

# AUSTRALIAN INTELLECTUAL PROPERTY JOURNAL

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## ARTICLES

### **To Boldly Reform IP Dispute Resolution: Experience in the IP Enterprise Court – *The Hon Mr Justice Birss***

Between 2010 and 2013 a series of reforms took place in the Patents County Court in London which led to the foundation of the Intellectual Property Enterprise Court. The reforms were an attempt to improve access to justice in intellectual property cases, particularly for disputes involving small and medium-sized enterprises. Justice Birss was appointed as a judge in 2010 to take charge of the Court and implement the reforms. In the seventh Francis Gurry Lecture on Intellectual Property, Justice Birss shares his experiences of the Court – addressing the nature of the reforms and how they worked in practice. .... 4

### **Cantarella Bros Pty Ltd v Modena Trading Pty Ltd: A Step in the Wrong Direction for Trade Mark Registration in Australia – *Alexander Thomas***

Section 41(2) of the *Trade Marks Act 1995* (Cth) formerly provided that an application for the registration of a trade mark must be rejected if the trade mark is not capable of distinguishing the applicant's goods or services in respect of which the trade mark is sought to be registered. Section 41(3) then provided that in deciding the question whether or not a trade mark is capable of distinguishing the designated goods or services from the goods or services of other persons, the Registrar must first take into account the extent to which the trade mark is inherently adapted to distinguish the designated goods or services from the goods or services of other persons. The article considers the recent High Court decision in *Cantarella Bros Pty Ltd v Modena Trading Pty Ltd*, which concerned whether certain Italian words were inherently adapted to distinguish within the meaning of what was then s 41(3). Although the wording of s 41 has since been amended, the section still relies on the concept of a trade mark's inherent adaptation to distinguish. The article argues that the decision is flawed and may carry significant implications for trade mark law in Australia. .... 16

### **Pay or Else: How Protected are Australian Internet Account Holders from Speculative Invoicing after Dallas Buyers Club? – *Joshua Yuvaraj***

To combat online copyright infringement, rights holders or their representatives may engage in "speculative invoicing": threatening alleged infringers with litigation unless they pay an excessive settlement fee. This article explores the extent to which Australians are protected from speculative invoicing in light of recent litigation. The copyright owner of the movie *Dallas Buyers Club* applied for preliminary discovery of account holder details under the *Federal Court Rules*. The Court denied access to these details because the owner sought to use them to claim damages that, in the opinion of the Court, it could not plausibly sue for. This approach significantly protects alleged individuals against speculative invoicing. However, the Court should more broadly supervise the draft

correspondence that rights holders propose to use. As this article contends, the Court should ensure that these letters are drafted in good faith to protect individuals against speculative invoicing. Decisions in Canada and the United Kingdom provide guidance as to the factors the Court could consider in assessing draft correspondence. .... 37