

# FRANCES ST JOHN

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

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APRIL 2015 – PRESENT

Commercial practice with a particular focus on intellectual property.

*Best Lawyers – Intellectual Property Law, 2018*

*Doyle’s Guide – Intellectual Property Barristers, Australia, 2018*

*Doyle’s Guide – Technology, Media & Telecommunications, Australia, 2018*

*Doyle’s Guide – Intellectual Property Barristers New South Wales, 2016, 2017, and 2018 (“Leading” junior counsel)*

*Doyle’s Guide – Technology, Media & Telecommunications, New South Wales, 2018*

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

- *Coretell Pty Ltd v Australian Mud Company Pty Ltd* [2017] FCAFC 54, (2017) 250 FCR 155, 124 IPR 210, [2017] AIPC 92-525; also [2016] FCA 706; [2017] FCAFC 122; [2017] HCSL 189 (special leave refused)
  - Patents – infringement and invalidity (drilling equipment)
  - Costs
- *Dinzel Construction Systems Pty Ltd v AFS Systems Pty Ltd & Anor* [2018] FCAFC 157; also [2017] FCA 262; [2017] FCA 791; [2017] FCA 919
  - Patents – infringement and invalidity (building products)
  - Interlocutory – interlocutory injunction
- *Domino’s Pizza Enterprises Ltd v Precision Tracking Pty Ltd & Ors* [2017] FCA 211; [2017] FCA 1264; [2018] FCA 48; [2018] FCA 910; [2018] FCA 1160 (Federal Court; settled)
  - Patents – infringement and invalidity (GPS tracking of pizza delivery)
  - Breach of confidence
  - Copyright – infringement
  - Misleading or deceptive conduct
- *Primary Health Care Limited v Commonwealth & Ors* [2017] FCAFC 174
  - Trade marks – opposition to registration – appeal (PRIMARY HEALTH CARE)
- *Globaltech Corporation Pty Ltd v Australian Mud Company Pty Ltd* (Full Federal Court; ongoing)
  - Patents – infringement and invalidity (drilling equipment)
- *Neurim Pharmaceuticals (1991) Ltd v Generic Partners Pty Ltd & Anor* [2018] FCA 1082 (Federal Court; settled; judgment is interlocutory)
  - Patents – infringement and amendment (pharmaceuticals)

- *Roadshow Films Pty Limited & Ors v Telstra Corporation Limited & Ors* (Federal Court; **unled**; orders made but reasons not yet published)
  - Copyright – application to block access to piracy websites under s 115A
- *Voxson Pty Ltd v Telstra Corporation Limited & Ors* [2017] FCA 267, (2017) 343 ALR 681, [2018] ALMD 729 (settled; judgment is on a pleading point)
  - Patents – infringement and invalidity (telecommunications)
  - Misleading or deceptive conduct
- *Fairfax Media Publications Pty Ltd v Network 10 Pty Ltd* (Federal Court; ongoing)
  - Urgent interlocutory relief
  - Trade marks – infringement (Network 10 rebrand to “10 BOSS”)
  - Misleading or deceptive conduct
- *Roadshow Films Pty Limited & Ors v Telstra Corporation Limited & Ors; Foxtel Management Pty Ltd v TPG Internet Pty Ltd & Ors* [2016] FCA 1503, (2016) 248 FCR 178, 343 ALR 428, 122 IPR 81, [2016] AIPC 92-517, [2017] ALMD 3345
  - Copyright – first applications to block access to piracy websites under new s 115A
- *Australian Mud Company Pty Ltd v Coretell Pty Ltd* [2016] FCA 830; [2018] FCA 1109; [2018] FCA 1608
  - Patents – infringement and invalidity (drilling equipment)
  - Interlocutory – freezing orders
  - Costs – lump sum costs order (**unled**)
- *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)
- *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)
- *Norton v DTA (Australia) Pty Ltd* (Federal Circuit Court; **unled**; settled)
  - Designs – infringement (angle grinders)
- *Universal Music Australia Pty Ltd & Ors v TPG Internet Pty Ltd & Ors* [2017] FCA 435, (2017) 348 ALR 493, 126 IPR 219, [2018] ALMD 2180, [2018] ALMD 2181
  - Copyright – second application to block access to piracy websites under new s 115A

- *Dometic Australia Pty Ltd v Houghton Leisure Products Pty Ltd* [2018] FCA 1573, (2018) 135 IPR 403, [2019] ALMD 759, [2019] ALMD 760, [2019] ALMD 761
  - Patents – infringement and invalidity (air-conditioners)
  - Interlocutory – interlocutory injunction
  - Misleading or deceptive conduct in advertising
- *Amga Palmer Pty Ltd v Ilestroke Pty Ltd & Ors* (Federal Court; **unled**; settled)
  - Copyright – infringement (house plans)
- *State of Escape Accessories Pty Limited v Anthony Biviano & Anor* (Federal Court; **unled**; settled)
  - Copyright – infringement; designs overlap (fashion – handbags)
  - Passing off
  - Misleading or deceptive conduct
- *Jujube Australia v Natures Treat Pty Ltd & Ors* [2018] FCA 962 (Federal Court; **unled**; settled)
  - Trade marks – infringement (fruit – JUJUBE AUSTRALIA device with dragon)
  - Passing off
  - Misleading or deceptive conduct
  - Costs
- *Meltwater Australia Pty Ltd – Reference to Copyright Tribunal* (Copyright Tribunal; ongoing)
  - Copyright – setting of appropriate licence fees (media-monitoring)
- *Workinonit Pty Ltd v Six Hunt Pty Ltd* (Federal Circuit Court; **unled**; settled)
  - Trade marks – revocation (fashion – clothing and sneakers – BUTTER)
- *Zetco Valves Pty Ltd v Elson Australasia Pty Ltd* (Federal Court; ongoing)
  - Patents – infringement and invalidity (plumbing supplies)
- *Acushnet Company v Golf Gods & Ors* (Federal Court)
  - Trade marks – infringement (fashion – golf clothing and other golf goods)
- *Right2Drive Pty Ltd v Pokerplus Pty Ltd* (Federal Court; **unled**; settled)
  - Trade marks – infringement (car sharing)
- *Prodata Solutions Pty Ltd v South Australian Fire and Emergency Services Commission & Anor* (Federal Court)
  - Breach of confidence (IT system)
  - Breach of contract
  - Copyright – infringement
  - Interlocutory – interlocutory injunction
- *Repipe Pty Ltd v Commissioner of Taxation* (Federal Court; ongoing)
  - Patents – validity – manner of manufacture (risk assessment system)

- *Laminar Air Flow Pty Ltd v Vokes Ltd & Ors* (Federal Court; **unled**)  
Trade marks – infringement (air-conditioners – VOKES marks)
- *Stelco Pty Ltd t/as Downrigger Shop v Facebook Australia Pty Ltd* (for Facebook; **unled**; resolved as against Facebook)  
Consumer protection
- *Chandrasekaran v Microsoft Pty Ltd & Ors* (Supreme Court; for Facebook; **unled**; resolved as against Facebook)  
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 (music)  
Breach of contract
- *Gram Engineering Pty Ltd v Oxworks Pty Ltd* (Federal Court; ongoing)  
Patents – infringement (fence posts)
- *Robson Environmental Pty Ltd v Lancaster & Ors* (Federal Court; settled)  
Copyright – infringement (asbestos reports)  
Breach of confidence  
Breach of contract
- *Hill & Smith Holdings PLC & Anor v Safe Barriers Pty Ltd* [2018] FCA 1882 (Federal Court; ongoing; judgment concerns discovery)  
Patents – infringement and invalidity (roadside barriers)
- *Tatts Group Limited v Lottoland Australia Pty Ltd* (Federal Court; settled)  
Misleading or deceptive conduct in advertising (online gambling)  
Trade marks – infringement
- *Steiner Legal v Rubicon Films Pty Limited* (Federal Court; **unled**; settled)  
Copyright – infringement (television commercial)  
Breach of contract  
Interlocutory – injunction (obtained urgent injunction unled)
- *Bohemia Crystal Pty Ltd v Host Corporation Pty Ltd* [2018] FCA 235, (2018) 129 IPR 482; also [2018] FCA 892  
Trade marks – infringement and invalidity (crystal glassware – BOHEMIA and related marks)  
Passing off  
Misleading or deceptive conduct in advertising  
Costs (**unled**)

- *Rajendra Patel v iNova Pharmaceuticals (Singapore) Pte* [2018] ATMO 124 (**unled**)  
Trade marks – opposition (pharmaceuticals – DUROFLAM)
- *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 (fashion – skull with wings mark)  
Copyright – infringement  
Interlocutory – security for costs
- *Rakman International Pty Ltd v Boss Fire & Safety Pty Ltd* (Federal Court; ongoing)  
Patents – infringement, invalidity (fire safety boxes)
- *CSR Building Products Limited v Steadiform Pty Ltd* (Federal Court; ongoing)  
Patents – infringement, invalidity (building products)
- *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 (industrial containers)
- *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)
- *GAIN Capital UK Limited v Citigroup Inc (No 2)* [2017] FCA 519, (2017) 123 IPR 234, [2017] ALMD 4126, [2017] ALMD 4127; also [2016] FCA 243, (2016) 118 IPR 4; also [2016] FCA 582  
Trade marks – opposition to registration – appeal (finance – 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 (beauty – rotating face brush)  
Interlocutory – preliminary discovery
- *Quantum Group Holdings Pty Ltd v Thompson* (Federal Circuit Court appeal from IP Australia; **unled**; ongoing)  
Trade marks – registration (accounting and finance – QUANTUM)
- *Pinnacle Runway Pty Ltd v Triangl Limited & Anor* (Federal Court; reserved)  
Trade marks – infringement and validity (fashion – swimwear)

- *Shape Shopfitters Pty Ltd v SHAPE Australia Pty Limited* [2017] FCA 474; [2017] FCA 865; [2017] FCA 1277
  - Trade marks – infringement (construction – SHAPE)
  - 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 (digital library of photographs of FMCG)
  - 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 (food – 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; settled)
  - Breach of confidence
  - Copyright – infringement
- *Brand Developers Limited v Commissioner of Patents & Anor* (Administrative Appeals Tribunal; settled)
  - Patents – validity (water balloons)
- *eos Products LLC v CBCH Australia Pty Ltd* (Federal Court; settled)
  - Passing off (beauty – lip balm)
  - Misleading or deceptive conduct in advertising
- *Complete Office Supplies v Corporate Office Supplies* (Federal Court; **unled**; settled)
  - Trade marks – infringement; passing off (stationery – COS)
  - Misleading or deceptive conduct in advertising
- *In the matter of Australian Patent Applications No. 2013351261 & 2013351262 in the name of K-Fee System GmbH* [2018] APO 31
  - Patents – opposition to registration (coffee machine)
- 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**)  
Breach of contract (solar panels)  
Defective goods
- *Kids Club Rozelle Pty Ltd v European Hire Cars Pty Ltd* [2018] NSWSC 1115  
Breach of contract  
Breach of Australian Consumer Law
- *Kegran v Warrik* (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**

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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)