

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.

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

Best Lawyers – Intellectual Property Law, 2018, 2019, 2020, 2021, and 2022

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

Doyle’s Guide – Intellectual Property Barristers New South Wales, 2016, 2017, 2018, 2019, 2020, and 2021 (“Leading” junior counsel in 2018, 2019, 2020, and 2021)

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

Doyle’s Guide – Technology, Media & Telecommunications, New South Wales, 2018, 2019, 2020, and 2021

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

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)