



FEDERAL COURT OF AUSTRALIA

Notice to Practitioners and Litigants issued by the Victorian District Registrar – Proceedings under the Patents Act 1990 (Cth)

This Notice sets out the usual procedures in relation to proceedings under the *Patents Act 1990* (Cth).

The aim of the procedures is to accelerate the identification of issues and generally to improve the facilitation of the trial process.

Upon filing in the District Registry, there will continue to be the random allocation of patent cases to individual judges assigned to the Patent Panel. The Judges are Middleton, (Convenor), Sundberg, Kenny and Jessup JJ.

New proceedings will be listed before a nominated Patents List Judge. Subsequent directions may be before the Patents List Judge depending upon the nature of the procedural dispute.

These procedures are deliberately not overly prescriptive, with an emphasis on flexibility of application to each proceeding.

However, by setting out what is expected of practitioners and litigants, the Court expects that, to the extent practicable, it will be informed of the matters required for giving the appropriate directions at the earliest possible stage in the proceedings.

The following are the general procedures which practitioners can expect will be adopted:

1. On the first return date, the parties should be in a position to explain the issues in the proceedings, including whether infringement is disputed.
2. After the filing of particulars of invalidity the party seeking revocation must explain how each ground of invalidity can be supported. The particulars of invalidity should include details of the passages of any prior publication relied upon for novelty purposes.

3. Before any directions are made for the filing of evidence, the Court will enquire (as appropriate):
 - (a) whether any expert evidence will be required
 - (b) whether a single expert is appropriate for all or any part of the evidence
 - (c) whether any of the evidence can be given orally or by reference to standard texts, or by a combination of summary outline and oral evidence
 - (d) whether a primer is appropriate
 - (e) as to the appropriate method of evidence (such as evidence of experts and prior meetings of experts to explain or narrow the issues in dispute).
4. Before discovery is ordered, the parties must confer to discuss the issues to be addressed by discovery and the nature of the documents sought, and whether evidence should precede discovery.
5. Unless there has been satisfactory narrowing of issues and resolution of procedural issues, the Court may refer the parties to a procedural mediation.
6. If appropriate, a case management conference will be arranged to resolve issues concerning discovery and any interlocutory steps.
7. Any special matters should be raised at the earliest possible occasion including, for instance, any intended application for amendment to the patent.

It is expected that at a time nominated by the Patents List Judge, the parties shall reduce to writing as relevant:

- amended pleadings containing only the matters in dispute
- issues in dispute with respect to each ground of claimed invalidity
- statement of non-controversial matters, such as publication dates and priority dates
- details of any outstanding pre-trial matters
- a list of the further actions to be taken by each party
- the issue or issues likely to be addressed by each [named] witness and expert
- the mechanism by which each witness will give his or her evidence
- details of any other case management issues, including likely interlocutory disputes
- details of any outstanding pre-trial matters
- details of any matters likely to attract cost orders
- the next appearance date
- the likely time required for the hearing.



Sia Lagos
District Registrar
Victorian Registry
2 September 2008