

# AUSTRALIAN INTELLECTUAL PROPERTY JOURNAL

Volume 16, Number 3

August 2005

## ARTICLES

### **Amgen, TKT and the erythropoietin patents – patent privileges in preference to competition – *Charles Lawson***

The United States Court of Appeals (Federal Circuit) decision in *Amgen Inc v Hoechst Marion Roussel Inc* 314 F 3d 1313 (2003) poses significant concerns for promoting competition in the biotechnology sector. The decision is, in effect, a win for old technology and “Big Pharma” at the expense of new and substitute technology that might have been expected to introduce new entrants and competition into the sector. This article reviews the key outcomes of that decision and places the consequences into a competition discourse concluding that the Court of Appeals’ preference for favouring a construction and written description that confounds new market entrants may not be desirable for competition. .... 129

### **Trade mark dilution in Singapore: The aftermath of McDonald’s v MacTea – *David Llewelyn and Susanna H S Leong***

In a unanimous decision delivered in September 2004, the Court of Appeal of Singapore has ruled against McDonald’s Corporation in its attempts to stop a small Singapore company, Future Enterprises Pty Ltd, from registering its marks “MacNoodles”, “MacTea” and “MacChocolate”. This case has international significance as the Singapore court ruled, confirming the position taken by courts in a number of other jurisdictions, that McDonald’s did not have an exclusive right over the prefix “Mc” in relation to food and beverages in the absence of deception or confusion. However, Singapore’s trade mark laws have since undergone a major revamp. Under the new laws, greater protection is accorded to well known marks. This paper studies the Singapore Court of Appeal’s decision in the *McDonald’s case* and comment on whether its result would have been different under the new laws. .... 138

### **Sufficiency of description: At what time is its adequacy considered? – *Ann L Monotti***

There is no express provision in the *Patents Act 1990* (Cth) that specifies the date at which the specification must fully describe the invention, including the best method for its performance. Nor is there express mention of the date at which the applicant’s knowledge of best method of performance is assessed. These temporal questions have received some attention in the United Kingdom, but little attention in Australia until recently. This article critically examines the approach that Australian courts have taken on these issues and draws conclusions that are consistent with the underlying rationales for a first to file patent system. .... 152

OPINION

<b>“If you go down to the woods today” – tales from the front line of criminal copyright enforcement .....</b>	<b>165</b>
--	------------

NEWS AND CURRENT DEVELOPMENTS

<b>News from the Attorney-General’s Department .....</b>	<b>178</b>
--	------------

# Guidelines for Contributors

## Submission and licence agreement instructions

All contributions to the journal are welcome and should be sent, with a signed licence agreement, to the Production Editor, *Australian Intellectual Property Journal*, Lawbook Co., PO Box 3502, Rozelle, NSW 2039 (mail), 100 Harris St, Pyrmont, NSW 2009 (courier) or by email to [aipj@thomson.com.au](mailto:aipj@thomson.com.au), for forwarding to the Editor. Licence agreements can be downloaded via the internet at [http://www.lawbookco.com.au/authorsupport/d\\_authorJournals.asp](http://www.lawbookco.com.au/authorsupport/d_authorJournals.asp). If you submit your contribution via email, please confirm that you have printed, signed and mailed the licence agreement to the attention of the Production Editor at the mailing address noted above.

## Letters to the Editor

By submitting a letter to the editor of this journal for publication, you agree that Thomson Legal & Regulatory Limited, trading as Lawbook Co., may edit and has the right to, and may license third parties to, reproduce in electronic form and communicate the letter.

## Manuscript

- Manuscript must be original, unpublished work that has not been submitted for publication elsewhere.
- Personal details (name, qualifications, position) for publication and a delivery address, email address and phone number must be included with the manuscript.
- Manuscript must be submitted electronically via email or on disk in Microsoft Word format.
- Manuscript should not exceed 10,000 words for articles or 1,500-2,000 words for section commentary or book reviews. An abstract of 100-150 words is to be submitted with article manuscripts.
- Proof pages will be sent to contributors. Authors are responsible for the accuracy of case names, citations and other references. Excessive changes to the text cannot be accommodated.
- Contributors of articles receive 25 free offprints of their article and a copy of the part in which the article is published. Other contributors receive a copy of the part to which they have contributed.
- Articles published are critically appraised or reviewed by an academic or professional peer of the author for the purpose of maintaining the standards of the journal.

## Style

### 1. Levels of headings should be clearly indicated (no more than four levels).

### 2. Cases:

- Case citation follows case name. Where a case is cited in the text, the citation should follow immediately rather than as a footnote. Give at least two and preferably all available citations, the first listed being the authorised reference.
- Australian citations should appear in the following order: authorised series; Lawbook Co./ATP series; other company series (ie CCH, Butterworths); media neutral citation.
- “At” references should only refer to the best available citation, eg: *Mabo v Queensland [No 2]* (1992) 175 CLR 1 at 34; 66 ALJR 408; 107 ALR 1.
- Where only a media neutral citation is available, “at” references should be to paragraph, eg: *YG v Minister for Community Services* [2002] NSWCA 247 at [19].
- For international cases best references only should be included.

### 3. Legislation should be cited as follows:

*Trade Practices Act 1974* (Cth), s 51AC. The full citation should be repeated in footnotes.

### 4. Books should be cited as follows:

Macken JJ, O’Grady P, Sappideen C and Warburton G, *The Law of Employment* (5th ed, Lawbook Co., 2002) p 55.

- In footnotes do not use *ibid* or *op cit*. The following style is preferred:

4. Austin RP, “Constructive Trusts” in Finn PD (ed), *Essays in Equity* (Law Book Co, 1985).

5. Austin, n 4, p 56.

### 5. Journals should be cited as follows:

Odgers S, “Police Interrogation: A Decade of Legal Development” (1990) 14 Crim LJ 220.

Wherever possible use official abbreviations not the full name for journal titles.

- In footnotes do not use *ibid* or *op cit*. The following style is preferred:

6. Sheehy EA, Stubbs J and Tolmie J, “Defending Battered Women on Trial: The Battered Woman Syndrome and its Limitations” (1992) 16 Crim LJ 220.

7. Sheehy et al, n 6 at 221.

### 6. Internet references should be cited as follows:

Ricketson S, *The Law of Intellectual Property: Copyright, Designs and Confidential Information* (Lawbook Co., subscription service) at [16.340], <http://subscriber.lawbookco.com.au> viewed 25 June 2002. Underline the URL and include the date the document was viewed.

For further information visit the Lawbook Co. website at <http://www.lawbookco.com.au> or contact the Production Editor.

## SUBSCRIPTION INFORMATION

The *Australian Intellectual Property Journal* comprises four parts a year.

Customer Service and sales inquiries:

**Tel: 1300 304 195**

**Fax: 1300 304 196**

**Web:** [www.lawbookco.com.au](http://www.lawbookco.com.au)

**Email:** [LRA.Service@thomson.com](mailto:LRA.Service@thomson.com)

Editorial inquiries:

**Tel: (02) 8587 7000**

### HEAD OFFICE

100 Harris Street PYRMONT NSW 2009

Tel: (02) 8587 7000 Fax: (02) 8587 7100



© Thomson Legal & Regulatory Limited ABN 64 058 914 668 trading as Lawbook Co.

ISSN 1038-1635

Typeset by Lawbook Co., Pyrmont, NSW  
Printed by Ligare Pty Ltd, Riverwood, NSW