SHORT PARTICULARS OF CASES

COMMENCING TUESDAY, 17 APRIL 2012

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JT INTERNATIONAL SA v THE COMMONWEALTH OF AUSTRALIA (S409/2011)

Date writ of summons filed: 15 December 2011

Date demurrer referred into the Full Court: 27 February 2012

JT International SA ("JT") is incorporated pursuant to the laws of Switzerland. It is the registered owner (or the exclusive licensee from the registered owner) of certain Trade Marks that are registered and/or protected under the *Trade Marks Act* 1995 (Cth). This entitles JT to use (or authorise the use of) those Trade Marks in the retail packaging and appearance of "Camel" cigarettes and "Old Holborn" tobacco ("the Tobacco Products") currently sold in Australia. It also entitles JT to take action in relation to infringements of its Trade Marks in Australia.

JT has, and will until the commencement of sections 17 to 27A and 30 to 48 of the *Tobacco Plain Packaging Act* 2011 (Cth) ("the TPP Act"), have the right to determine:

(i) The appearance of its Tobacco Products;

(ii) The form and appearance of at least 70% of the front and at least 10% of the back of its Tobacco Products.

The Tobacco Products use distinctive trade dress and get-up, including words, colours, designs, logos, lettering and markings ("the Get Up"). This distinguishes JT's Tobacco Products from other tobacco products in respect of which JT has rights of use, capable of being enforced by an action for passing off or misleading conduct. JT claims that its rights in both the Trade Marks and the Get Up are "property" for the purposes of section 51(xxxi) of the Constitution. It also claims that the provisions of the TPP Act, particularly Chapters 2 & 3, constitute an acquisition of its property otherwise than on just terms. It further submits that, but for section 15, those provisions are wholly invalid and are of no effect.

While the Defendant ("the Commonwealth") admits that JT's Trade Marks constitute "property" within the meaning of section 51(xxxi) of the Constitution, it denies that its Get Up is. In any event, the Commonwealth submits that such rights that are held by JT have always been subject to Commonwealth, State and Territory statutes, including regulations specifically directed to the packaging and marketing of tobacco products. This includes Commonwealth laws of the kind enacted by Chapters 3 and 5 of the TPP Act. JT's rights are also subject to the common law.

The Commonwealth further submits that the provisions of the TPP Act do not confer upon the Commonwealth any measurable benefits or advantages analogous to proprietary rights, thereby giving rise to an acquisition of JT's property within the meaning of section 51(xxxi) of the Constitution. The Commonwealth alternatively submits that even if JT's property is held to have been acquired, then any acquisition without just terms is subservient to the objects identified in section 3(1) of the TPP Act. It further submits that even if just terms are required, then any acquisition that has transpired has occurred on such terms.

Both JT and the Commonwealth have filed “Section 78B Notices”, while the Attorneys-General for Queensland, the Australian Capital Territory and the Northern Territory have all advised this Court that they will be intervening in this matter. The Cancer Council of Australia has also filed both a summons seeking leave to intervene as amicus curiae and its own “Section 78B Notice”.

On 27 February 2012 Justice Gummow set down JT’s demurrer for hearing by the Full Court on 17 April 2012. JT demurred to the Commonwealth’s defence on grounds which include:

- The Trade Marks and the Get-Up constitute “property” within section 51(xxxi) of the Constitution.
- The TPP Act would, apart from section 15, result in an acquisition of that property within section 51(xxxi) of the Constitution.
- That acquisition would be otherwise than on just terms.

BRITISH AMERICAN TOBACCO AUSTRALASIA & ORS v THE COMMONWEALTH OF AUSTRALIA (S389/2011)

Date writ of summons filed: 1 December 2011

Date questions referred into the Full Court: 27 February 2012

Between them, the Plaintiffs either own or hold (or claim to own or hold) a constellation of rights relating to the production, packaging and marketing of certain tobacco products in Australia.

The First Plaintiff owns certain Trade Marks, some of which are registered pursuant to the *Trade Marks Act* 1995 (Cth). It also claims to own the copyright subsisting in various artistic and literary works, the distinctive trade dress and get up as well as the associated licencing goodwill relating to those tobacco products. The Second Plaintiff is the registered owner of a design registered under the *Design Act* 2003 (Cth). It is also the patentee of patents registered pursuant to the *Patents Act* 1990 (Cth). The Third Plaintiff manufactures, imports into, owns and sells both tobacco products and the packaging of such products, in Australia. It also claims to own the goodwill attaching to the exploitation in Australia of the packaging rights.

The Plaintiffs submit, inter alia, that the *Tobacco Plain Packaging Act* 2011 (Cth) ("the TPP Act") would, but for the operation of section 15, result in an acquisition of their property rights otherwise than on just terms. They further submit that, by reason of section 15, the provisions of the TPP Act do not apply to (nor have any operation with respect to) either their tobacco products or the packaging of their tobacco products.

The Defendant submits that the Plaintiffs' claimed rights have always been the subject of restrictions arising from Commonwealth, State or Territory legislation and the common law. It further submits that the provisions of the TPP Act do not amount to an acquisition of the Plaintiffs' property within the meaning of section 51(xxxi) of the Constitution.

The Defendant alternatively submits that, even if the Plaintiffs' property has been acquired by the TPP Act, the objects identified in section 3(1) of the TPP Act are within the scope of the Commonwealth's legislative power pursuant to sections 51(i), (xx) and (xxix) of the Constitution. It also claims that the means selected in the TPP Act, as identified by section 3(2), are appropriate or reasonably necessary to achieve those goals. The Defendant further submits that section 51(xxxi) of the Constitution would not therefore require the provision of just terms on any such acquisition.

The Defendant additionally submits that, even if the Plaintiffs' property has been acquired by the TPP Act (and that just terms are required), the relevant provisions of the TPP Act constitute fair dealing and that any such acquisition is therefore on just terms.

On 27 February 2012 Justice Gummow referred certain questions into the Full Court for the Full Court's consideration.

On 9 March 2012 Justice Gummow ordered that Philip Morris Limited, Van Nelle Tabak Nederland BV and Imperial Tobacco Australia Limited be granted leave to intervene in this matter.

Various interested parties have filed “Section 78B Notices”, while the Attorneys-General of Queensland, the Australian Capital Territory and the Northern Territory have all advised this Court that they will be intervening in this matter.

On 26 March 2012 the Cancer Council of Australia also filed a summons seeking leave to intervene as amicus curiae in this matter.

The questions referred into the Full Court for its consideration include:

- Apart from section 15 of the TPP Act, would all or some of the provisions of the TPP Act result in an acquisition of any, and if so what, property of the Plaintiffs or any of them otherwise than on just terms, of a kind to which section 51(xxxi) of the Constitution applies?

- If the answer to the question above is “yes”, are all or some, and if so which, provisions of the TPP Act in whole or in part beyond the legislative competence of the Parliament by reason of section 51(xxxi) of the Constitution?

- Are all or some, and if so which, provisions of the TPP Act in whole or in part beyond the legislative competence of the Parliament by reason of the matters raised in paragraphs 10-12 of the Statement of Claim?

CLODUMAR v NAURU LANDS COMMITTEE & ORS (M37/2011)

Court appealed from: Supreme Court of Nauru

Date of judgment: 19 February 2002

This is an appeal as of right from a judgment of the Supreme Court of Nauru (the Nauru Court), pursuant to s5(1) of the *Nauru (High Court Appeals) Act* 1976 (Cth) (the Nauru Act).

In proceedings in the Nauru Court, the appellant (Clodumar) sought, inter alia, declaratory relief to the effect that he was the owner of a one half share in certain lands, on the basis of a transfer to him from Rick Burenbeiya (the deceased), before his death in 1999. On 19 February 2002, the Nauru Court found that the transfer of land in question from the deceased to Clodumar was not approved in accordance with s3 of the *Lands Act* 1976 (Nauru), namely that the transfer had not been approved by the President of the Republic of Nauru.

The 1st respondent (the Committee) is a statutory body charged with the due administration of certain aspects of land transfers in Nauru. Subsequent to the Nauru Court decision, the land estate of the deceased was the subject of a determination by the Committee, which distributed the land to certain people, as beneficiaries of the deceased's estate, according to the law and custom of Nauru. In 2010 Clodumar appealed that determination to the Supreme Court (the Land Appeal). During those proceedings, Clodumar was given some documents by a third party (the fresh evidence), which were said to have been found in a file which had been kept in a separate location and not officially recorded. Clodumar submits that the fresh evidence establishes that Presidential approval had in fact been given in 1999. The Land Appeal was, on 22 March 2011, adjourned pending this appeal in the High Court.

By his appeal in this Court, Clodumar seeks to have the fresh evidence admitted into evidence. Clodumar also seeks an extension of time for the filing of the appeal. The appeal depends on the reception of the fresh evidence, as no error of the Court below is relied upon. It is submitted that the fresh evidence, if received, points to a likelihood that the judgment below was based on a mutual mistake by the parties as to the critical fact of the existence or non-existence of Presidential approval. Clodumar submits that the power exercised by this Court, pursuant to the jurisdiction conferred by s5 of the Nauru Act, is wide enough to empower this Court to receive fresh evidence on appeal. This is because the jurisdiction conferred is original jurisdiction arising from a law validly made under s76(ii) of the Constitution, rather than appellate jurisdiction under s73 and thus the prohibition imposed by that section on the High Court receiving fresh evidence does not apply. Clodumar submits that the fresh evidence in this case meets the established stringent requirements for being received and so ought to be received. The Committee opposes the extension of time sought, submitting that any extension would be futile as this Court does not have the power to receive fresh evidence as Clodumar argues. Alternatively the Committee contends that if fresh evidence is permissible, it should not be received by this Court on the grounds of the availability of that evidence at trial with reasonable diligence and prejudice to the Committee on the basis that key witnesses have died.

On 22 November 2011, Gummow J ordered that certain persons, said to be beneficiaries of the deceased's estate, be added as second respondents. Those respondents have indicated that while they would support the Committee's position, for financial reasons they will not participate in the appeal and they will abide the Court's decision.

The grounds of appeal include:

- Whether fresh evidence, constituted by the copy of the Residential Approval, should be admitted in this appeal brought pursuant to the *Nauru (High Court Appeals) Act* 1976 (Cth).

- Whether the fresh evidence in this case justifies its reception on appeal.