FRANCES ST JOHN

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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 2026 (Band 1)

Chambers and Partners – Intellectual Property: The Bar, Asia Pacific, 2021 to 2027 (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 2022-2003) (no longer published)

Doyle's Guide – Intellectual Property Junior Counsel, New South Wales, 2016 to 2027 ("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
AUSTRALIAN NATIONAL UNIVERSITY

2014

BACHELOR OF LAWS with HONOURS
UNIVERSITY OF QUEENSLAND

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