

Edward Heerey KC

Barrister-at-law, Nigel Bowen Chambers

Background and Qualifications

Ed Heerey graduated from the University of Melbourne with a Bachelor of Arts, a Bachelor of Laws (Hons) and a Masters of Intellectual Property Law.

From 1995 to 1999 he practised in intellectual property litigation at Allens Arthur Robinson in Melbourne.

He joined the Victorian Bar in 2000, and developed a practice specialising in intellectual property, trade practices and related commercial law.

In 2014 he was admitted to practice in the High Court of New Zealand, and is a practising member of the New Zealand Bar Association.

He was appointed Senior Counsel in Victoria in 2015 and King's Counsel in 2016.

In 2017 he moved to Sydney and joined Nigel Bowen Chambers, but continues to practice regularly in Melbourne where he remains a member of List G Barristers in Owen Dixon Chambers West.

Selected cases of interest include:

Copyright

Lumen Australia Pty Ltd v Frontline Australasia Pty Ltd (2018) 137 IPR 189

Senior Counsel for Lumen establishing infringement of copyright, breach of confidence and misleading conduct for the sale of counterfeit trailer wiring harnesses, with compensatory damages of \$140,750.30 and additional damages of \$500,000.

Henley Arch Pty Ltd v Lucky Homes Pty Ltd (2016) 120 IPR 317

Counsel for Henley Arch establishing compensatory damages and additional damages for infringement of copyright in building plans.

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.

Patents

Becton Dickinson, Inc. v B Braun Melsungen AG [2018] FCA 1692

Senior Counsel for B Braun in trial on patent validity and infringement regarding medical devices.

United States Gypsum Company v CSR Building Products Limited [2017] FCA 595

Senior Counsel for USG in an appeal to the Federal Court against a decision of the Patent Office.

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

Counsel (with David Shavin KC) 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.

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) 330 ALR 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.

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 relation to an application for merger authorisation.

Trade Marks

Sensis Pty Ltd v Senses Direct Mail and Fulfillment Pty Ltd [2019] FCA 719
Senior Counsel for Sensis Pty Ltd establishing infringement of SENSIS by SENSES DIRECT, and defence of an application to remove parts of the SENSIS trade mark registrations.

Southcorp Brands Pty Ltd v Australia Rush Rich Winery Pty Ltd [2019] FCA 720
Senior Counsel for Southcorp obtaining summary judgment for infringement of PENFOLDS trade marks against two Chinese companies and two Australian companies for making and exporting wine from Australia to China bearing the Chinese character version of the PENFOLDS trade mark, including an account of profits and interest over \$370,000.

Red Bull GmbH v Bullson Co Ltd [2019] FCA 545
Senior Counsel for Red Bull obtaining cancellation of Bullson's charging bull trade mark registration.

Pham Global Pty Ltd v Insight Clinical Imaging Pty Ltd [2017] FCAFC
Senior Counsel in a Full Federal Court appeal on a trade mark case raising various issues as to substantial identity, ownership and confusion arising from reputation in trade marks in different parts of Australia.

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; [2015] FCAFC 91
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.

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 injunctions 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; 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.

Recommendations

Doyle's Guide 2022 – Leading Intellectual Property Senior Counsel for NSW and Australia

Chambers and Partners 2019, 2020, 2021, 2022 – Band 1 Intellectual Property Silks Asia Pacific and Global

World Trademark Review 2019 – Gold band Senior Counsel for intellectual property.

The Best Lawyers in Australia 2023 Edition – Recognised for Intellectual Property

The Legal 500 Asia Pacific 2021,2022 – TMT & IP