



Friday, 25 October 2024

## Weekly Intellectual Property Law A Weekly Bulletin listing Decisions of Superior Courts of Australia covering Intellectual Property Law

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### Executive Summary (One Minute Read)

**Sandoz AG v Bayer Intellectual Property GmbH** (FCAFC) - appeal allowed against a decision upholding two patents regarding a therapeutic drug

**Nguyen v Northern Sydney Local Health District** (NSWSC) - expert report rejected for failing to comply with the requirements set out in *Makita (Australia) Pty Limited v Sprowles* (2001) 52 NSWLR 705 and *Dasreef Pty Ltd v Hawchar* (2011) 243 CLR 588

## HABEAS CANEM

### Habeus Halloween



## Summaries With Link (Five Minute Read)

### **Sandoz AG v Bayer Intellectual Property GmbH [2024] FCAFC 135**

Full Court of the Federal Court of Australia

Yates, Burley, & Downes JJ

Patents - Bayer was the patentee of two patents, being a method for the production of a solid, orally applicable pharmaceutical composition, and for the prevention and treatment of thromboembolic disorders - Bayer sold Pharmaceutical Benefits Scheme listed products comprising the drug that was the subject of the patents - Sandoz sought to revoke the patents on the grounds that the claimed inventions were obvious in the light of the common general knowledge together with an international patent, and certain abstracts published in the scientific literature - the primary judge upheld the patents - Sandoz appealed - held: the primary judge erred in finding that a person skilled in the relevant art could not be reasonably expected to have ascertained the international patent within the meaning of s7(3) of the *Patents Act 1990* (Cth) - "ascertained" in s7(3) simply means "discovered" or "found out" - s7(3) does not require proof that the hypothetical skilled person would ascertain the document, but only requires proof sufficient to demonstrate a reasonable expectation that the skilled person would do so - it is not necessary for evidence to be adduced that the skilled person would prefer, prioritise, or select the information in question over all other information which they could be reasonably expected to have - Sandoz had established on the balance of probabilities that the international patent could be reasonably expected to have been ascertained by the hypothetical skilled person - further, the inventions claimed in both patents were obvious in the light of the general common knowledge and the international patent - in the field of drug development, the need to carry out clinical trials and other tests in order to obtain relevant data can be regarded as routine work consistent with a finding of obviousness - it was implicit in the primary judge's finding that the person skilled in the art would directly be led, as a matter of course, to undertake drug development work regarding the drug in question in the expectation that it might well produce a useful alternative to, or a better drug than, existing compounds - appeal allowed.

[Sandoz AG](#)

[From Benchmark Friday, 25 October 2024]

### **Nguyen v Northern Sydney Local Health District [2024] NSWSC 1299**

Supreme Court of New South Wales

Parker J

Expert evidence - the plaintiff research scientist had been employed by NSW Health - he contributed to a scientific discovery regarding therapeutic uses of certain antibodies in the treatment of diseases affecting or involving the operation of the immune system - he contended that there was a 2008 agreement between the individuals who were responsible for the discovery and the Northern Sydney Local Health District (NSLHD), under which the four individuals were to share a one third interest in any intellectual property, with the plaintiff to receive a 55% share in that one-third - patents were granted in Australia; the European Union; the USA, and Canada - the plaintiff contended there was a 2012 commercialisation agreement

under which he transferred his share of the IP to NSLHD, which NSLHD had to reassign if it did not successfully commercialise the IP within three years - NSLHD did not successfully commercialise the IP, but did not reassign it, having assigned it to AIGD Biotech Pty Limited - the plaintiff sued NSLHD, AIGD, and the State of NSW, seeking damages for breach of contract - the plaintiff sought to lead evidence on damages from a business broker and valuer, addressing the value of the IP - the Court made a preliminary ruling under s192A of the *Evidence Act 1995* (NSW) as to this report's admissibility - held: as explained in *Makita (Australia) Pty Limited v Sprowles* (2001) 52 NSWLR 705 and *Dasreef Pty Ltd v Hawchar* (2011) 243 CLR 588, for an expert report to comply with the s79 exception from the opinion rule for expert evidence, ordinarily, it must explain how the field of 'specialised knowledge' in which the witness is expert by reason of 'training, study or experience', and, on which the opinion is 'wholly or substantially based' applies to the facts assumed or observed to produce the opinion stated - usually, and in the current case, the court only has the expert report to go on - the report assumed that, if a drug based on the IP were approved, it would generate US\$1 billion in sales, which was an assumption that the plaintiff had asked the expert to make - in submissions, the (now self-represented) plaintiff admitted he was the sole source of the US\$1 billion, but that he was also an expert and that his assessment of this figure was also expert evidence - the Court did not accept this - the report failed to comply with the *Makita* requirement for supporting reasons regarding the revenue that would have been derived, and also regarding several other integers of the expert's calculations - report ruled inadmissible.

[View Decision](#)

[From Benchmark Tuesday, 22 October 2024]

# Benchmark

## INTERNATIONAL LAW

### Executive Summary and (One Minute Read)

**In the Matter of McAleenon (UKSC)** - Supreme Court held that an individual had the right to compel judicial review of a government decision relating to landfill contamination even though a private right of action against the alleged polluter may have been available

### Summaries With Link (Five Minute Read)

#### **In the Matter of McAleenon [2024] UKSC 31**

Supreme Court of the United Kingdom

Lord Lloyd-Jones, Lord Briggs, Lord Sales, Lord Stephens, & Lady Simler

Noeleen McAleenon resided near a landfill that was operated by a private firm. Ms McAleenon maintained that the Lisburn and Castlereagh Council had regulatory authority concerning nuisances like the landfill. She sought judicial review of how the Council had dealt with complaints about the landfill. The government argued that she could not seek judicial review of the Council's actions because she had available to her a private right of action against the alleged polluter. The Court of Appeal sustained this objection and held that there were suitable alternative remedies available to Ms McAleenon and that judicial review was not available to her. The Supreme Court reversed and found that the existence of a private claim in nuisance against the alleged polluter did not constitute a suitable alternative remedy to judicial review of the Council's conduct. The Court stated that the fact that different proceedings could have been brought against another party did not mean that there existed a suitable alternative so as to preclude judicial review. The Court further stated that it is not the courts' role to say that a claimant should have sued someone other than the branch of government whose actions were being questioned.

[In the Matter of McAleenon](#)

# Benchmark

## Poem for Friday

### Life

By Charlotte Brontë (1816-1855)

LIFE, believe, is not a dream  
So dark as sages say;  
Oft a little morning rain  
Foretells a pleasant day.  
Sometimes there are clouds of gloom,  
But these are transient all;  
If the shower will make the roses bloom,  
O why lament its fall ?

Rapidly, merrily,  
Life's sunny hours flit by,  
Gratefully, cheerily,  
Enjoy them as they fly !

What though Death at times steps in  
And calls our Best away ?  
What though sorrow seems to win,  
O'er hope, a heavy sway ?  
Yet hope again elastic springs,  
Unconquered, though she fell;  
Still buoyant are her golden wings,  
Still strong to bear us well.  
Manfully, fearlessly,  
The day of trial bear,  
For gloriously, victoriously,  
Can courage quell despair !

**Charlotte Brontë** was born on 21 April 1816, in West Yorkshire, UK. She was an English poet and novelist. She was the eldest of the three Brontë sisters. Her siblings were Emily Brontë, Anne Brontë, Branwell Brontë, Elizabeth Brontë, and Maria Brontë. She had a year of formal education at Clergy Daughters' School at Cowan Bridge. Thereafter she and her siblings learned at home, from each other and their parents, and aunt Elizabeth Branwell who lived with the family. She is famous for her novel *Jane Eyre*, which she first published under the pseudonym Currer Bell in 1847. She was married to Arthur Bell Nicholls from 1854 to 1855, for the last 9 months of her life. Nicholls had been the curate



to Charlotte's father, Patrick Brontë, an Anglican clergyman. Charlotte Brontë died on 31 March 1855 in Haworth, England.

Reading by **Patricia Conolly**. With seven decades experience as a professional actress in three continents, Patricia Conolly has credits from most of the western world's leading theatrical centres. She has worked extensively in her native Australia, in London's West End, at The Royal Shakespeare Company, on Broadway, off Broadway, and widely in the USA and Canada. Her professional life includes noted productions with some of the greatest names in English speaking theatre, a partial list would include: Sir Peter Hall, Peter Brook, Sir Laurence Olivier, Dame Maggie Smith, Rex Harrison, Dame Judi Dench, Tennessee Williams, Lauren Bacall, Rosemary Harris, Tony Randall, Marthe Keller, Wal Cherry, Alan Seymour, and Michael Blakemore.

She has played some 16 Shakespearean leading roles, including both Merry Wives, both Viola and Olivia, Regan (with Sir Peter Ustinov as Lear), and The Fool (with Hal Holbrook as Lear), a partial list of other classical work includes: various works of Moliere, Sheridan, Congreve, Farquar, Ibsen, and Shaw, as well as roles such as, Jocasta in Oedipus, The Princess of France in Love's Labour's Lost, and Yelena in Uncle Vanya (directed by Sir Tyrone Guthrie), not to mention three Blanche du Bois and one Stella in A Streetcar Named Desire.

Patricia has also made a significant contribution as a guest speaker, teacher and director, she has taught at The Julliard School of the Arts, Boston University, Florida Atlantic University, The North Carolina School of the Arts, University of Southern California, University of San Diego, and been a guest speaker at NIDA, and the Delaware MFA program.

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