Copyright Tribunal of Australia

Isentia Pty Limited v Copyright Agency Limited (Release of Implied Undertaking) [2022] ACopyT 5

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| File numbers: | CT 2 of 2017  CT 2 of 2018  CT 1 of 2018 |
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| The Tribunal: | **PERRAM J (ACTING PRESIDENT)** |
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| Date of decision: | 8 September 2022 |
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| Catchwords: | **PRACTICE AND PROCEDURE** – where application for release of implied undertaking – whether confidentiality regime applies to four documents – where documents not in evidence in present application – where documents part of affidavit evidence in prior hearing – where document not read in prior hearing |
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| Legislation: | *Copyright Act 1968* (Cth) s 31(1)(a)  *Limitation Act 1969* (NSW) s 14 |
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| Cases cited: | *Application by Isentia Pty Limited* [2021] ACopyT 2  *Ashby v Slipper (No 2)* [2016] FCA 550; 343 ALR 351  *Halcon International Inc v Shell Transport and Trading Co* [1979] RPC 97  *Hearne v Street* [2008] HCA 36; 235 CLR 125  *Mann v Medical Defence Union Limited* [1997] FCA 45  *Otter Gold Mines Ltd v McDonald* (1997) 76 FCR 467  *Paino v Hofbauer* (1988) 13 NSWLR 193  *Perdaman Chemicals & Fertilisers Pty Ltd v Griffin Coal Mining Company Pty Ltd [No 2]* [2011] WASC 189  *Royal ExpressPty Ltd (Receivers and Managers Appointed)(Administrator Appointed) v Huang (No.5)* [2021] FCA 1302  *Springfield Nominees Pty Ltd v Bridgelands Securities Ltd* (1992) 38 FCR 217  *Treasury Wine Estates Ltd v Maurice Blackburn Pty Ltd* [2020] FCAFC 226; 282 FCR 95 |
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| Number of paragraphs: | 67 |
|  |  |
| Date of last submission/s: | 6 September 2022 |
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| Date of hearing: | 2 September 2022 |
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| Solicitor for the Respondent: | MinterEllison |

COMMONWEALTH OF AUSTRALIA

*COPYRIGHT ACT 1968*

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| IN THE COPYRIGHT TRIBUNAL | | CT 2 of 2018 |
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| BETWEEN: | ISENTIA PTY LIMITED (ABN 11 002 533 851)  Applicant | |
| AND: | COPYRIGHT AGENCY LIMITED (ABN 53 001 228 799)  Respondent | |

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| TRIBUNAL: | PERRAM J (ACTING PRESIDENT) |
| DATE OF ORDER: | 8 September 2022 |

THE TRIBUNAL ORDERS THAT:

1. To the extent necessary, release the implied undertaking in respect of each of the four documents to permit them to be put before the Tribunal on the present application.
2. Vary the orders of 18 July 2019 and the undertakings given under them sufficiently to permit Isentia to place the four documents into evidence before the Tribunal.
3. Stand the matter over to Monday, 12 September 2022 to permit Isentia to tender the documents.

COMMONWEALTH OF AUSTRALIA

*COPYRIGHT ACT 1968*

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| IN THE COPYRIGHT TRIBUNAL | | CT 2 of 2017 |
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| BETWEEN: | MELTWATER AUSTRALIA PTY LTD (ABN 91 121 849 769)  Applicant | |
| AND: | COPYRIGHT AGENCY LIMITED (ABN 53 001 228 799)  Respondent | |

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| TRIBUNAL: | PERRAM J (ACTING PRESIDENT) |
| DATE OF ORDER: | 8 sEPTEMBER 2022 |

THE TRIBUNAL ORDERS THAT:

1. To the extent necessary, release the implied undertaking in respect of each of the four documents to permit them to be put before the Tribunal on the present application.
2. Vary the orders of 18 July 2019 and the undertakings given under them sufficiently to permit Isentia to place the four documents into evidence before the Tribunal.
3. Stand the matter over to Monday, 12 September 2022 to permit Isentia to tender the documents.

ORDERS

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|  | | CT 1 of 2018 |
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| BETWEEN: | STREEM PTY LIMITED (ACN 600 621 627) V COPYRIGHT AGENCY LIMITED (ABN 53 001 228 799)  Applicant | |
| AND: | COPYRIGHT AGENCY LIMITED (ABN 53 001 228 799)  Respondent | |

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| order made by: | PERRAM J (ACTING PRESIDENT) |
| DATE OF ORDER: | 8 sEPTEMBER 2022 |

THE COURT ORDERS THAT:

1. To the extent necessary, release the implied undertaking in respect of each of the four documents to permit them to be put before the Tribunal on the present application.
2. Vary the orders of 18 July 2019 and the undertakings given under them sufficiently to permit Isentia to place the four documents into evidence before the Tribunal.
3. Stand the matter over to Monday, 12 September 2022 to permit Isentia to tender the documents.

REASONS FOR DETERMINATION

PERRAM J (ACTING PRESIDENT):

# Introduction

1. There are two questions. First, should Isentia Pty Limited (‘Isentia’) be released from its implied undertaking not to use four documents apparently obtained through the processes of this Tribunal other than for the purposes of the Tribunal’s proceedings? Secondly, should its advisors be released from an undertaking they have given not to use the four documents other than for the purposes of the Tribunal’s proceedings?

# Formalities

1. There were three proceedings before the Tribunal. These were Application by Meltwater Australia Pty Ltd (CT 2 of 2017), Application by Streem Pty Ltd (CT 1 of 2018) and Application by Isentia Pty Limited (CT 2 of 2018). They were heard together and evidence in one was evidence in the other. Isentia applies by interlocutory application in the Meltwater and Isentia proceedings. Both applications are dated 17 August 2022. On the hearing of the applications, Isentia read two affidavits of Mr Timothy Webb, the solicitor for Isentia. These were dated 17 and 31 August 2022 respectively. The second affidavit had two exhibits, TBW-13 and TBW-14, which were received in evidence. The Copyright Agency Limited (‘CA’) read an affidavit of Mr John Fairbairn, the solicitor for CA, dated 31 August 2022 which was accompanied by exhibit JIF-18 which was also received in evidence. There were no objections or cross-examination. During the hearing, it became apparent that orders would need to be made in the Streem proceeding. Streem Pty Ltd was notified of this but, other than to indicate its opposition, it did not take part in the hearing.

# Principles

1. As to the first question, it was not in dispute that the implied undertaking will apply if the documents were produced under the Tribunal’s compulsory processes: *Otter Gold Mines Ltd v McDonald* (1997) 76 FCR 467 at 473 per Sundberg J (‘*Otter Gold Mines*’). *Otter Gold Mines* was concerned with the position of the Administrative Appeals Tribunal, but there is no relevant distinction between that Tribunal and this Tribunal.
2. It is also not in dispute that where one party to litigation is compelled, whether by reason of a rule of court or by reason of a specific order of the court, or otherwise, to disclose documents or information, the party obtaining the disclosure cannot, without the leave of the court, use it for any purpose other than that for which it was given unless it was received into evidence: *Hearne v Street* [2008] HCA 36; 235 CLR 125 at [96] per Hayne, Heydon and Crennan JJ (‘*Hearne*’). The rationale underlying the principle is to ensure that privacy and confidentiality are not invaded more than is necessary for the purpose of doing justice: *Hearne* at [107].
3. That principle applies to tribunals which have compulsory powers and in such cases the implied undertaking and the power to release a party from that undertaking are to be seen as incidental to the power of compulsion to which they attach: *Otter Gold Mines* per Sundberg J at 473. An affidavit which is filed pursuant to a direction that it should be filed is, relevantly, produced under compulsion. This is a proposition which I doubt where the relevant order is permissive in nature. However, it was not in contest in this hearing.
4. Whilst it is true that the implied undertaking does not apply where the document in question is received in evidence, the undertaking will continue to apply where its reception into evidence has not resulted in the document entering the public domain and the Court makes orders which prevent the publication of that evidence: *Treasury Wine Estates Ltd v Maurice Blackburn Pty Ltd* [2020] FCAFC 226; 282 FCR 95 at [53], [83(2)] (‘*Treasury Wine*’).

# The Three Proceedings in this Tribunal

1. Each of Isentia, Meltwater Australia Pty Ltd (‘Meltwater’) and Streem Pty Limited are businesses which provide media monitoring services, for example, press clippings. CA, on the other hand, represents, inter alia, the interests of the owners of the copyright in the press clippings. Each of Isentia, Meltwater and Streem require a licence from CA in order to conduct their businesses since the communication or copying of news articles is a right comprised in the copyright conferred by s 31(1)(a) of the *Copyright Act 1968* (Cth). Where agreement cannot be reached, this Tribunal has the power to determine the terms on which such a licence is to be granted.
2. Although each of Isentia, Meltwater and Streem had prior consensual agreements with CA, during the course of 2017 and 2018, it became clear that each was unable to conclude new licence agreements with CA. Litigation in this Tribunal ensued. There were three proceedings:
3. Isentia Pty Limited v Copyright Agency Limited (CT 2 of 2018);
4. Meltwater Australia Pty Ltd v Copyright Agency Limited (CT 2 of 2017); and
5. Streem Pty Limited v Copyright Agency Limited (CT 1 of 2018).
6. On 18 July 2019, the Tribunal ordered that the Isentia, Meltwater and Streem proceedings be heard together and that evidence in each be evidence in the others (the Streem Proceeding was subsequently resolved consensually). On the same day that the Tribunal ordered that the three proceedings be heard together, it also made orders by consent providing for a confidentiality regime in each of those proceedings.
7. Pending the final determination of these claims, interim determinations were made.

# Charging of Different Rates

1. The charging of different rates to Isentia, Meltwater and Streem might result in an uneven playing field. Isentia’s concern to avoid this was reflected in cl 6.10 of a licence agreement with CA dated 8 April 2016 (‘the Isentia Licence’). The Isentia Licence was to be effective from 1 July 2016. Clause 6.10 of the Isentia Licence provided:

Copyright Agency will not offer a new licence, or amend an existing licence, providing equivalent rights on these or similar terms to any other organisation providing similar services for a more favourable licence fee unless Copyright Agency has first offered a licence fee at that lower rate.

1. The present debate has arisen because documents produced in the course of the three proceedings have engendered in Isentia the suspicion that CA may not have complied with this clause in as much as that it may have given better terms to Streem and Meltwater. However, the implied undertaking (if it applies) and the express undertakings given by its advisors presently prevent the use of the four documents for any purpose extraneous to the purposes of the three proceedings. Consideration of whether to pursue CA for breach of contract and, indeed, pursuit of CA in such a contract suit is a purpose extraneous to the three proceedings.
2. Since there are potentially two sets of undertakings involved it is useful to begin with the express regime which applies to Isentia’s advisors.

# The Confidentiality Regime

1. The regime was put in place by orders made in each of the proceedings on 18 July 2019. There are four aspects of the regime which should be noted.
2. First, the regime was self-nominating in that a party could make a claim for various levels of confidentiality by marking a document ‘Restricted Access’, ‘Highly Confidential’ and ‘Confidential’ (collectively referred to as ‘confidential documents’) whereupon different confidentiality obligations would arise. Unless the claim was challenged, its validity did not need to be determined.
3. Secondly, documents marked ‘Restricted access’ could only be accessed by the Tribunal, Australian counsel and external solicitors retained for the three proceedings (and their support staff), and anyone with the consent of the party which claims confidentiality in the specified information. Documents that were marked ‘Confidential’ or ‘Highly Confidential’ could only be accessed by external lawyers, up to three in-house counsel and four instructing executives each of whom had to sign a confidentiality undertaking. The terms of the confidentiality undertaking were specified in an attachment to the orders. Paragraph 2 of the draft confidentiality undertaking provided that:

I will use the Confidential Documents, Highly Confidential Documents, Restricted Access Documents and the Information only for the purposes of the Proceedings.

1. All persons who have had access to the confidential documents in all three proceedings have given this undertaking. Quite apart from the implied undertaking, these undertakings prevent the persons who have given them from using any confidential document other than for the purposes of the three proceedings.
2. Thirdly, although the Streem Proceeding has been finalised, the confidentiality regime in it remains in place, as do each of the undertakings which have been given. During the course of the hearing, Isentia expanded its application to extend to the Streem proceeding. As I have already mentioned, Streem was given notice of this and afforded an opportunity to appear to oppose it but it did not take this up.
3. Fourthly, the confidentiality orders of 18 July 2019 did not make any provision for what was to occur where a document subject to it was introduced into evidence. It is unclear on the evidence before me what occurred when a document subject to the confidentiality regime was tendered or annexed to an affidavit. There was no evidence on the present application that the Tribunal made suppression orders in this circumstance although it would appear that, from time to time, the Tribunal’s proceedings were conducted in camera. I raised this with the parties subsequent to the hearing. Their joint position was that all parties had conducted themselves on the basis that the regime had the effect of preventing publication of any document subject to it even if introduced into evidence. This is not my reading of what the orders say. However, I do accept that, as a matter of fact, the documents have remained undisclosed to the public. Further, I also accept that it would be appropriate for an appropriate suppression order now to be made and that the order should be retroactive to 18 July 2019.
4. Fifthly, the regime contained an explicit entitlement for any party to apply to vary the operation of the regime. This was contained in order 9:

On 3 days’ notice to the Confidentiality Claimant, CA or the MMOs have liberty to apply for a direction seeking access to Confidential Information or a direction that a document that has been marked as ‘Restricted Access’, ‘Highly Confidential’ or ‘Confidential’ be reclassified or declassified. The relevant Confidentiality Claimant will be provided with an opportunity to be heard before the Confidential Information is disclosed to any person other than as permitted by these Orders.

1. It will be seen that this has two limbs. Under the first limb, access may be sought without declassification whilst under the second, a document may be declassified.
2. In any event, I am satisfied that Isentia’s advisors are bound by the undertakings they have given under the confidentiality regime not to use the four documents for the purpose of advising on whether to pursue CA for breach of contract.

# The Four Documents

1. Next, it is useful to identify the four documents in respect of which Isentia makes its application. In doing this, it is necessary, in fact, to refer to five documents. These are:

## The Meltwater Licence

1. On 12 October 2015, Meltwater and CA entered into a licence agreement entitled ‘Press Clipping Service Licence Newspapers and Magazines: Copying and Communication Rights’ (‘the Meltwater Licence’). The Meltwater Licence was not before the Tribunal on the present application.

## The 5 October 2016 Letter

1. At a case management hearing held by the Tribunal on 19 December 2018, it emerged that the rates being invoiced to Meltwater by CA were less than the rate specified in the Meltwater Licence. Although the Meltwater Licence had by then expired, the Tribunal, in an earlier interim determination of 23 May 2018, had ordered that the rates payable to CA should be the same as those specified in the Meltwater Licence. At the case management hearing, Meltwater raised that it expected to be invoiced by CA at this lower rate. In the course of this discussion reference was made to an arrangement which suggested that an agreement as to the lower rates was to be found in a letter dated 5 October 2016 (‘the 5 October 2016 Letter’). The 5 October 2016 Letter was not in evidence on the present application.

## The Scraping Licence and the Variation Agreement

1. On 1 December 2014, Meltwater and CA entered into agreement known as the ‘Scraping Licence’. This was varied by an agreement of 7 October 2016. I will refer to this variation agreement as the ‘Variation Agreement’. As with the Meltwater Licence, the rates in the Scraping Licence and the Variation Agreement were implemented by the Tribunal in its interim determination of 23 May 2018. These agreements were not in evidence on the present application.

## The Streem Licence

1. On 1 March 2017, but with effect from July 2017, Streem and CA entered into an agreement entitled ‘Press Monitoring and Online Monitoring Licence’. The Tribunal made an interim determination in the Streem Proceeding based on this agreement.
2. Turning then to Isentia’s application.

# Isentia’s Application

1. Isentia seeks to be released from the implied undertaking and the confidentiality regime in relation to:
2. the Variation Agreement;
3. the 5 October 2016 Letter;
4. the Meltwater Licence; and
5. the Streem Licence.
6. In respect of each document, three factual questions need to be determined. The first is whether the confidentiality regime applies to the document. The second is whether the document was produced as a result of the exercise of a compulsory power by the Tribunal. The third is whether the document was introduced into evidence and, if it was, whether it became publicly available.
7. Dealing with the four (not five) documents involved in the above order:

## The Variation Agreement

1. Mr Webb gave evidence about the how the Variation Agreement came to be in his possession as the solicitor for Isentia. Mr Webb set out a table which details the procedural history of each of the four documents. It is not clear to me from Mr Webb’s otherwise helpful table whether by the expression ‘Scraping Licence’ Mr Webb was referring to the original Scraping Licence and with it the Variation Agreement or whether he was referring only to the Variation Agreement. My confusion arises from the interplay between §24(a) and §22 of his first affidavit. Since, however, it is clear that Isentia is only applying in relation to the Variation Agreement, I will proceed on the basis that Mr Webb intended in his table to refer to the Variation Agreement.
2. The Variation Agreement was marked confidential which enlivened the confidentiality regime. It was attached to an affidavit of Mr Andrew Stewart dated 14 March 2018. That affidavit was filed in the Meltwater Proceeding pursuant to orders made by the Tribunal on 27 February 2018. Isentia accepted that the affidavit and the Variation Agreement was produced to the Tribunal as a result of compulsion so that the implied undertaking applied to it. Mr Stewart’s affidavit was read, however, for the reasons I have given, I am satisfied that the Variation Agreement has not become publicly available.
3. I therefore accept that the Variation Agreement is subject to both the confidentiality regime and the implied undertaking.

## The Meltwater Licence

1. The Meltwater Licence was marked confidential which enlivened the confidentiality regime. It was attached, inter alia, to Mr Stewart’s affidavit. It was filed in the Meltwater Proceeding. That affidavit had been filed pursuant to orders made by the Tribunal on 27 February 2018 and was read. There is no evidence of a suppression order having been in relation to the affidavit. However, for the reasons I have given, I am satisfied that the Meltwater Licence has not become publicly available. .

## The 5 October 2016 Letter

1. The letter was attached to an affidavit of CA’s solicitor, Mr Fairbairn, dated 18 December 2018 and filed in the Meltwater Proceeding, and an affidavit of Mr Adam Suckling dated 24 September 2020 and filed in the Isentia and Meltwater Proceedings. It was marked ‘Highly Confidential’ so far as Isentia is concerned. Consequently, it is subject to the confidentiality regime.
2. The letter was in possession of CA as one of the parties to the letter. CA did not obtain it by compulsory production and in its hands it was not subject to the implied undertaking.
3. Mr Fairbairn’s affidavit was filed to correct previous evidence and does not appear to have been the result of any order made by the Tribunal. This was the understanding of Mr Webb and Mr Fairbairn did not suggest otherwise in his affidavit.
4. Thus, it cannot be said that the provision of letter to Isentia by the service of Mr Fairbairn’s affidavit was the result of the compulsory processes of the Tribunal in the Meltwater Proceeding. It was the voluntary act of CA in deciding to correct its evidence by providing further evidence. I do not accept therefore that Isentia is bound by the implied undertaking only to use it for the purposes of the Tribunal’s proceedings.
5. As it happens, Mr Fairbairn’s affidavit was not read. However, this does not matter where the implied undertaking did not attach in the first place. On the other hand, I am satisfied that this copy of the letter continued to be subject to the confidentiality regime in all three proceedings.
6. There was another copy of the letter attached to Mr Suckling’s affidavit. The status of this letter does not matter given the above conclusion.

## Streem Licence

1. This was attached to an affidavit of Mr Suckling which had been filed pursuant to orders of the Tribunal and was read in the Isentia and Meltwater proceedings. For the reasons already given, I conclude that it is subject to both the confidentiality regime and the implied undertaking.

# Release from the implied undertaking

1. On the view I take of the facts, three of the documents are subject to the implied undertaking. In the case of the fourth document, the 5 October 2016 Letter, it was never subject to the implied undertaking since: (a) it was already in CA’s possession; and (b) Mr Fairbairn’s affidavit was not filed pursuant to an order of the Tribunal. Despite that conclusion, I will consider the status of the letter in assessing whether the undertaking should be released. If I reach the conclusion that the undertaking should be released (if it had been subject to the undertaking) then the form of order I will use will release the undertaking ‘to the extent necessary’: cf. *Royal Express Pty Ltd (Receivers and Managers Appointed)(Administrator Appointed) v Huang (No.5)* [2021] FCA 1302
2. The case law requires the existence of special circumstances but that requirement has been interpreted to mean that some good reason must be show why the obligation should be released. Some matters relevant to the exercise of the discretion were set out by Wilcox J in *Springfield Nominees Pty Ltd v Bridgelands Securities Ltd* (1992) 38 FCR 217at 225:

It is neither possible nor desirable to propound an exhaustive list of those factors. But plainly they include the nature of the document, the circumstances under which it came into existence, the attitude of the author of the document and any prejudice the author may sustain, whether the document pre-existed litigation or was created for that purpose and therefore expected to enter the public domain, the nature of the information in the document (in particular whether it contains personal data or commercially sensitive information), the circumstances in which the document came into the hands of the applicant for leave and, perhaps most important of all, the likely contribution of the document to achieving justice in the second proceeding.

1. I accept that the parties to each of the four documents did not expect them to come to light or into the possession of Isentia and that CA, in particular, suffers prejudice if it comes to light that it has breached cl 6.10 of the Isentia Licence. This is the prejudice in being exposed to a potential suit for breach of contract which it otherwise will not have to face. I also accept that the information contained within the four documents is commercially sensitive. The documents have come into the possession of Isentia only because the Tribunal was required to make interim orders and this required some attention to be given to what the arrangements which had actually been in place had been with Meltwater and Streem.
2. It is not possible to judge directly what the likely contribution of the four documents to any breach of contract suit will be. This is because they are not in evidence. Isentia did not put them in evidence because it was concerned that to do so would be a breach of the implied undertaking. I would for myself think this unlikely but I accept that Isentia’s advisors were actuated by legitimate caution. Were it relevant for the future, I would regard the purpose of seeking leave to be released from the implied undertaking as being a purpose of the proceeding in which the undertaking exists. This is illustrated by the fact that leave may be refused. The contrary view leads to a degree of complexity in the bringing of the application which serves no underlying purpose and creates a great deal of practical inconvenience. It also leads to the unhelpful situation on the present application where the body which is asked to release the undertaking is not able to see the documents in question even though the case law requires it to assess their significance. A path of legal reasoning which leads to this place has taken a wrong turn.
3. CA also chose not to put them in evidence for which it, too, cannot be criticised.
4. This makes any assessment of the value of the documents necessarily indirect. What occurred at the case management hearing on 19 December 2018 satisfies me that, at least in the case of Meltwater, CA was charging it a lower rate than what appeared from the Meltwater Licence. This is also apparent from [218] of the Tribunal reason’s where it referred to evidence of Meltwater’s Mr Hickey to the effect that Isentia’s 2016 licence fee was a significant price increase over what Meltwater had been paying: *Application by Isentia Pty Limited* [2021] ACopyT 2.
5. This does not answer the question posed by cl 6.10 because it is possible that the rights conferred were not the same. To ascertain whether a breach of cl 6.10 has occurred it would be necessary to take account not only of the rates charged but also of the rights conferred. Consequently, I am unable to ascertain the significance of the Meltwater Licence, the 5 October 2016 Letter or the Variation Agreement.
6. In relation to Streem, there is no evidence one way or the other. As such, I am unable to assess the significance of the Streem Licence.
7. I do not accept that it is enough to justify the release of the implied undertaking that the documents will show one way or the other whether cl 6.10 was breached.
8. Consequently, on the state of the evidence I would not at this stage release the undertaking since I have not been shown the documents. I would, however, release the undertaking sufficiently to permit Isentia to put them into evidence on the present application.

# Release from the confidentiality regime

1. Order 9 explicitly entitles Isentia to apply to have access to a confidential document. Isentia’s application to be released from the confidentiality regime falls within what the regime itself contemplates. The only question is whether the application under order 9 should be acceded to. This is not a case therefore where a party seeks to vary consent orders. Were I satisfied that the implied undertaking should be released I would also be satisfied that the confidentiality regime should be varied. The same interests underpin both sets of undertakings and the facts, matters and circumstances warranting the release of one equally warrant the release of the other.
2. If I am wrong in my interpretation of order 9, then the Tribunal would have the power in any event provided exceptional circumstances were demonstrated: *Paino v Hofbauer* (1988) 13 NSWLR 193 at 198 per McHugh JA. At this stage exceptional circumstances have not been demonstrated. However, this does not matter in light of my reading of order 9.
3. As presently advised, I would vary the confidentiality undertakings sufficiently for the Tribunal to be shown the four documents and release the implied undertaking to the same extent.

# CA’s submissions as to why the implied undertaking should not be discharged

1. CA made a number of submissions as to why the implied undertaking should not be released. None were persuasive.
2. First, I do not accept that it is necessary for Isentia to show that there is a reasonable or close relationship between its potential contract claims and the claims it makes in the Tribunal. In his oral submissions, Mr Dimitriadis for CA identified this principle as being located in the authorities at footnote 20 of his written submissions. These were, first, *Perdaman Chemicals & Fertilisers Pty Ltd v Griffin Coal Mining Company Pty Ltd [No 2]* [2011] WASC 189 at [20] and [24] (‘*Perdaman*’). In that case, Beech J concluded that the proposed claim was ‘closely connected’ to the claim which was already before the court: at [24]. He did not, however, apply that as the relevant standard. The standard his Honour applied was the standard at [17]-[10] which was the ordinary ‘special circumstances’ approach. *Perdaman* is therefore not authority for the proposition that it is necessary to show that there is a reasonable or close connection.
3. Further, the context in which the question arose concerned an amendment to a case already before the court. This is quite different to the situation in the present case where the Tribunal lacks any jurisdiction over the proposed contract suit.
4. The second authority CA relied upon was what said to be an unreported decision of the Federal Court of Australia, *Mann v Medical Defence Union Limited* but which in fact appears at [1997] FCA 45. Like *Perdaman* it was concerned with an attempt to add a claim to an existing claim. It does not bear on the current situation.
5. If I were wrong in that conclusion of law, I am satisfied that there is in any event just such a relationship. A central question in the Tribunal proceedings is whether the Isentia, Meltwater and Streem should each be charged the same rate by CA. That issue is the subject matter of cl. 6.10.
6. Secondly, whilst I accept CA’s submission there was an inconsistency between the purpose for which the four documents were produced and the proposed purpose for which Isentia now seeks to use them, I do not see that as providing a reason not to grant leave. There will always be an inconsistency of this kind on an application such as the present.
7. Thirdly, I do not accept that the fact that the confidentiality regime was agreed consensually is a matter which ought to be afforded much weight. The regime included order 9 which contemplated that a party could apply to be released from it. It is not to the point therefore that the parties have conducted themselves in accordance with that regime for several years.
8. Fourthly, I do not accept that the position of any third parties, apart from Streem, under the confidentiality regime is shown to be relevant. In the case of Streem, I am satisfied that it is on notice of the present application. Apart from communicating the fact that it did not consent, it took no part in the application. I accept that there is prejudice to Streem (and Meltwater) in that Isentia will learn the rates they have been paying to CA. However, it already knows that. What is to change is that it will be able to use that knowledge against CA. CA did not explain what risk Meltwater and Streem faced if CA were sued by Isentia for breach of cl 6.10. To that may be added the fact that the documents in question are historical having expired and having been superseded by the Tribunal’s decision.
9. Fifthly, I do not accept that delay is relevant on the present application. CA submitted that it had been held that where release from the undertaking was sought after the event, delay was relevant. Accepting that to be so, CA did not identify any decision in which delay had been held relevant to the prospective release of the undertaking. I do not accept that delay is relevant in that circumstance. If I were wrong in that and that the equitable notion of delay is relevant, I would conclude that it would be necessary for CA to demonstrate some prejudice arising from the delay. There is no evidence of any such prejudice. If I were wrong in that and CA did not need to identify any prejudice, I would conclude that there was no relevant delay. Isentia has been aware of the circumstances since the evidence was served on it in 2018. Since 2018, Isentia has been locked in the litigation before this Tribunal and more recently the Full Court. I do not think it was required during that period to address this satellite issue particularly where CA is protected by s 14 of the *Limitation Act 1969* (NSW).
10. Sixthly, I do not accept that there is principle that it is not sufficient for the release of the undertaking that the proposed proceeding serves only some private interest. CA referred to a statement by Whitford J in *Halcon International Inc v Shell Transport and Trading Co* [1979] RPC 97 to the effect that ‘furtherance of a private interest could not justify the grant of leave to use discovered documents for the purpose of other proceedings and that some overriding public interest would normally be required’. There is no example of this principle being applied in Australia and it is inconsistent with the outcome in *Treasury Wine*. It does not reflect the state of Australian law. The most that can be said is that the Federal Court has accepted that the existence of such public considerations is itself a positive reason to release the undertaking: *Ashby v Slipper (No 2)* [2016] FCA 550; 343 ALR 351 at [10] per Flick J. However, it is not possible to fashion from that proposition the quite different one that such public considerations must be present for the undertaking to be released.
11. Seventhly, whilst I accept that Isentia could obtain the documents through a preliminary discovery application, this would appear to be a cumbersome procedure when it already has them.

# Orders

1. At this stage, in relation to each of the four documents I would, to the extent necessary, release the implied undertaking and vary the confidentiality regime sufficiently for them to be placed before the Tribunal. The documents may be tendered at 9.30am next Monday. At that time, the parties should present an appropriate retroactive suppression order. At this stage, the orders I will make are:
2. To the extent necessary, release the implied undertaking in respect of each of the four documents to permit them to be put before the Tribunal on the present application.
3. Vary the orders of 18 July 2019 and the undertakings given under them sufficiently to permit Isentia to place the four documents into evidence before the Tribunal.
4. Stand the matter over to Monday, 12 September 2022 to permit Isentia to tender the documents.

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| I certify that the preceding sixty-seven (67) numbered paragraphs are a true copy of the Reasons for Judgment of the Honourable Justice Perram. |

Associate:

Dated: 8 September 2022