

Bird & Bird

Australia

Patent Litigation Q&A

June 2025



Australia – Patent Litigation

Where can patent infringement actions be started? Is there a choice of venue?

Patent infringement actions are primarily heard by the Federal Court of Australia (Federal Court). While State and Territory Supreme Courts also have jurisdiction to hear patent infringement matters, infringement proceedings are typically brought in the Federal Court because there are numerous judges with patent (and other IP) expertise and technical qualifications.

Are the judges' specialists? Do they have technical backgrounds?

The Federal Court has an Intellectual Property National Practice Area with a specific sub-area for Patents & Associated Statutes. There are 13 judges allocated to the Patents & Associated Statutes sub-area that hear patent matters and have extensive patent experience.

In the Federal Court there are some judges who have specific technical backgrounds.

How long does it take from starting proceedings to trial?

The aim of the Federal Court is to bring cases to trial within 12-18 months of commencement.

Can a party be compelled to disclose documents before or during the proceedings?

There are several ways to compel a party to disclose documents.

If a party believes that it may have a claim or the right to obtain relief, but it does not have sufficient information to decide whether to bring proceedings, it can seek preliminary discovery of documents from the opposing party.

Once proceedings have begun, a party can still seek discovery of documents from the other party by making an application with the court, on the basis that discovery will facilitate the just resolution of the proceeding as quickly, inexpensively and efficiently as possible. However, the parties do not have a guaranteed right to discovery. The Court will not approve expansive or unqualified requests. If the Court orders discovery, the parties have a continuing obligation to make discovery.

Parties can also use 'Notices to Produce' to compel the other party to produce a document or thing, within its "control" (i.e., possession, custody or power).

How are arguments and evidence presented at the trial?

Parties can present their arguments by way of written submissions and oral submissions.

Any affidavit evidence that is relied on by a party will be formally 'read' at the hearing, and the person that gave the affidavit will then usually be required for cross-examination.

How long does the trial generally last and how long is it before a judgment is made available? Are judgments publicly available?

Trials for patent infringement may last anywhere between 5-7 days. If there is a cross-claim for invalidity, such matters can run anywhere between 10 and 15 days.

A judgment can usually be expected some 6 to 12 months after the conclusion of the trial. Judgments are typically published on the Federal Court website within 24 hours of them being delivered.

Can a defence of patent invalidity be raised? Are infringement and validity issues heard together?

A party that has been sued for patent infringement can raise a defence of invalidity, and cross-claim for invalidity.

Infringement and validity issues are normally heard together. However, in infringement proceedings it is common for issues relating to liability for infringement to be considered separately from issues relating to the quantum of relief that the patentee may be entitled to recover if they successfully establish infringement.

Are infringement proceedings stayed pending resolution of validity in the national patent office (or, if relevant, the EPO) or another court?

No, re-examination of the patent in the Australian Patent Office cannot occur while proceedings are pending in the Court. The Federal Court Rules also require the party who has commenced infringement proceedings to serve copies of the pleadings on the Commissioner of Patents, so that the Australian Patent Office has notice of pending infringement proceedings.

Are preliminary injunctions available? If they are, can they be obtained *ex parte*? Is a bond necessary? Can a potential defendant file protective letters?

Preliminary injunctions are available and can be obtained *ex parte* in urgent cases. In deciding whether to grant a preliminary injunction against an alleged infringer, the court will make these enquiries: (i) whether the patentee has a *prima facie* case (i.e. there is a probability that the patentee will succeed at the final hearing); (ii) whether the balance of convenience favours the granting of the injunction (this involves an assessment of the harm to the applicant and prejudice to the respondent in ordering the injunction); (iii) whether damages are likely to be an adequate remedy if an injunction is not granted.

A party does not need to give a bond, but it will need to give the 'usual undertaking as to damages' whereby it undertakes to submit to any order of the Court for the payment of compensation to any person affected by the operation of the injunction. If a preliminary injunction is granted but the patentee is ultimately unsuccessful at trial, then the alleged infringer, and any other third parties who have suffered loss as a result of the grant of the injunction, can make a claim on the undertaking given by the patentee. However, the claimant on the undertaking bears the burden of proving, on the balance of probabilities, that the loss was caused by the grant of the injunction.

Protective letters cannot be filed with the Court to protect against *ex parte* injunctions.

Are final injunctions available as of right? Is a bond necessary?

Final injunctions may be granted, as well as any other relief orders that the Court sees fit. Injunctions are discretionary and not available as of right.

A bond is not necessary.

What other remedies are usually ordered if a patentee is successful?

Available remedies that may be ordered include declarations of infringement, damages, or an account of profits, and additional damages (though additional damages are rarely ordered).

Would the tribunal consider granting cross-border relief?

The tribunal would not consider granting cross-border relief.

Is there a right of appeal from a first instance judgment? How long between judgment at first instance and hearing the appeal?

There is a right to appeal from a first instance judgment - a party can appeal to the Full Court of the Federal Court of Australia.

A party should allow between 4 to 6 months for appeal to be heard (it will be heard during one of the designated sitting periods of the Full Court).

Is an appeal by way of a review or a rehearing? Can new evidence be adduced on appeal?

An appeal is limited to the issues raised on appeal and is confined to oral and written submissions.

No new evidence can be adduced, and no submissions can be made that were not made at first instance.

What is the cost of a typical infringement action to first instance judgment? If the issues of invalidity and infringement are bifurcated, what is the cost of the invalidity action? Can the winner's costs be recovered from the losing party? How much is the cost of an appeal?

Depending on the complexity and range of expert evidence required, a party should expect costs of an infringement and invalidity action to be in the range of €500,000 and €1,252,500.

If the issues of invalidity and infringement are bifurcated (which does not normally occur), a party could anticipate costs of the invalidity action alone to be €380,000 – €940,000.

The winner should anticipate recovering between 60 and 75% of its costs from the losing party.

Costs of an appeal can range from €95,000 - €190,000, depending on the number of issues raised on appeal.

Author



Rebecca Currey

Partner

+61292269865

rebecca.currey@twobirds.com



Tom Johnston

Senior Associate

+61292269888

tom.johnston@twobirds.com

twobirds.com

Abu Dhabi • Amsterdam • Beijing • Bratislava • Brussels • Budapest • Casablanca • Copenhagen • Dubai
• Dublin • Dusseldorf • Frankfurt • The Hague • Hamburg • Helsinki • Hong Kong • London • Lyon • Madrid
• Milan • Munich • Paris • Prague • Rome • San Francisco • Shanghai • Shenzhen • Singapore • Stockholm
• Sydney • Tokyo • Warsaw

The information given in this document concerning technical legal or professional subject matter is for guidance only and does not constitute legal or professional advice. Always consult a suitably qualified lawyer on any specific legal problem or matter. Bird & Bird assumes no responsibility for such information contained in this document and disclaims all liability in respect of such information.

This document is confidential. Bird & Bird is, unless otherwise stated, the owner of copyright of this document and its contents. No part of this document may be published, distributed, extracted, re-utilised, or reproduced in any material form.

Bird & Bird is an international legal practice comprising Bird & Bird LLP and its affiliated and associated businesses.

Bird & Bird LLP is a limited liability partnership, registered in England and Wales with registered number OC340318 and is authorised and regulated by the Solicitors Regulation Authority (SRA) with SRA ID497264. Its registered office and principal place of business is at 12 New Fetter Lane, London EC4A 1JP. A list of members of Bird & Bird LLP and of any non-members who are designated as partners, and of their respective professional qualifications, is open to inspection at that address.