

IN THE HIGH COURT OF AUSTRALIA  
SYDNEY REGISTRY

No. *S389* of 2011

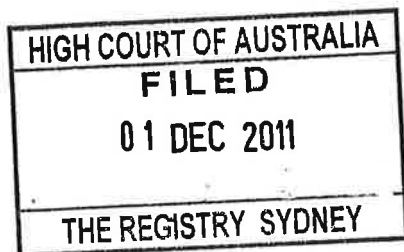
BETWEEN:

**British American Tobacco Australasia Limited**  
ACN 002 717 160  
First Plaintiff

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**British American Tobacco (Investments) Limited**  
BCN 00074974  
Second Plaintiff

**British American Tobacco Australia Limited**  
ACN 000 151 100  
Third Plaintiff



20

**The Commonwealth of Australia**  
Defendant

**WRIT OF SUMMONS**



TO: The Defendant  
The Commonwealth of Australia  
Australian Government Solicitor's Office  
Level 42 MLC Centre  
19 Martin Place  
Sydney NSW 2000

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TAKE NOTICE that this proceeding has been brought against you by the plaintiffs for the claim set out in this Writ.

IF YOU INTEND TO DEFEND the proceeding you must file a notice of appearance in the office of the Registry named above.

Date of document: 1 December 2011

Filed on behalf of: **The plaintiffs**

Prepared by: **Corrs Chambers Westgarth**

Lawyers  
Level 32  
Governor Phillip Tower  
1 Farrer Place  
Sydney NSW 2000

Solicitors Code 9973  
Tel: (02) 9210 6500  
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Ref: BJW/JXM 9056488  
James Whittaker/Jim  
Micallef

IF YOU ARE WILLING TO SUBMIT to any order that the Court may make, save as to costs, you may file a submitting appearance in the office of the Registry named above.

THE TIME FOR FILING AN APPEARANCE is as follows:

- (a) where you are served with the application within Australia – 14 days from the date of service; and
- (b) in any other case – 42 days from the date of service.



## STATEMENT OF CLAIM

### Jurisdiction of the High Court of Australia

- 1 This proceeding is within the original jurisdiction of the High Court of Australia by reason of:
- (a) section 75(iii) of the Constitution, being a matter in which the Commonwealth is a party; and
  - (b) section 76(i) of the Constitution and section 30(a) of the *Judiciary Act 1903* (Cth), being a matter which arises under the Constitution or involves its interpretation.

### 10 Parties

- 2 The first plaintiff is a corporation incorporated under the *Corporations Act 2001* (Cth) and entitled to sue.
- 3 The second plaintiff is a corporation incorporated under the laws of England and Wales and entitled to sue.
- 4 The third plaintiff is:
- (a) a corporation incorporated under the *Corporations Act 2001* (Cth) and entitled to sue; and
  - (b) a wholly owned subsidiary of the first plaintiff.
- 5 The defendant (**Commonwealth**) is and was at all material times a polity able  
20 to be sued.

### Plaintiffs' property

- 6 The first plaintiff is the owner of:
- (a) the trade marks:
    - (i) registered under the *Trade Marks Act 1995* (Cth) set out in Annexure A; and



(ii) not registered pursuant to the *Trade Marks Act 1995* (Cth) set out in Annexure B,

(“**the Trade Marks**”), and is entitled to use the Trade Marks for tobacco products and the packaging of tobacco products in Australia and to authorise others to carry out such acts;

(b) copyright subsisting in artistic and literary works set out in Annexure C (“**the Copyright Works**”), and is entitled to reproduce the Copyright Works for tobacco products and the packaging of tobacco products in Australia and to authorise others to carry out such acts;

10 (c) distinctive trade dress and get up, including size, shape, arrangements of words, colours, decorations, designs, logos, lettering and markings for tobacco products which use the Trade Marks and/or reproduce the Copyright Works (“**the Get Up**”) and is entitled to authorise others to use the Get Up; and

(d) the substantial reputation and goodwill arising from the use in Australia by the third plaintiff of the Trade Marks, the Copyright Works and/or the Get Up in conjunction with tobacco products and the packaging of tobacco products (“**the Licensing Goodwill**”).

7 The second plaintiff is:

20 (a) the registered owner of the design registered under the *Designs Act 2003* (Cth) set out in Annexure D (“**the Design**”); and

(b) the patentee of the patents registered pursuant to the *Patents Act 1990* (Cth) set out in:

(i) Annexure E-1 (“**the E-1 Patent**”); and

(ii) Annexure E-2 (“**the E-2 Patent**”),

(together, “**the Patents**”),



and is entitled to import, make, offer for sale, sell and use products which embody the Design, and to exploit the Patents for the packaging of tobacco products in Australia and to authorise others to carry out such acts.

8 The third plaintiff:

- (a) manufactures in, imports into, owns and sells in Australia tobacco products and packaging of tobacco products;
- (b) has the rights (subject to lawful exception) (“**the Packaging Rights**”):

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- (i) to manufacture, import, sell and use tobacco products and packaging of tobacco products in such shape or design as it may choose; and
- (ii) to print or to use on the tobacco products and packaging of tobacco products such trade marks or copyright works or designs or patents or messaging (including on behalf of third parties) as it may choose;

- (c) by reason of the above, owns substantial goodwill attaching to its exploitation in Australia of the Packaging Rights (“**the Packaging Goodwill**”), not being goodwill arising from the use of intellectual property on or in relation to the tobacco products and packaging of tobacco products; and

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- (d) has and exercises the rights pursuant to licences (“**the IP Licence Rights**”):
  - (i) to use the Trade Marks in Australia for tobacco products and packaging for those tobacco products, and to reproduce and publish the Copyright Works and/or to use the Get Up; and
  - (ii) to manufacture and sell in Australia tobacco products in tobacco product packaging where such packaging embodies the Design and/or exploits the E-1 Patent.

### Acquisition otherwise than on just terms



9 The provisions of the *Tobacco Plain Packaging Act 2011* (Cth) (“**the Packaging Act**”), particularly Chapter 2 thereof:

(a) would, but for the operation of section 15, result in an acquisition of the first, second and/or third plaintiffs’ property comprising the Trade Marks, the Copyright Works, the Get Up, the Licensing Goodwill, the Design, the Patents, the Packaging Rights, the Packaging Goodwill and the IP Licence Rights otherwise than on just terms; and

10

(b) by reason of section 15, do not apply to and have no operation with respect to the plaintiffs’ tobacco products and packaging of tobacco products.

### Invalidity

10 Further or alternatively, the Packaging Act is invalid, in that it purports to confer legislative power upon the judicial branch of government, by reason of the fact that the extent to which conduct is rendered criminal by the Packaging Act is determined by the extent to which section 51(xxxi) of the Constitution would, but for section 15 of the Packaging Act, be engaged.

11 Further or alternatively, the Packaging Act is invalid by reason that:

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(a) it purports to identify, as the circumstances to which it applies, those circumstances (and only those circumstances) which would not result in section 51(xxxi) being engaged; and

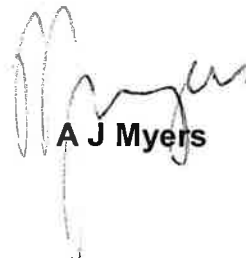
(b) such provision is, in substance and effect, no different from a law which provides that “This law applies only in the circumstances in which its application is valid”, which is not a valid exercise of legislative power.

12 Further or alternatively, the Packaging Act is invalid because it does not provide for a rule of conduct or a declaration as to power, right or duty and its purported enactment did not involve an exercise of the powers to make “laws” conferred upon the Commonwealth Parliament by the Constitution.

**Relief**

The plaintiffs claim the following relief:

- A A declaration that the Packaging Act does not apply and has no operation with respect to the plaintiffs' tobacco products and packaging of tobacco products because, but for the operation of section 15, its operation would result in an acquisition of the first, second and/or third plaintiffs' property comprising the Trade Marks, the Copyright Works, the Get Up, the Licensing Goodwill, the Design, the Patents, the Packaging Rights, the Packaging Goodwill and/or the IP Licence Rights otherwise than on just terms.
- 10 B Alternatively, a declaration that the Packaging Act is invalid.
- C Costs.
- D Such further or other orders as the Court deems fit.

  
A J Myers

M J Leeming



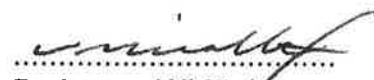
C M Archibald

  
N J Owens



This writ was filed by Corrs Chambers Westgarth on behalf of the plaintiffs.

20 Dated 1/12/2011

  
B. James Whittaker  
Solicitor for the plaintiffs  
*by his employee*  
*James McBeath*

The plaintiffs' address in Australia is:

Virginia Park,  
1 Westfield Drive,  
Eastgardens, New South Wales 2036


The plaintiffs' address for service is:

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Corrs Chambers Westgarth,  
Governor Phillip Tower,  
1 Farrer Place  
Sydney, New South Wales 2000




## Annexure A – Registered trade marks

Number	Details	
270845	Trade mark	Word: WINFIELD W CLASS A  
	Class	34
	Status	Registered/Protected
	Owner	British American Tobacco Australasia Limited
	Registered from	31 July 1973
	Endorsements	<p>In use the description of goods appearing in the mark is varied in accordance with the application of the mark to other goods comprised in the specification. Registration of this trade mark shall give no right to the exclusive use of the letter "W". The words appearing in the coat of arms maybe translated as "I FORCE NO FRIEND I FEAR NO FOE". The preceding endorsement(s) were recorded prior to commencement of the <i>Trade Marks Act 1995</i>.</p> <p>This mark was registered under the <i>Trade Marks Act 1955</i> in Part A.</p>




Number	Details	
752287	Trade mark	Word: <b>WINFIELD W</b>  
	Class	34
	Status	Registered/Protected
	Owner	British American Tobacco Australasia Limited
	Registered from	7 January 1998
	Endorsements	The second and third trade marks in the series of trade marks are depicted in the colours RED, BLUE, GOLD and WHITE as shown in the representation attached to the application form.




Number	Details	
917043	<b>Trade mark</b>	Word: <b>WINFIELD W</b>  
	<b>Class</b>	34
	<b>Status</b>	Registered/Protected
	<b>Owner</b>	British American Tobacco Australasia Limited
	<b>Registered from</b>	20 June 2002
	<b>Endorsements</b>	<p>The FIRST and SECOND trade marks in the series of trade marks is depicted in the colours BLACK and WHITE, the THIRD trade mark in the series of trade marks is depicted in the colours RED, WHITE and GOLD, the FOURTH trade mark in the series of trade marks is depicted in the colours BLUE, WHITE, RED and GOLD, the FIFTH trade mark in the series of trade marks is depicted in the colours SILVER, WHITE, GOLD and RED, the SIXTH trade mark in the series of trade marks is depicted in the colours GOLD, WHITE and RED, all as shown in the representations attached to the application form</p>



Number	Details	
1326870	Trade mark	Word: W WINFIELD OPTIMUM NIGHT  
	Class	34
	Status	Registered/Protected
	Owner	British American Tobacco Australasia Limited
	Registered from	20 October 2009



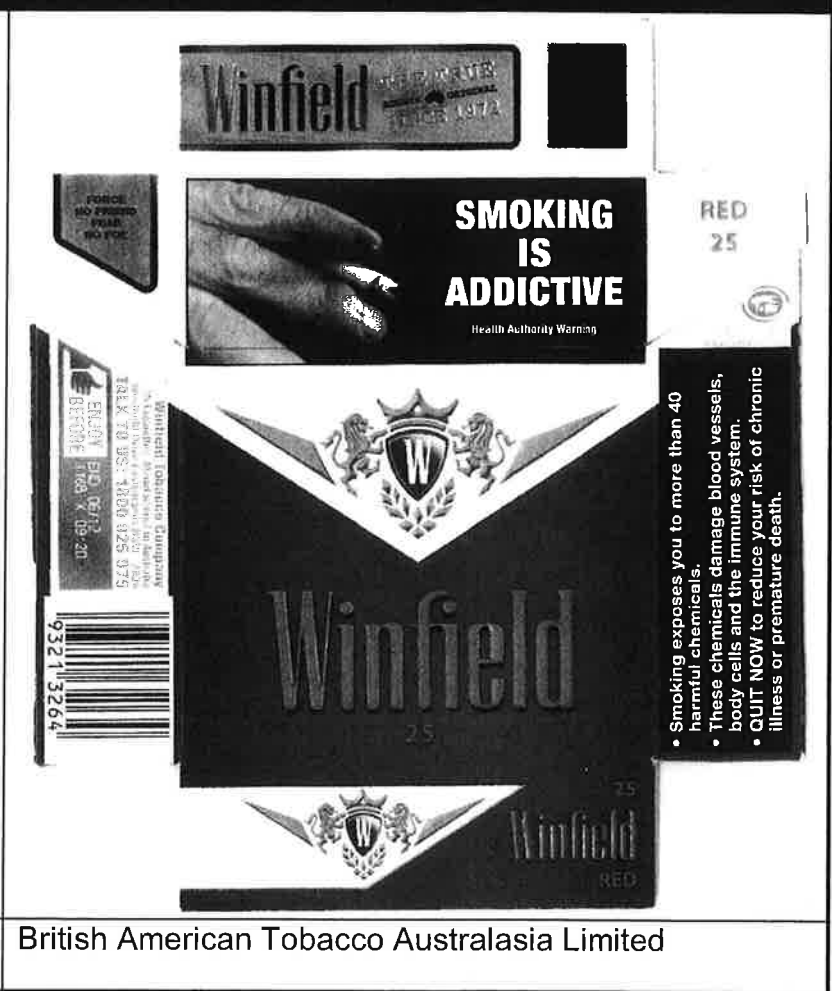
**Annexure B – Unregistered trade marks**

Pack	Details	
<p><b>Winfield Optimum Night</b></p>	<p><b>Trade mark</b></p>	
	<p><b>Owner</b></p>	<p>British American Tobacco Australasia Limited</p>



Pack	Details	
<p><b>Winfield Blue</b></p>	<p><b>Trade mark</b></p>	
	<p><b>Owner</b></p>	<p>British American Tobacco Australasia Limited</p>



Pack	Details	
<p>Winfield Red</p>	<p>Trade mark</p>	 <p>FORCED TO SMOKE FEAR NO FEAR</p> <p><b>SMOKING IS ADDICTIVE</b> Health Authority Warning</p> <p>RED 25</p> <p>British Tobacco Company 11, Market Street, Adelaide, South Australia 5000 TEL: 81 93 1000 FAX: 81 93 1000 9321 3264</p> <p>Winfield 25</p> <p>Winfield 25 RED</p> <ul style="list-style-type: none"> <li>• Smoking exposes you to more than 40 harmful chemicals.</li> <li>• These chemicals damage blood vessels, body cells and the immune system.</li> <li>• QUIT NOW to reduce your risk of chronic illness or premature death.</li> </ul>
	<p>Owner</p>	<p>British American Tobacco Australasia Limited</p>



Pack	Details	
<p><b>Winfield Silver</b></p>	<p><b>Trade mark</b></p>	
	<p><b>Owner</b></p>	<p>British American Tobacco Australasia Limited</p>





Annexure C – Copyright works

Pack	Details	
<p><b>Winfield Optimum Night</b></p>	<p><b>Work</b></p>	
	<p><b>Owner</b></p>	<p>British American Tobacco Australasia Limited</p>



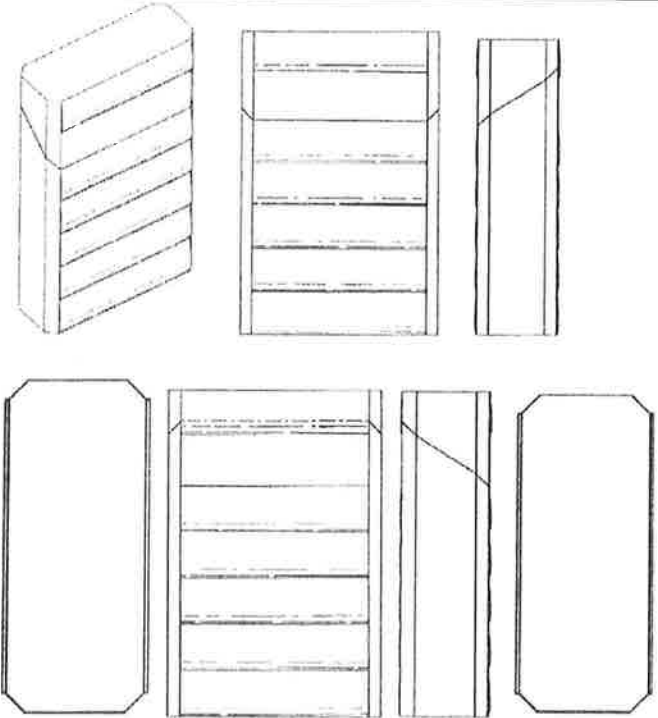
Pack	Details	
<p>Winfield Blue</p>	<p>Work</p>	
	<p>Owner</p>	<p>British American Tobacco Australasia Limited</p>

Pack	Details
<p><b>Winfield Red</b></p>	<p><b>Work</b></p> <p><b>Owner</b></p> <p>British American Tobacco Australasia Limited</p>

Pack	Details	
<p><b>Winfield Silver</b></p>	<p><b>Work</b></p>	<p><b>Winfield</b> 25</p> <p>9321 3271 POSITIONAL ONLY</p> <p>Smoking during pregnancy reduces the flow of blood in the placenta and limits the oxygen and nutrients reach the growing baby. This increases the risk of miscarriage, stillbirth, premature birth, complications during birth or the baby having a smaller brain and body.</p> <p>You CAN quit smoking. Call Quitline 131 848 talk to your doctor or pharmacist, or visit <a href="http://www.quitnow.nf.au">www.quitnow.nf.au</a></p> <p>ALWAYS READ THE TIPS ON EACH TOBACCO PACK USE CARE IN DISPOSAL</p> <p><b>SMOKING HARMS UNBORN BABIES</b> Health Authority Warning</p> <p><b>SMOKING - A LEADING CAUSE OF DEATH</b> Health Authority Warning</p> <p><b>TOBACCO - 19,019</b> Alcohol - 2,831 Motor Vehicle Accidents - 1,731 Illegal Drugs - 863 Murders - 203 CAUSES OF DEATH IN AUSTRALIA*</p> <p>PRINTERS MARKS COUNTRY SAP CODE</p> <p>SILVER 25</p> <p>SILVER 25</p> <p>THE SEAL OF THE HIGH COURT OF AUSTRALIA</p>
	<p><b>Owner</b></p>	<p>British American Tobacco Australasia Limited</p>

Pack	Details	
<p><b>Winfield Gold</b></p>	<p><b>Work</b></p>	<p><b>Winfield 25</b></p> <p>9321 13271 POSITIONAL ONLY</p> <p><b>SMOKING HARMS UNBORN BABIES</b></p> <p>Health Authority Warning</p> <p><b>SMOKING-A LEADING CAUSE OF DEATH</b></p> <p>Health Authority Warning</p> <p>TOBACCO - 19,019 Alcohol - 2,831 Motor Vehicle Accidents - 1,731 Illegal Drugs - 863 Murders - 203 CAUSES OF DEATH IN AUSTRALIA*</p> <p><b>SMOKING exposes you to more than 40 harmful chemicals.</b> • These chemicals damage blood vessels, body cells and the immune system. • <b>QUIT NOW</b> to reduce your risk of chronic illness or premature death.</p> <p>PRINTING MARKS COUNTRY SAP CODE</p> <p>GOLD 25</p> <p>THE SEAL OF THE HIGH COURT OF AUSTRALIA</p>
	<p><b>Owner</b></p>	<p>British American Tobacco Australasia Limited</p>

## Annexure D – Registered design

Number	Details	
AU 323481	<b>Article/product name</b>	Ribbed pack
	<b>Lodgement date</b>	31 October 2008
	<b>Statement of Newness and Distinctiveness (as registered)</b>	Newness and distinctiveness resides in the features of shape and configuration of a ribbed pack as illustrated in the accompanying representations.
	<b>Representations</b>	 <p>The 'Representations' section contains two sets of technical drawings. The top set shows a perspective view of a rectangular pack with horizontal ribs, followed by a front view and a side view. The bottom set shows a perspective view of a rectangular pack with horizontal ribs, followed by a front view, a side view, and a back view. All views illustrate the ribbed structure of the pack.</p>
<b>Owner</b>	British American Tobacco (Investments) Limited	

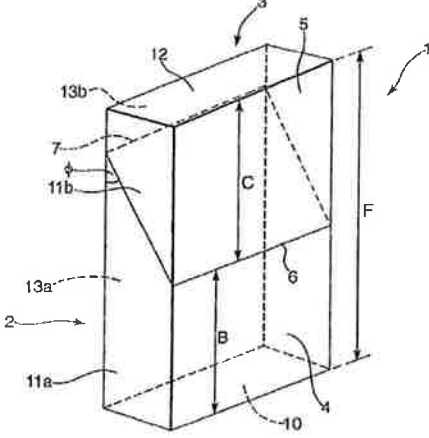


## Annexure E-1 – Patents

Number	Details	
2001258572	<b>Title</b>	Smoking article packaging
	<b>Filing Date</b>	22 May 2001
	<b>Abstract contained in specification</b>	<p>The invention relates to a smoking article package, which package comprises a sealed enclosure around a charge of smoking articles and a sheet material wrap disposed exteriorly of the enclosure. The sheet material wrap is so configured as to provide means by which the first opening of the enclosure cannot take place without the wrap being torn or partially or fully removed.</p>
	<b>Illustration</b>	
<b>Owner</b>	British American Tobacco (Investments) Limited	



## Annexure E-2 – Patents

Number	Details	
2007202891	<b>Title</b>	Pack for smoking articles
	<b>Filing Date</b>	21 June 2007
	<b>Abstract contained in specification</b>	This invention relates to a smoking article pack. The pack and the inner frame used in combination therewith provide a substantially increased internal surface area for the printing of graphics and/or indicia in order to provide information to the consumer whilst not substantially increasing the surface area of the blank required to make the body of the pack.
	<b>Illustration</b>	<p data-bbox="861 840 941 873">Fig.1.</p> 
<b>Owner</b>	British American Tobacco (Investments) Limited	

