## THE NEW FEDERAL COURT PRACTICES NOTES

The new IP Practice Note (and other related Practice Notes) came into effect on 25 October 2016 as part of the implementation of the Court's new National Court Framework. The new Practice Notes apply to IP cases nationally across each registry of the Federal Court.<sup>1</sup> All previous practice and administrative notes have now been revoked.

## AN INTERNATIONALLY COMPETITIVE COURT

One of the fundamental drivers for refreshing the practice and procedure in the Court has been the Court's acknowledgement that although it is a national court, 'a significant amount of its work is international in character'.<sup>2</sup> To ensure the Court remains internationally competitive, the new Practice Notes reflect a commitment by the Court to not only delivering high quality judgments, but also ensuring that its procedures facilitate the expeditious and cost effective resolution of disputes.

The new Practice Notes aim to improve consistency across the court nationally, as well as simplify the practice and procedure in the Court generally to 'foster the effective, orderly and expeditious' discharge of proceedings.<sup>3</sup>

The approach adopted in the Practice Notes, particularly the IP Practice Note, is largely non-prescriptive. This reflects a conscious philosophical approach of the Court that it is primarily up to the parties, as the litigants, to co-operate and work together to ensure proceedings progress efficiently and cost effectively. This is in contrast to the approach taken in some other jurisdictions, where procedures for IP cases are less flexible.

Although the Practice Notes impose much of the burden on specialist IP practitioners and the parties, a key ingredient for the success of these reforms will be implementation by the Court, particularly in providing proactive judicial case management that supports and reflects the objectives of the Practice Notes.

## **INTELLECTUAL PROPERTY CASES**

IP cases make up a significant portion of the Court's work and the Court's judgments in this area are highly regarded in overseas jurisdictions. These cases also have a reputation for being a specialist area where disputes are particularly hard-fought. The new Practice Notes are intended to provide parties, practitioners and the Court with the tools to enable the quick, efficient and cost-effective resolution of IP disputes.

As well as the IP Practice Note the following newly-issued Practice Notes are likely to be most relevant to IP cases:

- *Central Practice Note: National Court Framework and Case Management'*, which sets out the fundamental principles concerning the new National Court Framework and applies generally to all proceedings;
- *Expert Evidence Practice Note; and*
- *Survey Evidence Practice Note.*

Consistent with the non-prescriptive approach, the IP Practice Note sets out guiding principles for conducting IP cases in the Court, but with an emphasis on flexibility. The key objectives of this note are to reduce costs and delays by:

- Reducing the number of issues in contest;
- The effective use of expert evidence;
- Ensuring there is no more factual investigation that justice requires; and

- Having as few interlocutory applications as necessary.

Importantly, aspects of case management which have been recognised strengths of the current Federal Court system have been retained, including the individual docket system and allocation of IP cases to specialist IP judges. In addition, the Expert Evidence Practice Note maintains the Court's emphasis on the role of expert witnesses as independent experts and reflects a continuing commitment to its pioneering practice of concurrent expert evidence ('hot tubs').

There are a number of other mechanisms enabled by the Practice Notes which parties to IP cases may find particularly useful, including:

- **Use of a concise pleading process:** (referred to as a 'Concise Statement', similar to the previous Fast Track regime): This may be more appropriate in urgent or less complex cases;
- **Setting a trial date early in the proceedings, with a hearing date as early as reasonably possible:** This is aimed at reducing interlocutory disputes, encouraging the early narrowing of issues and reducing the time taken from commencement to hearing;
- **Provision of a verified product or process description in lieu of discovery in patent infringement cases:** This may reduce discovery in appropriate cases;
- **Limiting orders for discovery** in copyright trade marks and passing off cases to that which is strictly necessary.

The new IP Practice Note (and related practice notes) provide a good opportunity for IP practitioners and clients to seek to utilise the approach advocated in the practice notes to streamline proceedings and achieve more efficient, cost effective and expeditious resolution of IP disputes.

## ENDNOTES

1. Copies of the new practice notes, including the IP Practice Note, can be downloaded [here](#).
2. See paragraph 2.1, Central Practice Note.

3. See paragraph 2.1, Central Practice Note.

## KEY CONTACTS

If you have any questions, or would like to know how this might affect your business, phone, or email these key contacts.



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