

Edwina Whitby

Barrister-at-law, Nigel Bowen Chambers

Admissions and Career Overview

2014	Barrister, New South Wales
2009-2014	Solicitor, King & Wood Mallesons (Senior Associate 2013 in Dispute Resolution and Intellectual Property, Solicitor 2009)
2008	Tipstaff to the Honorable Justice Margaret Beazley AO, President of the New South Wales Court of Appeal.
2006	Mallesons Stephen Jaques, Summer Clerk and Law Clerk, Dispute Resolution & Mergers Acquisition (2004/6)
2005	Winter Clerkship, Linklaters London

Tertiary qualifications

2008	LLB (Hons) (Class 1) University of Sydney
2007	Diploma of Languages (Hispanic Studies), UNSW
2004	Bachelor of Arts (Government and English), University of Sydney

Experience at the Bar and Notable Cases

Edwina has a diverse commercial litigation practice, focusing on intellectual property, media, competition and consumer law. Edwina has been listed in the 2019-22 Doyle's Guide as a Leading Intellectual Property Junior Counsel and in The Legal 500 2022 Edition: '*Excellent junior. Strong grasp of the law and Federal Court practice generally. A delight to work with; approachable, smart, willing to give time to the client.*' Edwina's broader commercial litigation practice includes general commercial, contracts, construction and environmental and planning law. Selected cases include:

Intellectual Property and Australian Consumer Law

- *Allergan Inc v Self-Care* - NSD15/2017; 1802/2017 (reserved) (led by S. Goddard SC) – appearing for Allergan in trade mark infringement and misleading and deceptive conduct claim against Self-Care for use of the "BOTOX" trade mark and making of therapeutic claims for cosmetics products.

- *Boomerang Investments & Ors v Padgett & Ors* – NSD1738/2017 (reserved) (led by C. Dimitriadis SC) – defending Air France in music copyright infringement proceedings brought by rightsholders of the song “*Love is in the Air*”.
- *Application by Isentia Pty Limited* [2018] ACopyT 4 (ongoing) (led by C. Dimitriadis SC) – acting for Copyright Agency Limited in three Copyright Tribunal proceedings brought by media monitoring organisations (Isentia, Meltwater, Stream) in relation to press clipping licences for newspaper content.
- *JWR Productions v Duncan-Watt* (NSD266/2017) (reserved) (led by M. Hall SC) – acting for an award winning screenwriter in a dispute concerning a “Golden Girls” puppet parody show, raising legal issues of copyright, defamation and misleading and deceptive conduct.
- *Aristocrat Technologies Australia v Commissioner of Patents* – NSD1343/2018 (ongoing) (led by C. Dimitriadis SC) – appearing for the Commissioner in appeal brought by Aristocrat from a decision to revoke gaming machine patents.
- *SKYN v Ansell* (WAD20/2018) (ongoing) (unled) – acting for Ansell in appeal against a decision of the Registrar to refuse registration of a trade mark.
- *Caesarstone Ltd v Ceramiche Caesar S.p.A. (No 2)* [2018] FCA 1096 (led by C. Burgess) – appeared for Ceramiche Caesar S.p.A in an appeal from decisions of the Registrar of Trade Marks to reject applications for registration of the CAESARSTONE word/device; appeal pending before Full Federal Court.
- *American Media Inc & Howard V TCN Channel Nine* (settled) (led by D. Sibtain) – appeared for AMI to restrain broadcast of media footage by 60 Minutes.
- *Australian Competition and Consumer Commission v Servcorp Limited* [2018] FCA 1044 (led by G. Curtin SC) – appeared for Servcorp against the ACCC in case concerning unfair contract terms in leases of commercial property.
- *Crescent Capital Partners Management v Crescent Funds Management* [2016] FCA 229 and on appeal [2017] FCAFC 2 (led by R. Cobden SC) – acted for private equity firm Crescent Capital in misleading and deceptive conduct claim to restrain use of name “Crescent Wealth” by a rival financial services provider.
- *Moroccanoil v Aldi* [2017] FCA 823 (led by R Cobden SC, J Cooke) acted for Moroccanoil against Aldi in relation to “Moroccan Argan Oil” hair products, suing for trade mark infringement, passing off and misleading and deceptive conduct.
- *Biomax v Jabiru Agribusiness* [2016] FCA 505 and [2016] FCA 600 (unled) successful application for default judgment for copyright infringement in drawings and photographs advertising farm machinery; “slip rule” application.
- *Scandinavian Tobacco Group v Trojan Trading Company* [2015] FCA 1086 (led by M R Hall SC) – successfully defended a parallel importer of tobacco products against allegations of trade mark infringement, who repackaged goods for compliance with tobacco plain packaging regime in unofficial packaging.
- *Unilever Australia v Revlon* [2014] FCA 573 (led by Studdy SC) and [2014] FCA 875 (led by M R Hall SC) appeared for Revlon against allegations of misleading and deceptive conduct for advertising and packaging claims for Mitchum Clinical antiperspirant deodorant; resisted interlocutory application for injunctive relief.

Trade Mark Oppositions

- *Celli S.P.A v Inlon Pty Ltd* (reserved, led by S. J. Goddard SC).
- *Digitus v Leap Software Developments* [2018] ATMO 153 (unled).
- *Susanne Lang Fragrance Inc. v The Lip Lab* [2018] ATMO 82 (unled).
- *Imperial S.p.A. v Alliance Apparel Group, Inc.* [2018] ATMO 62 (unled).
- *Patriot Campers Pty Ltd v Sunland RV* [2018] ATMO 59 (unled).
- *Allergan, Inc. v Selfcare IP Holdings* [2017] ATMO 102 (unled).
- *My Brilliance v Samsung Electronics* [2016] ATMO 84 (unled).
- *Health Boutique v Boom Ideas* [2015] ATMO 104 (unled).

Property, Building and Construction

- *Pentalign Sales Pty Limited trading as Ray White Maroubra / South Coogee v Lee* (unled) (Local Court 2015/00284644) – successfully defended property vendor against suit for breach of contract and voided agent’s entitlement to commission on sale of a commercial property with indemnity costs.
- *Walker Group Constructions v Bluescope Steel* (led by D Ryan SC and FP Hicks) (settled); appearing for Walkers in dispute concerning breach of a building and construction contract for defective bolts in roof of a paint facility.
- *Tzaneros Investments v Walker Group Constructions* [2016] NSWSC 50 (led by M Rudge SC and FP Hicks); [2017] NSWCA 27; led by I Jackman SC, M R Hall SC, FP Hicks) - appeared for Walkers in a dispute concerning breach of design and construct contract for shipping container terminal pavement in Port Botany; successful suit against design engineer for defective design of pavement.
- *Fuentes v Bondi Beachside* [2016] NSWSC 531 (led by Epstein SC) acted for property developer in dispute concerning the on-sale of an “off the plan” luxury unit prior to settlement.

Environment and Planning

- *St Marys Recycling v NSW* (NSD1735/2015) (settled) (led by P Larkin SC) – acted for operator of waste transfer and recycling centre in case concerning contributions payable for waste received at facilities; validity of the ‘proximity principle’ under the *Protection of the Environment Operations (Waste) Act* (NSW).

- *Australia Skydive Pty Ltd v Wyong Shire Council* [2014] NSWLEC 185 (led by P Larkin SC) – defended council in judicial review proceedings concerning validity of fees imposed for use of Warnervale Airport by a skydiving business (settled).
 - *Teys Australia Southern Pty Limited v Burns* [2015] NSWLEC 1; (2015) 206 LGERA 186 (led by P Larkin SC) – defended landholders in judicial review proceedings challenging an approved application for residential subdivision under the *Environmental Planning and Assessment Act 1979* (NSW).
 - *Save Little Manly Beach Foreshore Inc v Minister for Planning (No 3)* [2015] NSWLEC 77 (led by P Larkin SC) – acted for community interest group in judicial review proceedings concerning amendments to a Local Environmental Plan affecting waterfront and community land.
 - *Wilks v Wagga Wagga City Council* [2015] NSWLEC 1432 (led by P Larkin SC) – acted for landholders in Class 1 review of development application for residential subdivision of land in proximity to industrial estate.
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Selection of cases as a solicitor at King & Wood Mallesons (2009-2014)

- *Samsung Electronics Australia v LG Electronics Australia* [2015] FCA 227 (instructing R Webb SC and M R Hall) – defended LG’s advertising campaign for LG Cinema 3D TVs against allegations of misleading and deceptive conduct and injurious falsehood – consumer survey evidence.
 - *JT International SA v Commonwealth of Australia* [2012] HCA 43; (2012) 291 ALR 669 (instructing B Walker SC and C Lenehan) – acted for ITA in constitutional challenge to the *Tobacco Plain Packaging Act 2011* (Cth).
 - *Peter Bodum A/S v DKSH Australia* [2011] FCAFC 98 (instructing Catterns QC, Goddard SC and M R Hall) – successfully acted for Bodum in case against a seller of copycat plungers, establishing a common law reputation in the get-up and features of the Bodum Chambord coffee plunger, breach of the Trade Practices Act and passing off.
 - *Luxottica Retail Australia* – 3 month secondment in role of Legal Counsel to leading eyewear company advising OPSM, Sunglass Hut and Laubman and Pank on branding, as general commercial, regulatory, therapeutic goods and medical devices.
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Interests

Edwina is a certified yoga teacher, completing over 500 hours of training with Power Living Australia (Vinyasa 200 hours, Yin 75 hours; Philosophy 150 hours; Advanced Vinyasa 50 hours; Advanced Assisting 30 hours).

Edwina is also fluent in Spanish, completing studies at the Universidad de La Habana, Cuba, and a Diploma of Languages at the University of New South Wales, where she obtained the Benchmark Prize in Hispanic Studies in consecutive years for 2006 and 2007.