



JOSEPH ELKS

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OVERVIEW

Joseph accepts briefs in all areas of law, and specialises in intellectual property, complex commercial disputes, sports law, defamation and competition law.

ADMISSIONS

Australia:

2020 Barrister, New South Wales
2012 Solicitor, Supreme Court of New South Wales and High Court of Australia

United States:

2016 New York State Bar (also eligible to appear in: Southern District of NY, Eastern District of NY, Court of Appeals for Federal Circuit)

ACADEMIC QUALIFICATIONS

New York University, Master of Laws, IP and Competition Law, 2016

Honours: *Hauser Global Scholar* (full-tuition and living stipend merit-based scholarship)
Frank T. Diersen Prize for graduating first in program

University of Queensland, Bachelor of Laws (*Hons Class I*) and Bachelor of Commerce, 2010

Honours: *Freehills Prize in Law* (student with the highest graduating Law GPA in dual program)
Gilshenan & Luton Prize in Criminal Law
UQ Exchange Scholarship

PRIOR PROFESSIONAL EXPERIENCE

Herbert Smith Freehills, Sydney

Senior Associate, 2019-2020

Solicitor, 2012-2015

Wilmer Cutler Pickering Hale and Dorr LLP, New York, USA

Senior Associate, 2016-2019

Federal Court of Australia, Sydney

Associate to Justice Cawdron OAM, 2011-2012

Allens Arthur Robinson, Brisbane

Paralegal and Summer Clerk, 2009-2010

Clayton Utz, Brisbane

Summer Clerk, 2008

SELECTED CASES (AS COUNSEL)

Intellectual Property (patent, design, copyright and trade mark)

- *Pfizer v Juno Pharmaceuticals* (NSD 1370/2019). Patent infringement and invalidity proceeding. With A Ryan SC and JS Cooke for the Respondent (3 week hearing concluded May 2021, judgment reserved).
- *Janssen Sciences v Juno Pharmaceuticals* (NSD 698/2020). Patent infringement proceeding. With JS Cooke for the Applicant (resolved by settlement).
- *LTJ Innovations Pty Ltd v Matchmaster Communications Pty Ltd* (VID 594/2020). Patent and design infringement proceeding. With JS Cooke for the Respondent (resolved by settlement).
- *Vector Corrosion Technologies Limited v Duoguard Australia Pty Ltd* (QUD 649/2018, QUD117/2019). Patent infringement and entitlement proceeding. With JS Cooke for the Respondents (briefed in relation to interlocutory disputes).
- *Frucor v Doctor V* (NSD 146/2021). Misleading or deceptive conduct and trade mark revocation proceedings relating to V Energy drinks. With JS Cooke for the Applicants (ongoing).
- *Sydney Opera House Trust v ACETCA* (NSD 1281/2020). Trade mark and copyright proceedings relating to the Sydney Opera House. With JS Cooke for the Applicant (ongoing).
- *Epic Games v Brandon Despotakis* (NSD 326/2021). Copyright infringement, inducement of breach of contract and ACL relating to the game *Fortnite*. With JS Cooke for the Respondent (ongoing).
- *Dietitians Association of Australia v ACNM* (ACD 49/2021). Trade mark proceedings. With JS Cooke for the Appellant (ongoing).

Trade Marks Office Proceedings

- Trade mark oppositions relating to the “VASILI GARDEN” trade marks. Representing Maresi Productions Pty Ltd. Unled (resolved prior to hearing).
- Trade mark opposition relating to the “SPAN 2” trade mark. Representing International Exchange Incorporated. With JS Cooke.
- Trade mark opposition relating to the “CLUB BUNKER” trade mark application. Representing Fitness Playground. Unled (ongoing).

Confidential information

- *Jubilant Generics v Generic Partners Pty Ltd* (NSD 1342/2020). Confidential information, copyright and contractual claims. Led by JS Cooke for the Respondent (ongoing).
- *Sydney Tools Pty Ltd v Total Tools Pty Ltd and Others* (Supreme Court, 2019/110529). Breach of confidential information, breach of contract, conspiracy and other actions. With Gerard Dalton QC and David Larish for the Respondents (ongoing).

Competition & Consumer Law

- *Omari v Skinner & Skinner* (District Court, 2021/00195268). ACL claims, breach of contract, negligence. Unled (ongoing).
- *Venning v Ren* (Federal Circuit Court), representing second respondent in relation to enforcement examination with respect to an ACL claim. Unled (ongoing).
- *Elite Design v AEV Pty Ltd* (Local Court, 2021/00258109), representing plaintiff, relating to breach of contract and ACL claims. Unled (ongoing).

Contract law

- *Hertog v Sugden* (District Court, 2020/00055545). Contractual loan dispute. Unled (settled on eve of two day final hearing).
- *Confidential arbitration hearing relating to contractual issues*. Led by Pat Zappia QC (hearing held in December 2020).
- *Change Freight Forwarding v Grocery Delivery E-Services* (Local Court, 2020/00263310). Contractual dispute. Unled (ongoing).

Torts

- *Newham v Rana* (Local Court, General Division, 2019/00349192). Negligence action. Unled (settled on eve of final hearing).

Administrative Law

- *DZD20 v Minister for Immigration* (SYG2058/2020). Application for judicial review relating to the *Migration Act*. Unled, appearing *pro bono* (ongoing).

Property Law

- *Giardi v Duncum & Ors* (Supreme Court, 2021/62408). Application for sale of a racehorse under s 36A of the *Conveyancing Act 1919* (NSW). Unled (finalised). Indemnity costs obtained: [2021] NSWSC 1138 per Ward CJ in Eq.
- *LMC v Carr & Another* (Supreme Court, 2021/00257811). Relief sought for the lodgement of a caveat, and substantive claims relating to misappropriation of funds. Unled (ongoing).

Sports law

- Representing Harness Racing NSW in an appeal brought by Mr Phillip Walters in the *NSW Racing Appeals Tribunal* (relating to presenting a horse to race while positive to prohibited substances). Unled (part-heard).
- Representing Harness Racing NSW in an appeal brought by Mr Trevor-Jones in the *NSW Racing Appeals Tribunal*.

Insolvency

- *Karnav Pty Ltd v Star Car Wash Café* (FCA, SAD 152/2021). Representing Respondents in an application to set aside statutory demand. Unled (resolved).

Criminal law

- *Booth v Khaqaal* (NSD 859/2020); [2020] FCA 1528. Application for interim control order. Led by C Parkin.

Defamation

- Several defamation matters that resolved pre-litigation.

SELECTED CASES AS A SOLICITOR (AUSTRALIA)

- Acted for Motorola Solutions in relation to patent and copyright litigation brought against Hytera Communications in the Federal Court of Australia (NSD 1283 of 2017).
- Acted for Ariosa Diagnostics in the Federal Court appeal against Sequenom in relation to alleged patent infringement of a cell-free DNA diagnostics patent (VID 875 of 2019).
- Acted for Cantarella Bros. in relation to two appeals from decisions of the Trade Marks Office, and Australian Patent Office opposition proceedings.

- Acted for Apotex in Federal Court of Australia proceedings for patent infringement brought by Les Laboratoires Servier in relation to an anti-diabetic medication (VID 603 of 2013).
- Acted for Apple and Apple Australia in multiple sets of Federal Court of Australia proceedings (including NSD 1243 of 2011) against Samsung Electronics concerning allegations of patent infringement, design infringement, competition law, and FRAND issues.
- Acted for DePuy and Johnson & Johnson in the ASR hip implants class action, that was ultimately settled (NSD 213 of 2011).

SELECTED CASES AS AN ATTORNEY (UNITED STATES)

- Acted for Apple against Acacia Research Corporation and Conversant Intellectual Property Management in the Northern District of California with respect to allegations by Apple of anticompetitive conduct by those defendants and Nokia (5:2016-cv-07266).
- Acted for Apple in a patent infringement, competition law, and FRAND case brought by Nokia.
- Acted for Apple and Intel in the International Trade Commission defending patent infringement proceedings brought by Qualcomm with respect to various iPhone models (ITC 337-TA-1093).
- Acted for Apple and Intel with respect to patent infringement proceedings in the San Diego District Court and *inter partes* review proceedings before the Patent Trial and Appeal Board.
- Acted for Intel and Ibiden with respect to a patent infringement action brought by Continental Circuits LLC in the District Court of Arizona relating to semiconductor technology (2:16-cv-02026), and subsequent appeal in the Federal Circuit (2018-01076).
- Acted for VMR Products and Juul in relation to a patent infringement proceeding brought by Lightwire LLC with respect to a patent for a smoking cessation aid in the Southern District of Florida (1:18-cv-23408-KMW).
- Acted for T-Mobile in relation to a patent infringement proceeding brought by Vertical Connection Technologies in the Eastern District of New York with respect to a patent relating to vertical handover technology in 3G and 4G networks (2:17-cv-04992).
- Acted for Omega and Swatch in relation to a jury trade mark infringement trial brought against 375 Canal LLC in the Southern District of New York (1:12-cv-06979-PAC).

PRO BONO

- Advised the community organisation Downtown Alliance for New York with respect to a variety of intellectual property issues and potential disputes (2016 – 2019).
- Appeared in NSW local courts to provide pro bono assistance to disadvantaged youths in relation to a variety of criminal offences as part of the Shopfront Legal Centre (2012 – 2015).
- Acted for an under-age victim of sexual crimes in NSW to successfully obtain the maximum statutory compensation (2014 – 2015).
- Provided legal assistance to Australian artists through the Arts Law Legal Centre of Australia across a variety of copyright, patent, and registered design issues (2012 – 2015).

MEMBERSHIPS

- NSW Bar Association
- NY Bar Association
- IPSANZ

PUBLICATIONS

FRAND patents: the new battleground in patent litigation, Australian International Property Law Bulletin, 28 (7) September 2015: p.200-203 28 AIPLB 200, (2015)

Neighbourly Love: Baxter & the "Bad" Seeds, HSF General Counsel Update, July 2014

Love Thy neighbour? The potential coexistence of organic and GM farming is examined by the WA Supreme Court, HSF IP Bulletin, July 2014

Private Label v Branded Goods: The Rise of Private Label Products in Australia, Consumer Products Update, Herbert Smith Freehills, Summer 2013