

29 November 2021

The Hon. Justice John Nicholas
Federal Court of Australia
Law Courts Building
Queens Square
Sydney NSW 2000

By email: justice.nicholas@fedcourt.gov.au

Copied to:
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Dear Justice Nicholas,

Comment on the scope of rules 10.07 and 10.08 of the *Federal Court Rules 2011* (Cth)

The Intellectual Property Committee of the Business Law Section of the Law Council of Australia (the **IPC**) is writing in relation to a possible shortcoming in the drafting of rr 10.07 and 10.08 of the *Federal Court Rules 2011* (Cth) (**FCR**), and makes suggestions for the possible reform of these rules.

Background to the issue

1. Rule 10.08 of the *FCR* provides:

10.08 Service in a proceeding under the *Trade Marks Act 1995*

In a proceeding brought against the owner of a registered trade mark (the **respondent**) in relation to a cause of action under the *Trade Marks Act 1995*, a document to be served on the respondent may be served:

- (a) if the respondent has an address for service under section 215 of the *Trade Marks Act 1995*, at that address for service;
- (b) by leaving the document with a person who is apparently an adult.

To similar effect, r 10.07 provides:

10.07 Service in a proceeding under the *Patents Act 1990*

In a proceeding brought against a patentee (the **respondent**) in relation to a cause of action under the *Patents Act 1990*, a document to be served on the respondent may be served:

- (a) if the respondent has an address for service under section 221 of the *Patents Act 1990*, at that address for service;
- (b) by leaving the document with a person who is apparently an adult.

2. The scope of r 10.08 was recently considered in *Freshfood Holdings Pte Ltd v Pablo Enterprise Pte Ltd* [2021] FCA 323; (2021) 157 IPR 492 (**Freshfood v Pablo**). In 2017, Singaporean-based Pablo Enterprise Pte Ltd (**Pablo**) applied to the Registrar of Trade Marks under s 92 of the *Trade Marks Act 1995* (Cth) (**TMA**) to have registered mark 170010, owned by Freshfood Holdings Pte Ltd (**Freshfood**), removed from the Register on the grounds of non-use. At that time, Pablo nominated an Australian address for service (namely, the Brisbane office of Pizzeys Patent and Trade Mark Attorneys Pty Ltd), pursuant to s 215 of the *TMA*. On 17 December 2020 a delegate of the Registrar decided, under s 101 of the *TMA*, that Freshfood's registered mark should be removed from the Register. Freshfood sought to appeal the Registrar's decision to the Federal Court under s 104 of the *TMA*. On 2 February 2021 Freshfood's solicitor served a copy of the notice of appeal on Pablo's Australian address for service. That day, a trade marks attorney from Pizzeys informed the solicitor for Freshfood that Pizzeys had not received instructions from Pablo to accept service of the notice of appeal.
3. Thawley J held that Freshfood's service of the notice of appeal on the office of Pizzeys did not constitute effective service. His Honour held that:
 - s 215(6) of the *TMA* did not assist Freshfood, since that subsection applies where the *TMA* provides that a document is to be served on or given or sent to a person, whereas service of a notice of an appeal to the Federal Court occurs under the *FCR* and not the *TMA* (at [23]); and
 - r 10.08 of the *FCR* did not assist Freshfood, since that rule only applies in a Federal Court proceeding brought *against* the owner of a registered trade mark in relation to a cause of action under the *TMA*, whereas in this case the Court proceeding was being brought *by* the registered owner against the party seeking the removal of the registered mark (at [25]).
4. In relation to the latter holding, his Honour stated at [25] that '[i]t may be that the terms of r 10.08 should be revisited and expanded'.
5. We agree with Thawley J that there are grounds for revisiting and expanding the scope of r 10.08 to deal with both the specific problem that arose in *Freshfood* and a closely related problem involving appeals from decisions of the Registrar of Trade Marks in opposition to registration proceedings. We also consider that there are grounds for revisiting and expanding the similar r 10.07, which deals with service in

proceedings against a patentee under the *Patents Act 1900* (Cth) (***Patents Act***), to deal with similar problems.

Justifications for expanding rr 10.08 and 10.07

6. Rule 10.08, as currently drafted, recognises that a registered trade mark owner will already have provided an Australian or New Zealand address for service, which will have been entered on the Register of Trade Marks under s 215(2) of the *TMA*. It makes good sense where a party seeking to bring a proceeding in the Federal Court against the registered owner in relation to an action under the *TMA* (for example, to have the registration cancelled under s 88, or in an appeal under s 104 where the Registrar decided under s 101 not to remove the mark from the Register) to allow a document to be served on the registered owner at that address for service. This is presently provided for under r 10.08.
7. What r 10.08 fails to address, however, is service of a document in an appeal to the Federal Court against the decision of the Registrar under the *TMA* where the respondent is a party other than 'the owner of a registered trade mark'. The respondent in such circumstances could be:
 - the party that applied for removal of a mark from the Registrar on the basis of 'non-use', where the Registrar decided under s 101 to remove the mark from the Register (this being the situation in *Freshfood*);
 - the opponent to the registration of a trade mark, where the Registrar decided under s 55 that one or more grounds of opposition was made out and that registration of the mark should be refused; or
 - an applicant for registration of a trade mark, where the application was opposed but where the Registrar decided under s 55 that no ground of opposition was made out and that the mark should be registered.

The apparent consequence is that the service of any appeal proceedings on a respondent in these circumstances must be effected in accordance with the ordinary rules of service, thereby leading to particular complexity where the respondent is based outside the jurisdiction.

8. In this regard, it is noted that an applicant for removal, an opponent to registration and an applicant for registration will all be required to provide an Australian or New Zealand address for service under s 215(2) of the *TMA* at the time for filing the application for removal, the notice of opposition to registration or the application for registration. More specifically:
 - (a) A party that wishes to have a registered mark removed from the Register on the grounds of non-use must apply to the Registrar under s 92 of the *TMA* by filing an application for removal. Under s 92(2), this application must be in accordance with the *Trade Marks Regulations 1995* (Cth) (***TMR***), and reg 9.5 requires such an application to be in 'an approved form'. The approved form of the removal application requires the applicant to provide an address for service in Australia or

New Zealand. This, in turn, becomes the 'address for service' for the purposes of s 215(1) (since it is an 'address for service of a person who has filed an application'). The Registrar must, within a month from the filing of the application for removal, give a copy of the application 'to each person who, in the Registrar's opinion, should receive one' (s 95(1) and reg 9.6), which will, in practice, include the registered owner. The Registrar is also obliged to advertise the application for removal in the Official Journal of Trade Marks (s 95(2)).

- (b) An opponent to the registration of a trade mark must file a notice of opposition (s 52(1)) which must consist of a notice of intention to oppose (reg 5.5(1)(a)) which must be in 'approved form' (reg 5.6(2)). The approved form of the notice of intention to oppose requires the opponent to provide an address for service in Australia or New Zealand. This, in turn, becomes the 'address for service' for the purposes of s 215(1) (since it is an 'address for service of a person who has filed [a] ... notice'). The Registrar must give a copy of this notice to the applicant for registration (reg 5.6(3)).
 - (c) An applicant for registration must make its application in 'approved form' (s 27(2)(a) and reg 4.1(1)(a)). The approved form of the notice of intention to oppose requires the applicant to provide an address for service in Australia or New Zealand. If a notice of opposition has been filed, the applicant must file a notice of intention to defend (s 52A) otherwise the application will lapse (s 54A). Although there is no requirement in the *TMR* that this notice be in 'approved form', IP Australia requires applicants to provide an Australian or New Zealand address for service, which then becomes the 'address for service' for the purposes of s 215(1). The Registrar is required to provide a copy of the notice to the opponent (reg 5.13(2)).
9. If the applicant for removal is successful before the Registrar, and an appeal is filed from this decision to the Federal Court under s 104, it would therefore seem entirely appropriate to allow the appellant to be able to serve the notice of appeal on the same address for service that was provided by the applicant for removal in the very action to which the appeal relates. In the same vein, where an appeal to the Federal Court is made under s 56 against the Registrar's decision in opposition proceedings, it would also be appropriate to allow the appellant to serve the notice of appeal on the same address for service that was provided by the respondent in the opposition proceedings.
10. Analogous situations might potentially arise under the Patents Act, which expose the same limitations of r 10.07 of the *FCR* as those outlined in relation to r 10.08.
11. In the situation that most closely resembles Freshfood in the patents context, under s 101M of the Patents Act a party may 'oppose an innovation patent that has been certified and seek the revocation of it' before the Commissioner of Patents. The Commissioner's decision as to whether or not to revoke the innovation patent can be appealed to the Federal Court under s 101N(7) by either the patentee or opponent. Where the appeal is by the opponent, r 10.07 applies, and a document may be served on the patentee at an address for service under s 221 (this being the Australian or

New Zealand address for service that the patentee was required to provide when it made its patent request in relation to a complete application for a standard or innovation patent (see s 29(4A)(a) and IP Australia's approved Patent Request form)). However, where the appeal under s 101N(7) is by the patentee, r 10.07 does not apply. This is so notwithstanding that the opponent will have provided an address for service in the proceedings before the Commissioner. To explain, an opponent needs to file 'a notice of opposition in the approved form' (*Patents Regulations 1991* (Cth), reg 5.6(1)(a)) and the approved form requires the applicant to provide an address for service in Australia or New Zealand. Under reg 5.6(3), the Commissioner of Patents must give copies of the documents required to be filed by the opponent to the 'applicant' as soon as practicable (in our view, 'applicant' should be read as the 'patentee', given that the innovation patent will have been certified). As with the position outlined in paras 8-10 above, it seems entirely appropriate to allow the patentee to be able to serve the notice of appeal on the same address for service that was provided by the opponent in the action before the Commissioner to which the appeal to the Federal Court relates.

12. Similar points can be made about the parties that wish to appeal the Commissioner's decision under s 60 to refuse or allow an application for the grant of a standard patent following opposition. These parties might be the unsuccessful opponent or the unsuccessful applicant for the standard patent. The opponent and applicant will have been required to have filed documents listing an Australian address for service (for opponents, see *Patents Regulations 1991* (Cth), reg 5.4(1) and IP Australia's approved Notice of Opposition form; for applicants, see *Patents Act*, s 29(4A) and IP Australia's approved Patent Request form). If either the opponent or applicant seeks to appeal the Commissioner's decision to the Federal Court under s 60(4), the appellant should be able to serve the notice of appeal on the respondent at the address for service that that party has already provided.

Suggested redrafting of rr 10.08 and 10.07

13. If expansions of rr 10.08 and 10.07 of the *FCR* were thought to be desirable to enable service at the address for service notified to IP Australia in the circumstances described above, the rules could be amended as follows.

14. Rule 10.08 could be amended so that it provides:

10.08 Service in a proceeding under the *Trade Marks Act 1995*

In a proceeding brought against the owner of a registered trade mark ~~(the **respondent**)~~ in relation to a cause of action under the *Trade Marks Act 1995*, or against a party in an appeal from a decision of the Registrar of Trade Marks under section 56 or section 104 of the *Trade Marks Act 1995* (in either case, the **respondent**), a document to be served on the respondent may be served:

- (a) if the respondent has an address for service under section 215 of the *Trade Marks Act 1995*, at that address for service;
- (b) by leaving the document with a person who is apparently an adult.

15. A more complex amendment to r 10.07 would be needed. This rule currently allows for service 'if the respondent has an address for service under section 221 of the Patents Act, at that address for service'. Section 221(1) states that '[w]here this Act provides for a document to be served on, or given or sent to, a person and the person has given the Commissioner an address in Australia or New Zealand for service of documents, the document may be served on, or given or sent to, the person by a prescribed means to that address'. The Patents Act does not provide for a document to be served on, or given or sent to, an opponent to an innovation patent under s 101N or an opponent to the grant of a standard patent under s 60, so any address for service provided by those opponent would not be 'an address for service under section 221' in r 10.07(a). It may be that an applicant for the grant of a patent, who is required to be notified of the acceptance of its patent request and complete specification under s 49(5), will have 'an address for service under section 221' in r 10.07(a). Therefore, r 10.07 may need to be amended as follows, by adding a new subrule:

10.07 Service in a proceeding under the *Patents Act 1990*

- (1) In a proceeding brought against a patentee (the **respondent**) in relation to a cause of action under the *Patents Act 1990*, a document to be served on the respondent may be served:
 - (a) if the respondent has an address for service under section 221 of the *Patents Act 1990*, at that address for service;
 - (b) by leaving the document with a person who is apparently an adult.

- (2) In an appeal brought against an applicant for the grant of a standard patent under subsection 60(4) of the *Patents Act 1990* (the **respondent**), a document to be served on the respondent may be served:
 - (a) if the respondent has an address for service under section 221 of the *Patents Act 1990*, at that address for service;
 - (a) by leaving the document with a person who is apparently an adult.

- (3) In an appeal brought against either an opponent to the grant of a standard patent under subsection 60(4) of the *Patents Act* or an opponent to an innovation patent under subsection 101N(7) of the *Patents Act* (in either case, the **respondent**), a document to be served on the respondent may be served:
 - (a) if the respondent provided an address for service at the time it filed its notice of opposition to the grant of the standard patent or to the innovation patent, at that address for service;
 - (b) by leaving the document with a person who is apparently an adult.

Conclusion and further contact

The Committee would be pleased to discuss any aspect of this submission.

Please contact the chair of the Committee Matthew Swinn on 0411 349 242 or at matthew.swinn@au.kwm.com, if you would like to do so.

Yours faithfully

A handwritten signature in black ink, appearing to read "Greg Rodgers". The signature is written in a cursive, flowing style.

Greg Rodgers
Chair, Business Law Section