

FRANCES ST JOHN

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

APRIL 2015 – PRESENT

Intellectual property practice, including trade marks, copyright, designs, breach of confidence, consumer protection (misleading or deceptive conduct), and patents.

Chambers and Partners – Intellectual Property: The Bar, Global, 2021 to 2025 (Band 1)

Chambers and Partners – Intellectual Property: The Bar, Asia Pacific, 2021 to 2025 (Band 1)

Lexology Index 2026 – Copyright; Trade Marks; Patents

Best Lawyers – Intellectual Property Law, 2018 to 2027

Doyle’s Guide – Intellectual Property Barristers, Australia, 2018 to 2023 (“Leading” junior counsel 2022-2023) (no longer published)

Doyle’s Guide – Intellectual Property Junior Counsel, New South Wales, 2016 to 2026 (“Preeminent” since 2023)

Doyle’s Guide – Technology, Media & Telecommunications Barristers, Australia, 2023 to 2024 (“Leading” junior counsel in 2024) (no longer published)

Doyle’s Guide – Technology, Media & Telecommunications Junior Counsel, New South Wales, 2018 to 2026 (“Preeminent” junior counsel since 2026)

SELECTED RECENT MATTERS

- *Aristocrat Technologies Australia Pty Ltd v Commissioner of Patents* [2022] HCA 29; (2022) 403 ALR 625 (High Court; **unled** at hearing)
Patents – validity – manner of manufacture (computer-implemented inventions)
- *Bed Bath ‘N’ Table Pty Ltd v Global Retail Brands Australia Pty Ltd* [2025] HCA 50, (2025) 426 ALR 518, 100 ALJR 57, 190 IPR 20; [2024] FCAFC 139 (Full Federal Court and High Court; made submissions in the Full Federal Court on some aspects of the case)
Trade marks – infringement (soft homewares)
Consumer protection – misleading or deceptive conduct
- *Globaltech Corporation Pty Ltd v Australian Mud Company Pty Ltd* (2019) 145 IPR 39, [2019] FCAFC 162; [2017] HCASL 189; [2020] HCATrans 45 (special leave refused after oral hearing)
Patents – infringement and invalidity (mechanical: drilling equipment used in mining)

- *Jusand Nominees Pty Ltd v Rattlejack Innovations Pty Ltd* (2022) 167 IPR 1, [2022] FCA 540; [2022] FCA 867; [2023] FCAFC 178, (2023) 300 FCR 408, (2023) 176 IPR 336 (Full Federal Court; at trial, cross-examined expert witness and made oral submissions on some aspects of the case; on appeal, made oral submissions on part of the case)
 - Patents – infringement (mechanical: device to plug bore holes to catch broken drill rods)
 - Patents – invalidity
 - Interlocutory – urgent interlocutory relief
 - Appeals
- *RB (Hygiene Home) Australia Pty Ltd v Henkel Australia Pty Ltd (No 2)* [2021] FCA 1194; (2021) 162 IPR 496, [2021] FCA 1094; (No 2) [2023] FCA 1491; [2024] FCAFC 10, (2024) 302 FCR 285, (2024) 420 ALR 173, (2024) 179 IPR 178; [2024] FCAFC 92 (Full Federal Court; made oral submissions)
 - Trade marks – infringement and invalidity (FMCG – dishwashing tablets)
 - Trade marks – shape trade marks
 - Consumer protection – misleading or deceptive conduct
 - Consumer protection – alleged false advertising (claim to be ecologically friendly)
 - Interlocutory – urgent interlocutory relief
- *Rakman International Pty Ltd v Boss Fire & Safety Pty Ltd* (2022) 166 IPR 264; [2022] FCA 464; [2022] FCA 1113; [2023] FCAFC 202, (2023) 178 IPR 20; [2024] FCA 914 (Federal Court and Full Federal Court; at trial, cross-examined witnesses, including an expert witness; on appeal, made oral submissions on part of the case)
 - Patents – infringement, invalidity (mechanical: fire safety boxes)
- *Fortescue Ltd v Element Zero Pty Ltd* [2024] FCA 590; [2024] FCA 1157 (Federal Court; settled; **unled**)
 - Copyright and breach of confidence – employee allegedly taking material to a competitor
 - Interlocutory – Anton Pillar orders
- *McCallum v Projector Films Pty Ltd* [2025] FCA 903, (2025) 427 ALR 620, 187 IPR 191; [2026] FCA 173; [2026] FCA 653 (Federal Court; **unled**, including at trial)
 - Copyright – moral rights (right of attribution and false attribution – documentary film)
 - Consumer protection – misleading or deceptive conduct; statutory guarantees
 - Breach of contract (director’s agreement)
 - Interlocutory – urgent injunctive relief
- *Trafalgar Group Pty Ltd v Boss Fire & Safety Pty Ltd* [2026] FCA 202; [2026] FCA 366 (Federal Court; **unled**, including at trial)
 - Trade marks – registration (fire safety boxes)
 - Costs
- *Sabo Skirt Pty Ltd v Shein Distribution Australia Pty Ltd* (Federal Court; ongoing; **unled**)
 - Copyright infringement (fashion – against Kmart and Shein among others)
 - Design infringement and validity
 - Trade mark infringement and validity

- *Lift Shop Pty Ltd v Next Level Elevators Pty Ltd* [2025] FCAFC 108, (2025) 312 FCR 127, 187 IPR 22; [2023] FedCFamC2G 268; [2023] FedCFamC2G 394; [2024] FedCFamC2G 554 (Full Federal Court; cross-examined witnesses, including expert witnesses; made oral submissions at appeal hearing)
 - Copyright – infringement (business documentation)
 - Breach of confidence (former employee)
 - Consumer protection – misleading and deceptive conduct
 - Interlocutory – application to set aside notice to produce (**unled**); application to exclude evidence said to be improperly obtained (**unled**)
- *Karen Walker Limited v Premonition Designs Pty Ltd & Ors* (Federal Court; ongoing; **unled**)
 - Trade mark infringement (fashion)
 - Trade mark registration
- *Seven West v Juhasz* (Federal Court; ongoing; **unled**)
 - Copyright – moral rights infringement in artistic works (paintings in Maryborough’s “Cistern Chapel”)
- *Aristocrat Technologies Australia Pty Ltd v Light & Wonder, Inc.* [2024] FCA 439; [2024] FCA 870
 - Copyright and breach of confidence – employee allegedly taking material to a competitor
 - Interlocutory – Preliminary discovery
- *Copyright Agency Limited v Isentia Pty Limited & Ors* [2022] FCAFC 163, (2022) 294 FCR 636, 405 ALR 619, 169 IPR 216; (2022) 405 ALR 619 (Full Federal Court; made oral submissions on part of the case)
 - Copyright – setting of appropriate licence fees (media monitoring)
- *Reference by APRA AMCOS to Copyright Tribunal* [2022] ACopyT 4 (Copyright Tribunal; **unled** for Apple)
 - Copyright – setting of appropriate licence fees (use of musical works in streaming video on demand services)
 - Interlocutory – Tribunal’s power to issue summonses
- *The DLA Group Pty Limited v The State of Western Australia* [2022] ACopyT 6; [2023] ACopyT 1 (Copyright Tribunal; **unled** for the State of WA; settled; judgments concern costs and summonses)
 - Copyright – Commonwealth use of copyright works
 - Costs
 - Procedure – Tribunal’s power to issue summonses
- *Assignar Pty Ltd v Varicon Pty Ltd* (Federal Court; ongoing)
 - Copyright – Computer software (SaaS)
 - Interlocutory – Preliminary discovery

- *Roadshow Films Pty Limited & Ors v Telstra Corporation Limited & Ors; Foxtel Management Pty Ltd v TPG Internet Pty Ltd & Ors* (2016) 248 FCR 178, 343 ALR 428, 122 IPR 81, [2016] AIPC 92-517, [2017] ALMD 3345, [2016] FCA 1503; *Universal Music Australia Pty Ltd & Ors v TPG Internet Pty Ltd & Ors* (2017) 348 ALR 493, 126 IPR 219, [2018] ALMD 2180, [2018] ALMD 2181, [2017] FCA 435; *Roadshow Films Pty Limited & Ors v Telstra Corporation Limited & Ors* (application no. 4; Federal Court; **unled**; orders made as sought but no reasons published); also [2019] FCA 885 (application no. 5; **unled**); also [2019] FCA 1328 (application no. 6; **unled**); also *Roadshow Films Pty Limited & Ors v Telstra Corporation Limited & Ors* (2020) 151 IPR 449 and (2020) 153 IPR 317 (application no. 7; **unled**); also *Roadshow Films Pty Limited & Ors v Telstra Corporation Limited & Ors* [2020] FCA 1468 (application no. 8; **unled**); *Roadshow Films Pty Limited & Ors v Telstra Corporation Limited & Ors* [2021] FCA 1588 (application no. 9; **unled**); *Roadshow Films Pty Limited & Ors v Telstra Corporation Limited & Ors* [2022] FCA 134 (application no. 10; **unled**); *Roadshow Films Pty Limited & Ors v Telstra Corporation Limited & Ors* [2022] FCA 1413 (application no. 11; **unled**); *Roadshow Films Pty Limited & Ors v Telstra Corporation Limited & Ors* [2022] FCA 1468 (application no. 12; **unled**); *Roadshow Films Pty Limited & Ors v Telstra Limited* [2023] FCA 777 (application no. 13; **unled**); *Roadshow Films Pty Limited & Ors v Telstra Limited* [2023] FCA 1167 (**unled**); *Roadshow Films Pty Limited & Ors v Telstra Limited* [2024] FCA 246 (application no. 14; **unled**); *Roadshow Films Pty Limited & Ors v Telstra Limited* [2024] FCA 485 (application no. 15; **unled**); *Roadshow Films Pty Limited & Ors v Telstra Limited* [2024] FCA 1388 (application no. 16; **unled**); *Roadshow Films Pty Limited v Telstra Limited* [2025] FCA 744 (application no. 17; **unled**); *Universal City Studios LLC v Telstra Limited* (No 2) [2025] FCA 1390; [2025] FCA 1485 (application no. 18; **unled**)

Copyright – applications to block access to piracy websites under s 115A

Interlocutory – applications for urgent relief

- *AGL Energy Limited v Greenpeace Australia Pacific Limited* (2021) 395 ALR 275, [2021] FCA 625

Copyright – infringement (parody or satire and criticism or review defences)

Trade marks – infringement (AGL logo used in Greenpeace campaign)

Interlocutory – urgent interlocutory relief

- *Coretell Pty Ltd v Australian Mud Company Pty Ltd* (2017) 250 FCR 155, 124 IPR 210, [2017] AIPC 92-525, [2017] FCAFC 54; [2016] FCA 706; [2017] FCAFC 122; [2017] HCASL 189 (special leave refused)

Patents – infringement and invalidity (mechanical: drilling equipment used in mining)

Costs

- *Dyno Nobel Asia Pacific Pty Ltd v Orica Explosives Technology Pty Ltd & Ors* [2025] FCA 767

Patents – infringement and invalidity (mechanical/electrical: wireless explosive devices)

Patents – unjustified threats

Preliminary discovery

Procedure – amendment of pleadings

- *Meltwater Australia Pty Ltd – Reference to Copyright Tribunal* [2019] ACopyT 1; [2020] ACopyT 2; [2021] ACopyT 1; [2021] ACopyT 3; [2022] ACopyT 5

Copyright – setting of appropriate licence fees (media monitoring)

Interlocutory – release of Harman undertaking (**unled**)

- *Pentana Solutions Pty Ltd v Titan Dealer Management Solutions Pty Ltd* (Federal Court; reserved)
 - Copyright – infringement (software)
 - Copyright – circumvention of electronic protection measures
 - Torts – inducing breach of contract
 - Competition – misuse of market power
- *Goal Professional Services Pty Ltd v SAHR Group Pty Ltd* (Federal Court; settled; **unled**)
 - Breach of confidence – employee allegedly taking material to a competitor
 - Interlocutory – Preliminary discovery
- *Primary Health Care Limited v Commonwealth & Ors* [2017] FCAFC 174
 - Trade marks – registration – appeal (PRIMARY HEALTH CARE)
- *Hemmes Trading Pty Limited v Establishment 203 Pty Ltd* [2024] FCA 1100, (2024) 179 IPR 315 (Federal Court; cross-examined witnesses and made oral submissions)
 - Trade marks – infringement and invalidity (ESTABLISHMENT in relation to restaurant services)
- *GME Pty Ltd v Uniden Australia* [2022] FCA 520; (*No 2*) [2022] FCA 638
 - Designs – infringement (handheld radio microphones)
- *Victoria’s Secret Stores Brand Management, LLC v ePharmacy Group Pty Ltd* (Federal Court; settled; **unled**)
 - Trade marks – infringement (VICTORIA’S SECRET in relation to fragrances)
 - Interlocutory – urgent interlocutory relief
 - Confidentiality – application for final orders
- *Premonition Designs Pty Ltd v Karen Walker Limited* (Federal Court; ongoing; **unled**)
 - Trade marks – appeal of registration decision (fashion)
 - Trade marks – infringement (fashion)
- *Dr August Wolff GmbH & Co. KG Arzneimittel v Combe International Ltd* (2020) 149 IPR 1, [2020] FCA 730; (2021) 157 IPR 230, [2021] FCAFC 8
 - Trade marks – registration (VAGISAN v VAGISIL)
 - Costs
- *Penfold Projects Pty Ltd v Penfold Property Group Pty Ltd* (Federal Court; **unled**; settled)
 - Trade marks – infringement and validity (PENFOLD PROJECTS)
- *Cranky Health Pty Ltd v Biogenic Health Australia Pty Ltd* (Federal Court; **unled**; settled)
 - Trade marks – infringement and validity (THE MAN SHAKE)
- *RB (Hygiene Home) Australia Pty Ltd v Procter & Gamble Australia Pty Ltd* [2023] FCA 383; [2023] FCA 1650 (Federal Court)
 - Consumer protection – misleading or deceptive conduct (dishwashing tablets)
 - Interlocutory – urgent interlocutory relief

- *Domino's Pizza Enterprises Ltd v Precision Tracking Pty Ltd & Ors* [2017] FCA 211; [2017] FCA 1063; [2017] FCA 1264; [2018] FCA 48; [2018] FCA 910; [2018] FCA 1160 (settled – judgments are interlocutory)
 - Consumer protection – misleading or deceptive conduct
 - Patents – infringement and invalidity (mechanical/electrical: GPS tracking of pizza delivery)
 - Breach of confidence
 - Copyright – infringement
- *F45 Training Pty Ltd v Body Fit Training Company Pty Ltd* [2020] NSWSC 1879 (discontinued; judgment concerns an application under cross-vesting legislation)
 - Trade marks – infringement and invalidity (fitness studios)
 - Consumer protection – misleading or deceptive conduct
- *AGL Energy Limited v Greenpeace Australia Pacific Limited* (2021) 395 ALR 275, (2021) 159 IPR 336, [2021] FCA 625
 - Trade marks – infringement (AGL logo used in Greenpeace campaign)
 - Copyright – infringement (parody or satire and criticism or review defences)
 - Interlocutory – urgent interlocutory relief
- *Fairfax Media Publications Pty Ltd v Network 10 Pty Ltd* [2018] FCA 2003 (settled; judgment is interlocutory)
 - Trade marks – infringement (Network 10 rebrand to “10 BOSS”)
 - Consumer protection – misleading or deceptive conduct
 - Interlocutory – urgent interlocutory relief
- *Pinnacle Runway Pty Ltd v Triangl Group Limited* (2019) 375 ALR 251, 148 IPR 211, [2020] FCA 1379
 - Trade marks – infringement and invalidity (women’s clothing, particularly swimwear)
 - Evidence – admissibility of Wayback Machine records
 - Costs – settlement offers
- *iNova Pharmaceuticals (Australia) Pty Ltd v Letos Group Pty Ltd* [2022] FedCFamC2G 1052; [2023] FedCFamC2G 801 (**unled**)
 - Trade marks – infringement (counterfeit pharmaceutical goods)
 - Interlocutory – summary judgment
 - Damages and costs
- *Dometic Australia Pty Ltd v Houghton Leisure Products Pty Ltd* (2018) 135 IPR 403, [2019] ALMD 759, [2019] ALMD 760, [2019] ALMD 761, [2018] FCA 1573
 - Consumer protection – misleading or deceptive conduct
 - Patents – infringement and invalidity (mechanical: air-conditioners used in caravans)
 - Interlocutory – interlocutory injunction
 - Costs

- *Howden Australia Pty Ltd & Anor v Minetek Investments Pty Ltd & Ors* [2019] FCA 981; [2019] FCA 1851
 - Consumer protection – misleading or deceptive conduct
 - Breach of confidence (fans used in mines)
 - Breach of contract (employee misuse of information)
 - Patents – ownership (mechanical: fans used in mines)
 - Interlocutory – interlocutory injunction
 - Interlocutory – discovery (forensic imaging)
- *Taxiprop Pty Ltd v Neutron Holdings Inc* (2020) 156 IPR 1, [2020] FCA 1565; (2020) 157 IPR 10, [2020] FCA 1822; [2021] FCA 274
 - Trade marks – infringement and invalidity (transport – LIME)
- *Meenakshi Krishnan v Estee Lauder Companies Inc* (Federal Court; **unled** for Estee Lauder)
 - Consumer protection – alleged false advertising (beauty products)
 - Therapeutic goods – alleged breaches of regulatory regime
- *7 Network (Operations) Limited v 7-Eleven Inc* [2023] FCA 608; [2024] FCAFC 65, (2024) 181 IPR 210 (Full Federal Court)
 - Trade marks – invalidity (media and entertainment; FMCG – convenience stores)
- *Bangkok Broadcasting & TV Co Ltd v Seven Network (Operations) Limited; Seven Network (Operations) Limited v Bangkok Broadcasting & TV Co Ltd* (Federal Court; settled)
 - Trade marks – invalidity (media and entertainment)
- *Derma Pen LLC v Biosoft (Australia) Pty Ltd* [2022] FCA 885 (Federal Court; settled)
 - Trade marks – infringement and invalidity (beauty products – micro-needling devices)
 - Trade marks – whether purported assignment is void under *Conveyancing Act 1919*
 - Trade marks – ownership
 - Copyright – infringement
 - Contracts – whether contract is void
 - Enforcement of foreign judgment
 - Interlocutory – security for costs (**unled**)
- *Bohemia Crystal Pty Ltd v Host Corporation Pty Ltd* (2018) 129 IPR 482, [2018] FCA 235; [2018] FCA 892
 - Trade marks – infringement and invalidity (crystal glassware – BOHEMIA and related marks)
 - Passing off
 - Consumer protection – misleading or deceptive conduct
 - Costs (**unled**)
- *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

- *Steiner Legal v Rubicon Films Pty Limited* (Federal Court; **unled**; settled)
 - Copyright – infringement (television commercial)
 - Breach of contract
 - Interlocutory – injunction (obtained urgent injunction **unled**)
- *Wisdom Properties Group Pty Ltd v Velibor Todic & Ors* (Federal Court; **unled**; settled)
 - Copyright – infringement (house plans)
- *Jujube Australia v Natures Treat Pty Ltd & Ors* [2018] FCA 962 (**unled**; settled)
 - Trade marks – infringement (fruit – JUJUBE AUSTRALIA device with dragon)
 - Consumer protection – misleading or deceptive conduct
 - Costs
- *Shape Shopfitters Pty Ltd v SHAPE Australia Pty Limited* [2017] FCA 474; [2017] FCA 865; [2017] FCA 1277
 - Trade marks – infringement (construction – SHAPE)
 - Consumer protection – misleading or deceptive conduct
 - Interlocutory – admissibility of evidence from the Wayback Machine
 - Costs
- *Quantum Group Holdings Pty Ltd v Thompson* [2021] FedCFamC2G 339 (Federal Circuit Court; **unled**)
 - Trade marks – registration (accounting and finance – QUANTUM)
- *L’Oreal Australia Pty Ltd v BrandPoint Pty Ltd* [2015] FCA 978
 - Consumer protection – misleading or deceptive conduct (beauty – rotating face brush)
 - Interlocutory – preliminary discovery
- *Stelco Pty Ltd t/as Downrigger Shop v Facebook Australia Pty Ltd* (for Facebook; **unled**; resolved against Facebook)
 - Consumer protection
- *Chandrasekaran v Microsoft Pty Ltd & Ors* (Supreme Court; for Facebook; **unled**; resolved against Facebook)
 - Interlocutory – preliminary discovery
- *True Manufacturing Co Inc & Anor v Food Equipment Distributors Pty Ltd* (Federal Court; **unled**; settled)
 - Trade marks – infringement and invalidity
- *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)
 - Consumer protection – misleading or deceptive conduct
 - Copyright – infringement; designs overlap (fashion – handbags)
- *Workinonit Pty Ltd v Six Hunt Pty Ltd* (Federal Circuit Court; **unled**; settled)
 - Trade marks – revocation (fashion – clothing and sneakers – BUTTER)

- *Right2Drive Pty Ltd v Pokerplus Pty Ltd* (Federal Court; **unled**; settled)
Trade marks – infringement (car sharing)
- *Laminar Air Flow Pty Ltd v Vokes Ltd & Ors* (Federal Court; **unled**)
Trade marks – infringement (air-conditioners – VOKES marks)
- *Complete Office Supplies v Corporate Office Supplies* (Federal Court; **unled**; settled)
Trade marks – infringement (stationery – COS)
Consumer protection – misleading or deceptive conduct
- *eos Products LLC v CBCH Australia Pty Ltd* (Federal Court; settled)
Consumer protection – misleading or deceptive conduct (beauty products – lip balm)
- *NPP Australia Limited v Ripple Labs, Inc* (Federal Court; settled)
Trade marks – infringement (blockchain-style banking technology)
Consumer protection – misleading or deceptive conduct
International application and enforcement of laws
- *Frankies Bikinis LLC v Frankii Swim Pty Ltd & Anor* (Federal Court; settled)
Trade marks – infringement and invalidity (fashion – bikinis)
Consumer protection – misleading or deceptive conduct
Contracts – breach of settlement agreement
- *Boss Fire & Safety Pty Ltd v Fire Containment Pty Ltd* (2022) 166 IPR 264, [2022] FCA 464 (cross-examined witnesses, including an expert witness)
Trade marks – registration (fire safety boxes)
- Various trade mark and patent oppositions, **unled**, including for Ampol, Macquarie Bank, Imdb, and Penfolds

SOLICITOR at two major law firms

JULY 2010 – APRIL 2015

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
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BACHELOR OF LAWS with HONOURS
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2007; Dean's List Commendation for High Achievement (various semesters)