

## Melissa Marcus



Melissa Marcus practises in defamation law and all aspects of intellectual property

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### QUALIFICATIONS

Bachelor of Arts  
Bachelor of Laws (Hons)  
Master of Laws (Cantab)

### CORRESPONDENCE

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### CHAMBERS

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### INTELLECTUAL PROPERTY

Appellate | Confidential Information | Copyright & Designs | Media & Entertainment | Patents | Trade Marks

### TORT LAW

Commissions & Inquiries | Defamation

Melissa has expertise in intellectual property litigation, with extensive experience in trade marks, copyright and misleading or deceptive conduct litigation. Melissa also does defamation law. She is a recommended Junior Counsel in intellectual property law by [Doyle's Guide](#) to the Australian Legal Profession. Melissa has also been distinguished as outstanding by Best Lawyers 2022 in intellectual property law.

Melissa also has experience in Royal Commissions, having acted for a client before the Royal Commission into Institutional Responses to Child Sexual Abuse (led by Dr Matt Collins AM QC), and for a client in relation to the Royal Commission into Violence, Abuse, Neglect and Exploitation of People with Disability.

She also has experience as an independent auditor in relation to undertakings to the ACCC pursuant to section 87B of the Competition and Consumer Act 2010.

Before joining the Bar, Melissa managed Mallesons Stephen Jaques' Trade Marks Group in Melbourne, providing trade mark, branding and general strategic advice to clients in Australia and overseas, and advising on oppositions and other IP disputes. She also worked at Linklaters in London after completing a Master of Laws at Cambridge University.

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## Recent Cases

### ROYAL COMMISSIONS

Melissa represented a client in Royal Commission into Violence, Abuse, Neglect and Exploitation of People with Disability.

Acting for the Salvation Army Southern Territory in relation to the Royal Commission into Institutional Responses to Child Sex Abuse, including appearing before the Royal Commission in Adelaide in October 2015 in relation to Case Study 33 and in Sydney in December 2016 in relation to Case Study 49 (led by Dr Matt Collins QC).

### FEDERAL COURT

*Bendigo and Adelaide Bank Limited v Community First Credit Union Limited (No 2)* [2021] FCAFC 62 (27 April 2021) – costs.

*Bendigo and Adelaide Bank Limited v Community First Credit Union Limited* [2021] FCAFC 31 (11 March 2021) (led by Tony Bannon SC).

*Swancom Pty Ltd v The Jazz Corner Hotel Pty Ltd and others*. Acted for the Respondents in relation to a claim for trade mark infringement (led by Colin Golvan QC) [2020] FCA 396 and (No. 2) [2021] FCA 328

*State Street Global Advisors Trust Company and Another v Maurice Blackburn Pty Ltd and others* (2019) FCA 1464 – Harmen application (led by Colin Golvan AM QC).

*State Street Global Advisors Trust Company and Another v Maurice Blackburn Pty Ltd and others (No 2)* [2021] FCA 137. Acted for Maurice Blackburn in relation to claim for trade mark infringement, copyright infringement, inducing breach of contract and misleading or deceptive conduct relating to a replica statue of a girl unveiled in Melbourne (led by Colin Golvan AM QC).

*Nesor Nominees Pty Ltd v Big Boys BBQ Pty Ltd* (2019) - trade mark infringement action. [2019] FCA 1208.

*Community First Credit Union Limited v Bendigo and Adelaide Bank Limited*(2017) - trade mark cancellation proceedings and appeal from decision of Trade Marks Office (**TMO**) in trade mark opposition (led by Colin Golvan AM QC). [2019] FCA 1553 and (No. 2) [2019] FCA 1576.

*Metalsistem Australia Storage and Display Solutions Pty Ltd v Oshrat Kirk* - (2017) claim for breach of confidence and breach of section 183 of the *Corporations Act*.

*Dollhouse v Love D&VXOXO* (2016) - Federal Court - trade mark infringement and misleading or deceptive conduct.

*Fire Protection Association of Australia v Third Planet Group Pty Ltd and Anor*(2016) - copyright infringement proceedings (led by Colin Golvan QC).

*Monster Energy Company v Ox Group Global Pty Ltd* (2016) - appeal from decision of TMO re opposition to registration of Ox Group trade mark.

*Roundtable on Sustainable Palm Oil v Apperley Holdings Pty Ltd* (2016) - Federal Court trade mark proceedings and misleading or deceptive conduct (led by Colin Golvan QC).

*Wolveridge Architects Pty Ltd v Sorrento Moon Pty Ltd and Ors* (2016) - copyright infringement proceedings.

*Louis Vuitton v Sonya Valentine and others* (2015) - acting for one of the Respondents in Federal Court action in Victoria in relation to trade mark infringement, misleading or deceptive conduct and passing off action.

*Marshall Power Australia Pty Ltd v Exide Australia Pty Ltd and Ors* (2015) - trade mark infringement and misleading or deceptive conduct in the Federal Circuit Court in Sydney.

*MZZNF v Minister for Immigration & Border Protection & Refugee Review Tribunal* [2015] FCCA 1792 - pro bono matter acting for asylum seeker.

*Radnor v Ricegrowers Limited* (2015) - Federal Court of Victoria trade mark infringement action against Ricegrowers.

*Telstra Corporation Limited v Phone Directories Company Australia Limited and Ors*[2015] FCAFC 156 - Full Court decision concerning Telstra's application to register the word Yellow (led by G Schoff QC).

*DTA (Australia) Pty Ltd v Italia Ceramics Pty Ltd* (2014) - Federal Court action involving trade mark infringement, misleading or deceptive conduct and passing off (led by G Schoff QC).

*Fire Protection Association of Australia v Simpro Software* (2014) - copyright infringement action in the Federal Court of Victoria (led by M Collins QC).

*Phone Directories Company Australia and others v Telstra Corporation Limited*[2014] FCA 373 - 2

separate appeals (de novo) from the TMO relating to Telstra's application to register the word Yellow (led by G Schoff QC).

*Pandrol Australia Limited and another v Australian Railway Supply Company Limited*(2013) – Federal Court NSW, trade mark infringement, misleading or deceptive conduct and passing off.

*Sarkis Manufacturing and another v Diamonds International and others*(2013) – acting for one of the respondents in relation to application for an interlocutory injunction in the Federal Court in Melbourne.

*Smile Solutions v Cosmetic and Microdentistry Centre* (2012) – acting for Smile Solutions in Federal Court application for urgent interlocutory injunction relating to the use of trade marks in keyword searches.

*Wirra IP v Nutrition Care Pharmaceutical and another* (2012) – trade mark infringement, trade mark revocation, misleading or deceptive conduct and passing off. Federal Court NSW.

*Timber Ridge Investments v Auscut Queensland and others*(2011) – Federal Court action involving trade mark infringement, misleading or deceptive conduct and passing off (led by C Golvan QC).

#### **SUPREME COURT - COURT OF APPEAL**

*Mulvany v Hive & Wellness Australia Pty Ltd (formlery Capilano Honey)* [2019] VSCA 122 – acting (unled) for Hive & Wellness Australia (formerly Capilano Honey) in Court of Appeal in relation appeal by Mulvany from decision of Dixon J to not vary injunctions previously made.

#### **SUPREME COURT**

*Hive and Wellness Australia Pty Ltd v Mulvany* [2019] VSC 273 – acting for Hive and Wellness in relation to strike out application of defamation defences.

*Capilano Honey Ltd v Mulvany* [2018] VSC 672 – hearing before Dixon J in which Mulvany sought to vary injunctions imposed upon him previously by the Supreme Court in NSW.

*Telstra Corporation Limited v Singtel Optus Pty Ltd* [2018] VSC 247 - urgent application on behalf of Telstra for interlocutory injunction relating to Optus' advertisements relating to its mobile phone network (led by M Collins QC and Jim Peters QC).

*Dean Al Sesalim v The Herald & Weekly Times and Anor* (2017) – defamation proceedings (led by G Schoff QC).

*Contract Control Services Pty Ltd & Anor v Regional Publishers (Western Victoria) Pty Ltd and Anor* (2016) – injurious falsehood and defamation proceedings (led by M Collins QC).

*Antonio Madafferi v The Age Limited and Ors*[2015] VSC 682, [2016] VSC 103 – defamation proceedings (led by G Schoff QC).

*Barry Plant Group Pty Ltd v Northcote Realty Pty Ltd* (2016) – urgent injunction application relating to potential breach of franchise agreement.

*Sharkey v The Age Company* – defamation proceedings acting for The Age (led by M Collins QC).

*Cripps and another v Vakras and another* – defamation proceedings (led by W Houghton QC).

*Winbet (Aust) v Racing Vic* – Supreme Court of Victoria action relating to calculation of levy payable by Winbet to Racing Vic (led by M Collins QC).

*Leon Pompei v The Mordialloc Boating and Angling Club and Ors* – defamation proceedings.

*McIntyre v Zadel* – Supreme Court Victoria defamation proceedings.

*Funtastic and another v IE Enterprises and another* – urgent interlocutory application for search orders by Funtastic in late 2013.

#### COUNTY COURT

*Parke v Zivkovic and Ors* [2021] VCC 188 – defamation, costs.

*Parke v Zivkovic and Ors* [2021] VCC 41- Defamation, assessment of damages (led by M Collins AM QC).

*Deb Fryers v Shane Jacobson & Anor (2018)* - acting for Ms Fryers in relation to a claim for breach of contract and quantum meruit.

*Access Solutions Pty Ltd v Gamet Pty Ltd* [2017] VCC 1563 – dispute concerning lockout of tenant by landlord involving conversion of goods and business interruption.

*Deerfield Productions Pty Ltd v Evergreen Films Pty Ltd* – acting for Australian subsidiary of US film production company in relation to commercial dispute brought by Australian composer.

*MMP Greater Geelong v Hayeswinckle Holding* – County Court of Victoria defamation action (led by M Collins QC).

*Schiavello v Exquisite Pty Ltd and another* [2015] VCC 4 (29 May 2015) – County Court proceedings in relation to commercial dispute between the parties.

#### TRADE MARKS OFFICE PROCEEDINGS

*Bendigo and Adelaide Bank Limited v Community First Credit Union Ltd* [2017] ATMO 73 - acting for Bendigo and Adelaide Bank Limited in relation to opposition to registration of the marks COMMUNITY FIRST BANK and COMMUNITY FIRST MUTUAL BANK in the name of Community First Credit Union Limited.

*PayPal Inc v Giftmobile Pty Ltd* [2017] ATMO 113 - acting for PayPal in relation to opposition to trade mark number 1677875 for GiftPAL in the name of Giftmobile Pty Ltd.

*Ananda Marga Pracaraka Samgha Ltd v Amurt Inc* [2016] ATMO 72 (opposition).

*Ananda Marga Pracaraka Samgha Ltd v Seva Dharma Mission (Australia) Limited* [2016] ATMO 79 (opposition).

*Ananda Marga Pracaraka Samgha Ltd v Seva Darma Mission (Australia) Ltd* [2015] ATMO 96 (section

92 removal application)

*Storm Group v Storm International Group Pty Ltd* [2016] ATMO 99 (opposition).

*Abaco Machines (Australia) Pty Limited v Aardwolf Australia Pty Ltd* [2015] ATMO 55 72 (opposition).

*Gervasi Nominees Pty Ltd and Santo Gervasi v Winmart Pty Ltd* [2015] ATMO 6 (opposition).

Phone Directories Company Australia and Optus' opposition to Telstra Corporation Limited's application to register the colour yellow [2015].

*McD Asia Pacific LLC v Sheikhtaba Pty Ltd* [2015] ATMO 112 – acting for Sheikhtaba in relation to opposition by McDonalds to registration of the mark MAKFOODS and device.

*eBay Inc v Tradiebay* [2013] ATMO 58 72 (opposition).

Medibank Private Limited opposition to Randall Communications Pty Ltd's application to register MEDIBAND PLUS [2013] 72.

*Match Investments v Match Realty Limited* [2012] ATMO 90 72 (opposition).

*Basic Trademark SA v Krelia Tobacco Company Inc* [2012] ATMO 125 72 (opposition).

*Telstra Corporation Limited v Phone Directories Company Pty Ltd* [2012] ATMO 114 72 (opposition).

*NSE Products Ltd v International Waters Pty Ltd* [2011] ATMO 35 72 (opposition).

*PayPal Inc v Credibank Pty Ltd* [2011] ATMO 76 72 (opposition).

## Memberships

Victorian Bar - Commercial Bar Association

Intellectual Property Society of Australia and New Zealand (IPSANZ)

Intellectual Property Society of Australia and New Zealand (IPSANZ) - Committee Member Victorian Division