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In Conversation with The Right Honourable Sir Thomas Gault

Sheana Wheeldon
Kensington Swan

It is no exaggeration to describe Sir Thomas Gault as New Zealand's most eminent IP personage. Having begun his legal career in 1961 as a young lawyer at AJ Park in Wellington, Sir Thomas qualified as a patent attorney but soon became recognised as a skilled IP litigator, subsequently moving to the independent Bar and taking silk in 1984. In that career he was involved in many high profile IP cases, and took this depth of expertise with him on his appointment in 1987 to the New Zealand High Court Bench. Sir Thomas was quickly promoted to the Court of Appeal (eventually being appointed President), and finally to the New Zealand Supreme Court. IP practitioners enjoyed a golden period of knowing there was one Judge who spoke our language as his native tongue, and Sir Thomas penned many of New Zealand's leading IP judgments while on the Bench. In 2001, Sir Thomas was named a Distinguished Companion of the New Zealand Order of Merit (the then equivalent of a Knighthood) for services to the law.

In what could be seen as a parallel career, Sir Thomas has throughout his lifetime been involved in the golfing world, including in its administration in New Zealand and as a referee at the British Open Championships. In 2005, Sir Thomas had the honour of being offered the Captaincy of the Royal and Ancient Golf Club of St Andrews in Scotland, and brought forward his retirement to take up this prestigious role. Sir Thomas was based at St Andrews for two years, during which he travelled and undertook extensive speaking engagements as "ambassador for the sport". He remains involved in the golfing world, one of his ongoing obligations being to participate in appointing new Captains of the Royal and Ancient. I spoke to Sir Thomas about some of the events and highlights of his stellar careers in both the law and golf.

Q: Starting at the beginning, you studied law at Victoria University and then spent 20 years at AJ Park. Tell me how you came to be interested in intellectual property law?

A: I don't know if I have met anybody who has got in there other than by accident. I was still at Victoria University and I had in mind practising law outside Wellington, and I stayed to do a Master's degree. We all studied part-time in those days so I needed a job and AJ Park were, I think, offering a little bit more for law clerks than most others. So, I got a job there. Principally it was trade mark work but they had a small general legal practice as well and I more or less ran that on the side so to speak.

Q: Were you much involved in litigation?

A: Not initially, because there was not much intellectual property or trade mark litigation at that time, but what there was I did and

it gradually grew. One of the partners, Arch Callander, who was a patent man, did some also and we would tend to work together on some of the bigger IP cases that came along.

Q: I remember Arch Callander.

A: He was a man of wide skills. He had been in the war, a pilot, then he worked at the Taranaki Power Board I think, married, had a family, and then took a job at AJ Park basically as a technical draftsman. He eventually qualified as a patent attorney and then as a lawyer, all while he had a young family. He was a very interesting chap. After he retired he lived not far from my home and I used to see him from time to time. He was always going to the library. He loved technical books.

Q: You did law before doing the patent attorney exams. How did you find the patent attorney exams?

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A: I did not have any difficulty with the legal side of it, the technical side was difficult and I think they were rather kind to pass me.

Q: Over those 20 years did you specialise in trade marks and litigation for all that time, or did it develop more into litigation that you then ended up going to the Bar?

A: As the country developed and there was more commercial activity we got involved more in litigation work. We had a lot of overseas-sourced instructions and we got all sorts of litigation work from there, so that's where I tended further into litigation.

Q: Can you recall any particularly interesting or exciting cases that were highlights during that time?

A: We had a lot. There were some major wars among the pharmaceutical companies, and there was a lot of very interesting and good work for companies like Monsanto and ICI, so that was always very good work.

Q: Were those patent infringement cases?

A: One or two of the big ones were infringement cases, often they were challenges to validity and attacks on patentability and that sort of thing.

Q: By the infringer of course, counterclaiming?

A: Yes. On the trade mark side there was an increasing number of interesting cases, wine name cases and the like. A wonderful case took us to Germany – *Bernkastel* and *Bern Kaizler*, I think, were the trade marks involved. I was acting for the German Wine Authority. We found Julian Miles on the other side so we were having a good tussle. We eventually met in this lovely old castle on the banks of the Rhine, had a wonderful dinner and settled.

Q: Perfect outcome!

A: Oh yes.

Q: So was *Bernkastel* the wine name?

A: Yes. The German Wine Authority were very protective of the geographical names of which *Bernkastel* was one, and I think it was Montana that came up with *Bern Kaizler* which was an ordinary New Zealand white wine.

Q: And you settled it to the Germans' satisfaction?

A: Yes. Then we had another interesting one; it was the first comparative advertising case again involving wine.

Q: Was that *Villa Maria v Montana*?

A: Yes. Montana again. Then we had, perhaps a bit later, the *Champagne* case.

Q: So were you acting on that case before you went to the Bench?

A: I had advised in some respects but not the immediate dispute. I think I might even have been in the Court of Appeal before it was finally decided. It was around for a long time before that. Of course, the French were suing whoever they could trying to protect the geographical name.

Q: Having notably failed to do so in Australia back then at that time. And was Julian Miles making the most of what he had learned from the German case?

A: He and I were perhaps the main litigators in the IP field. In most of the big cases we were on opposite sides. We were good friends of course and he was always good fun.

Q: I was going to ask you about the period around the 1970s. My impression is that that was the time when copyright was suddenly being turned to protecting industrial designs which had not been anticipated. Were you involved in any of those cases?

A: Yes I was. Arch Callander, who was my partner at the time, was involved in the first one which was the lavatory pans case (*Johnson v Bucko*). Then I did quite a number of other ones such as the *Frisbee* case.

Q: Oh yes, *Whamo*.

A: Yes. We did a lot of work, it didn't all get to Court, but there were some quite big trials in that period. There was one for an American company which I do not necessarily think we should have won, but did. It is hard to recollect the details of some of them, but there were a lot of them in that copyright design area.

Q: The conversion damages issue was one of the big parts of the *Frisbee* case wasn't it?

A: Yes. It was quite late in the piece before legislation got to that issue, but yes it was quite a significant factor, although like most IP cases you went to trial on liability but not very many went right through to an assessment of damages. One or two may have but we generally settled, and I don't remember any full-on quantum cases that went all the way, they settled.

Q: My impression is that most of them end at the interim injunction stage and then settle.

A: Yes. There is a flood of interim injunction work. I suppose through the late '80s to the early '90s that was the popular thing to apply for. Of course, sooner or later one went to trial which took away the enthusiasm.

Q: Moving from your time in practice to being on the Bench from 1987, did you have any reservations about leaving practice and going to the Bench?

A: I am sure everybody who is appointed to the Bench worries about how it will go with certain economic questions in the back of your mind. But no, I went on to the Bench almost with a bit of relief. I was practising as a barrister, hugely busy taking me all over the country and I worried that sooner or later I would make a big mistake or mess something up just through sheer burden of work.

I was rushing from one town to another to do some trial and the Chief Justice got me on the phone at a weak moment. I couldn't think of anything better than to give up all those cases. I had got caught up with a big Maori case. One of the principles of practising as a barrister is that you have to take it if you can. I was asked to represent the Maori applicants in a hearing to determine who would have the third television channel and I certainly didn't want to do it. I was quite busy enough and this was going to take ages. So I said to the solicitor that I couldn't do it, that I was too busy, and he very cleverly said we "will take you subject to all you have on" – in other words, we want to have you, so you can't refuse. So I took it on. I certainly couldn't go every day and that made it all the more difficult because this thing lasted a year. I would have to suddenly bone up on where the thing was up to when I had to appear for cross examination or argument on a particular part of the case. What with that and everything else I was working harder than I really felt I should be, so I was relieved when I was given the opportunity to leave it all behind.

Q: And what about afterwards, did you feel it was the right thing to do, the right move?

A: Oh why yes I think it is a matter of whether it suits you temperamentally. I didn't have any problems on that score. It involved moving my home to Auckland from Wellington, with

which I was quite happy. I think I was about to do that anyway because I seemed to have more work there than anywhere else. So we moved up here, but then I was only here for three years and I was asked to go back to the Court of Appeal. I therefore went to the Court of Appeal and, of course, I was there for a long time.

Q: I remember at an NZIPA conference in the very early '90s hearing you say that you had thought you might be allocated IP cases when you were appointed to the Bench but you seemed to have been allocated a whole bunch of criminal ones. I don't know if that changed. Do you have a view on specialisation on the Bench or lack of it?

A: I believe that the best use of talent is to specialise although that view is controversial. The Chief Justice doesn't favour that view. I always did and thought you must play to strengths, but I recognised that when I went on the Bench I would have to do everything and of course I had a pretty sharp introduction to criminal law because I hadn't done any of that, and we had to do our share. But IP cases did tend to find their way to me somehow. I did much of what was there and again; there wasn't that much early on but it gradually increased.

Q: It seems to me that once you were in the Court of Appeal you became the author of a number of important IP judgments.

A: Well, yes. I think that was inevitable and I would be asked to sit on those and then of course asked to write the judgments. I did do most of those Court of Appeal ones.

Q: And a great thing for the IP profession was to know that there was an IP judge!

A: Well, it probably encouraged a few more to go to the Courts, it gave them some assurance that they wouldn't have to start by trying to explain the very basics. It saved time and I think it was appreciated.

Q: I can tell you it was, and that it was a tragedy when you went off to St Andrews.

A: I was going to have to anyway as I was age bound. I only retired a few months before I had to.

Q: Are there any appeal cases that you would see as highlights?

A: I finally did my last IP judgment on the *Lucas v Peterson* patent invalidity case. I did

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an interesting copyright case earlier (*Bleiman v News Media (Auckland) Ltd*). It was an interlocutory injunction. In fact, I did an oral, but I did quite a long judgment on the copyright issue because I thought it was the only chance I would get to write it.

Q: I think something that we practitioners do really appreciate is to get a well-reasoned judgment in an IP case because so few cases get to trial, let alone to appeal in New Zealand.

A: That's right.

Q: We have so little of our own case law, so it is very helpful to get a judgment that really sets it out. One of the highlights for me was the Supreme Court decision which you wrote in *Lucas v Peterson* where you had already knocked out Claim 7 on lack of novelty, but you also went right through and spelt out the law on obviousness for New Zealand, which is fantastic.

A: Again, that is one of the advantages of specialisation and I suppose I had that background.

Q: Do you remember the HEALTHY CHOICE case, *McCain v Conagra*?

A: Yes.

Q: I was pleased to see the result on that because I thought that was never a trade mark, but it had to go to the Court of Appeal for that decision to be made.

A: Yes, I think that wasn't quite as difficult as the other one that went to the Court of Appeal. I think we finally decided this mark was registrable but it was very controversial.

Q: VINTAGE?

A: Ah yes. That was very controversial. I think maybe in retrospect that the parties could have come up with a bit better evidence. They could probably have found instances of generic use but they didn't. It was interesting because I know a lot of people would say the VINTAGE decision was wrong.

Q: I think it is really borderline, but my personal view is that for cheese it's got enough, it's got that molecule of distinctiveness.

A: That's what I thought. I was concerned that there could be some generic use that we weren't being told about.

Q: I was going to ask you about being with the Court of Appeal as opposed to in the High Court at first instance. Was that different? Was it frustrating not having heard the evidence or was it better?

A: Again, I think it is what suits you temperamentally. I found the Court of Appeal suited me. It is different – a bit more remote than witness actions. I don't think it is for everybody but it is intellectually more demanding. I enjoyed the appeal work; sitting with others on a panel on cases. I think you get a lot of satisfaction there.

Q: Moving away from the legal side of things, I would like to talk briefly about your other career in the golfing world. I understand you have been a golfer for a long time?

A: A lifetime!

Q: How did you come to be connected with St Andrews?

A: I was involved in golf administration in New Zealand in the quite early days and New Zealand Golf was affiliated internationally to Royal and Ancient in St Andrews. That is really the governing authority for the sport and so I became involved in meetings about rules of golf and that sort of thing. Being a lawyer I suppose I was a natural for that role. That used to take me to Scotland from time to time representing the New Zealand Golf Association. When I was doing a stint in the Privy Council in the early '90s I was asked if, while I was in London, I would like to referee at the Open Championship in Britain that was being held at the time at Royal St George's near Dover. I did that, and I had a very enjoyable time over the week of the Open Championship, so much so that I went back and did that every year for the next six years. Of course, in that way I became known in the wider golf world. I had finished all of that connection when I received a letter asking me if I would be prepared to take on the Captaincy. It is a very respected and prestigious position and the timing was marvellous because I was about to retire anyway. I just brought forward my retirement and did that, which was really an exciting privilege.

Q: What did the job actually entail?

A: You are essentially an ambassador for the sport. You have nominal roles at general meetings and attend the administrative meetings, but only to

keep informed so you can be the spokesperson. It involved a huge amount of travel, lots of meetings and events, particularly around the United Kingdom, dinners and functions like that. It involved big speaking obligations. I was barely in New Zealand for more than a few weeks, and when my term ended, I had not been home long when my successor died in office, so I went back and stood in for him for the rest of his term. By the time I had done the necessary preliminary orientation beforehand and done the job I was away for much of two years.

Q: Did you enjoy living in St Andrews?

A: Indeed, they looked after me very well. Not that we were in St Andrews that much because we were travelling around Britain as well as many countries, it was a very busy travelling role. It was very special.

Q: Did your legal background come into it very much?

A: Not a lot really. I suspect I might not have been appointed if I did not have the legal and judicial background, but that might go more to status than experience. You never know why you are appointed.

Q: Do you see any symbiosis between the golfing career and law?

A: I think rather the great merit in it as far as I was concerned was the lovely contrast and to get away from the enclave of the law to do something quite different with different people.

Q: Do you still do any golfing here in Auckland?

A: I'm not playing much. Once you have held this office in St Andrews you have ongoing obligations – the past Captains meet and appoint the next one and that sort of thing, so I was in London just before Christmas. So, yes there is an ongoing link. It is not heavy but it is nice. It takes me there once or twice a year.

Q: Christmas time would be a bit cold to be in Scotland.

A: Yes, you stay inside. But I go back and of course I have so many good friends now over there.

Q: You would have been ahead of the William and Kate glory that St Andrews now has wouldn't you?

A: Oh yes. Prince Andrew was a Captain before

me so I see him and the meeting we had in December was at Buckingham Palace.

Q: How exciting! I was in St Andrews last May, and I saw notices in the cafes claiming that William and Kate had had coffees there and met there and whatever.

A: They really were pretty good, they left them alone while he was a student there. We were just talking the other day because we have a couple staying with us from St Andrews, and they said that Prince William was just someone else on the street.

Q: Would you have ever seen yourself doing anything other than law as a career? Or if you hadn't done law what would you have done?

A: No. It seemed to be assumed very early on that I would go into law. I think partly because I had an uncle who practised law in Wellington, and he seemed to be a sort of role model focus, so it was assumed I would eventually be in law. But certainly not IP law. Everybody gets into that by accident.

Q: Are there any IP issues you think need to be addressed at the moment, in the legislation for example?

A: I really am not the right person to ask because I am out of date in that respect. I watch with interest the continuing suggestions for changes and statutory amendment and so on, but of course you have got this complex international web of arrangements which constrain individual countries from doing a lot. In a way, that is quite good because it does stop these knee-jerk reactions you get in certain jurisdictions if somebody gets a bright idea or an economist has a big view about something. It does stabilise things a lot, but it also stifles progress in a way.

Q: A lot of countries have increased the copyright term from 50 to 70 years from the death of the author. Do you have any view on that?

A: I think uniformity is quite important. But that aside, copyright has huge problems hasn't it, with the electronic world. I don't know where it will go but it seems to be a little bit artificial to be discussing whether it should be 50 years or 70 years when the real issues in copyright are how it can survive with the electronic onslaught. It is certainly an interesting field.

Q: You wrote the Court of Appeal's judgment in the *Pharmac* case on patentability of Swiss

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claims. I don't know if you would want to express a view on methods of medical treatment that are patentable in Australia but not here in New Zealand and specifically ruled out by the new Patents Bill. Do you have a view on that?

A: I don't think it is very helpful having exceptions to patentability. I would be quite happy to see patents granted on things like computer programs and pharmaceutical products, but you would want a good robust obviousness and novelty approach so that you are not just handing out patents willy nilly, when really they are too cheap. But I think there are quite good arguments for not having exceptions.

Q: The *Pharmac* case was about Swiss claims. IPONZ had just overnight changed their practice on Swiss claims from not being allowable in New Zealand to being allowable in New Zealand. *Pharmac* was a judicial review of IPONZ's decision and you decided IPONZ was correct and that Swiss claims were valid. They are a way of partially getting around the prohibition on methods of medical treatment.

A: It is circumvention really isn't it?

Q: Yes, but only for a new use of a known medicament.

A: It seemed to me that if you get a sufficiently new inventive new use why not? Patentability is about providing that incentive, it is expensive enough.

Q: I think one of the rationales on methods of medical treatment is that if you find a new kind of operation to fix a heart, for example, doctors shouldn't be at risk of infringement. That was traditionally not an exclusion; it was just a policy. The actual reasoning is I think that it is not a manner of manufacture. Do you have a view on that sort of a method?

A: I certainly had a view on it, but I didn't think it was the problem people said it was. In practical real terms I can't really see an injunction to stop a medical procedure that is important and new. I think it is more a theoretical argument than a practical one because, even if you say the method cannot be protected, there are always materials, implements or products that will be brought in to support some sort of claim for commercialisation. I think if you have someone who comes up with something innovative then why shouldn't they obtain some protection,

but sure you can't have people with injunctions bursting into operating theatres. However, I don't believe it would happen. I understand that theoretically there is an issue of human rights and human dignity but would it really arise?

Q: Is there anything else you would like to say to the IPSANZ readers?

A: There is no shortage of issues that need considering. They will be slow to work out because of the constraining international arrangements and competing interests. I have already mentioned copyright.

A major, long-standing issue is the very credibility of the IP system. It is consistently challenged by some who assert broader (public) interests or who seek short-term domestic advantage. For my part, I think it unrealistic to contemplate wholesale abolition but I accept that there is room for some innovative changes.

The pace of development in some areas of technology seems to demand new thinking. The fields of computer software and copyright come to mind. They are obvious candidates. The threshold for patentability is also controversial and does seem to clog the systems in major jurisdictions. I would raise it.

On the practical side, pressure for efficiencies and cost savings raise questions around unification and cross-border arrangements. They, too, raise complex issues.



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