LIST G
BARRISTERS

Benjamin Gardiner KC



Ben Gardiner KC practises primarily in intellectual property litigation

QUALIFICATIONS

Bachelor of Pharmacy
Bachelor of Business
Juris Doctor (JD)
Bachelor of Civil Law (BCL)

CORRESPONDENCE

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CHAMBERS

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INTELLECTUAL PROPERTY

Appellate | Confidential Information | Copyright & Designs | Information Technology | Media & Entertainment | Patents | Privacy & Data Protection | Telecommunications | Trade Marks

Ben specialises in intellectual property law and practises primarily in patent, trade marks, copyright, confidential information and consumer protection / trade practices matters.

Ben has appeared on behalf of, and advised, a wide range of clients across a range of industries including pharmaceuticals, medical, mining, fast moving consumer goods, fashion, gaming, information technology and primary industries. He frequently appears in the Federal Court of Australia, the Australian Patent Office and the Australian Trade Marks Office.

He is also a nationally accredited mediator.

Before joining the Bar, Ben was associate to the Chief Justice of the Federal Court of Australia. Prior to that, he practised as a pharmacist for 12 years.

Ben has tertiary qualifications in pharmacy, business and law and completed post-graduate studies in law (BCL) at the University of Oxford in 2005. The Australian Financial Review's *Best Lawyers* lists Ben as a leading barrister in intellectual property law. Doyle's Guide has listed Ben as a recommended or leading barrister in intellectual property law since 2010.

Ben is a member of the Intellectual Property Society of Australia and New Zealand (IPSANZ) and has taught intellectual property law at post-graduate level at Melbourne University.

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Recent Cases

PATENTS

Trista Technology Pty Ltd v Idealcorp Pty Ltd (QUD67/2021, Greenwood J) – unled – patent infringement – ongoing.

The Sy-Klone Company LLC v Tracs (Qld) Pty Ltd (QUD46/2021, Greenwood J) – led by Neil Murray SC – patent infringement – ongoing.

C.M.E. Blasting & Mining Equipment Ltd v Rock Tool Refurbishment Solutions Pty Ltd (SAD43/2020, Besanko J) – led by Ed Heerey QC – patent infringement and validity – ongoing.

C.M.E. Blasting & Mining Equipment Ltd v Rock Tool Refurbishment Solutions Pty Ltd [2021] FCA 160 – unled – application for security for costs in patent infringement proceeding.

Daryl Patrick Norton v Aussie Concrete Products Pty Ltd (QUD386/2019, Greenwood J) – led by Tom Cordiner QC – patent infringement and validity – ongoing.

Advanta Seeds Pty Ltd v Commissioner of Patents (AAT 2020/8517) – led by John Hennessy SC – administrative review of refusal of extension of time to renew patent – ongoing.

Phoenix Contact GmbH & Co KG v Pivot Electronics Pty Ltd [2020] APO 35 – unled – patent opposition – novelty – inventive step.

Global Fruit Protection Pty Ltd v Mount Somerset Pty Ltd QUD462/2018 – unled – opposed to David Logan QC – patent infringement – cross-claim for invalidity – settled after mediation.

Global Fruit Protection Pty Ltd v Mount Somerset Pty Ltd [2019] FCA 1264 – unled – opposed to David Logan QC – application for leave to amend pleadings.

ESCO Australia Holdings Pty Ltd v CQMS Pty Ltd (VID63/2019) – led by Ed Heerey QC – patent infringement and validity – novelty – inventive step – best method – utility – unjustified threats – authorisation – settled shortly before trial.

Liberation Developments Pty Ltd v Lomax Group Pty Ltd (2019) 144 IPR 413 – led by Tom Cordiner QC – patent infringement & validity – trade mark infringement & validity – breach of Australian Consumer Law – unjustified threats – personal liability of respondent directors.

Liberation Developments Pty Ltd v Lomax Group Pty Ltd [2018] FCA 842 – unled – opposed to Anthony Franklin SC and David Larish – patents – leave sought to press cross-claim and to file late evidence.

Resmed Limited v Fisher and Paykel Healthcare Limited – led by Ed Heerey QC – High Court of New Zealand CIV No 216-404-1968 – patent infringement and validity – 3 patents in suit in relation to masks and headgear for use with CPAP machines – settled prior to trial.

CSR Building Products Ltd v United States Gypsum Company [2017] APO 64 – led by Ed Heerey QC – opposed to Neil Murray – patent opposition – construction – clarity – inventive step.

Sportsbet Pty Ltd v Diogenes Ltd [2017] APO 60 – unled – patent opposition – invalidity – inventive step – utility – manner of manufacture.

Aussie Concrete Products Pty Ltd v Norton QUD 196/2017 – unled – defence of application to have patent revoked pursuant to s 138 of the *Patents Act 1990* (Cth) – settled prior to trial with payment of indemnity costs.

Mineral Technologies Pty Ltd v Orekinetics Investments Pty Ltd [2015] APO 23 – unled – patent opposition – novelty – inventive step – method of manufacture.

AstraZeneca AB v Alphapharm Pty Ltd VID876 of 2013 – led by Colin Golvan QC – pharmaceutical patent dispute.

Ranbaxy Laboratories Ltd v AstraZeneca AB (2013) 101 IPR 11 – led by Tony Bannon SC with Ben Fitzpatrick – pharmaceutical patent dispute – three patents – issues of infringement and invalidity.

TRADE MARKS

Uber Technologies Inc v Uber Geeks Pty Ltd (NSD93/2021, Yates J) – unled – removal of trade mark for non-use – appeal from Australian Trade Marks Office – ongoing.

The a2 Milk Company Ltd v Open Country Dairy Ltd (NSD1743/2019, Bromwich J) – unled – opposed to Richard Cobden SC and Laura Thomas – appeal from the Australian Trade Marks Office – ongoing.

Austin John Watson v Cosmetic Warriors Ltd (QUD72/2020, Greenwood J) – unled – removal of trade mark for non-use – appeal from the Australian Trade Marks Office – ongoing.

Re QWB Residential Precinct Operations [2021] ATMO 2 – unled – *ex parte* application following rejection of trade mark.

Verge Design Ltd v Romani Clothing Co [2020] ATMO 1 – unled – opposed to Ian Horak – trade mark opposition.

Star Television Productions Ltd v Star Entertainment Group Ltd [2019] ATMO 163 – unled – application for removal

of a trade mark for non-use.

Calico Global Pty Ltd v Calico LLC [2018] FCA 2096 – unled – opposed to John Hennessy SC and Angus Lang – two appeals from decisions of the Registrar of Trade Marks.

JBS Australia Pty Ltd v Australian Meat Group Pty Ltd (2017) 128 IPR 398 – led by Ed Heerey QC – trade mark infringement – passing off – breach of the ACL.

Titan Enterprises (Qld) Pty Ltd v Cross [2016] FCA 1241 – led by Pat O'Shea QC – subpoenas – privilege – trade mark attorney privilege.

Home Sweet Loans Pty Ltd v Members Equity Bank Limited QUD 399 of 2016 – unled – trade mark infringement – whether use "as a trade mark" – settled after mediation.

Business Strategies International Pty Ltd v British Standards Institution [2016] ATMO 9 – unled – trade marks – application for removal of a trade mark for non-use.

Accor Australia & New Zealand Hospitality Pty Ltd v Liv Pty Ltd [2015] FCA 746 – unled – opposed to Pat O'Shea QC and Andrew Musgrave – costs – apportionment of costs where neither party wholly successful.

Target Australia Pty Ltd v Catchoftheday.com.au Pty Ltd [2015] ATMO 54 – unled – trade mark opposition – parody – whether applicant's mark likely to mislead or deceive.

Chernae Noonan v Benefit Cosmetics LLC [2015] ATMO 17 – unled – trade marks opposition – appeal (VID100/2015) settled at mediation.

Roebuck v News Limited (2014) 105 IPR 459 – unled – trade marks opposition.

Feggari Pty Ltd v ModelCo Pty Ltd (VID 387 of 2013) – unled – trade mark infringement, passing off claim – cross-claim for invalidity – settled at mediation.

Australian Postal Corporation v Digital Post Australia Pty Ltd (No 2) (2012) 293 ALR 369 – led by Colin Golvan QC – trade mark infringement, passing off, breach of ACL.

Seek Ltd v GMO (WA) Pty Ltd [2012] ATMO 25 – unled – trade mark opposition.

Yarra Valley Dairy Pty Ltd v Lemnos Foods Pty Ltd (No 2) [2011] FCA 283– led by Ed Heerey – costs, indemnity costs following formal offer of compromise.

Yarra Valley Dairy Pty Ltd v Lemnos Foods Pty Ltd (2010) 191 FCR 297 – led by Ed Heerey – trade mark infringement, passing off, Part V TPA.

Dimokranitis v Exotic Limo Pty Ltd [2010] ATMO 69 – unled – trade mark opposition.

Liquideng Farm Supplies Pty Ltd v Liquid Engineering 2003 Pty Ltd (2009) 79 IPR 437 – led by Ed Heerey – Full Court appeal concerning the principles to be applied when assessing an account of profits in context of trade mark infringement.

COPYRIGHT

Chhabra v McPherson as Trustee for the McPherson Practice Trust [2019] FCAFC 228 – led by Andrew Crowe QC – appeal to the Full Court – copyright – co-ownership – revocation of licence.

Chhabra v McPherson as Trustee for the McPherson Practice Trust (No 2) [2019] FCA 448 – led by Andrew Crowe QC – costs – offer of compromise – indemnity costs.

Chhabra v McPherson as Trustee for the McPherson Practice Trust (2018) 138 IPR 1 – led by Andrew Crowe QC – opposed to Michael Green SC and Rebecca White – copyright infringement – passing off – breach of Australian Consumer Law.

Whitsunday Aerial Solutions Professionals Pty Ltd v Emprja Pty Ltd BRG603/2018 – unled – copyright infringement – judgment reserved.

Naiad Design Limited v Woody Marine Pty Ltd BRG 948 of 2014 – unled – breach of copyright in boat design – trade mark infringement – passing off – breach of confidence – breach of ACL – settled at mediation.

Ron Englehart Pty Ltd v Enterprise Constructions (Australia) Pty Ltd (2012) 95 IPR 64 – led by Colin Golvan QC – Full Court appeal concerning copyright in building plans.

CONFIDENTIAL INFORMATION

Trisco Foods Pty Ltd v Peter Skarshewski (QUD366/2020) – unled – application for discovery from prospective respondent – potential actions for breach of confidence, breach of employment contract and under s 36 of the *Patents Act 1990* (Cth) – settled at mediation.

Complete Technology Integrations Pty Ltd v Green Energy Management Solutions Pty Ltd [2011] FCA 1319 – unled – summary judgment – breach of employment contract, trade mark infringement, copyright infringement, breach of confidence, joint tortfeasorship of directors.

Bostik Australia Pty Ltd v Construction Technologies Australia Pty Ltd (VID322 of 2011) – led by Ed Heerey – trade mark infringement, infringement of copyright, breach of contract, breach of contract, passing off, breach of trade practices legislation, joint tortfeasorship – settled at mediation.

CONSUMER LAW AND PASSING OFF

SPEL Environmental Pty Ltd v IES Stormwater Pty Ltd (QUD36/2021) – unled – application for discovery from prospective respondent – settled.

Alzheimer's Association of Queensland Inc v Dementia Australia Ltd (QUD645/2018) – unled – breach of Australian Consumer Law – settled.

Sambazon, Inc v Amazonia Pty Ltd VID 464/2018 – unled – opposed to Luke Merrick – breach of ACL – settled after mediation.

Tatts Group Ltd v Lottoland Australia Pty Ltd QUD 634 of 2016 – led by Andrew Crowe QC – trade mark infringement, breach of ACL – cross-claim alleging invalidity of registered marks – settled at mediation.

Titan Enterprises (Qld) Pty Ltd v Cross [2016] FCA 890 – unled – application to issue international subpoenas to foreign corporations.

Titan Enterprises (Qld) Pty Ltd v Cross [2016] FCA 664 – unled – application for substituted service.

Fletcher v Nextra Australia Pty Ltd (2015) 229 FCR 153 – led by Colin Golvan QC – Full Court appeal - consumer law – representations made in online blog – whether in trade or commerce – whether representations of fact or opinion.

NQ Group Pty Ltd v CQ Group Australia Pty Ltd [2014] FCA 317 – unled – passing off - discovery dispute – relevance of respondent's intention.

Hillbrick Bicycles Pty Ltd v F45 Training Pty Ltd [2017] FCA 1089 – unled – security for costs.

Madden v Seafolly Pty Ltd (2014) 313 ALR 1 – led by Colin Golvan QC – Full Court appeal – trade practices – defamation.

Mondelez Australia Pty Ltd v The Natural Cordial Company Pty Ltd VID 952 of 2013 – unled – opposed to Ed Heerey – trade mark infringement, passing off, breach of Australian Consumer Law – cross-claim for invalidity of trade mark – settled at mediation.

Seafolly Pty Ltd v Madden (2012) 98 IPR 389 – led by Colin Golvan QC – injurious falsehood, defamation, breach of TPA, copyright infringement.

Groupon Inc v Scoopon Pty Ltd VID 655 of 2010 – led by Colin Golvan QC – breach of trade practices legislation, passing off.

Nutrientwater Pty Ltd v Baco Pty Ltd (2010) 265 ALR 140 – led by Colin Golvan QC, with Ed Heerey – passing off, breach of Part V of the TPA.

MIGRATION (PRO BONO)

Xiadong Chen v Minister for Immigration and Citizenship (AAT 245 of 2011) – application for review of decision to refuse grant of Australian citizenship on character grounds – orders made by consent setting decision aside and remitting matter to original decision-maker for further consideration pursuant to s 42C of the *Administrative Appeals Tribunal Act 1975* (Cth).

Minister for Immigration and Citizenship v DNCW [2011] FCA 806 – judicial review – Minster cancelled applicant's visa pursuant to s 501 of the Migration Act 1958 (Cth) – applicant sought merits review – decision to cancel visa set aside by Administrative Appeals Tribunal– whether the Administrative Appeals Tribunal committed jurisdictional error.

DNCW v Minister for Immigration and Citizenship (2010) 117 ALD 192 – visa cancellation – substantial criminal record - fails to pass character test — discretion to cancel - whether cancellation in the national interest – whether Applicant part of Australian community - Direction 21 – balancing of primary and other considerations.

Memberships

Intellectual Property Society of Australia and New Zealand (IPSANZ)

Victorian Bar - Commercial Bar Association