

TRADE MARK PROSECUTION

TIER 1

Davies Collison Cave
Griffith Hack
Phillips Ormonde Fitzpatrick
Spruson & Ferguson

TIER 2

Allens Arthur Robinson
Blake Dawson
FB Rice & Co
Freehills
Shelston IP
Watermark

TIER 3

Baker & McKenzie
Corrs Chambers Westgarth

TIER 4

Clayton Utz
Deacons
Gilbert + Tobin

Mallesons Stephen Jaques
Middletons
Minter Ellison
Pizzey's
Wray & Associates

TIER 5

Banki Haddock Flora
Callinans
Cullen & Co
Fisher Adams Kelly
Halford & Co
Madderns
Nicholas Weston

TRADE MARK CONTENTIOUS

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Holding Redlich
Middletons

TIER 4

Anisimoff Davenport
Norman Waterhouse

strategically. That was not the original intent, but now they're open to be used in more and more ways that weren't envisaged". Copyright stole the limelight in IP litigation this year and Nine Network's dispute with IceTV over programme guides earned a date in High Court over what constitutes a compilation.

Changes to make patent litigation cheaper and quicker are expected soon and will be welcomed by clients and lawyers. "I think judges are actively trying to manage the litigation process, realising this is ridiculous and patent litigation takes too long," says one client. Another patent litigator adds: "The profession is sympathetic to it. It won't hurt us because more clients will be willing to litigate – we could see

At-a-glance

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even more cases. Everyone's on board to make patent litigation more cost effective."

The IP practice at Allens Arthur Robinson continues to earn new clients. The consensus from various industries is echoed by one client that returns to the firm because: "There's a depth of knowledge and expertise there, and it's a good fit." Last year, Singapore-based Atlantis Resources Corporation, a renewable energy company, asked Allens to manage and protect its patent rights for underwater power generative systems across 45 different countries, an unusually expansive reach for the turbine industry. The firm has continued to develop a prosecution department that earned this year's improved rankings. Lead partner Jackie O'Brien and team are advising recent client MySpace on issues such as the ownership of information and branding within the new digital environment. Other work from the News Corporation subsidiary includes registering a trade mark portfolio in Australia and drafting specifications for new trade mark applications. The pharmaceutical industry often turns to renowned litigator Richard Hamer for his science background. During infringement and

confused others. A litigator in Melbourne explains that one recent Federal Court case on innovate step "confirmed that the threshold test is lower than we had expected. Now that it's

harder for the defending party to overturn an innovation patent, I think a lot of more sophisticated users will see them as enforcement tools and I suspect they'll be used rather

revocation proceedings a client says: "We'd have quite detailed chemistry questions even our office patent department – who are PhDs in chemistry – couldn't always answer, that Richard could." Another client calls partner Jim Dwyer a "very astute and experienced lawyer". Andrew Wiseman and practice leader Phillip Kerr are also recommended.

With offices in five major cities, IP boutique **Davies Collison Cave** is one of the largest in the industry, but numbers do not dilute quality. A client calls it "a dream firm to work with, very proactive and they understand [our] business". He further explains that the firm not only has "technical knowledge that's very good, but also when you work in-house you need more than technical expertise, Davies Collison Cave are all around very good and pick things up very quickly". In February 2008 respected IP specialist Ian Pascal joined Davies Collison Cave's Melbourne office from Blake Dawson. A client that briefs Michael Wohnizer reports that "he understands our business very well. He's very commercially minded with a high level of legal and technical expertise and very time proficient". The firm this year took several IP issues to the Federal Court and stood US-based Hanson Beverage Company through an appeal to the Full Federal Court after its case against local drinks maker Bickfords stumbled in earlier judgments. The original Monster Energy maker had neglected to register the drink's mark in Australia, while Bickfords had applied to register two Monster marks. Hanson initiated an ultimately successful action for passing off and misleading and deceptive conduct against the Australian. More discussion followed the Federal Court's interpretation of the Copyright Act 1968 in a copyright infringement case brought by Polo Ralph Lauren in response to Ziliani Holdings' parallel importation of genuine Polo products without licence to its polo player logo in Australia. After its appeal to the full Federal Court was rejected, at time of going to press

Polo is waiting to hear if the High Court will accept its appeal of the decision.

A preferred choice for both Telstra and Microsoft, **Mallesons Stephen Jaques** IP practice reaches three major cities on the country's eastern seaboard and includes three full-time IP partners in Melbourne and Sydney and in Brisbane. The integrated patent attorney practice has practitioners triple qualified as patent attorneys, lawyers and scientists or engineers. A client that instructs the firm on trade mark and patent matters says the team is "efficient and knows our business well". Clients are quick to mention partner Katrina Rathie, and "cannot recommend her highly enough". One told *Managing IP*: "Katrina has an exceptionally high level of client service and expertise. Her understanding of our business and the implications on us makes it feel as if she is one of the family! This gives us absolute confidence in her ability and performance in ensuring we get the best advice every time." Partner Sonia Stewart also receives high accolades. Fans of carbon-neutral Barefoot Rader beer can thank partner Scott Bouvier, who defended the catchy name that long-time client Lion Nathan chose for its new carbon-neutral brew against a trade mark infringement allegation brought by E & J Gallo. The US winery claimed it owned trade mark rights to Barefoot in Australia, despite never having used its registered Barefoot mark there. The Federal Court did not agree, but the case is on appeal. Alcohol brand owners await a conclusion that may secure beer a separate class from wine for trade mark purposes and will address what constitutes non-use. Mallesons represents the generic side of *Alphapharm v H Lundbeck* and its Australian subsidiary, another piece of patent litigation in the pharmaceutical sector, over brand name anti-depressant Lexapro. Lead partner Kim O'Connell managed to knock five years off the Dutch patent's expected expiration date when the Federal Court last heard the case. The publisher of the Australian Financial Review initiated

proceedings against Reed International Books trading as publisher LexisNexis for reprinting headlines as part of its web subscription service in a loaded test case in copyright law that challenges the limits of Australia's fair dealing exception and seeks to determine what protection newspaper headlines deserve. Mallesons partner John Swinson leads the defence.

Sydney-based **Spruson & Ferguson** keeps another office in Canberra and a presence in both Singapore and Malaysia through associated firm Ella Cheong Spruson & Ferguson. Managing principal David Griffith oversees one of Australia's largest IP teams, including patent attorneys, trade mark attorneys and lawyers. The firm's legal wing, **Spruson & Ferguson Lawyers**, represented Caroma Industries in a design and copyright infringement action against Technicon Industries over Caroma's Trident toilet pan. In October 2008 the Court found Technicon's toilet pan to be a fraudulent imitation of the Trident design, and the copycat manufacturers, although unaware of the registered original, guilty of infringement. A closely watched dispute between two local roadside post manufacturers questioned the validity of an innovation patent before court for the first time. In the Federal Court the firm defended three innovation patents for Delnorth and brought a successful infringement suit against Dura-Post. Although pending appeal to the Full Federal Court, Judge Gyles' August 2008 ruling opened the door for future parties to use innovation patents as offensive weapons against competitors.

Other patent attorney practices might dominate when it comes to servicing the corporate market, but **Griffith Hack's** team presents stiff competition on the home front, winning what one rival describes as "the largest local client base", which includes Australian mining giants BHP Billiton and Rio Tinto. The firm takes instructions from Germany's Sandoz, on the generic side in the ongoing battle against Eli Lilly over patent rights to the manufacture of gemtacinib, the anti-cancer treatment behind the US pharmaceutical's Genzar mark, which Wayne Condon and team will see to trial this June. The November 2008 appointment of special counsel Geraldine Farrell further strengthens the legal team. The October 2008 launch of a clean technologies group, headed by Sydney-based principal Robert Wallf, means the firm is poised to benefit from incentive schemes from a government that's been pushing hard for innovation in this area.

June's pharmaceutical face-off in Federal Court will see Griffith Hack take on **Clayton Utz**. Eli Lilly's counsel has already managed an interlocutory injunction restraining Interpharma from launching its generic version of Genzar. Partner John Collins co-ordinates the law firm's national combined IP/IT practice, reputed for its commercial and contentious work, from his Sydney post. Meanwhile partner Kate Marshall acts for Weatherford and Johnson Screens in patent infringement proceedings against Screenex Australia, and defends counterattacks on patent validity. The dispute over critical mining technology began in Australia before expanding to the US.

Frechills has an established IP practice that is equally strong in prosecution and contentious work, despite senior partner Anthony Muratore's move to Gilbert + Tobin, along with senior associate Lisa Taliadoros. A client that instructs the firm on trade mark and IP commercialisation issues says "Frechills are more proactive and more strategic" than competitors. Clients of patents partner Tom Gurney applaud his skill. In particular, says one: "Tom's got a science background that's really helpful when it comes to advising on patents and commercialisation strategy." A client praises Kristin Stammer for her "ability to summarise the key issues on complicated topics". Partner Frances Drummond manages the trade marks portfolio for a client who appreciates her "good team that provide the day to day support."

relying on Drummond to "get involved in the more strategic issues". Canadian generic Apotex has instructed the firm since 2007 in a commercially critical dispute with Les Laboratoires Servier and its Australian subsidiary regarding chemical patent rights to blood pressure regulator perindopril. The Freehills team has so far succeeded in a number of the proceedings' interlocutory applications, leading Servier to surrender one of the patents under scrutiny.

Baker & McKenzie offers full IP advisory services, although trade marks, anti-counterfeiting and enforcement are where the team really stands out. The firm guards a long list of top international clients, one of its longest relationships managing Mars' Asia-Pacific trade mark portfolio and all IP work in Australia. A client recalls that "very sound" partner Robert Arnold "had some good connections with Customs and police". Macquarie Bank looks to the firm to manage its marks, as does Pfizer, after it handed over its consolidated trade mark portfolio in Australia to Baker & McKenzie exclusively following a pitch four years ago, in addition to the regional management of its Viagra mark. Consultancy firm Strategic Management Group and Premier Media Group are other clients.

Recent departures aside, a client sums up the IP practice at **Blake Dawson** with ready praise, calling it "great" and "very commercial, always solution focused and very cost efficient, vital in today's environment". Its IP services include a complete range of contentious and non-contentious specialist services. The team manages impressive portfolios, particularly trade marks, including those of Conde Nast Publications Australian and Qantas Airways. More big brands such as Burger King, HSBC and Rolex have recently instructed the team. Many are under the charge of respected practice leader Lisa Ritson. Also this year, AstraZeneca appointed the firm to its IP advisory group. Partner Peter Chalk recently advised Aporex on

an application to revoke a Sanofi-Aventis patent for the prize drug Plavix. One client recommends Chalk explaining: "He is very solution focused; his advice is always to the point and practical. Peter really understands the in-house environment, the challenges, the business and what we require from external counsel."

Peter is an exceptional IP lawyer and an exceptional business partner," says another. Partner Ben Miller finished more than nine years of intensive patent litigation for subsidiaries of Swedish medical technology and healthcare group Gambro and Gambro Lundia, in a settlement with Fresenius Medical Care Australia.

Cors Chambers Westgarth has developed a diverse IP practice that gets its specialists involved in the IP aspects of transactional and commercial advisory projects undertaken for the firm's corporate and M&A clients in addition to the team's portfolio work for household name brands such as Louis Vuitton, Moët Hennessy, Ferrari, Gucci and the Foster's Group. An appointment by the Department of Broadband, Communications and the Digital Economy as the legal advisor for the National Broadband Network (NBN), an ambitious telecommunications infrastructure project supports the firm's good reputation for handling broad-scope IP issues. Partners Andrew Messenger and Eddie Scuderi are working on the project. Anti-counterfeiting, copyright and licensing are strengths, but the firm features in key patent and trade mark litigation as well, acting for Research in Motion, Cadbury and H Lundbeck. A prominent trade mark client finds the group "to be very efficient, professional and commercially focused," particularly group leader Stephen Stern and senior associate Luke Merrick, who "work very well as a team". A peer says Stern's relentless dedication to clients makes him a fearsome opponent. "Stephen Stern is a terrier!" she declares.

Clients appreciate that **Gilbert + Tobin IP** group leader Michael Williams "is very savvy and keen to litigate, not afraid of it, he has a

positive attitude towards litigation and sets realistic expectations to what you can expect as a result". A client familiar with Williams' work in the recording industry says "he's very good, very experienced" and "an effective litigator".

Overall the firm "has a strong litigation team - lots of good people, lots of resources," says another client. New hire Anthony Muratore has made an immediate impact and is working on a series of cases for the firm, including advising casino game designer Aristocrat Technologies in a Federal Court appeal over a patent application and maker of respiratory medical devices ResMed in Federal Court proceedings against the University of Sydney. The firm is also strong in copyright.

Distinguished patent and trade mark attorney firm **Phillips Ormonde Fitzpatrick** has been developing its legal wing. **Phillips Ormonde Fitzpatrick** Lawyers and maintains an affiliation with IP think tank, IP Organisers. Managing partner Graham Cowin's team includes 26 other partners between offices in Melbourne, Sydney and Adelaide. In recent years, the firm's copyright practice has experienced strong growth. A number of partners advise on copyright cases that concern building plans, including a matter for the Royal Institute of Architects, in conjunction with regular attention to protection and infringement issues, and drafting agreements that cover copyright.

Competitors view the firm's contentious work favourably and call the IP firm "a good firm; a capable team". The practice further distinguishes itself as one of the jurisdiction's few to develop plant breeders' rights expertise.

The IP practice at top law firm **Minter Ellison** has a "very strong pharmaceutical group" admits one rival in addition to several of the jurisdiction's top litigators, including partners Paul Zawa and Charles Alexander. In March 2008, Lynne Peach joined the partnership from Mallesons Stephen Jaques. Alexander is acting for John Fairfax Publications which is challenging the *Australian Financial Review's*

alleged reproduction of headlines. The firm has also been assisting Google and Fox (MySpace) in negotiations with the Australian Performing Rights Association that concern the websites' use of music.

The sizeable prosecution boutique practice **Shelston IP** combines forces with adjacent law firm **Shelston IP Lawyers** to work across patents, trade marks and designs, in addition to advising on trade practices and copyright issues. **Johnson & Johnson** instructs the firm on portfolio work; in October 2008 partner Sean McManis defended a trade mark opposition for the leading name in healthcare that concerned device marks, where little precedent for assessing similarities exists. **Dyson Technology**, industrial building materials group **James Hardie** and **BOC Gases** have all instructed the firm for a decade at least.

The IP practice group at commercial law firm **Deacons** is equipped to advise names such as **Blockbuster Australia**, **Colorado Group**, **eBay**, **GlaxoSmithKline**, **Remington** and **Swatch**. Litigation is a newly busy arena for the team, who acted for **GSK** on the trade secrets portion, regarding opiate extraction processes, of its

patent litigation with Scottish company **Ritche Pharmaceuticals**. Partner Cameron Harvey carried a trade mark infringement and revocation case for the **Colorado Group**, one of Australia's biggest retailers, against **Strandbags**, to the High Court. The issue concerned first user rights, geographical names as trade marks and statutory construction in the **Trade Marks Act**.

The market has seen more of **FB Rice & Co** lately, the IP boutique a client calls "very good; very efficient," with its partnership of 12 and two offices in the jurisdiction managed by highly regarded partner **Paul Whelan**. Partner **Paul Kilborn** has left the practice. A competitor describes the firm as one of the "movers in the profession right now," a sentiment echoed elsewhere. Over the last 12 months the biotech group recruited several attorneys and staff to the Sydney office, a reflection of rapid growth in demand for IP management in that sector. When

commenting on activity over the past year, Whennan explains: "Our firm has been quieter on the contentious side, and our clients are more likely to ask an infringer for a licensing

arrangement or settlement; they prefer to settle commercially rather than in court." In February 2008 though, Whennan earned a favourable non-infringement decision from the Federal Court for animal health care company Jurox, in litigation with rival Nufarm concerning its launch of the product Q Drench. The Court dismissed the patentee's subsequent appeal, securing a commercially vital win for the defendant. Trade mark partner Joanne Martin defended medical equipment manufacturer Karl Storz in a 2008 opposition launched by Bausch & Lomb that raised issues dating from a decades-old agreement between the parties. The opponent brought the same case before UK and US courts as well, with different outcomes in each country. IP Australia has favoured Karl Storz in a decision now subject to appeal by Bausch & Lomb.

Adelaide IP attorney firm Madderns best serves patent clients in the electronics and telecommunications and medical devices industries, at home and abroad, although its younger trade mark group has picked up steam in the domestic market, particularly among local wineries, conning Pernod Ricard Pacific and 49 others among its clientele. Cartridge World Australia, one of the fastest growing franchises, also looks to the prosecution shop's trade marks group. A local medical device company and pleased client of three years "would highly recommend the staff at Madderns, particularly partner Martin Pannall," for "the highest level of customer service. They have created a dedicated team to look after our IP work and they always meet deadlines". Another client, for whom the firm files patent applications and organises trade mark watches, praises the firm's response time: "They very promptly send confirmations and also always communicate if they will be later in delivering something. They have the most open

and consistent communications and tend to go that extra mile to keep the lines of communications open."

Dura-Post Australia instructed the firm on the infringement and validity proceedings between local fence-making rivals that produced the Federal Court's first words on what constitutes an innovative step. Existing client Codan Group turned to Bill McFarlane and Chris Wilkinson in March 2008 to advise on due diligence for its \$70 million acquisition of IP-based company MineLab Electronics, a world leader in the design and manufacture of mine and metal detectors. Since the acquisition, MineLab is now also a client. Partner Tom Melville's client Hark, a supplier of premium urban landscape products with its roots in Adelaide, has instructed the firm to leverage its entire IP portfolio through licence agreements worldwide, a testament to Madderns' ability to help domestic clients grow into global companies.

Partner Tony Watson heads Middletons' IP group in Sydney, Melbourne and Perth, which comprises commercial IP lawyers, litigators and a small team of attorneys. Key clients have included Porter Davis Homes, Darrell Lea, iNova Pharmaceuticals, Vodafone and the Australian Football League, which instructed the firm this year in a programme of new trade mark registration. Successful litigation on behalf of Porter Davis Homes has proved certain elements of housing design protectable by copyright. Tony Watson has advised domestic chocolate maker Darrell Lea since 2003 on several key episodes from the long-running battle with Cadbury over the enforceability of rights to the colour purple for chocolate. iNova has enlisted special counsel Jim Lennon to a massive exercise in portfolio management and due diligence after acquiring the whole of 3M Pharmaceuticals' IP assets in 2007.

The seven-partner practice at small but powerful boutique law firm Banki Haddock Flora specialises in copyright and trade marks,

especially for clients in media and the arts, although the team handles designs, patent licensing and, occasionally, patent litigation.

Partners Margaret Shearer and Simon Kneebone are trade mark specialists. A successful action in the Federal Magistrates Court last year enforced trade mark rights for removal company Two Men And A Truck. Shearer, along with partner Julie Robb, led a successful opposition by Nestlé to Mars' application for Whiskas purple. The dispute, now on appeal to the Federal Court, is part of the uphill battle for single colour marks.

Copyright partners Peter Banki and Kate Haddock are two of the most active and renowned in the field. Banki chairs the Australian Copyright Council and Haddock won a landmark victory on behalf of Copyright Agency, an Australian copyright management company, bringing a case against the crown for using protected material. The decision is now on appeal to the High Court. On August 6 2008 the Court ruled unanimously in favour of Haddock's client, holding that the State of New South Wales government's use of surveyors' plans is subject to statutory licence. The Copyright Tribunal must still determine appropriate terms for that use.

Banki and partner Julie Robb teamed up for San Pellegrino to tackle copycat bottled water Santa Vittoria, slapping the distributor, Camarella Bros, with a Federal Court action. Attracting a good deal of publicity, the case took a novel approach to managing IP looking at trade practices, trade mark and design issues.

Commercially focused attorney firm **Watmark** handles IP prosecution, licensing, acquisition, management and enforcement issues from offices in Melbourne, Sydney and Perth for a mixed domestic and international clientele, including German Chemical company BASF, ExxonMobil Chemical Europe, Sanofi-Aventis US, Alcan International and Note Printing Australia, which is responsible for the nation's banknotes. The firm began instructions last year from Flory Neuroscience Institutes to audit the medical research giant's IP management systems.

Watermark IP Lawyers ran a major trade mark case for the applicant Bavaria against Bayerischer Brauerbund concerning registration in Australia of marks with a geographical indication. Senior associate Peter Halliwell advised BHP Billiton on the commercial legal aspects of various technology contracts.

Melbourne-based **Nicholas Weston**, the niche commercial IP start-up of lawyer and trade mark attorney Nick Weston, practises both Australian and New Zealand law. Weston, creator of the Australian Trade Marks Law Blog and recent WIPO appointee, together with Lea Lewin, a lawyer with both trade mark and patent attorney qualifications, and lawyer Eryonne Kan at the firm's China desk, keeps a focus on disputes, technology and brands. The event-organising company for the Commonwealth Games and the Japan Karate Association are among recent clients.

Managing partner John Woodhams oversees seven-partner prosecution firm **Prizzeys**, split between a Brisbane and a Canberra office, with 17 registered patent attorneys and five trade mark solicitors on the team, most qualified and experienced in multiple jurisdictions. Australian peers are seeing more of Prizzeys. One fellow Brisbane practitioner contends that the relatively new outfit has "grown a lot-definitely". In 2008 the firm saw a net gain in practitioners and remains a top patent filer in Australia across various technologies. The team is capable of handling contract drafting and prosecution, patent oppositions, reexaminations, ownership disputes and pharmaceutical extensions of term as well as trade mark oppositions and revocation proceedings. Some key domestic clients of the last year are Commonwealth Scientific and Industrial Research Organization, The University of Queensland Julius Kruttschnitt Mineral Research Centre and Baker Medical Research Institute. Internationally, Johnson & Johnson, The Clorox Company and Cargill all recently engaged the boutique practice.