

Edward Heerey KC

Barrister-at-Law Nigel Bowen Chambers

Background and qualifications

Ed joined the Victorian Bar in 2000, and developed a practice specialising in intellectual property, trade practices and related commercial law. Previously he worked as a solicitor in intellectual property litigation at Allens Arthur Robinson in Melbourne.

Ed was appointed Senior Counsel in 2015 and Queen's Counsel in 2016.

In 2017, Ed relocated with his family to Sydney, and joined Nigel Bowen Chambers. He continues to work regularly in Melbourne, where he is a member of Emmerson Chambers and List G Barristers.

Ed is a Senior Fellow of the University of Melbourne Law School, where he has taught in the post-graduate intellectual property programme for over 20 years, having completed a Masters of Intellectual Property Law in 1999.

Ed has represented a range of international and Australian clients dealing with disputes over alleged misleading packaging and advertising, misuse of confidential information, copyright in music and industrial plans and infringement of patents and trade marks. His clients cover a diverse range of industries, including biotech, medical, mining, automotive, architecture, construction, fashion, food, wine, brewing, FMCG, music, film, television and government regulators.

Ed is also admitted in New Zealand and has been a practising member of the New Zealand Bar Association since 2014.

Recent recommendations

Doyle's Guide 2024 – Pre-eminent Intellectual Property Senior Counsel for NSW and Australia

Chambers and Partners 2024 – Band 1 Intellectual Property Silks Asia Pacific and Global

The Best Lawyers in Australia 2024 Edition – Recognised as 'Lawyer of the Year' for Intellectual Property.

The Legal 500 Asia Pacific 2024 – TMT & IP

Selected cases of interest

Current cases in which Ed is involved include:

- A Federal Court proceeding for Instagram regarding infringement of its INSTA and INSTAGRAM trade marks - *Instagram, LLC v Instagoods Pty Ltd* SAD165/2021
- An appeal to the Federal Court for Google from a decision of the Trade Marks Office - *Google LLC v Interactive Engineering Pty Ltd* NSD61/2024
- An appeal to the Full Federal Court for Light & Wonder Inc against Aristocrat relating to alleged misuse of copyright and confidential information in gaming machines - *Aristocrat Technologies Australia Pty Limited v Light & Wonder, Inc. & Ors* NSD1576/2023
- A Federal Court proceeding for Crocs Inc seeking to enforce its trade mark registration of the shape of its footwear against a similar shape used by the Rivers brand - *Crocs, Inc v Mosaic Brands Ltd* NSD859/2021
- A Full Federal Court appeal for Lavazza coffee defending a claim by Cantarella Brothers for infringement of its ORO trade mark - *Cantarella Bros Pty Ltd v Lavazza Australia Pty Ltd* NSD1549/2023
- A Federal Court proceeding for the international Douwe Egberts business, seeking to enforce its rights in a shape trade mark for its Moccona coffee jar products against a similar shape used by the Vittoria brand - *Koninklijke Douwe Egberts B.V. v Cantarella Bros Pty Ltd* VID61/2023

Recent reported cases of note include:

- *RB (Hygiene Home) Australia Pty Ltd v Henkel Australia Pty Ltd* [2024] FCAFC 10
Full Federal Court appeal for Henkel successfully defending claims of trade mark infringement relating to FINISH and SOMAT dishwashing tablets.
- *Brick Lane Brewing Co Pty Ltd v Torquay Beverage Co Pty Ltd* (2023) 170 IPR 195
Federal Court trial for Torquay Beverage Co Pty Ltd successfully defending an allegation of misleading packaging for BETTER BEER.
- *Airco Fasteners Pty Ltd v Illinois Tool Works Inc* (2023) 170 IPR 225
Counsel for Airco in a Federal Court trial and Full Federal Court appeal on patent infringement relating to combustion tools.
- *Boehringer Ingelheim Animal Health USA Inc v Elanco New Zealand* (2021) 164 IPR 17
Counsel for Elanco successfully defending an appeal to the Federal Court from a decision of the Commissioner of Patents relating to veterinary formulations.
- *Combe International Ltd v Dr August Wolff GmbH & Co. KG Arzneimittel* (2021) 157 IPR 230
Full Federal Court appeal successfully establishing opposition to the VAGISAN trade mark.
- *Goodman Fielder Pte Ltd v Conga Foods Pty Ltd* (2020) 158 IPR 9
Federal Court trial for Goodman Fielder successfully establishing infringement of LA FAMIGLIA trade marks.
- *Taxiprop Pty Ltd v Neutron Holdings Inc* (2020) 156 IPR 1
Federal Court trial for Neutron successfully defending a claim of infringement and obtaining cancellation of LIME trade marks.
- *RB (Hygiene Home) Australia Pty Ltd v Procter & Gamble Australia Pty Ltd* [2023] FCA 383
Federal Court trial for Procter & Gamble successfully defending an allegation of misleading packaging for FAIRY dishwashing tablets.
- *Southcorp Brands Pty Ltd v Australia Rush Rich Winery Pty Ltd* (2019) 141 IPR 238
Federal Court trial for Southcorp obtaining summary judgment and an account of profits for infringement of PENFOLDS trade marks against Chinese and Australian companies for making and exporting wine from Australia to China bearing the Chinese character version of the PENFOLDS trade mark.
- *Becton Dickinson, Inc. v B Braun Melsungen AG* [2018] FCA 1692
Federal Court trial for B Braun in trial on patent validity and infringement regarding medical devices.
- *Lumen Australia Pty Ltd v Frontline Australasia Pty Ltd* (2018) 137 IPR 189
Federal Court trial for Lumen successfully 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
Federal Court trial for Henley Arch successfully 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 the song "I am Australian" in citizenship ceremonies.
- *Pham Global Pty Ltd v Insight Clinical Imaging Pty Ltd* (2017) 251 FCR 379
Full Federal Court appeal for Insight 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.

- *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
Senior 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.
 - *Rodney Jane Racing Pty Ltd v Monster Energy Company* (2019) 142 IPR 275
Senior Counsel for Rodney Jane Racing in successful appeal from Trade Mark Office opposition concerning MONSTER trade marks.
 - *Sensis Pty Ltd v Senses Direct Mail and Fulfillment Pty Ltd* (2019) 141 IPR 463
Federal Court trial 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.
 - *Red Bull GmbH v Bullsone Co Ltd* [2019] FCA 545
Federal Court proceeding for Red Bull obtaining cancellation of Bullsone's charging bull trade mark registration.
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Professional memberships

Ed is an active member of the Intellectual Property Society of Australia and New Zealand and the Institute of Patent and Trademark Attorneys, for whom he provides annual Trade Marks Updates around Australia.

Ed is also a member of the International Trademarks Association.

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