

## Andrew Sykes



Andrew conducts a dedicated practice in intellectual property law with a predominate focus branding (trade mark law, domain names and passing off).

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### QUALIFICATIONS

Bachelor of Laws (Hons)  
Bachelor of Arts (International  
Studies)  
Registered Trade Mark Attorney

### CORRESPONDENCE

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### CHAMBERS

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### EMPLOYMENT & INDUSTRIAL

Confidential Information | Restraint of Trade

### INTELLECTUAL PROPERTY

Appellate | Confidential Information | Copyright & Designs | Information Technology | Trade Marks

In this area alone he has acted as counsel or arbitrator in over 50 matters issued and determined before various courts and tribunals. He has been recognised in the World Trade Mark Review's Leading Trade Mark Professionals (Gold Band), Doyle's Guide (Intellectual Property) and in Best Lawyers Australia (Intellectual Property).

His other areas include domain names, copyright, designs, internet law, software, confidential information and related areas of misleading and deceptive conduct and restraint of trade. He does not accept briefs to act as counsel outside these areas. However he does accept briefs to act as a mediator in a broader scope of areas.

Andrew has authored a number of articles in professional journals. He is the author of *Australian Trade Mark Opposition Law*, which is now in its second edition and published by LexisNexis Butterworths. He is also the co-author of the chapter "Trade Marks and the Internet" in the leading publication "*Lahore's, Patents, Trade Marks & Related Rights*".

He is also a member of the Intellectual Property Society of Australia and New Zealand (IPSANZ) and the Institute of Patent and Trade Mark Attorneys (IPTA) and he has presented on trade mark law at numerous conferences and professional education forums.

### **National and International Appointments**

2016 to present – Asian Domain Name Dispute Resolution Centre – Appointed to the Panel of Arbitrators

2016 to present – Czech Arbitration Court – Appointed to the Uniform Domain Name Dispute Resolution Policy Panel of Arbitrators.

2021 to present – Appointed to the auDA Licence Review Panel.

*Liability limited by a scheme approved under Professional Standards legislation.*

## Recent Cases

### TRADE MARKS & PASSING OFF – AS COUNSEL

*Henley Arch Pty Ltd v. Henley Constructions Pty Ltd* [2021] FCA 1369 (Led by J Hennessy SC)

*David Edwards v. Samuel James John Perry* [2021] ATMO 124

*THF Innovation Pty Ltd v. Caterpillar Inc* [2021] ATMO 80

*The Grapevine BVBA v. Are Media Pty Ltd* [2021] ATMO 66

*Australian Chiropractors Association Ltd v. Chiro Care Mattresses Pty Ltd* [2021] ATMO 28

*REA Group Ltd v. Real Estate Store Pty Ltd* [2021] ATMO 18

*Happy Skincare Pty Ltd ATF Breckell Family Trust v. Happy Skin Co Pty Ltd* [2021] ATMO 16

*Clarendon Lawyers Pty Ltd v. Cornwalls Lawyers Pty Ltd* [2020] ATMO 192

*Cohga Pty Ltd v. Google LLC* [2020] ATMO 189

*Pinnacle Runway Pty Ltd v. Triangl Limited (No.3)* [2020] FCA 1379 (Led by T Cordiner KC)

*Happy Skincare Pty Ltd ATF Breckell Family Trust v. Happy Skin Co Pty Ltd* (2020) 158 IPR 153

*Victoria Beckham v. VB Skinlab Pty Ltd* (2020) 156 IPR 259 (also counsel for Ms Beckham in the resolved appeal)

*Coffee Republic Australia Pty Ltd v. Espresso Republic LLC* (2020) 156 IPR 135

*Murley Pty Ltd v. The Craft & Co Pty Ltd* [2020] ATMO 2

*Swole Gym Wear Group Pty Ltd v. Swole O'Clock Ltd* [2019] FCA 685

*Darwin Funeral Services Pty Ltd* [2019] ATMO 142

*Pinnacle Runway Pty Ltd v. Triangl Limited (No.2)* (2019) 148 IPR 211 (Led by S Stuckey QC)

*Ezy Auto Pty Ltd v. Ezyauto Pty Ltd* (2019) 151 IPR 47

*Factory Direct Garage Doors Pty Ltd v. Starship Australia Pty Ltd* (2019) 147 IPR 149

[\*Paypal, Inc v Finpal Pty Ltd\* \[2018\] ATMO 196 \(10 December 2018\)](#)

[\*Active Skin P/L v Yey P/L\* \(2018\) 145 IPR 499](#)

[\*Agave Loco LLC v DZ Licores SLU\* \(2018\) 147 IPR 44](#)

[\*Macy's Merchandising Group Inc v Sheertex Pty Ltd\* \(2018\) 149 IPR 33](#)

[\*Swole Gym Wear Group Pty Ltd v Swole O'Clock Ltd\* \[2018\] ATMO 129 \(16 August 2018\)](#)

[\*TWM Imports Pty Ltd v Hangzhou Great Star Industrial Co., Ltd\* \[2018\] ATMO 61 \(1 May 2018\)](#)

[\*Council of the City of Shellharbour v Bright Events Pty Ltd\* \(2018\) 136 IPR 401](#)

[\*Juno Pharmaceuticals Inc v Juno Therapeutics Inc\* \(2017\) 132 IPR 107](#)

[\*Martin & Pleasance Wholesale Pty Ltd v Biz-Oz Pty Ltd\* \(2017\) 132 IPR 450](#)

[\*Keune Haircosmetics Manufacturing BV v Guangzhou Hodm Professionals Cosmetics Co Ltd\* \(2017\) 132 IPR 372](#)

[\*Nhon Hoa Nguyen v Aardwolf Australia Pty Ltd\* \(2017\) 130 IPR 209](#)

[\*Teka Industrial SA v Deka Australia Pty Ltd\* \[2017\] ATMO 47 \(24 May 2017\)](#)

[\*Five V's Pty Ltd v La Gaia Pty Ltd\* \[2017\] ATMO 31 \(11 April 2017\)](#)

*Activated Carbon Technologies v. Carbon Activated Corp Australia Pty Ltd* (CI-18-02788)

#### OTHER AREAS OF INTELLECTUAL PROPERTY, TECHNOLOGY AND LAW – AS COUNSEL

*DST Bluedoor Pty Ltd v. AMP Services Ltd (No.3)* [2021] VSC 665 (Led by S Stuckey KC) – Software, Restraint of Trade, Confidential Information

*DST Bluedoor Pty Ltd v. AMP Services Ltd (No.2)* [2021] VSC 499 (Led by S Stuckey KC) – Software, Restraint of Trade, Confidential Information

[\*DST Bluedoor Pty Ltd v. AMP Services Ltd\* \[2020\] VSC 254 \(Led by S Stuckey KC\)](#) – Software, Restraint of Trade

*Guardian v. Kwong & Crockett* [2020] VCC 1391 – Computer Data, Confidential Information.

*Adelaide Oval Hotel Pty Ltd and Anor v. Hines Property Asset Services Pty Ltd* (2020) WIPO Case No. DAU2020-

## 0021 – Domain Names

*Reflex Instruments Asia Pacific Pty Ltd v. Minnovare Limited* [2017] APO 8 – Patents

## DOMAIN NAMES – AS AN INTERNATIONAL ARBITRATOR

*Schneider Electric SE v. Dong Sheng Huang* (2021) CAC 103894

*Boehringer Ingelheim Animal Health France v. Distribution & Transportation* (2021) CAC 103794

*Arcelormittal (SA) v. IT Depart*(2021) CAC 103739

*O'Neill Brand S.a.r.l. v. Uwe Eisenhower*(2021) CAC 103594

*Credit Agricole S.A. v. Sci Du Roncier* (2021) CAC 103497

*Intesa Sanpaolo S.p.A. v. Carlo Cortese* (2020) CAC 103389

*Novartis AG v. shenchao yong* (2020) CAC 103326

*Intesa Sanpaolo S.p.A. v. Roberta Esposito* (2020) CAC 103313

*Boursorama SA v. Regolo Greece* (2020) CAC 103201

*Boehringer Ingelheim Pharma GmbH & Co. KG v. Fundacion Comercio Electronico* (2020) CAC 103132

*Victorian Ambulance Union v. Hall Payne Lawyers* (2020) AIAC/ADNDRC-809-2020

*Intesa Sanpaolo S.p.A. v. Xavier Dylan* (2019) CAC 102599

*Hugo Boss Trade Mark Management GmbH & Co. v. wang su qing* (2019) CAC 102514

*Intesa Sanpaolo S.p.A. v. Coil services (Byron King)* (2019) CAC 102503

*Acindar Industria Argentina De Aceros S.A. v. Sandeep Rangu* (2019) CAC 102400

*Boursorama SA v An entity using the pseudonym 'Technology Vavelle'* (2019) CAC 102331

*RueDuCommerce v Jean-Louis Conte* (2018) CAC 102217

*Amundi S.A v Milen Radmilo* (2018) CAC 102149

*Sparco S.p.A v Grillstuff, LLC.* (2018) CAC 102055

*ArcelorMittal SA v Rajkamal Gupta* (2018) CAC 101986

*Boehringer Ingelheim Pharma GmbH & Co. KG v Pelres Investments Ltd* (2018) CAC 101965

*Credit Mutuel Arkea v BeninWeb* (2018) CAC 101915

*JCDECAUX SA v James White* (2018) CAC 101852

*Phillip Plein v Chen JieQing* (2017) CAC 101748

*Bollere v Wirelord* (2017) CAC 101689

*Intesta Sanpaolo S.p.A v Giovanni Cusco* (2017) CAC 101603

*Credit Agricole S.A v Thomas Horcholles* (2017) CAC 101523

*Dorne WSBK Organization S.R.L v Sawebs Internet Solution* (2017) CAC 101461

## Memberships

Intellectual Property Society of Australia and New Zealand (IPSANZ)

Institute of Patent and Trade Mark Attorneys (IPTA)