

# FRANCES ST JOHN

TENTH FLOOR SELBORNE/WENTWORTH CHAMBERS  
174 PHILLIP STREET SYDNEY NSW 2000  
02 9232 4609 STJOHN@TENTHFLOOR.ORG

## **BARRISTER at TENTH FLOOR SELBORNE/WENTWORTH CHAMBERS**

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APRIL 2015 – PRESENT

Commercial practice with a particular focus on intellectual property and consumer protection.

*Listed in Doyles Guide – Leading Intellectual Property Barristers, New South Wales, 2016 & 2017*

### **Selected recent matters – Intellectual property and consumer protection**

- *Voxson Pty Ltd v Telstra Corporation Limited & Ors* [2017] FCA 267 (Federal Court; ongoing; judgment is on a pleading point)  
Patents – infringement and invalidity (telecommunications)
- *Australian Competition and Consumer Commission v Reckitt Benckiser (Australia) Pty Ltd (No 4)* [2015] FCA 1408  
Misleading or deceptive conduct in advertising (packaging of Nurofen products)
- *Domino's Pizza Enterprises Ltd v Precision Tracking Pty Ltd & Ors* (Federal Court; ongoing)  
Patents – infringement and invalidity (GPS tracking of pizza delivery)
- *Coretell Pty Ltd v Australian Mud Company Pty Ltd* [2017] FCAFC 54; [2016] FCA 706  
Patents – infringement and invalidity (drilling equipment)
- *Australian Mud Company Pty Ltd v Coretell Pty Ltd* [2016] FCA 830 (Federal Court; ongoing)  
Patents – infringement and invalidity (drilling equipment; including application for freezing orders)
- *Roadshow Films Pty Limited & Ors v Telstra Corporation Limited & Ors; Foxtel Management Pty Ltd v TPG Internet Pty Ltd & Ors* [2016] FCA 1503  
Copyright – first applications to block access to piracy websites under new s 115A
- *Universal Music Australia Pty Ltd & Ors v TPG Internet Pty Ltd & Ors* [2017] FCA 435  
Copyright – application to block access to piracy websites under new s 115A
- *Primary Health Care Limited v Commonwealth & Ors* (Full Federal Court; reserved)  
Trade marks – appeal – opposition to registration
- *Alembic Pharmaceuticals Ltd v Generic Partners Pty Ltd; Generic Partners Pty Ltd v Alembic Pharmaceuticals Ltd* (Federal Court; ongoing)  
Breach of confidence (pharmaceuticals; including interlocutory injunction)  
Copyright – infringement  
Application for stay under *International Arbitration Act 1974* (Cth)
- *Dincol Construction Systems Pty Ltd v AFS Systems Pty Ltd & Anor* [2017] FCA 262 (Federal Court; ongoing; judgment is on application for urgent interlocutory relief)  
Patents – infringement and invalidity (building products; including interlocutory injunction)

- *Right2Drive Pty Ltd v Pokerplus Pty Ltd* (Federal Court; ongoing; unled)  
Trade marks – infringement
- *Dometic Australia Pty Ltd v Houghton Leisure Products Pty Ltd* (Federal Court; ongoing)  
Patents – infringement (air-conditioners; including interlocutory injunction)  
Misleading or deceptive conduct in advertising
- *Stelco Pty Ltd t/as Downrigger Shop v Facebook Australia Pty Ltd* (for Facebook; unled)  
Consumer protection
- *Chandrasekaran v Microsoft Pty Ltd & Ors* (Supreme Court; for Facebook; ongoing; unled)  
Preliminary discovery
- *Universal Music Australia Pty Limited v Pavlovic & Anor; Pavlovic & Anor v Universal Music Australia Pty Limited & Ors* [2017] NSWSC 247; [2017] NSWSC 314 (Supreme Court; settled)  
Copyright – infringement  
Breach of contract
- *Tatts Group Limited v Lottoland Australia Pty Ltd* (Federal Court; settled)  
Misleading or deceptive conduct in advertising  
Trade marks – infringement
- *Steiner Legal v Rubicon Films Pty Limited* (Federal Court; unled; urgent interlocutory injunction granted)  
Copyright – infringement  
Breach of contract
- *Bohemia Crystal Pty Ltd v Host Corporation Pty Ltd* (Federal Court; reserved)  
Trade marks – infringement, rectification; passing off  
Misleading or deceptive conduct in advertising
- *NUC Electronics Co Ltd v Optimum Appliances Pty Ltd* (Federal Court; settled)  
Patents – infringement, invalidity
- *Load and Move Pty Ltd v Container Rotation Systems Pty Ltd* [2016] FCA 843  
Patents – infringement – preliminary discovery
- *Hunter Pacific International Pty Ltd v Martec Pty Ltd* [2016] FCA 796; (2016) 121 IPR 1, [2016] AIPC 92-509, [2017] ALMD 1099  
Designs – infringement (ceiling fans)
- *Hells Angels Motorcycle Corporation (Australia) Pty Ltd v Redbubble Limited & Anor* [2016] FCA 530; [2016] AIPC 92-506, [2017] ALMD 696, [2017] ALMD 731 (ongoing; judgment concerns security for costs)  
Trade marks – infringement  
Copyright – infringement
- *GAIN Capital UK Limited v Citigroup Inc (No 2)* [2017] FCA 519; [2016] FCA 582; [2016] FCA 243, (2016) 118 IPR 4  
Trade marks – opposition – appeal

- *Balanced Body, Inc v The Joint Workshop Pty Ltd* (Federal Court; settled)
  - Patents – infringement (Pilates equipment)
- *L’Oreal Australia Pty Ltd v BrandPoint Pty Ltd* [2015] FCA 978
  - Misleading or deceptive conduct in advertising – preliminary discovery
- *Shape Shopfitters Pty Ltd v SHAPE Australia Pty Limited* [2017] FCA 474 (ongoing; decision is about admissibility of evidence from the Wayback Machine)
  - Trade mark infringement; passing off
  - Misleading or deceptive conduct in advertising
- *PMP Digital Pty Ltd v Joshua Gavin & Ors* (Federal Court; ongoing; unled)
  - Copyright – infringement
  - Breach of contract
  - Torts – interference with contractual relations
- *Zuru Limited & Anor v Brand Developers Aust Pty Ltd* (Federal Court; ongoing)
  - Patents – infringement (water balloons)
  - Misleading or deceptive conduct in advertising
- *Clearlight Investments Pty Ltd v Barilla Ge R Fratelli – Societa per Azioni* [2017] ATMO 38 (unled)
  - Trade marks – opposition (BARILLA PASTA PRONTO)
- *Raymond Mizzi v Hobsons Australia Pty Ltd & Anor* (Federal Court)
  - Copyright – infringement – preliminary discovery
- *Clipsal Australia Pty Ltd v Clipso Electrical Pty Ltd* [2016] FCA 37
  - Patents – infringement (light switches)
  - Trade marks – infringement
- *Integratedliving Australia Ltd v Maitland Community Care Services Inc & Fuller* (Supreme Court; ongoing)
  - Breach of confidence
  - Copyright – infringement
- *Brand Developers Limited v Commissioner of Patents & Anor* (AAT; ongoing)
  - Patents (water balloons)
- *eos Products LLC v CBCH Australia Pty Ltd* (Federal Court; settled)
  - Passing off
  - Misleading or deceptive conduct in advertising
- *Complete Office Supplies v Corporate Office Supplies* (Federal Court; unled; settled)
  - Trade marks – infringement; passing off
  - Misleading or deceptive conduct in advertising
- Various trade mark oppositions

## Selected recent matters – Other fields

- *Commonwealth Bank of Australia v Brick & Block Company Pty Ltd (in Liq)* [2016] NSWSC 1277 (Supreme Court; unled)
  - Application for suppression orders
- *Application by ActewAGL Distribution* [2016] ACompT 4 and related matters [2016] ACompT 2, [2016] ACompT 3, [2016] ACompT 5 (judicial review application)
  - Competition law (electricity price regulation)
  - Administrative law
- *Metziya Pty Ltd v ICR Engineering Pty Ltd* and related matters [2016] NSWSC 1703
  - Appeal – contracts
- *Universal Music Australia Pty Limited v Pavlovic & Anor; Pavlovic & Anor v Universal Music Australia Pty Limited & Ors* [2017] NSWSC 247; [2017] NSWSC 314 (Supreme Court; settled; judgments relate to discovery and release from undertakings)
  - Breach of contract
  - Corporations – directors’ duties
  - Equity – fiduciary responsibility, constructive trust
- *Stillman v Rusbourne* [2015] NSWCA 410
  - Appeal – professional negligence – advocates’ immunity
- *Margan v Manias* [2015] NSWCA 388 (appeared as amicus curiae)
  - Appeal – human rights
- *Nalbandian v Commonwealth of Australia* (Federal Court; settled at hearing)
  - Appeal – security for costs
- *Crowe Horwath (Aust) Pty Limited v Mantarro* (Supreme Court)
  - Restraint of trade – application for interlocutory relief
- *In the matter of McGee Projects Pty Ltd* (Federal Court; settled; unled)
  - Corporations – application to set aside statutory demand
- *Willard Public Affairs Pty Ltd v AusBiotech Ltd* (District Court; settled; unled)
  - Breach of contract
  - Quantum meruit
- *Generic Partners Pty Ltd v Alembic Pharmaceuticals Ltd* (Federal Court; ongoing)
  - Application for stay under *International Arbitration Act 1974* (Cth)
- *McGee Projects Pty Ltd v Buildworx (Australia) Pty Limited* (District Court; ongoing; unled)
  - Breach of contract
  - Quantum meruit
- *Giorgio Ciccone v NSW Land and Housing Corporation* [2016] NSWCATAP 120 (unled)
  - Administrative law – tenancy

## **SOLICITOR at GILBERT + TOBIN**

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OCTOBER 2011 – APRIL 2015

Cases included the following:

- *Samsung Electronics Australia Pty Limited v LG Electronics Australia Pty Limited* [2015] FCA 227 and [2015] FCA 477 (consumer protection)
- *Kafataris v Davis* (2014) 109 IPR 29 (patents)
- *Energizer Australia v Procter & Gamble* (consumer protection – interlocutory injunction granted; settled)
- *Commonwealth v Primary Health Care* (2014) 108 IPR 610 (trade marks)
- *Storm Productions v John Marsden* (copyright – settled)
- *Ainsworth Game Technology v Aristocrat Technologies Australia* (patents, copyright – settled)
- *Washington v Qantas Airways Ltd* (2014) 107 IPR 144 (consumer protection, copyright – costs)
- *The Weather Channel v XYZnetworks* (consumer protection, trade marks – settled)
- *Perez & Ors v Fernandez* (2012) 260 FLR 1 (copyright)
- *PPCA Limited under s 154 of the Copyright Act 1968 (Cth)* [2015] ACopyT 3

## **SOLICITOR at MINTER ELLISON**

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JULY 2010 – OCTOBER 2011

## **INTERN at the AUSTRALIAN LAW REFORM COMMISSION**

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APRIL 2010 – JUNE 2010

## **ASSOCIATE to JUSTICE GREENWOOD OF THE FEDERAL COURT OF AUSTRALIA**

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JANUARY 2009 – FEBRUARY 2010

## **LEGAL RESEARCH ASSISTANT at LEVEL 11 INNS OF COURT, BRISBANE**

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AUGUST 2006 – JANUARY 2008

- Research work for the Hon. Ian Callinan AC
- Research work for Sir Laurence Street AC KCMG on an Inquiry commissioned by the Attorney-General of Queensland into an Aboriginal death in custody on Palm Island
- Research work for Mr Jonathan Horton QC in respect of the constitutional case *Betfair Pty Limited v Western Australia* (2008) 234 CLR 418
- Research work for the Hon. Bill Pincus QC's Commission of Inquiry into the Fuel Subsidy

## **MASTER OF LAWS with FIRST CLASS HONOURS AUSTRALIAN NATIONAL UNIVERSITY**

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2014

## **BACHELOR OF LAWS with HONOURS UNIVERSITY OF QUEENSLAND**

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2007; Dean's List Commendation for High Achievement (various semesters)