

FRANCES ST JOHN

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

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

Listed in Best Lawyers 2018

Selected recent matters – Intellectual property and consumer protection

- *Voxson Pty Ltd v Telstra Corporation Limited & Ors* [2017] FCA 267 (ongoing; judgment is on a pleading point)
 - Patents – infringement and invalidity (telecommunications)
 - Misleading or deceptive conduct
- *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)
 - Breach of confidence
 - Copyright – infringement
 - Misleading or deceptive conduct
- *Neurim Pharmaceuticals (1991) Ltd v Generic Partners Pty Ltd & Anor* (Federal Court; ongoing)
 - Patents – infringement and amendment (pharmaceuticals)
- *Coretell Pty Ltd v Australian Mud Company Pty Ltd* [2017] FCAFC 54; [2016] FCA 706; [2017] FCAFC 122; [2017] HCASL 191 (special leave refused)
 - Patents – infringement and invalidity (drilling equipment)
 - Costs
- *Australian Mud Company Pty Ltd v Coretell Pty Ltd* [2016] FCA 830 (reserved; judgment is interlocutory)
 - Patents – infringement and invalidity (drilling equipment)
 - Interlocutory – 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* [2017] FCAFC 174
Trade marks – opposition to registration – appeal
- *In the matter of Australian Patent Applications No. 2013351261 & 2013351262 in the name of K-Fee System GmbH* (IP Australia; ongoing)
Patents – opposition to registration
- *Alembic Pharmaceuticals Ltd v Generic Partners Pty Ltd; Generic Partners Pty Ltd v Alembic Pharmaceuticals Ltd* (Federal Court; settled)
Breach of confidence (pharmaceuticals)
Copyright – infringement
Interlocutory – interlocutory injunction
Interlocutory – application for stay under *International Arbitration Act 1974* (Cth)
- *Dintel Construction Systems Pty Ltd v AFS Systems Pty Ltd & Anor* [2017] FCA 262; [2017] FCA 791; [2017] FCA 919 (appeal decision reserved)
Patents – infringement and invalidity (building products)
Interlocutory – interlocutory injunction
- *Gram Engineering Pty Ltd v Registrar of Trade Marks* (Federal Court; ongoing)
Trade marks – registration (appeal) (shape trade mark)
- *Meltwater Australia Pty Ltd – Reference to Copyright Tribunal* (Copyright Tribunal; ongoing)
Copyright – setting of appropriate licence fees (media-monitoring)
- *Right2Drive Pty Ltd v Pokerplus Pty Ltd* (Federal Court; unled; settled)
Trade marks – infringement
- *Dometic Australia Pty Ltd v Houghton Leisure Products Pty Ltd* (Federal Court; reserved)
Patents – infringement and invalidity (air-conditioners)
Interlocutory – interlocutory injunction
Misleading or deceptive conduct in advertising
- *Prodata Solutions Pty Ltd v South Australian Fire and Emergency Services Commission & Anor* (Federal Court; ongoing)
Breach of confidence (IT system)
Breach of contract
Copyright – infringement
Interlocutory – interlocutory injunction
- *Stelco Pty Ltd t/as Downrigger Shop v Facebook Australia Pty Ltd* (for Facebook; unled; resolved)
Consumer protection
- *Chandrasekaran v Microsoft Pty Ltd & Ors* (Supreme Court; for Facebook; unled; resolved)
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 (settled; judgments relate to discovery and release from undertakings)
 - Copyright – infringement
 - Breach of contract
- *Robson Environmental Pty Ltd v Lancaster & Ors* (Federal Court; ongoing)
 - Copyright – infringement (asbestos reports)
 - Breach of confidence
 - 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; settled)
 - Copyright – infringement
 - Breach of contract
 - Interlocutory – injunction (obtained urgent injunction unled)
- *Bohemia Crystal Pty Ltd v Host Corporation Pty Ltd* (Federal Court; reserved)
 - Trade marks – infringement and invalidity (crystal glassware)
 - Passing off
 - Misleading or deceptive conduct in advertising
- *NUC Electronics Co Ltd v Optimum Appliances Pty Ltd* (Federal Court; settled)
 - Patents – infringement, invalidity (juicers)
- *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
 - Trade marks – infringement (skull with wings mark)
 - Copyright – infringement
 - Interlocutory – security for costs
- *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 to registration – appeal (CITY FX and related marks)
- *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
 - Interlocutory – preliminary discovery
- *Shape Shopfitters Pty Ltd v SHAPE Australia Pty Limited* [2017] FCA 474; [2017] FCA 865; [2017] FCA 1277 (appeal on foot)
 - Trade marks – infringement
 - Passing off
 - Misleading or deceptive conduct in advertising
 - Interlocutory – admissibility of evidence from the Wayback Machine
 - Costs
- *PMP Digital Pty Ltd v Joshua Gavin & Ors* (Federal Court; unled; settled)
 - Copyright – infringement
 - Breach of contract
 - Torts – interference with contractual relations
- *Zuru Limited & Anor v Brand Developers Aust Pty Ltd* [2017] FCA 1023 (Federal Court; settled)
 - 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 to registration (BARILLA PASTA PRONTO; successfully defended opposition unled)
- *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; settled)
 - Breach of confidence
 - Copyright – infringement
- *Brand Developers Limited v Commissioner of Patents & Anor* (AAT; ongoing)
 - Patents – validity (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

- *Balanced Body Inc v Online Distribution Pty Ltd* (Federal Court; ongoing)
Patents – infringement, invalidity (Pilates equipment)
- Various trade mark and patent oppositions, including unled

Selected recent matters – Other fields

- *Commonwealth Bank of Australia v Brick & Block Company Pty Ltd (in Liq)* [2016] NSWSC 1277 (unled)
Interlocutory – application for suppression orders (successfully applied unled)
- *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
Breach of contract – appeal
- *Universal Music Australia Pty Limited v Pavlovic & Anor; Pavlovic & Anor v Universal Music Australia Pty Limited & Ors* [2017] NSWSC 247; [2017] NSWSC 314 (settled; judgments relate to discovery and release from undertakings)
Breach of contract
Corporations – directors’ duties
Equity – fiduciary responsibility, constructive trust
- *Sungrow Australia Group Pty Ltd v Sanctus One Pty Ltd & Anor* (Supreme Court; unled; ongoing)
Breach of contract (solar panels)
Defective goods
- *Kids Club Rozelle Pty Ltd v European Hire Cars Pty Ltd* (Supreme Court; ongoing)
Breach of contract
Breach of Australian Consumer Law
- *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; unled; settled)
Corporations – application to set aside statutory demand
- *Willard Public Affairs Pty Ltd v AusBiotech Ltd* (District Court; unled; settled)
Breach of contract
Quantum meruit

- *McGee Projects Pty Ltd v Buildworx (Australia) Pty Limited* (District Court; unled; settled)
 - Breach of contract
 - Quantum meruit
- *Giorgio Ciccone v NSW Land and Housing Corporation* [2016] NSWCATAP 120 (unled)
 - Administrative law – tenancy

SOLICITOR at GILBERT + TOBIN

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

JULY 2010 – OCTOBER 2011

INTERN at the AUSTRALIAN LAW REFORM COMMISSION

APRIL 2010 – JUNE 2010

ASSOCIATE to JUSTICE GREENWOOD OF THE FEDERAL COURT OF AUSTRALIA

JANUARY 2009 – FEBRUARY 2010

LEGAL RESEARCH ASSISTANT at LEVEL 11 INNS OF COURT, BRISBANE

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

2014

BACHELOR OF LAWS with HONOURS UNIVERSITY OF QUEENSLAND

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