

# 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.

*Chambers and Partners – Intellectual Property: The Bar, Australia, 2020*

*Best Lawyers – Intellectual Property Law, 2018, 2019, 2020, and 2021*

*Doyle’s Guide – Intellectual Property Barristers, Australia, 2018, 2019, and 2020*

*Doyle’s Guide – Intellectual Property Barristers New South Wales, 2016, 2017, 2018, 2019, and 2020*  
*(“Leading” junior counsel in 2018, 2019, and 2020)*

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

*Doyle’s Guide – Technology, Media & Telecommunications, New South Wales, 2018, 2019, and 2020*

### **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] HCASL 189 (special leave refused)
  - Patents – infringement and invalidity (drilling equipment)
  - Costs
- *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**)
  - Copyright – applications to block access to piracy websites under s 115A
- *Dincol Construction Systems Pty Ltd v AFS Systems Pty Ltd & Anor* [2018] FCAFC 157, (2018) 360 ALR 273, (2018) 135 IPR 197; 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 – judgment is interlocutory)
  - 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)

- *Pinnacle Runway Pty Ltd v Triangl Group Limited* (2019) 375 ALR 251, 148 IPR 211; [2020] FCA 1379 (appeal discontinued)
  - Trade marks – infringement and invalidity (women’s clothing, particularly swimwear)
  - Evidence – admissibility of Wayback Machine records
  - Costs – settlement offers
- *Globaltech Corporation Pty Ltd v Australian Mud Company Pty Ltd* [2019] FCAFC 162, (2019) 145 IPR 39; [2017] HCASL 189 (special leave refused after oral hearing)
  - Patents – infringement and invalidity (drilling equipment)
- *Neurim Pharmaceuticals (1991) Ltd v Generic Partners Pty Ltd & Anor* [2018] FCA 1082; [2019] FCA 154, (2019) 139 IPR 424 (Federal Court; judgments are interlocutory)
  - Patents – infringement and invalidity (pharmaceuticals)
  - Patents - amendment
- *Voxson Pty Ltd v Telstra Corporation Limited & Ors* [2017] FCA 267, (2017) 343 ALR 681, [2018] ALMD 729 (settled – judgment is interlocutory)
  - Patents – infringement and invalidity (telecommunications)
  - Misleading or deceptive conduct
- *F45 Training Pty Ltd v Body Fit Training Company Pty Ltd* [2020] NSWSC 1879 (ongoing; judgment concerns an application under cross-vesting legislation)
  - Trade marks – infringement and invalidity (fitness studios)
  - Misleading or deceptive conduct
- *Fairfax Media Publications Pty Ltd v Network 10 Pty Ltd* [2018] FCA 2003 (Federal Court; settled; judgment is interlocutory)
  - 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
- *True Manufacturing Co Inc & Anor v Food Equipment Distributors Pty Ltd* (Federal Court; **unled**; settled)
  - Trade marks – infringement and invalidity
- *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**)

- *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)
- *Australian Mud Company Pty Ltd & Anor v Globaltech Corporation Pty Ltd & Anor* (Federal Court; ongoing)
  - Patents – infringement – quantum (drilling equipment)
  - Costs – lump sum costs
- *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
- *Australian Olympic Committee Inc v Colonial Leisure Group Pty Ltd* (Federal Court; settled)
  - Copyright – infringement (craft beer)
  - Olympic insignia - infringement (craft beer)
- *NPP Australia Limited v Ripple Labs, Inc* (Federal Court; settled)
  - Trade marks – infringement (blockchain-style banking technology)
  - Misleading or deceptive conduct
  - International application and enforcement of laws
- *PGS Australia Pty Limited v Polarcus Seismic Limited & Ors* (Federal Court; ongoing)
  - Patents – infringement and invalidity (seismic surveying)
- *Taxiprop Pty Ltd v Neutron Holdings Inc* [2020] FCA 1565; [2020] FCA 1822 (Federal Court; ongoing as to quantum)
  - Trade marks – infringement and invalidity (transport – LIME)
- *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
  - Costs
- *Dr August Wolff GmbH & Co. KG Arzneimittel v Combe International Ltd* (2020) 149 IPR 1; [2020] FCA 730 (appeal reserved)
  - Trade marks – registration (VAGISAN v VAGISIL)
  - Costs

- *Howden Australia Pty Ltd & Anor v Minetek Investments Pty Ltd & Ors* [2019] FCA 981; [2019] FCA 1851 (Federal Court)
  - Breach of confidence (fans used in mines)
  - Breach of contract (employee misuse of information)
  - Misleading or deceptive conduct in advertising
  - Patents – ownership
  - Interlocutory – interlocutory injunction
  - Interlocutory – discovery (forensic imaging)
- *Pentana Solutions Pty Ltd v Titan Dealer Management Solutions Pty Ltd* (Federal Court; ongoing)
  - Copyright – infringement (software)
  - Copyright – circumvention of electronic protection measures
  - Torts – inducing breach of contract
  - Competition – misuse of market power
- *QAD Inc & Ors v Shepparton Partners Collective Operations Pty Ltd* (Federal Court; ongoing)
  - Copyright – infringement (software)
  - Copyright – licensing (software)
  - Contracts (technology licensing)
- *Australian Mud Company Pty Ltd & Anor v Globaltech Corporation Pty Ltd & Anor* [2020] FCA 811 (Federal Court; ongoing – judgment is interlocutory)
  - Patents – infringement
  - Interlocutory – preliminary discovery
  - Recusal (argued **unled**)
- *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* [2019] ACopyT 1; [2020] ACopyT 2 (Copyright Tribunal; ongoing – judgments are interlocutory)
  - 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; settled)
  - Patents – infringement and invalidity (plumbing supplies)
- *Wisdom Properties Group Pty Ltd v Velibor Todic & Ors* (Federal Court; **unled**; settled)
  - Copyright – infringement (house plans)
- *Acushnet Company v Golf Gods & Ors* (Federal Court; settled)
  - 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* (2019) 148 IPR 164
  - 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)
  - 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; settled; judgment concerns discovery)
  - Patents – infringement and invalidity (roadside barriers)
  - Interlocutory – discovery
- *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)
- *Dywidag-Systems International Pty Ltd v FCI Holdings Delaware, Inc* (Federal Court; settled)
  - Patents – infringement and invalidity (roof bolts in mines)
- *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)
- *Frankies Bikinis LLC v Frankii Swim Pty Ltd & Anor* (Federal Court; settled)
  - Trade marks infringement and invalidity (fashion – bikinis)
  - Passing off
  - Misleading or deceptive conduct in advertising
  - Contracts – breach of settlement agreement

- *CSR Building Products Limited v Steadiform Pty Ltd* (Federal Court)  
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)
- *Boss Fire & Safety Pty Ltd v Fire Containment Pty Ltd* (Federal Court; ongoing)  
Trade marks – registration (fire safety boxes)
- *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**; reserved)  
Trade marks – registration (accounting and finance – QUANTUM)
- *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
- *Sydney Discus World Aquariums Pty Ltd v Botany Way Scapes Pty Ltd & Ors* (Federal Circuit Court; **unled**; ongoing)
  - Trade marks – infringement, invalidity (aquascaping)
- *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)
- *Chicago Mercantile Exchange Inc v Barry Taylor International Pty Ltd* [2020] ATMO 100 (**unled**)
  - Trade marks – opposition to registration (financial products and services – E-MINI)
- Various other trade mark and patent oppositions, mostly **unled**



## **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**

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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)