

TRADE MARK PROSECUTION

Tier 1

Davies Collison Cave
Griffith Hack
Phillips Ormonde & Fitzpatrick
Spruson & Ferguson

Tier 2

FB Rice & Co
Freehills
Shelston IP
Watermark

Tier 3

Allens Arthur Robinson
Blake Dawson
Corrs Chambers Westgarth

Tier 4

Baker & McKenzie
Clayton Utz
Deacons
Gilbert + Tobin
Mallesons Stephen Jaques
Middletons
Minter Ellison
Pizeys
Wray & Associates

TRADE MARK CONTENTIOUS

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Allens Arthur Robinson

Tier 2

Baker & McKenzie
Blake Dawson

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Davies Collison Cave
Freehills
Mallesons Stephen Jaques
Spruson & Ferguson

Tier 4

Addisons
Banki Haddock Flora
Deacons
Middletons
Nicholas Weston

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Freehills
Holding Redlich

Tier 4

Anisimoff Davenport
Norman Waterhouse

At-a-qlance

IP Australia
Discovery House
47 Bowes Street
Phillip ACT 2606

Mailing address

P0 Box 200
Woden
ACT 2606
Tel: +61 2 6283 2999
Fax: +61 2 6283 7999
Email: assist@ipaustralia.gov.au
Website: www.ipaustralia.gov.au

Horels). The firm successfully acted for Pfizer in its long-running patent infringement case against Ranbaxy over the drug Lipitor. Pfizer got an injunction granted which was then upheld at an appeal heard in August 2007. The result was significant for Pfizer, preventing the introduction of a generic competitor to Lipitor – the company's biggest selling drug with global sales of approximately \$10 billion per year. The firm also obtained an interlocutory injunction for Sanofi-Aventis against Apotex who also filed a revocation of Sanofi-Aventis' drug Plavix. The final hearing is expected in April 2008.

Allens Arthur Robinson has also been rated highly in *Managing IP's* inaugural copyright rankings. The firm acted for Airservices Australia in a major copyright infringement proceeding against Jeppesen Sanderson, owned by Boeing, in the Federal Court of Australia. Airservices Australia is responsible for compiling and publishing all the maps, plans, charts and other air navigation materials which are in constant use by aircraft pilots on both domestic and international aircrafts. The dispute, which was successfully mediated, marks the first time in which a government agency moved to enforce its copyright in its airway publication. Attorney and IP law firm Griffith Hack has

joined the firm as partner from full service firm Blake Dawson, which further strengthened the firm's expertise in the biotechnology and medicinal chemistry field. With 31 partners and

70 associates on the IP team the firm advises major clients such as Microsoft, CSL and Telstra. One satisfied client described the advice the firm gave as "informed, practical and easily

communicated to the business managers". Raymond Hind and Adam Sears were singled out as being "very enjoyable to work with". In contentious work the firm advised Hasen Beverage Company in a case over trade mark ownership issues under sections 52 and 53 of the Trade Practices Act. The case dealt with the extent to which promotional activity in Australia with no trading is sufficient enough to file a claim for misleading conduct. Philip Kerr, partner and head of IP at full service law firm Allens Arthur Robinson, was singled out for praise by a client as "very knowledgeable and professional". The firm, which retained its top-tier ranking for both trade mark and patent contentious work, advises a blue-chip list of clients that includes Heineken Lion, the Rugby World Cup 2007 Limited and Carlson Companies (Regent

consolidated its top-tier ranking for both trade mark and patent prosecution this year and made a string of top-level hires to help ensure that it retains its impressive reputation. In 2007 Russell Berry and Wayne Condon joined the team from full service law firm Clayton Utz, along with Andrew Coacher from Allens Arthur Robinson and John Lee from Malleson Stephens Jaques. The firm now consists of 34 partners and 38 associates. Long-term clients include commodity companies BHP Billiton and Rio Tinto, as well as Cadbury Schweppes. But the firm has also been busy adding new clients to its roster, including Aristocrat Technologies and engineering group Weir. Over the past year Griffith Hack advised on a patent infringement case relating to caravans and a cross-claim for validity with MVB Enterprises as the appellant and Camouflage as the respondent. The Court found that the appellant was not entitled to the patent. The decision illustrates that materials publicly available overseas will not be considered to be reasonably ascertained by the notional skilled person in Australia in the absence of specific evidence on this point.

The firm also advised on a Federal Court case concerning a claim by client Sena Rederi Aktiebolag, a Swedish Shipping company, relating to alleged infringement of a patent over one of its hull designs by a large western Australian-based ship builder. The case raised important points on patent claim construction and is now on appeal. Clients praised the highly experienced professionals working at the firm. Many of the IP practitioners in Australia contacted by *Managing IP* during the research process named *Lockwood v Doric* as one of the most significant patent cases of the year. In May, the Australian High Court handed down its landmark decision on obviousness, which many practitioners say will make it harder to strike down patents. The dispute had come before the High Court for an unprecedented second time and follows seven years of litigation between the parties. It concerned a patent, owned by

Lockwood, for a key controlled latch in which both the inner and the outer locks can be opened from the outside. IP specialists Phillips Ormonde & Fitzpatrick acted for the ultimately victorious Lockwood, helping the company obtain a ruling that its patent was valid. Greg Chambers is the senior partner at the firm of 28 partners and 11 associates. Having won this crucial case the firm enters *Managing IP*'s patent contentious rankings for the first time this year and is tipped by many to rise rapidly over the next few years. Chambers and his team also acted for AMR Technology in a Federal Court patent infringement case against generic drug maker Alphapharm. Other clients include car company GM Holden, Procter & Gamble and Coca-Cola.

On the other side of the *Lockwood v Doric* dispute was 120 year-old IP firm Spruson & Ferguson, which, despite the legal setback that its client Doric had in the High Court, experienced another impressive year. Managing principal David Griffith leads a team of 26 partners and 35 associates. The firm retains its top-tier position for both patent and trade mark prosecution this year, as well as a solid tier 2 ranking for contentious work across trade marks and patents. The team's patent practice is divided into four areas: life sciences, chemistry, mechanical and electrical. A series of departures saw Blake Dawson drop down a tier in the patent prosecution rankings this year. Bill Pickering, a life sciences specialist and partner of Blake Dawson Waldron Patent Services, left the firm in September. That followed the departure of senior associate Damian Slizys and associate Karin Innes from the firm's Melbourne office in June, when they moved to patent prosecution specialists FB Rice. Despite the losses, Blake Dawson remains a highly rated player in the IP legal market. It recently featured in a landmark dispute relating to the world's first vaccine against cervical cancer when it represented CSL in a dispute against GlaxoSmithKline Australia. The dispute finally settled out of court. The firm

also acted for Conor Med Systems in a dispute relating to the revocation of patent held by Angiotech Pharmaceuticals and the University of British Columbia over taxol-coated stents. The case considered whether the inclusion of an additional patentee who has no entitlement to the claimed invention renders the patent liable to be revoked under the Patents Act. Head of IP Lisa Ritson leads a team of 18 partners and clients include Qantas Airways, medical technology company Gambro and International Game Technology.

FB Rice & Co filed Australia's first electronic patent in June 2007, after IP Australia introduced an e-filing system. The firm claims its heavy investment in cutting edge technology benefits clients by reducing processing costs. Scott Sloan heads up a team at the IP specialist firm that focuses on IT. Partner Paul Wheman manages the firm's 13 partners and 20 associates, all of whom are IP attorneys. The firm focuses primarily on patent drafting, filing and prosecution as well as trade mark filing and litigation support. Over the past year, FB Rice & Co successfully advised financial services company Fexco in opposing a grant of a patent that could have monopolized certain currency conversion transactions in Australia. All of the patent's claims were found to be invalid. The firm also helped client Bramco Electronics to resolve a patent infringement dispute with rival ATF through mediation. Other clients include Giaconda Vineyard, research institute NICTA and cardiac catheter company CathRx. One satisfied client praised the firm's "ability to provide creative counsel".

Full service law firm Freehills lost patent litigation partners Anthony Muratore and Lisa Taladoros to rival firm Gilbert + Tobin in September, but retained its tier 2 patent contentious ranking and climbed from tier 3 to tier 2 in the patent prosecution rankings – testament to the firm's abilities in the patent sphere. The firm hired David Stuart as special counsel from the Perth office of Minter Ellison

in April. Frances Drummond leads the team of 75 professionals consisting of 15 IP partners and 60 associates. Freehills added medical devices company Resmed to its list of clients, which includes brand management company Pacific Brands, kitchen appliances maker Sunbeam Corporation and Seven Network. Clients praised lawyers at the firm for "knowing their stuff". Over the past year, the firm has been involved in a number of pharmaceutical disputes, representing Canadian generics drug maker Apotex in a case over the anti-hypertension drug Perindopril. The complex dispute involved claims related to the Trade Practices Act, patent invalidity, patent infringement and proceedings before the Administrative Appeals Tribunal. Freehills also had a strong showing in the area of copyright. It recently advised Telstra in a copyright infringement case brought by Spatialinfo.

Lawyers at full service firm Mallesons Stephen Jaques have "strong skills and are fantastic at partnering with us to find a solution", according to one enthusiastic client. This year's rankings see the firm not only maintain its impressive tier 2 status in the patent and trade mark contentious lists, but also secure a place in the top tier of the inaugural copyright rankings. Partner Maurice Gonsalves heads up the IP team of 20 partners and 55 associates. Clients include Microsoft, Nestle Australia and Starbucks. Mallesons continues to play an important role advising Cadbury against rival domestic confectionery company Darrell Lea in a long-running passing-off case relating to the use of the colour purple for chocolates. Lawyers from the firm also represented drinks maker SPI Group in complex cross-border litigation against Diageo Australia relating to the use of the Stolichnaya trade mark. Gonsalves and John Swinson obtained an order for the transfer of the trade marks to SPI pending determination of Russian government claims.

Shelston IP, founded in Melbourne in 1859, celebrated the 100th anniversary of its Sydney

office last year and then went on to open a new office in Brisbane. Chris Brevitt joined the partnership from Middletons and the firm now consists of 17 partners and 30 associates with Stuart Smith as chairman. Shelston IP added pharmaceutical company GlaxoSmithKline to its roster of clients, which includes gas group BOC, Disney and Unistraw International. One client remarked on the "excellent work done over the years" by the firm. Over the past year Shelston IP represented Sandoz in a patent revocation dispute that raised questions of novelty, obviousness and entitlement to an extension of the term. In another case the firm acted for Tridon Australia in an application for a declaration of non-infringement of copyright plus damages for unjustified threats against Autocaps.

Melbourne-based prosecution specialist Watermark has three offices across Australia with 11 partners and five associates. BASF, Note Printing Australia and ExxonMobil Chemical Europe are just a few of the firm's clients. Over the past year the team advised industrial and automation company Festo in an innovation patent infringement and validity case relating to valves for safety apparatus involving issues regarding contributory infringement. The firm also represented Bellian Australia in a patent infringement and validity case relating to sheep shearing equipment.

Andrew Stewart joined Baker & McKenzie from Deacons as partner in the firm's IP practice in March 2007. Richard Gough remains head of the group, which has six partners and 13 associates. Clients singled out partner Robert Arnold as having "extensive trade mark experience and delivering practical, realistic advice". The firm acts for, among others, Apple, Esteé Lauder and Mars. In the past year, a Baker & McKenzie team advised Premier Media Group in a high profile row with Telstra, which was one of the first cases in the world to test fair dealing provisions in the context of new media. The

dispute helped Baker & McKenzie secure a strong tier two ranking in the copyright table. The firm also represented Unilever in a dispute with Colorado over the ambit of the monopoly rights relating to the use of its key brand Lynx for different types of goods. After a series of claims and cross-claims the dispute was settled out of court.

The departure of partners Wayne Condon and Russell Berry has caused full service firm Clayton Utz to move down a tier for patent and trade mark contentious work this year. But the firm strengthened its IP capabilities by promoting John Fairbairn and Cynthia Sargent to the partnership in January 2007 and the firm is rated one of the leading Australian practices for copyright matters. Computer Associates, AstraZeneca and Network Appliance, a data delivery company, are some of the clients served by the firm.

The arrival of highly rated partner Odette Gurley from Miner Ellison has boosted Corrs Chambers Westgarth this year. The firm now boasts 15 partners and 49 associates. National practice group leader Stephen Stern was recognized by peers as a specialist for trade mark work and the firm is rated as one of the top 12 in Australia for copyright work. Clients include Foster's Group, H Lundbeck and luxury goods company LVMH. The firm has been advising Cadbury on its attempts to register the colour purple as a trade mark in Australia. The application, which was opposed by rival Darrell Lea, involves cutting edge trade mark law issues and is now on appeal in the Federal Court.

Miner Ellison secured a tier one ranking in *Managing IP's* inaugural copyright table this year, in addition to maintaining a strong reputation for work in other areas of IP, despite losing leading IP practitioner Odette Gurley. Clients were particularly impressed by partner Charles Alexander's expertise in the copyright field. The firm recently acted for newspaper company John Fairfax over

copyright in headlines. Other clients include H Heinz Company Australia, the Copyright Advisory Group and Schools Resource Taskforce.

Cameron Harvey, a partner at Deacons, continues to impress rivals in the market. Over the past year he has advised JAG, part of the footwear and clothing company Colorado Group, in a matter dealing with new provisions of the Copyright Act covering an overlap between copyright and design. The outcome is expected to have significant impact on the fashion industry in Australia. The firm also advised GlaxoSmithKline on protecting a production methodology for the extraction of opiates from legally grown poppies. This Supreme Court case raises important issues related to the protection of trade secrets. Other clients include Walter & Eliza Hall Institute and Alchemia.

Gilbert + Tobin has a very impressive reputation in the area of copyright, guaranteeing it a top spot ranking in this year's copyright table. It boosted its IP team this year with the addition of patent litigation partners Anthony Muratore and Lisa Taliadoros from Freehills. The firm's IP team is led by six partners and includes three special counsel and 15 associates. Clients include Autodesk, Silverbrook Research and the MPA. The firm recently acted for Foxtel and sued a business that supplied equipment and software to enable unauthorized access to Foxtel subscription television broadcasts. The Court awarded compensatory and flagrancy damages in excess of A\$1 million (\$934,000) to Foxtel. The important case demonstrated the Court's willingness to award damages based on evidence of actual loss suffered by IP owners as a result of piracy activities and to award additional discretionary damages.

Peter Banking, a copyright specialist at the boutique IP firm Banki Haddock Flora, is well-respected by his peers. His strong reputation helped the firm secure a top-tier

position in the inaugural rankings. One client singled out partner Margaret Shearer for her "innovative strategies with the Australian Trade Mark Office and a competitive price structure". The firm recently won a case – securing a damages award of A\$100,000 – for the Australasian Performing Right Association over the unlicensed use of musical works for ringtunes.

Prosecution firm Madderns acquired new client Schneider Electric in the past 12 months. The firm continues to grow and has recently set up a new life sciences group along with a dedicated trade mark team. Clients include Qualcomm, medical devices company Cook Group and Period Ricard Pacific. One client praised the firm for its "brilliant customer service".

Halford & Co counts Eveready Battery Corp/Schick Wilkinson Sword, Electrolux and Rheem Australia as clients. Two partners, two associates, a patent scientist and a consultant make up the small but strong Sydney-based firm. The six partner and 21 associate firm Pizzey's runs a practice spanning patent, design and trade mark prosecution. Clients include Google, Cisco, MIT and Alcoa.

Small firm Nicholas Weston enters the trade mark rankings this year and its ambitious expansion programme makes it one to watch. Clients noted the thoroughness of the firm's paperwork and "attention to detail". The firm has worked for camera retailer Ralerau, 3Lglogix and vodka company Brilliant Spirit. Name partner Nick Weston recently advised Casa Della Pasta in a trade practices dispute that was eventually settled out of court. Another firm to watch is Swaab Attorneys, which last year won *Business Review Weekly's* client choice award for best law firm with revenues of A\$20 million and under. The firm acts for a number of Mexican film production companies in relation to copyright issues in Australia, especially in the area of licensing and infringement by payment subscription services.