

COMMONWEALTH OF AUSTRALIA
[Patents Act 1990]

IN THE MATTER of **M & L SCOTT**
Australian Patent Application No.
2006 246325 in the name of
Laurence Clifford Scott entitled "AIR
DUCT"

and

Opposition thereto by **Icon Plastics
Pty Ltd**

OUTLINE OF SUBMISSIONS ON BEHALF OF THE PATENT APPLICANT
IN RELATION TO THE OPPOSITION HEARING AS SCHEDULED TO BE
HEARD IN CANBERRA ON WEDNESDAY, 10 AUGUST 2011

General

1. The within submissions are directed to, and relied upon in support of the Opposition to the Application in suit, Australian Patent Application No. 2006 246325 in the name of Laurence Clifford Scott entitled "Air Duct", as brought under section 59 of the *Patents Act 1990 (Cth)* (**Patents Act**), being dismissed on the basis that the onus of Icon Plastics Pty Ltd (**Icon**), in its capacity as Opponent to the Patent Application in suit, establishing the grounds relied upon, and each of them, has not been made out, either on the evidence or as a matter of the application of legal principle.

Grounds and Particulars of Opposition

2. The Opponent, by reference to its Statement of Grounds of Opposition dated 19 April 2010 (**SGO**), relies on grounds and particulars of opposition as follows, as expressed in summary form only, namely:

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- (a) section 59(a)(i) and (ii) – lack of entitlement to grant of patent;¹
- (b) section 59(b) – not a patentable invention as noncompliant with subsection 18(1)(a) (manner of manufacture), 18(1)(b)(i) (lack of novelty) and/or 18(1)(b)(ii) (lack of inventive step);² and
- (c) section 59(c) – specification not comply with section 40(3) of the *Patents Act* – lack of fair basing, claims not clear or succinct.³

3. For the reasons referred to below in the within submissions, and as a matter of a summary of the contentions of the Patent Applicant, the grounds relied upon in the SGO, are not supported by the evidence to the requisite standard, or at all, and the Opposition should be dismissed accordingly.

Preliminary Matters

4. During the course of the examination, amendments were proposed, pursuant to section 104 of the *Patents Act*, to Claims 5, 6, 13 and 14. The Claims, in amended form, are set out in Annexure “A” to the within submissions.
5. Formal leave to amend the complete specification is, accordingly, sought, on the basis that the proposed amendments meet the requirements, including claims to finding the inventions, are clear and fairly based.⁴
6. As referred to below, leave is sought to rely on a further declaration by John Gerard Weir made 8 August 2011, by reason of certain minor matters needing to be corrected and clarified, and leave is sought accordingly under Regulation 5.10. This matter is dealt with in further detail in paragraphs 9 to 18 below.

¹ Item 1 under Grounds of SGO

² Item 3 under Grounds of SGO

³ Item 2 under Grounds of SGO

⁴ for power of the Commissioner to allow amendments to remove grounds of objection in the course of an examination: see section 104(1)(a) and (b) for limitations on amendments, refer Lahore, *Patents, Trade Marks & Related Rights*, Butterworths Service, at [15,360] *Powers to amend* also refer *Expo-Net Danmark A/s v Buono-Net Australia Pty Ltd* (2010) 88 IPR 1 at [7]-[9], [15]-[22] and [23]-[33] per Bennett J

7. The within submissions have been prepared without any submissions in support of the Opposition having been made available. The position of the Patent Applicant is, accordingly, and necessarily, reserved in that regard.

Evidence

8. The evidence in the Opposition comprises the following, namely:

Evidence in Support

- (a) statutory declaration of Royston Douglas Bull declared 8 July 2010, including exhibits RDB-1 to RDB-12 (**Bull Declaration**);
- (b) statutory declaration of Terrance William Green declared 14 October 2010, including exhibit TWG-1 (**Green Declaration**);

Evidence in Answer

- (c) first statutory declaration of John Gerard Weir declared 17 March 2011, together with exhibits JGW-1 to JGW-18 (**First Weir Declaration**);
- (d) second statutory declaration of John Gerard Weir declared 17 March 2011, together with exhibits JGW-19 to JGW-22 (**Second Weir Declaration**);
- (e) statutory declaration of Gregory Wayne Scott declared 18 March 2011 (**Gregory Scott Declaration**);
- (f) statutory declaration of Martyn Laurence Scott declared 18 March 2011 (**Martyn Scott Declaration**);
- (g) third statutory declaration of John Gerard Weir declared 8 August 2011, together with exhibits JGW-23 and JGW-24 (**Third Weir Declaration**);
and

Evidence in Reply

- (h) no evidence in reply has been filed.

Leave – Third Weir Declaration

9. For the reasons stated by John Gerard Weir in the Third Weir Declaration, which explains that on review of the First and Second Weir Declarations, the matter of some details as to dates has been drawn to his attention, and he has clarified this aspect of his declaration for completeness sake.

10. Mr Weir has also been provided with a statement of the claims of the subject Patent Application in suit, which is the subject of amendments to Claims 5, 6, 13 and 14, as referred to in paragraphs 7 to 11 of the Second Weir Declaration.
11. Mr Weir has, accordingly, identified the proposed amendments in a combined form, where such amendments appear as redlined into the original form of the subject Claims 5, 6, 13 and 14, respectively. This is a matter which has been referred to by Mr Weir for the purpose of clarity.
12. Mr Weir has also, again for the purposes of certainty, identified and annexed to the Third Weir Declaration, a true copy of the Patent Application, which he refers to as having been provided to him, and which he has read and understood same, that aspect being confirmed in subparagraph 6(a) at page 3 of the Second Weir Declaration.
13. Having regard to the above matters, it is respectfully requested that leave be granted to the Patent Applicant in relation to the Opposition hearing, to refer to and rely upon the Third Weir Declaration.
14. It is submitted that it is *appropriate in the circumstances* to do so, because of there being no further issues of fact, nothing of contention raised, and with the benefit of certainty, each of which matters are consistent with the duty of the Commissioner in relation to ensuring the public interest is appropriately served, is duly satisfied.
15. The Commissioner has a broad discretion and power as conferred by Regulation 5.10(1) and (2), subject to Regulation 5.10(5), to so grant the extension of time to serve the evidence in the Third Weir Declaration.
16. If the matter is regarded as further evidence, the Commissioner similarly has a discretion to admit same on the application of the Patent Applicant in the present case, pursuant to Regulations 5.10(4) and (5).

17. As referred to above, the Third Weir Declaration does not introduce any new evidence as such, rather it is material already referred to and intended to assist in determining the Opposition proceedings.
18. It is also noted that the Commissioner may have regard to the further material in any event.⁵

Invention

19. The Application, the priority date of which is 11 May 2005 (**Priority Date**),⁶ is for a combination patent involving features which are so placed together that by their working inter-relation a claim is made for a new or improved result. The mere fact that each component or integer is previously known is no bar to a combination patent, providing that the combination claimed to achieve the new or improved result involves the requisite exercise of inventive faculty.⁷
20. By way of a brief description of the invention, which had been amended such as to be in the form described in claims 1 to 14 as set out in the schedule to the within submissions and marked "A", reference should be had to the following parts of the specification and comments, as set out below.
21. The principal difficulty addressed by the invention, which concerns:
 - (a) product claims direct to blow moulded products,⁸ and
 - (b) methods for making the same,⁹
 has its genesis in multi-storey dwellings, such as apartment blocks, and some designs of commercial buildings, are not constructed such that exhaust air can be vented into the roof space.
22. Rather, the practical difficulty encountered in the field of art concerned with provision of air ducting designed to convey air into different sections of a

⁵ see, for example, *Flexible Steel Lacing Co v Beltreco Ltd* (2000) 48 IPR 345 at 350-355 per delegate R Osborne

Cadbury Schweppes Plc v Effem Foods Pty Ltd [2002] APO 38 at [7]-[10] per delegate LR Tristram Lahore (supra) at [10,125] Further evidence

⁶ page 2 lines 9-11

⁷ *Palmer v Dunlop Perdirau Rubber Co* (1937) 59 CLR 30 at 61-62, and at 73 per Dixon J (as he then was) *Breville Pty Ltd v Sunbeam Corporation Ltd* (2010) 90 IPR 569 at [74], [92], [93] per delegate SK Aggarwal

⁸ refer Claims 1 to 12 and 16, and also refer to Claim 13 for omnibus claim

⁹ refer Claims 14 and 15

building, is that the prior art involved ducting having to be positioned across and above ceilings to reach wall vents.

23. An example of this are range hoods and bathroom air extractors, which cause air to be emitted through ducts installed between floors, or if that is not available, to an escape point positioned through a wall.
24. The cost and degree of difficulty associated with interfering with structure of an existing building in this manner was a significant disadvantage, and occasioning increased cost and general difficulty in achieving a passage of air in a desired direction to a particular location, both for removal of air, such as extractors are used for, and as in air-conditioning, where air is delivered from the external aspect of the building to an internal outlet.
25. The use of metal ducting is associated with significant acoustic issues, which are not desirable. Increased condensation is also associated with high thermal conductivity of metal.

Summary of the Invention - Specification

26. As the summary of the invention provides for in the Patent Application, through the specification, the apparatus aspect of the invention *provides a moulded air duct of elongated section capable of installation in wall or ceiling space and containing an effective quantity of flame retardant.*¹⁰
27. A ducting system using the components described in the specification permits installation of a cooling distribution circuit in the ceiling, with wall supplied outlets, just above floor level. In addition, under floor heating distribution circuit with wall supplied outlets are able to be accommodated, at any desired height.
28. The ability to position ducts up and down walls and across ceilings within an existing structure, thereby permitting cooling, heating and ventilation, is a significant step comprising an advance over the prior art as it existed at the priority date of 11 May 2005.¹¹

¹⁰ page 2 lines 9-11

¹¹ the Patent Application in suit, involves a national phase entry of PCT/AU2006/00776, claiming priority

Construction

29. The rules of claim construction are well established. In ***Welsh Perrin & Company Pty Ltd v Worrel*** (1961) 106 CLR 588 at 610, Dixon CJ, Kitto and Windeyer JJ identified the following principles, namely:

- (a) a specification is not to be read in the abstract;
- (b) it is to be construed in the light of the common general knowledge in the art before the priority date;¹²
- (c) in construing claims in a specification a Court is not construing a written instrument operating *inter partes*, rather it is a public instrument the validity of which depends on the instrument defining the monopoly in a way not reasonably capable of being misunderstood;¹³
- (d) a specification is made up of several parts and those parts have different functions. It is not legitimate to narrow or expand the boundaries of a monopoly as fixed by the words of a claim by reference to other parts of the specification;¹⁴
- (e) similarly, where the words of a claim are clear they are not to be made obscure by reference to statements in other parts of the specification. Further, where terms in a claim are unclear, those terms may be defined or clarified by reference to the body of the specification;¹⁵ and
- (f) the construction of claims in a specification is a matter of law and as such is to be determined by the Court. The Court may however be assisted by evidence which puts it in the position of a reader skilled in the relevant art as at the relevant date.¹⁶

Skilled Addressee

30. The hypothetical addressee of the patent specification is a person skilled in the art as at the priority date. That person is a non-inventive person, and the evidence may assist the Court on the meaning to be given to technical terms

¹² *Kimberley-Clark Australia Pty Ltd v Arico Trading International Pty Ltd* (2001) 50 IPR 513 at [24]

¹³ *Kimberley-Clark* (supra) at [34]

Aspirating IP Ltd v Vision Systems Ltd (2010) 88 IPR 52 at [107]-[111] per Besanko J

¹⁴ *Aspirating IP v Vision Systems* (supra) at [107]

¹⁵ *Kimberley-Clark* (supra) at [15]

Aspirating IP v Vision Systems (supra) at [108]

¹⁶ *General Tire and Rubber Company v Firestone Tyre and Rubber Co Ltd* (1971) 1A IPR 121 at 138

Kinabalu Investments Pty Ltd v Barron & Rawson Pty Ltd [2008] FCAFC 178 at [45]

or terms of art, and also the way in which the specification would be read by a person skilled in the art as at the priority date. The level of skill of such a person may vary.¹⁷

31. In the present case, the skilled worker is a person who has knowledge of the design, construction or use of air ducting systems, and the materials of which they are comprised, as well as the nature of buildings and other structures into which the air ducting product, and the method of application of same, as reflected by the claims of the specification in suit, are directed. Mr Weir is a relevantly skilled addressee in the field of art as at the priority date of the Patent Application, that being 11 May 2005.

Method

32. The specification provides, relevantly:

*The method aspect of this invention provides a method of making a duct of elongated section by blow moulding a parison to form a duct which is closed at both ends with a joint site at one end and at least one other joint site intermediate the ends and removing both ends to create a male join at one end and a female join at the other end.*¹⁸

and:

*The method may include the step of connecting the internal faces of the duct with a tubular support in the central area of the duct.*¹⁹

33. As referred to above, the method claims comprise Claims 14 and 15.

Drawings

34. The various embodiments of the claimed invention are described by reference to the accompanying drawings, being:
- (a) Figure 1 – plan of a piece of duct;
 - (b) Figure 2 – end view of the duct of Figure 1;
 - (c) Figure 3 – a 45 degree corner component in the same plane;
 - (d) Figure 4 – a perspective of a 90 degree corner in different plane;
 - (e) Figure 5 – a perspective of an adaptor;

¹⁷ *Jupiters Ltd v Neurizon Pty Ltd* (2005) 65 IPR 86 at [154]

¹⁸ specification at page 3, lines 15-20

¹⁹ *ibid* at lines 21-22

- (f) Figure 6 – side view of a moulding before conversion to a duct;
- (g) Figure 7 – perspective of a specialised air duct containing a butterfly valve;
- (h) Figure 8 – section through part of a two storey building with in-wall ducting;
- (i) Figure 9 – section through part of a single storey building with ducting in the roof space;
- (j) Figure 10 – section through part of a multi-storey apartment building with an air duct in the suspended ceiling space; and
- (k) Figure 11 – a plan of a department with air ducts exhausting the outside air through the ceiling space.

Description with respect to the Drawings

35. The specification describes in detail the invention, by reference to the Drawings, at pages 4-6 of the specification, and reference should be had regard thereto.

Comprising

36. The term “comprising”, as used throughout the specification, is interpreted in its inclusive form, so as not to exclude the addition of other elements.²⁰

Onus

37. The Opponent, Icon, carries the onus of establishing the Opposition.²¹

Test – Refusal of Acceptance of an Application

38. It is well settled that the Commissioner ought not to refuse acceptance of an application and specification, unless it appears *practically certain* that Letters Patent granted on the subject specification, would be held invalid by a Court.²²

²⁰ specification at page 6, lines 26-29

²¹ *Stamp v WJ Powell Pty Ltd* (1918) 24 CLR 339 at 343 per Barton J, with whom Gavan, Duffy and Rich JJ agreed

²² *Commissioner of Patents v Microcell Ltd* (1959) 102 CLR 232 at 244-245
F Hoffman-La Roche AG v New England Biolabs Inc (2000) 50 IPR 305 at [48]-[53] per Emmett J

Balance of Probabilities

39. The primary facts are to be established on the balance of probabilities. The ultimate facts, being those leading directly to a conclusion of any of the grounds of invalidity as relied upon in the SGO, must be proved to the level of practical certainty.
40. In *Austal Ships*, Bennett J said:²³

12. *I can accept that a lower standard may apply to proof of evidence such as whether a document has been published or, indeed, whether a prior art vessel was well-known. I do not accept that it properly applies to the factual question that itself is the test for obviousness or lack of inventive step. Where the factual question is itself the legal test, as set out in s7(3) of the Act, it seems to me that it should be determined at the higher standard. That means that where there are two opposing expert views that are conclusive on obviousness, both present a bona fide by witnesses of accepted expertise, unless one set of views can be rejected on proper grounds, the legal burden to establish a ground of opposition is not discharged; the Court cannot be practically certain that obviousness or lack of inventive step is established.*

Evidence Act

41. Allowing for the Commissioner not to be bound by the technical rules of evidence, it is nonetheless relevant to have regard to the evidentiary issues as catered for by:
- (a) section 76 of the *Evidence Act 1995 (Cth)* (**Evidence Act**), which provides that evidence of an opinion is not admissible to prove the existence of a fact about the existence of which the opinion is expressed; and
 - (b) section 135, which enables the Court to refuse to admit evidence where probative value outweighed by risk of the evidence being misleading, confusing and involve undue waste of time, such that it may be preferable for the Court to exclude it.
42. The “opinion rule” is qualified by section 79, such that the opinion rule does not apply to the opinion evidence of a person where:
- (a) the person has specialised knowledge that is based on the person’s training, study or experience; and

²³ at [12]

(b) the opinion is wholly or substantially based on that specialised knowledge.

43. Further, under section 80 of the *Evidence Act*, evidence of an opinion is not inadmissible only because it is about a fact in issue or an ultimate issue. Accordingly, where evidence of an opinion is otherwise admissible, that opinion may extend to and include addressing a fact in issue, or an ultimate issue.
44. Questions of obviousness and inventive step involve questions of law, or questions of mixed fact and law. Evidence as to whether a claimed invention was obvious or did not involve an inventive step, as well as having regard to the prior art and expressing an opinion as to whether the invention as claimed has been anticipated, will, of necessity, involve an opinion which may be argumentative.
45. Section 135 of the *Evidence Act* provides power for the Court to refuse to admit evidence if its probative value is substantially outweighed by the danger that the evidence might be misleading or confusing, or cause or result in an undue waste of time. Where such evidence is strictly admissible, but is unlikely to be helpful, the Court may find it preferable to exclude it.²⁴
46. The issue of the evidentiary matters concerned with the Bull Declaration and Green Declaration, and the Schedule of Objections concerning same, are dealt with in paragraphs 79 to 81 below, and in the Schedule marked "B".

Evidence - Entitlement

47. The onus of proof is of particular significance where evidence is relied upon, such as in the Bull Declaration and Green Declaration, respectively, to support the claim to entitlement, as made in the present case.
48. Both the need for a strict approach to the evidence, such as the concern which arises where there is no independent corroboration, as well as the shifting

²⁴ see, for example of application of these principles, in *Minnesota Mining & Manufacturing Co v Tyco Electronics Pty Ltd* (2002) 56 IPR 248 at [48]-[50] per Full Federal Court

evidentiary standard of evidence, is a matter of particular significance in the present case. These aspects are also dealt with further below.²⁵

First Weir Declaration

49. The First Weir Declaration is relied upon as evidence of an independent skilled addressee in the relevant field of art as at the priority date, with insight being provided as to the materials available in the art consistent with common general knowledge in Australia before the priority date.
50. The First Weir Declaration was prepared without the specification in suit being provided to Mr Weir. The Second Weir Declaration, as referred to below, deals with the further stage of Mr Weir's evidence, concerning the substantive issues raised in the Opposition as to the various grounds relied upon by the Opponent.
51. The evidence of Mr Weir is in accordance with accepted practice, and is of assistance to the consideration of evidence because of his being an independent expert having specialised knowledge based on his training, study or experience, such as to qualify under section 79 of the *Evidence Act*.²⁶

Second Weir Declaration

52. The Second Weir Declaration deals in detail with the substance of the invention, and does so by reference to the various items of prior art as relied upon by the Opponent in support of the claimed lack of novelty under section 18(a)(b)(1):
- (a) US Patent Specification No. 5542223 (**Inda Patent**);²⁷ and
 - (b) Japanese Patent No. 2001-239571 (**Japanese Patent**).²⁸

²⁵ *Wake v Soniclean Pty Ltd* (2010) 88 IPR 186 at [41], [42] and [43] per delegate OL Haggar
Lee v Komipharm International Co Ltd (2010) 88 IPR 410 at [13], [15], [16] and [17] per delegate
 SD Barker

²⁶ *c/f VIP Plastic Packaging Pty Ltd v B.M.W. Plastics Pty Ltd* [2011] FCA 660 per Kenny J (10 June 2011)
 where the expert witness in that case was not in the class of a skilled addressee, so that the evidence was
 largely irrelevant and therefore inadmissible, and where admissible, little weight accorded

²⁷ refer, for copy of Inda Patent, at Exhibit RDB-10 to the Bull Declaration

²⁸ although the version of the Japanese Patent appears as part of RDB-10, there is no English translation of
 same

Gregory Wayne Scott

53. The declaration of Gregory Wayne Scott made 18 March 2011, is provided in his capacity as the named inventor of the proposed application. Mr Scott has read the statutory declaration of Mr Bull, as well as that made by Mr Green, respectively.
54. The issue addressed by Mr Scott concerns the background to his attending the subject meeting at the offices of Icon Plastics, as referred to in paragraph 9 of the Bull Declaration.
55. Mr Scott deals, in particular, with regard to the contents of paragraphs 11 and 12 of the Bull Declaration, which refers to certain matters alleged to have occurred during the meeting as held in or about February or March 2005, and which Mr Scott attended in company with his brother, Martyn Laurence Scott.²⁹
56. The evidence of Gregory Scott clarifies the very limited nature of the matters discussed at the meeting, and are relied upon in support of the claimed invention having been designed, in terms of the substantive features of the product, which was already in *an advanced concept form, when Martyn and I attended at that meeting.*³⁰

Martyn Laurence Scott

57. Martyn Laurence Scott provides evidence in his position as General Manager of M & L Scott Pty Ltd (**Company**), which company is licensed to exploit the invention the subject of the Patent Application.
58. Martyn Scott has also read the Bull Declaration and Green Declaration, and provides evidence which explains the background to the Company, which concerns the tendering for the supply and installation of air duct networks in commercial and other buildings in and around the city of Melbourne.³¹

²⁹ declaration of Martyn Laurence Scott made 18 March 2011

³⁰ declaration at para 23

³¹ declaration at para 5

59. The explanation provided by Martyn Scott discloses a clear objective in relation to the meeting at Icon, namely to ascertain whether Icon was a manufacturer which would enable the Company's prototype design to be put into practical production *including, in particular, ensuring that the central support structure could be incorporated.*³²
60. Martyn Scott also explains the timing for achieving manufacture of the prototype product was critical to the Company, because of existing market opportunity and a desire in the Company to exploit it *as soon as possible.*³³
61. Significantly, Martyn Scott produced at the meeting in February 2005 at Icon, *an example of air ducting and did so for the purpose of endeavouring to explain the manufacturing objective of the Company and sought general advice as to an appropriate manufacturing process.*³⁴
62. In contrast to the Bull Declaration, which seeks to elevate the involvement of Icon to that of the actual inventor of the very product and method as reflected in Claims 1 to 16 of the Patent Application, when regard is had to the evidence of:
- (a) Gregory Wayne Scott; and
 - (b) Martyn Laurence Scott,
- an entirely different picture emerges which is directly inconsistent with the contention of Icon being responsible for the inventive concept.³⁵

Weir Declarations

63. The evidence of Gregory Scott and Martyn Scott, respectively, is also supported by the prior art background evidence reflected in the First Weir Declaration, and also in the Second Weir Declaration, by reason of the

³² declaration at para 14

³³ declaration at paras 16-17

³⁴ declaration at para 19

³⁵ *Lee v Komipharm* (supra) at [13], [15], [16] and [17] per delegate SD Barker
Wake v Soniclean (supra) at [41], [42], [43] and [67] per delegate OL Hagggar

contentions as to the prior art as contended for by Mr Bull as being directly inconsistent in virtually all material respects.

64. The absence of independent corroboration of the Bull Declaration and Green Declaration raises a serious concern as to such evidence being relied upon, particularly when close regard is had to the content of the Bull Declaration and Green Declaration, respectively, considered in light of the objections as reflected in Schedule “B” to the within submissions.

Bull and Green Declarations

65. The evidence of Bull and Green is of a nature which should be given little or no weight, by reason of the objections which are made in Schedule “B”. This contention, on behalf of the Patent Applicant, is made with due awareness that the Commissioner is not bound by the technical rules of evidence, but, at the same time, will have regard to the need for such evidence as is received and relied upon in support of a determination of the Opposition, needing to meet the basic standard of being rational and probative.³⁶
66. The issue of the weight to be given to the evidence of Messrs Bull and Green is also to be considered by reference to the onus carried by the Opponent in the present case, to make good the grounds of Opposition. For the reasons referred to in the within submissions, and having regard to the evidence of Gregory Scott, Martyn Scott, and in the First and Second Weir Declarations,³⁷ is to be preferred.³⁸

Onus – Standard of Proof – Evidence and Procedure

67. The onus of meeting the requisite standard of proof, being the civil standard – the balance of probabilities,³⁹ rest on Icon as the Opponent.
68. Regulation 22.12(1) permits written evidence in the form of a declaration to be relied upon. The Commissioner of Patents, dealing with an Opposition,

³⁶ *VIP v B.M.W.* (supra) at [56]-[62], [80]-[81] per Kenny J

³⁷ see also the Third Weir Declaration for correction of inadvertent minor omissions and clarification

³⁸ *VIP v B.M.W.* (supra) at [80]-[81] per Kenny J

³⁹ see Australian Patent Office Manual of Practice and Procedures, Vol 2, at para 2.13.5.2.2

relevantly under section 59, does so as a tribunal, through a delegate of the Commissioner.

69. The strict rules of evidence are not followed in hearings. Accordingly, hearsay evidence is admissible,⁴⁰ but must be given appropriate weight:
- ***Optech International Ltd v Buxton Hicrarium Ltd*** (1993) 28 IPR 649 at 654-655, 656-657, per delegate D Herald
 - ***McKay v Shirlow Pty Ltd*** (1985) 7 IPR 135 at 139 lines 7-24, and at 140 lines 10-25, per delegate JL Roveta
70. The Applicant, Icon, has the burden of placing before the Commissioner, by way of a frank, comprehensive and clear disclosure of all the relevant facts, matters and circumstances. This is of particular significance where there is a claim as to entitlement, with conflicting views being expressed by the parties, such as to what occurred as at a particular stage of dealings between them.
71. Although the Commissioner is not bound by the rules of evidence, such evidence which lacks probative value should be rejected. In this regard, the role of the Commissioner, which is to be equated with that of an Administrative Tribunal,⁴¹ whilst affording procedural fairness to the parties, is subject to the requirements that all evidence accepted by and upon which the Commissioner is entitled to act, must be logically probative.
72. In ***Pochi v Minister for Immigration and Ethnic Affairs*** (1979) 26 ALR 247 at 256, lines 16-21, Brennan J (as he then was), speaking as President of the Administrative Appeals Tribunal, relevantly observed:

*The Tribunal and the Minister are equally free to disregard formal rules of evidence in receiving material on which the facts are to be found, but each must bear in mind that this assurance of desirable flexible procedure does not go so far as to justify orders without a basis in evidence having rational probative force.*⁴²

73. Accordingly, the weight to be given to evidence presented by the parties to the proceedings, whilst a matter for the Hearing Officer, nonetheless will take specific notice of factors such as:

⁴⁰ Regulation 22.12

⁴¹ Bodkin C, ***Patent Law in Australia***, Law Book Co, 2008 at [17020] Conduct of hearings – [17030] Lahore (supra) at [10,010] Evidence

⁴² ***Bodkin*** (supra) at [17030]

- (a) the relationship of the witness to the party presenting evidence;
- (b) evidence from independent witnesses is generally afforded more significant weight than that from witnesses with some association with the party concerned; and
- (c) uncorroborated evidence concerning the nature and extent of prior oral disclosure, unless presented by persons who are independent of the Opponent, is generally given relatively little weight.⁴³

74. Evidence such as that relied upon in the present case through the Bull Declaration, and also the Green Declaration, is to be scrutinised with particular care, as such evidence is provided by a witness who is **not independent** of Icon.⁴⁴
75. Further, a statement of belief by a declarant will have no probative value unless the sources and grounds of the information and belief are revealed.⁴⁵
76. The source and grounds of information and belief must be the original source, and not merely the intermediate source, so that, if necessary, the evidence can be properly challenged and answered.⁴⁶
77. Material which cannot be proved because it is inadmissible, cannot be allowed, as it does not meet the requirement of being evidence having the requisite level of rational probative force.⁴⁷

Evidentiary Onus

78. In *Purkess v Crittenden*,⁴⁸ the High Court emphasised the importance of requiring a party responding to a *prima facie* case, needing to, as part of the shifting evidentiary onus, provide some evidentiary material of appropriate relevance and weight to overcome it, whether elicited in cross-examination or

⁴³ *Old Digger Pty Ltd v Azuko Pty Ltd* (2001) 51 IPR 43 at [156] per von Doussa J
Grove Hill Pty Ltd v Great Western Corp Pty Ltd (2002) 55 IPR 257 at [216]-[221] per Dowsett J (Fed C of A – Full Court)

⁴⁴ *Windsurfing International Inc v Petit* (1984) 3 IPR 449 at 489, lines 14-21 per Waddell J (SC (NSW))

⁴⁵ *Savings & Investment Bank Ltd v Gasco Investments (Netherlands) BV* (1984) 1 WLR 271 at 283
⁴⁶ *ibid* at 283

⁴⁷ *Pochi* (supra) at 256, lines 16-21

⁴⁸ (1965) 114 CLR 164 at 167-168

led, so as to respond *either by proving the contrary or throwing the matter into doubt*.⁴⁹

Objections to Evidence

79. Having regard to the legal principles referred to above concerning the standard of evidence required to meet that of probative nature, including the issue of evidentiary onus, in the sense of being the shifting nature of same, as referred to in *Purkess v Crittenden*, the Bull Declaration and the Green Declaration, and each of them, include material which is objectionable as being inadmissible, alternatively little or no weight should be given to various aspects of same.
80. This is particularly significant in view of the uncorroborated nature of the various allegations made in the Green Declaration and the Bull Declaration, respectively, concerning the alleged dealings and nature and extent of disclosure which occurred, such as referred to at paragraphs 11 and 12 of the Bull Declaration, and relating to a meeting alleged to have been held in the offices of Icon in February or March 2005.⁵⁰
81. A Schedule of Objections relating to the Bull Declaration and the Green Declaration, respectively, is annexed hereto and marked "B". The Objections are dealt with in summary form in annexure "B" and will be the subject of further submissions by counsel at the Opposition hearing.

Terms of Specification – Ordinary or Technical Meaning

82. In reading the specification in suit as a whole, and having regard to the evidence, there is no suggestion that the terms appearing in any of Claims 1 to 16 carry a special meaning the relevant art.

⁴⁹ *ibid* at 171 per Windeyer J:

The plaintiff in his own case need do no more than rely upon the conclusion to be drawn from the basic facts ... Whether one calls such a conclusion an inference, a presumption of fact or a presumption hominus matters not. It is an inference which any tribunal of fact would ordinarily draw until the defendant had, by evidence elicited in cross-examination or led, provided some material to overcome it – either by proving the contrary or throwing the matter into doubt.

⁵⁰ *Old Digger v Azuko* (supra) at [156]
Grove Hill v Great Western (supra) at [216]-[221]

83. Accordingly, the terms contained in the subject claims, and each of them, should be construed according to their ordinary English meanings, the information presented in the opposed specification as a whole, and by reference to the submissions made at the hearing, including, in particular, the evidence of Mr Weir.
84. To the extent that reference is had to any dictionary, as Mr Weir does, this is consistent with the terms in the specification being construed according to ordinary English meaning and not a special meaning in the relevant art, in which case the specialised meaning should be adopted.⁵¹

Legal Principles

85. In the absence of having any submissions from the Opponent, the following submissions are directed to each of the grounds and particulars of opposition by reference to the accepted approach to be taken as a matter of legal principle.

Lack of Entitlement to Grant of Patent

86. Item 1 under grounds of SGO rely on section 59(a)(i) and (ii) in support of lack of entitlement to grant of patent. The law as to inventorship was dealt with recently in:
- (a) ***University of Western Australia v Grey*** (2009) 82 IPR 206;
 - (b) ***Polwood Pty Ltd v Foxworth Pty Ltd*** (2008) 75 IPR 1;
 - (c) ***Wake v Soniclean*** (supra); and
 - (d) ***Lee v Komipharm*** (supra).
87. On the facts, the present invention started and reached the stage of the “conception” or “heart” of the invention having crystallised with the approach taken by Gregory Scott, such that when the meeting occurred in February 2005, the elements of the invention as reflected in Claims 1 to 16, was complete in the relevant sense, and notwithstanding that experimentation and finalisation of the prototype was involved at that time.⁵²

⁵¹ *Electrical & Musical Industries Ltd v Lissen Ltd* (1938) 4 All ER 221 at 226-227

⁵² *Polwood v Foxworth* (supra) at [46]

Wake v Soniclean (supra) at [41]

Lee v Komipharm (supra) at [12]

88. The claim of lack of entitlement should be rejected, and a finding made that the Patent Applicant is entitled to the claimed invention, as meeting the requirements of section 15(1) of the *Patents Act*.⁵³

Manner of Manufacture

89. The Opponent relies on section 59(b), and contends that the claimed invention is non-compliant with subsection 18(1)(a) of the *Patents Act*, by not constituting a manner of manufacture.
90. There is no basis in the evidence in the Bull Declaration or Green Declaration to support this claim, having regard to the legal principles as set out in the High Court decision of ***NV Philips Gloeilampenfabrieken v Mirabella International Pty Ltd*** (1995) 32 IPR 449.
91. The invention, as construed by reference to the contents of the specification, is not a mere matter of a new use of known features. Rather, the invention is a combination of features and it does not matter that the individual features, or some of them, were known.
92. Further, as the claims are submitted to be novel and inventive, the Opponent's argument for lack of manufacture cannot be sustained and should be dismissed.

Lack of Novelty

93. The question of novelty is determined under the provisions of section 7(1) of the *Patents Act*, and has been discussed recently in a number of decisions which confirm the basic test as being the "reverse infringement test", as set out in ***Meyers Taylor Pty Ltd v Vicarr Industries*** (1977) 1A IPR 181 at 186, where Aickin J stated:

The basic test for anticipation or want of novelty is the same as that for infringement and generally one can properly ask oneself whether the alleged infringement would if the patent were valid, constitute an infringement.

⁵³ *Wake v Soniclean* (supra) at [37]-[38] and [47]

94. Infringement is said to occur where *each and every one of the essential features of that claim have been taken*.⁵⁴
95. There is nothing disclosed in the US Patent or other material referred to in the Bull Declaration which constitutes a relevant disclosure, as well as there being no *clear and unmistakable* directions to the claimed invention.⁵⁵
96. The Second Weir Declaration deals with the matters raised in the:
- (a) Bull Declaration; and
 - (b) Green Declaration,
- concludes, in each instance, that there is no relevant disclosure which meets the test for lack of novelty.⁵⁶
97. For the reasons referred to above, the Opponent's contention as to lack of novelty should be dismissed.

Lack of Inventive Step

98. The Opponent also relies on lack of inventive step, through Item 3 under grounds of SGO, and section 18(1)(b)(ii) of the *Patents Act*.
99. The question of inventive step is determined under the provisions of section 7(2) and (3) of the *Patents Act*.
100. While inventiveness requires more than novelty, even a "scintilla of inventiveness" is sufficient. Thus, a step, if otherwise inventive, does not lose its inventiveness because the idea, once conceived, is very simple to put into effect: ***Winner v Ammar Holdings Pty Ltd*** (1993) 25 IPR 273 at 294. The test is objective.
101. The High Court has also cautioned against the misuse of hindsight, noting that the danger of such misuse will be *particularly acute where what is claimed is a*

⁵⁴ ***Rodi and Wienerberger AG v Henry Showell Ltd*** (1969) RPC 367, as cited with approval in ***Societe des Produits Nestle SA v Cadbury Holdings Ltd*** (2010) 87 IPR 654 per delegate K Ayers

⁵⁵ ***Pfizer Overseas Pharmaceuticals v Eli Lilly and Company*** (2005) 68 IPR 1 at [311] *et seq*

⁵⁶ Second Weir Declaration at paras 126-150 in relation to the Bull Declaration, and at paras 151-154 in relation to the Green Declaration

*new and inventive combination for the interaction of integers, some or all of which are known.*⁵⁷

102. When regard is had to the evidence of Mr Weir, and that of Gregory Scott and Martyn Scott, together with the evidentiary difficulties summarised in Schedule “B”, there is no basis for a conclusion that the problem identified in the specification would have been arrived at by a hypothetical addressee as a matter of routine, having been led from the prior art to the invention.⁵⁸
103. For the reasons referred to above, the Opponent’s contention as to lack of inventive step should be dismissed.

Lack of Fair Basing

104. Section 40(3) of the *Patents Act* requires the claim or claims to be clear and succinct and *fairly based* on the matter described in the specification. In ***Lockwood Security Products Pty Ltd v Doric Products Pty Ltd*** (2004) 62 IPR 461 at [27], the Court noted that fair basis is concerned *purely with the relationship between the body and claims of the one specification*.
105. The essential test for fair basis is thus whether the claims are consistent with what the specification, considered as a whole, describes as the invention.
106. The requisition “invention”, for purposes of section 40, is the *embodiment around which the claims are drawn*.⁵⁹
107. The Second Weir Declaration addresses each of the issues raised in the Opponent’s SGO, and concludes that each of Claims 1 to 16 are fairly based on matter contained in the specification.
108. For the reasons referred to above, the Opponent’s contention as to Claims 1 to 16 not being fairly based, should be dismissed.

⁵⁷ *Aktiebolaget Hassle v Alphapharm Pty Ltd* (2002) 56 IPR 129 at [53]

⁵⁸ *Welcome Foundation Ltd v VR Laboratories (Aust) Pty Ltd* 1A IPR 268 at 281 per Aickin J
Nestle v Cadbury (supra) at [36]-[37]

⁵⁹ *Kimberley-Clark v Arico Trading* (supra) at [21]
see also *Nestle v Cadbury* (supra) at [55]-[57] per delegate K Ayers

Lack of Clarity

109. Item 2 of the SGO, expressed compendiously, includes a ground of lack of clarity under section 40(3). The requirement is that the claims must be clear and succinct.
110. There is no suggestion in the evidence that a skilled worker would not be able to determine the particular configuration of the claimed product,⁶⁰ in order to achieve the claimed result: ***Austal Ship Sales Pty Ltd v Stena Rederi Aktiebolag*** (2008) 77 IPR 229 at [14]:
14. ... what matters is not the grammar of the claim, but whether a reader would be left in doubt whether any given apparatus or method fell within the claim or not; the purpose of the rule is to enable the public to rely upon the words of the claim as defining the rights of the patentee. Accordingly, a mere grammatical ambiguity, not affecting the scope of the monopoly, will not invalidate.
111. Further, to such extent as there may be issues in determining exactly where the outer boundaries of the claim are, little weight should be given to such issues which arise *at the edge of the claim*, if such issue *would not, as a practical matter, cause difficulty for the skilled addressee or manufacturer wishing to satisfy himself that what he proposes to do will not infringe the patent.*⁶¹
112. There is no, or no sufficient, evidence adduced in support of the Opposition by either the Bull Declaration or Green Declaration, which supports the issue of lack of clarity.
113. The Patent Applicant refers to and relies on the evidence of Mr Weir in the Second Weir Declaration, and also the fact that little or no weight should be given to the evidence of Messrs Bull and Green, respectively.
114. Further, to such extent as there is a contest as between the views taken by Mr Weir in the Second Weir Declaration and the Bull Declaration, having regard to the nature and extent of the objections raised as to the status of

⁶⁰ Claims 1 to 12, and also refer to Claim 16, and for the omnibus claim, refer to Claim 13

⁶¹ ***Glaverbel SA v British Coal Corp*** (1994) RPC 443 at 495
Nestle v Cadbury (supra) at [75]

Mr Bull's evidence, particularly his expressing an unqualified expert opinion, the views of Mr Weir should be preferred.⁶²

115. For the reasons referred to above, the Opponent's contention as to lack of clarity in relation to the claims of the Patent Application, are not made out and should be dismissed.

Summary

116. For the reasons referred to above, it is respectfully submitted that the Opponent has failed to discharge the onus of proof which rests upon it to show, on the balance of probabilities, that any of the grounds relied upon in the SOGOP have been made out. This is not a case where, on the evidence before the Commissioner, it is a clear case that no patent granted in respect of the specification would be valid.⁶³
117. Accordingly, the Opposition should be dismissed with costs.⁶⁴
118. In relation to the order for costs, which it is submitted should follow the event, if the determination is, as contended for by the Patent Applicant, a dismissal of the Opposition, costs following the event.
119. As the Commissioner may make an award of costs that differs from the scale given in Schedule 8.⁶⁵
120. As Sandercock & Cowie, on behalf of the Patent Applicant, Mr Scott, has engaged in without prejudice (save as to costs) correspondence with the patent attorneys formally on the record for the Opponent, Icon, that being Watermark (Robert Wood & Associates), it is respectfully requested that in the event that the Opposition is dismissed and the issue of costs falls to be

⁶² *VIP v B.M.W.* (supra) at [56]-[69], [80]-[81] per Kenny J

⁶³ *Hoffman-La Roche* (supra) at [67]

Austal Ships Pty Ltd v Stena Rederi Aktiebolag (2006) 66 IPR 420 at [6] per Bennett J

Patents Amendment Act 2001 (Cth)

Aristocrat Technologies Australia Pty Ltd v IGT (Australia) Pty Ltd (2007) 71 IPR 259 at [5]-[10]

Track Shop Pty Ltd v Bundaberg Foundry Engineers Ltd [2005] APO 54

Bodkins (supra) at [17040]

⁶⁴ section 210(d) *Patents Act*

⁶⁵ Regulation 22.8

determined, that an opportunity be given to the Patent Applicant to be heard on the question of costs, including as to whether same should be varied from the scale of costs set out in Schedule 8, and seek an award in an amount higher than indicated by the scale.⁶⁶

DATED 9 August 2011

Richard McCormack
Darlington Chambers
Counsel

⁶⁶ *Colgate-Palmolive Co v Cussons Pty Ltd* (1993) 28 IPR 561 at 570 per Sheppard J
Monsanto Co v Zeneca Pty Ltd (1996) 36 IPR 120 (APO) at page 135 per delegate Dr SD Barker
Super Internet Site System Pty Ltd v Sensis Pty Ltd [2006] APO 27 at [23]-[24]

“A”

THE CLAIMS DEFINING THE INVENTION ARE AS FOLLOWS:

1. A moulded air duct of elongated cross-section capable of installation in a wall or ceiling space which contains an effective quantity of flame retardant, having male/female joins at the ends and at least one joint site of enlarged cross-section, intermediate the ends which when parted transversely creates a male and female join.
2. A moulded air duct as claimed in Claim 1, where the joins overlap with a clearance which allows sealant to occupy the clearance.
3. A moulded air duct as claimed in Claim 1 or 2, wherein the sides of the duct are of curved section joined by parallel walls.
4. A moulded air duct as claimed in any one of Claims 1-3, wherein the opposite parallel walls of the duct are joined by integrally moulded struts.
5. A moulded air duct as claimed in Claim 4, wherein struts are located between the joint site and the end of the duct. Deleted: the Deleted: is
6. A moulded air duct as claimed in Claim 4 or 5, wherein the struts are located between joint sites and between the end most site and the adjacent end. Deleted: is Deleted: substantially tubular
7. A moulded air duct as claimed in Claim 4 or 5, wherein the strut is waisted.
8. A moulded air duct as claimed in any one of Claims 1-7, wherein the wall thickness is 2-3mm.
9. A moulded air duct as claimed in any one of Claims 1-8, wherein the moulding mix contains 6-10% by weight of flame retardant.
10. A moulded air duct as claimed in Claim 9, wherein the flame retardant is a polyhalo acrylate.
11. A moulded air duct as claimed in any one of the preceding Claims, wherein the duct walls are curved in order to turn the flow path through 45 or 90°.
12. A moulded air duct as claimed in any one of the preceding Claims, when made by excising the ends from a blow moulded precursor.
13. A moulded air duct or precursor thereof substantially as herein described with reference to and as illustrated in Figures 1, 2 and 6, and as modified by Figure 3.

14. A method of making a duct of elongate cross-section by blow moulding a parison to form a duct which is closed at both ends with a joint site [of enlarged circumferential cross-section](#) at one end and at least one other joint site [of enlarged circumferential cross-section](#) intermediate the ends and excising both ends to create a male join at one end and a female join at the opposite end.
15. A method as claimed in Claim 14, including connecting the internal faces of the duct with a tubular support in the central area of the duct.
16. An air duct system comprising multiple ducts as claimed in Claim 1, joined end to end arranged to conduct air from a heating or cooling appliance in one part of a building to outlets in rooms in another part of the building with adaptors at the inlet for connecting the duct to hoses of circular section.

“B”

SCHEDULE OF OBJECTIONS

<u>No.</u>	<u>Para</u>	<u>Details</u>	<u>Ground of Objection</u>
Statutory Declaration of Royston Douglas Bull declared 8 July 2010			
1.	5	First and second sentences	Hearsay, lack of primary facts
2.	8	First, second and third sentences: <i>That my belief ... potentially earlier.</i>	Lack of source and grounds of belief
		Penultimate sentence: <i>The quotations other sources.</i>	Hearsay, speculation
3.	9	First sentence: <i>That it is my belief ... in Queensland.</i>	Hearsay, lack of source and grounds of belief, relevance
		Third sentence: <i>My understanding is ... alternative supply of such products.</i>	Hearsay, lack of source and grounds of belief, relevance
		<i>Greg Scott new Philip Stone ... ducting and fittings.</i>	Hearsay, relevance
		Last sentence: <i>Philip Stone obtained cost information ... Exhibit RDB-6.</i>	Hearsay, lack of source and grounds of belief, relevance
4.	10	First sentence: <i>That I realised ... possible manufacturing technique.</i>	Lack of primary facts, hearsay, conclusory, relevance
		Final sentence: <i>The blow moulded quotation documents ... pass on the quotation to Marty Scott.</i>	Lack of primary facts, hearsay, conclusory, relevance
5.	11	Second sentence: <i>separately acquired ... Marty Scott in Victoria.</i>	Hearsay, relevance
		Fourth sentence: <i>It can be seen ... Exhibit RDB-2).</i>	Conclusory, lack of primary facts, relevance
		<i>These drawings show ... opposed walls of the duct.</i>	Relevance, conclusory, lack of primary facts
		<i>It is, I believe ... but not with an extruded duct.</i>	Conclusion, unqualified opinion, lack of primary facts

No.	Para	Details	Ground of Objection
		<i>The sketch drawings ... enlarged sections is cut.</i>	Unqualified opinion, relevance, lack of primary facts, conclusory
		<i>and not Greg Scott.</i>	Assertion, argument
		<i>and were disclosed to Marty Scott and Greg Scott ... 2005.</i>	Conclusory, self-serving, relevance
		<i>It is my belief that ... until this meeting took place.</i>	Speculation, relevance, lack of source and grounds of belief, unqualified opinion
		<i>but regardless ... should any such rights validly exist.</i>	Conclusory, lack of source and grounds of belief, relevance
6.	12	<i>That at the one and only meeting ... verbally communicated to Marty and Greg Scott.</i>	Assertion, lack of primary facts, relevance
		<i>My belief is that ... too high and ...</i>	Hearsay, relevance, speculation
7.	13	<i>It is my belief ... before 11 May 2005.</i>	Unqualified opinion, lack of primary facts, lack of source and grounds of belief
		<i>By the same date, ... used in the aforesaid processes.</i>	Unqualified opinion, lack of primary facts, lack of source and grounds of belief
8.	14	<i>It is also my belief ... Such devices are shown in ...</i>	Unqualified opinion, lack of primary facts, lack of source and grounds of belief
		<i>A similar device ... in 1987.</i>	Unqualified opinion, lack of primary facts, lack of source and grounds of belief
		<i>and of the aforesaid ducts</i>	Unqualified opinion, lack of primary facts, lack of source and grounds of belief
9.	15	<i>A duct to me ... Claim 1 of Patent Application No. 2006246325.</i>	Unqualified opinion, lack of primary facts, lack of source and grounds of belief
10.	16	<i>It is not clear to me what limitation ... I do not believe this terminology is clear or interpretable</i>	Unqualified opinion, lack of primary facts, lack of source and grounds of belief

<u>No.</u>	<u>Para</u>	<u>Details</u>	<u>Ground of Objection</u>
11.	17	<i>This passage is unclear to me ... each longitudinal end.</i>	Unqualified opinion, lack of primary facts, lack of source and grounds of belief
12.	18	<i>The terminology "enlarged cross-section ... substantially uniform.</i>	Unqualified opinion, lack of primary facts, lack of source and grounds of belief
13.	19	<i>Again the term "join" suggests ... the act of bringing together two objects or things.</i>	Unqualified opinion, lack of primary facts, lack of source and grounds of belief
14.	20	<i>It is unclear to me ... difficulty of understanding Claim 1.</i>	Unqualified opinion, lack of primary facts, lack of source and grounds of belief
15.	21	<i>that do not seem to be defined in Claims 1 and 2.</i>	Conclusory, question of law as to construction of patent specification and claims
16.	22	<i>and defines "the strut" ... is located relative to.</i>	Conclusory, question of law as to construction of patent specification and claims
17.	23	Entire paragraph	Unqualified opinion, lack of primary facts, lack of source and grounds of belief
18.	24	<i>The only wall defined in claims 1 and 2 ... is intended to be installed.</i>	Conclusory, question of law as to construction of patent specification and claims
19.	25	Last two sentences: <i>This claim ... Claim 9 therefore seems to be unclear.</i>	Conclusory, question of law as to construction of patent specification and claims
20.	26	Entire paragraph: <i>Claim 13 ... and not a duct itself.</i>	Unqualified opinion, lack of primary facts, lack of source and grounds of belief
21.	27	Second sentence: <i>It is not clear to me ... both ends is formed by a blow moulding technique.</i> and also: <i>It can be seen ... blow moulding process.</i>	Unqualified opinion, lack of primary facts, lack of source and grounds of belief
22.	28	Entire paragraph: <i>That in fact the initial request for quotation by Marty Scott and Greg Scott ... (Hallam).</i>	Hearsay, speculation unsupported by any primary facts, argument

<u>No.</u>	<u>Para</u>	<u>Details</u>	<u>Ground of Objection</u>
23.	29	Entire paragraph: <i>Further to my observations in paragraph 27 ... the remainder of the duct.</i>	Unqualified opinion, lack of primary facts, lack of source and grounds of belief
24.	30	Entire paragraph: <i>Claim 15 ... is unclear to me.</i>	Conclusory, question of law as to construction of patent specification and claims
Statutory Declaration of Terrence William Green declared 14 October 2010			
25.	3	<i>That I worked ... Colin Van Staveren.</i>	Relevance
		<i>I was aware ... building exhaust ducting.</i>	Hearsay, relevance, self-serving
		<i>These quotations were for ... June 2004.</i>	Relevance, conclusory, hearsay
		<i>Colin Van Staveren ... Icon Plastics Pty Ltd.</i>	Relevance
26.	4	<i>My understanding was ... not produced by Icon Plastics Pty Ltd.</i>	Speculation, unsupported by any primary facts, hearsay, relevance

COMMONWEALTH OF AUSTRALIA
[Patents Act 1990]

IN THE MATTER of **M & L SCOTT**
Australian Patent Application No.
2006 246325 in the name of
Laurence Clifford Scott entitled "AIR
DUCT"

and

Opposition thereto by **Icon Plastics
Pty Ltd**

LIST OF AUTHORITIES ON BEHALF OF THE PATENT APPLICANT
IN RELATION TO THE OPPOSITION HEARING AS SCHEDULED TO BE
HEARD IN CANBERRA ON WEDNESDAY, 10 AUGUST 2011

CASES

A

1. ***Expo-Net Danmark A/s v Buono-Net Australia Pty Ltd*** (2010) 88 IPR 1 at [7]-[9], [15]-[22] and [23]-[33]
2. ***Flexible Steel Lacing Co v Beltreco Ltd*** (2000) 48 IPR 345 at 350-355
3. ***Cadbury Schweppes Plc v Effem Foods Pty Ltd*** [2002] APO 38 at [7]-[10]
4. ***Breville Pty Ltd v Sunbeam Corporation Ltd*** (2010) 90 IPR 569 at [74], [92], [93]
5. ***Kimberley-Clark Australia Pty Ltd v Arico Trading International Pty Ltd*** (2001) 50 IPR 513 at [15], [21], [24], [34]
6. ***Aspirating IP Ltd v Vision Systems Ltd*** (2010) 88 IPR 52 at [107]-[111]
7. ***Kinabalu Investments Pty Ltd v Barron & Rawson Pty Ltd*** [2008] FCAFC 178 at [45]

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8. ***Austal Ships Pty Ltd v Stena Rederi Aktiebolag*** (2005) 66 IPR 420 at [6], [12]
9. ***Minnesota Mining & Manufacturing Co v Tyco Electronics Pty Ltd*** (2002) 56 IPR 248 at [48]-[50]
10. ***Wake v Soniclean Pty Ltd*** (2010) 88 IPR 186 at [37]-[38], [41], [42], [43], [47], [67]
11. ***Lee v Komipharm International Co Ltd*** (2010) 88 IPR 410 at [12], [13], [15], [16] and [17]
12. ***VIP Plastic Packaging Pty Ltd v B.M.W. Plastics Pty Ltd*** [2011] FCA 660 (10 June 2011) at [56]-[69], [80]-[81]
13. ***Old Digger Pty Ltd v Azuko Pty Ltd*** (2001) 51 IPR 43 at [156]
14. ***Purkess v Crittenden*** (1965) 114 CLR 164 at 167-168, 171
15. ***Polwood Pty Ltd v Foxworth Pty Ltd*** (2008) 75 IPR 1 at [46]
16. ***Pfizer Overseas Pharmaceuticals v Eli Lilly and Company*** (2005) 68 IPR 1 at [311]
17. ***Winner v Ammar Holdings Pty Ltd*** (1993) 25 IPR 273 at 294
18. ***Aktiebolaget Hassle v Alphapharm Pty Ltd*** (2002) 56 IPR 129 at [53]
19. ***Welcome Foundation Ltd v VR Laboratories (Aust) Pty Ltd*** 1A IPR 268 at 281
20. ***Lockwood Security Products Pty Ltd v Doric Products Pty Ltd*** (2004) 62 IPR 461 at [27]
21. ***Austal Ship Sales Pty Ltd v Stena Rederi Aktiebolag*** (2008) 77 IPR 229 at [14]
22. ***Austal Ships Pty Ltd v Stena Rederi Aktiebolag*** (2006) 66 IPR 420 at [6]
23. ***Aristocrat Technologies Australia Pty Ltd v IGT (Australia) Pty Ltd*** (2007) 71 IPR 259 at [5]-[10]
24. ***Monsanto Co v Zeneca Pty Ltd*** (1996) 36 IPR 120 at page 135
25. ***Super Internet Site System Pty Ltd v Sensis Pty Ltd*** [2006] APO 27 at [23]-[24]

B

26. ***Palmer v Dunlop Perdirau Rubber Co*** (1937) 59 CLR 30 at 61-62
27. ***Welsh Perrin & Company Pty Ltd v Worrel*** (1961) 106 CLR 588 at 610
28. ***General Tire and Rubber Company v Firestone Tyre and Rubber Co Ltd*** (1971) 1A IPR 121 at 138
29. ***Jupiters Ltd v Neurizon Pty Ltd*** (2005) 65 IPR 86 at [154]
30. ***Stamp v WJ Powell Pty Ltd*** (1918) 24 CLR 339 at 343
31. ***Commissioner of Patents v Microcell Ltd*** (1959) 102 CLR 232 at 244-245
32. ***F Hoffman-La Roche AG v New England Biolabs Inc*** (2000) 50 IPR 305 at [48]-[53], [67]
33. ***Optech International Ltd v Buxton Hicrarium Ltd*** (1993) 28 IPR 649 at 654-655, 656-657
34. ***McKay v Shirlow Pty Ltd*** (1985) 7 IPR 135 at 139 lines 7-24, and at 140 lines 10-25
35. ***Pochi v Minister for Immigration and Ethnic Affairs*** (1979) 26 ALR 247 at 256, lines 16-21
36. ***Grove Hill Pty Ltd v Great Western Corp Pty Ltd*** (2002) 55 IPR 257 at [216]-[221]
37. ***Windsurfing International Inc v Petit*** (1984) 3 IPR 449 at 489, lines 14-21
38. ***Savings & Investment Bank Ltd v Gasco Investments (Netherlands) BV*** (1984) 1 WLR 271 at 283
39. ***Electrical & Musical Industries Ltd v Lissen Ltd*** (1938) 4 All ER 221 at 226-227
40. ***University of Western Australia v Grey*** (2009) 82 IPR 206
41. ***NV Philips Gloeilampenfabrieken v Mirabella International Pty Ltd*** (1995) 32 IPR 449
42. ***Meyers Taylor Pty Ltd v Vicarr Industries*** (1977) 1A IPR 181 at 186
43. ***Rodi and Wienenberger AG v Henry Showell Ltd*** (1969) RPC 367

44. ***Societe des Produits Nestle SA v Cadbury Holdings Ltd*** (2010) 87 IPR 654 at [36]-[37], [55]-[57], [75]
45. ***Glaverbel SA v British Coal Corp*** (1994) RPC 443 at 495
46. ***Track Shop Pty Ltd v Bundaberg Foundry Engineers Ltd*** [2005] APO 54
47. ***Colgate-Palmolive Co v Cussons Pty Ltd*** (1993) 28 IPR 561 at 570

STATUTORY

48. ***Patents Act 1990 (Cth)*** – Sections 7(2) and (3), 18(1)(a), 18(1)(b)(i), 18(1)(b)(ii), 59(a)(i) and (ii), 59(b), 59(c), 104(1)(a) and (b), 210(d)
49. ***Patent Regulations 1990 (Cth)*** – Regulations 5.10(1), (2) (4) and (5), 22.8, 22.12(1)
50. ***Patents Amendment Act 2001 (Cth)***
51. ***Evidence Act 1995 (Cth)*** – Sections 76, 79, 80, 135

REFERENCE MATERIALS

52. Lahore, ***Patents, Trade Marks & Related Rights***, Butterworths Service, at [10,010] *Evidence*, [10,125] *Further evidence*, [15,360] *Powers to amend*
53. ***Australian Patent Office Manual of Practice and Procedures***, Vol 2, at para 2.13.5.2.2
54. Bodkin C, ***Patent Law in Australia***, Law Book Co, 2008 at [17020], [17030], [17040]

- A** cases from which passages **will** be read
B cases from which passages may be read or otherwise referred to

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