LIST G
BARRISTERS

Edward Heerey KC



Ed Heerey KC practises in commercial law and is a specialist in intellectual property law

QUALIFICATIONS

Bachelor of Arts
Bachelor of Laws
Master of Laws (Intellectual Property)

CORRESPONDENCE

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CHAMBERS

Nigel Bowen Chambers
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169 Phillip Street
Sydney NSW 2000

COMMERCIAL LAW

Consumer Law

EMPLOYMENT & INDUSTRIAL

Restraint of Trade

INTELLECTUAL PROPERTY

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

Ed maintains chambers in both Sydney (Nigel Bowen Chambers) and Melbourne (Emmerson Chambers) and is ranked as one of Australia's pre-eminent intellectual property senior counsel by Doyle's Guide to the Australian Legal Profession. He is similarly ranked by Chambers and Partners, The Legal 500 and Best Lawyers International.

Ed's practice covers all fields of intellectual property, particularly copyright, patents and trade marks. He also conducts and defends prosecutions by the ACCC for breaches of competition and consumer laws, including pecuniary penalties and contempt of court.

Ed appears regularly in trials and appeals in the Federal Court of Australia in Sydney and Melbourne. He also appears in the Australian Patent Office, the Australian Trade Marks Office, the Australian Copyright Tribunal and the Australian Competition Tribunal. He also practises in the High Court of New Zealand as a member of the New Zealand Bar Association.

Ed is a registered Trade Marks Attorney and a Senior Fellow of the University of Melbourne Law School where he teaches in the post-graduate intellectual property programme. He is an active member of the Intellectual Property Society of Australia and New Zealand, for which he presents annual Trade Marks Updates around Australia and New Zealand.

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Recent Cases

PATENTS

CSR Building Products Ltd v United States Gypsum Co [2016] APO 7; [2015] APO 72; (2015) 112 IPR 406 – Counsel for United States Gypsum Co in a series of patent oppositions including new grounds of opposition introduced by the recent *Raising the Bar* legislative amendments.

B Braun Melsungen AG v Multigate Medical devices Pty Ltd [2014] FCA 1110; *Multigate Medical Devices Pty Ltd v B Braun Melsungen AG* [2016] 117 IPR 1 - Junior Counsel (with David Shavin QC) for B Braun in trial and appeal on patent validity and infringement regarding medical devices.

University of Western Australia v Gray (No 20) (2008) 246 ALR 603; 76 IPR 222; (2011) 276 ALR 267 - Junior Counsel (with James Elliott SC) for Sirtex Medical Limited in defence against claims by UWA for entitlement to various patents filed in Sirtex's name. Principal author of Sirtex's submissions on patent law, accepted by French J at trial and upheld by the Full Federal Court: (2009) 179 FCR 346.

COPYRIGHT

Pocketful of Tunes Pty Ltd v The Commonwealth of Australia (2015) 112 IPR 346 – Counsel for the Commonwealth before the Australian Copyright Tribunal in a determination of monetary compensation for the Commonwealth's use of Bruce Woodley's song "*I am Australian*" in citizenship ceremonies.

TRADE PRACTICES

Australian Competition and Consumer Commission v Hillside (Australia New Media) Pty Ltd trading as Bet365 [2015] FCA 1007; [2016] FCA 698 - junior counsel for the ACCC (with Mark Moshinsky QC) in prosecution of misleading "$200 free bet" advertising for on-line gambling. Penalties totalling 2.75 million ordered.

Australian Competition and Consumer Commission v TPG Internet Pty Ltd (2013) 304 ALR 186 - junior counsel (with Justin Gleeson SC and Colin Golvan SC) for the ACCC in High Court appeal restoring $2 million in pecuniary penalties for misleading advertising.

Comité Interprofessionnel du Vin de Champagne v Powell (2015) 330ALR 61; 115 IPR 269 - Pro bono counsel for Ms Powell (a.k.a. “Champagne Jayne”) defending a claim for misleading conduct and passing off brought by the French champagne industry.

Telstra Corporation Ltd v Singtel Optus Pty Ltd [2014] VSC 35 -Junior Counsel (with Peter Jopling QC) for Optus on Telstra’s application for an interlocutory injunction for misleading television advertising.

Re Application by Murray Goulburn Co-operative Co Ltd re proposed acquisition of Warrnambool Cheese and Butter Factory Company Holdings, Competition Tribunal proceeding ACT4/2013 – Counsel for ACCC in interlocutory hearing in relation to an application for merger authorisation.

TRADE MARKS

Playgro Pty Ltd v Playgo Art & Craft Manufactory Limited (2016) 117 IPR 489 – Counsel for Playgro establishing trade mark infringement in Australia against an overseas supplier.

Scandinavian Tobacco Group Eersel BV v Trojan Trading Company Pty Ltd (2015) 115 IPR 246 – Counsel for Scandinavian Tobacco Group in a claim for trade mark infringement, misleading conduct and passing off in relation to parallel importation and sale of cigars repackaged in the context of Australian tobacco plain packaging legislation. Appeal decision [2015] FCAFC 91.

Mastronardi Produce Ltd v Registrar of Trade Marks (2014) 318 ALR 249; 108 IPR 7 - Counsel for Mastronardi in appeal overturning a decision of the Registrar of Trade Marks regarding the trade mark ZIMA.

Delfi Chocolate Manufacturing S.A. v Mars Australia Pty Ltd (2015) 115 IPR 82 – Junior Counsel (with Adrian Ryan SC) for Delfi Chocolate in appeal overturning a decision of the Registrar of Trade Marks regarding the trade marks MALTITOS and MALTESERS.

Dealer Support Services Pty Ltd v Motor Trades Association of Australia Ltd (2014) 108 IPR 26 - Counsel on an application to restrain solicitors from acting to revoke a trade mark obtained by them for their former client.

Australian Football League v Hard On Sports [2012] VSC 475 - Counsel for the AFL in application for an *Anton Piller* order and injunctons against a merchandiser of unlicensed football memorabilia.

Bugatti GmbH v Shine Forever Men (2013) 103 IPR 574; (2014) 105 IPR 413 – Counsel for Bugatti establishing trade mark infringement and account of profits for $550,000.

Tivo Inc v Vivo International Corp Pty Ltd (2012) 294 ALR 661 - Junior Counsel (with David Shavin KC) for Tivo in claim for trade mark infringement and cancellation of trade mark registration against Vivo. Subsequent prosecution for contempt of court orders: [2013] FCA 1340.

*GM Holden Ltd v Paine (*2011) 281 ALR 406; *Taleb v GM Holden Ltd*(2011) 94 IPR 459 - Counsel for GM Holden

in counterfeiting trial and appeal involving 24 respondents and *Mareva* injunctions. Established exemplary damages for passing off.

Facton Ltd v Rifai Fashions Pty Ltd (2011) 91 IPR 109; (2012) 199 FCR 569 - Counsel for G-STAR companies in anti-counterfeiting trial and appeal establishing reputational and exemplary damages.

Yarra Valley Dairy Pty Ltd v Lemnos Foods Pty Ltd (2010) 191 FCR 297 - Counsel for Lemnos revoking PERSIAN FETTA trade mark registration and defending passing off and misleading conduct claim.

Nature's Blend Pty Ltd v Nestlé Australia Ltd (2010) 86 IPR 1; (2010) 87 IPR 464 272 ALR 487 - Counsel for Nestlé defending trial and appeal on LUSCIOUS LIPS trade mark infringement claim.

Deckers Outdoor Corp Inc v Farley (No 2) (2009) 176 FCR 33; (No 5) (2009) 262 ALR 53; (No 6) [2010] FCA 391; (No 7) [2010] FCA 560; (No 8) [2010] FCA 657 - Counsel for Deckers in counterfeiting prosecution involving 23 respondents, 11 *Anton Piller* searches and international *Mareva* injunctions. Damages totalling $6.5 million .Criminal prosecution for contempt of court: 2 years imprisonment for main offender, and lesser jail terms for other respondents.

Memberships

Institute of Patent and Trade Marks Attorneys of Australia

Intellectual Property Society of Australia and New Zealand (IPSANZ)