

Dear Ms. Collins,

Re: Federal Magistrates Court Service - IP Inclusion - Discussion Paper

It is observed that we have already responded to the first discussion paper on this topic and that the response to that is to issue a second discussion paper.

Intellectual Property is a specialised area of law and one that is often considered quite complex. Are there areas of IP law that are less complex and that could be easily identified as being suitable matters to be heard by a federal magistrate?

I imagine the discussions to date have already adequately identified these . The day to day matters in Patents, Trade Marks and Registered Designs concern infringement and validity, ownership of rights and confidentiality.

If so, what areas of IP law and what provisions could be considered suitable?

IP practitioners have pointed out already that the issues in a case are seldom complex to the initiated and there is no need to sift if the Magistrate works in conjunction with a qualified IP advisor. The solicitors choosing the forum will within the first year of operation know whether the Magistrates Court can give an adequate hearing to their case. It should be remembered that in overseas systems many applicants paid for an initial County Court hearing and proceeded to appeal.

Should workload and relative complexity be the overriding factors in determining what jurisdictions the Federal Magistrates service considers?

No, because the workload/complexity problem is soluble with the right approach.

Should adverse impacts on innovation and economic development be influencing factors?

Unrestrained copying leaves certain companies functioning as the unpaid design department to their industry.

Should intellectual property become a priority matter for the Federal Magistrates?

Yes, the Federal Court is prohibitively priced according to the solicitors who send cases there on our behalf.

Are there likely to be significant savings in time and cost of proceedings?

Only if the Magistrate has the nerve to restrict the Barristers to the skeletal issues agreed for this forum. If infringement is alleged, the Magistrate must expect to hear a counterclaim concerning validity.

What appeal structure would be appropriate?

Don't know.

Would it be feasible to appoint a Federal Magistrate with IP expertise?

I have practised in NSW, Victoria and Queensland and instructed Barristers in WA. Appointments are desirable in all these states.

What would be deemed a relevant level of IP expertise to enable a Federal Magistrate to hear certain IP matters?

It is not unusual for patent attorneys to have a technical degree, an LI B and experience in all fields of IP. Such a person would be a suitable candidate to appoint as a Federal Magistrate on his own, but finding someone who could give fair, just, certain and consistent rulings would not be easy. For this reason, I suggest that an existing Federal Magistrate be given the advisory services of a Patent Attorney who would function like an amicus curiae. The Magistrate would run the case in that he would decide on litigant standing, oversee cross examination and exert the authority in the conduct of the case that we are all familiar with, but the IP issues would be left to the amicus. Would a practising Magistrate accept such an arrangement? Why not ask one? In this way, the Court would only have to find the salary and expenses of the Attorney and the existing hierarchy which the legal profession regard as their own would be preserved.

Yours sincerely,

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