



JOSEPH ELKS

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OVERVIEW

Joseph accepts briefs in all areas of law, and specialises in intellectual property, commercial disputes, sports law, equity, consumer and trade practices.

Joseph is recognised in Doyle's Guide as a "*Recommended*" junior counsel in intellectual property litigation in New South Wales in 2022 and 2023, has been named by *Best Lawyers* as "*One to Watch*" in 2023, and was recently ranked a "Leading Junior" in IP and TMT by the *Legal 500*.

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 Cowdroy OAM, 2011-2012

Allens Arthur Robinson, Brisbane
Paralegal and Summer Clerk, 2009-2010

Clayton Utz, Brisbane
Summer Clerk, 2008

Intellectual Property – Patents and Registered Designs

Pharmaceuticals

- *Sun Pharma ANZ Pty Ltd v Otsuka Pharmaceutical Co., Ltd* (FCA, NSD172/2024). Patent revocation and extension of term proceedings. With JS Cooke SC for the Applicant (ongoing).
- *Samsung Bioepis AU Pty Ltd v Janssen Biotech, Inc.* (FCA, NSD65/2024). Patent revocation proceedings. With JS Cooke SC for the Respondent (ongoing).
- *Pfizer v Juno Pharmaceuticals* (FCA, NSD 1370/2019). Patent infringement and invalidity proceedings. With A Ryan SC and JS Cooke SC for the Respondent (3 week hearing concluded May 2021, first instance judgments: *Pharmacia LLC v Juno Pharmaceuticals Pty Ltd* [2022] FCA 92; 165 IPR 200; *Pharmacia LLC v Juno Pharmaceuticals Pty Ltd (No 2)* [2022] FCA 369).
- *Pfizer v Juno Pharmaceuticals* (FCA, NSD294/2022). Appeal proceeding. With Adrian Ryan SC and JS Cooke SC for the Respondent / Cross-Appellant. Appeal heard in August 2022. Judgment: *Pharmacia LLC v Juno Pharmaceuticals Pty Ltd* [2022] FCAFC 167; 168 IPR 431.
- *Janssen Sciences v Juno Pharmaceuticals* (FCA, NSD 698/2020). Patent infringement proceeding. With JS Cooke SC for the Applicant (resolved by settlement).
- Previously briefed to advise major pharmaceutical companies with respect to potential interlocutory injunction, patent infringement proceedings, and extension of time proceedings.

Mining

- *Technological Resources Pty Ltd (Rio Tinto) v Epiroc* (NSD 605/2022). Patent infringement proceedings. With Neil Murray SC and Ben Mee for the First-Fourth Respondents (ongoing).
- *Dyno Nobel v Orica* (FCA, NSD345/2022). Patent invalidity and infringement proceedings. With Cynthia Cochrane SC and Ben Mee for the Applicant (ongoing).
- *Orica v Dyno Nobel* (FCA, NSD514/2022). Preliminary discovery proceeding. With Cynthia Cochrane SC for the Prospective Respondent (resolved by settlement).
- *Dyno Nobel Asia Pacific v Olitek Pty Ltd* (FCA, NSD 693/2022). Appeal from Patents Office decision regarding entitlement dispute. With C Cochrane SC for the Appellant (ongoing, listed for trial in May 2024).
- Patent office opposition, representing Dyno Nobel against Orica, with respect to a patent application for wireless detonator technology. With Cynthia Cochrane SC for the Opponent.

Construction / Industry

- *All Valve Industries v Comino* (FCA, NSD1337/2021). Patent, design and copyright proceedings. With Patrick Flynn SC for the Applicant (ongoing, listed for trial in April 2024).
- *Deco Australia Pty Ltd v Aliwood Pty Ltd* (FCA, NSD 1061/2020). Patent infringement and revocation proceedings. With C Cochrane SC for the Respondent (resolved by settlement on eve of two-week trial in April 2022).
- *Calix Limited v Grenof Pty Ltd* (FCA, NSD 852/2021). Patent infringement and revocation proceedings. With M Green SC and B Oliak for the Applicant (one week trial

in March 2023). Judgment: [\[2023\] FCA 378](#); [\[2023\] FCA 832](#).

- *Vector Corrosion Technologies Limited v Duoguard Australia Pty Ltd* (FCA, QUD 649/2018, QUD117/2019). Patent infringement and entitlement proceeding. With JS Cooke SC for the Respondents (briefed in relation to interlocutory disputes).
- *LTJ Innovations Pty Ltd v Matchmaster Communications Pty Ltd* (FCA, VID 594/2020). Patent and design infringement proceeding. With JS Cooke SC for the Respondent (resolved by settlement).

Consumer products

- *Joseph Stasiuk v Monster Energy Pty Ltd* (NSD 317/2023). Patent infringement proceeding. Judgment: [\[2023\] FCA 856](#).

Patent Office

- Patent office opposition, representing Romteck Australia on entitlement dispute, led by D Larish. Judgment: *Romteck Australia Pty Ltd. v Philip Victor Harman* [\[2022\] APO 58](#).
- Patent office opposition, representing VALD Technologies (unled, reserved).

Intellectual Property – Copyright and Trade Marks

- *Sydney Opera House Trust v ACETCA* (FCA, NSD 1281/2020). Trade mark and copyright proceedings relating to the Sydney Opera House. With JS Cooke SC for the Applicant (resolved by settlement).
- *Polygon v Vox* (FCA, NSD 593/2023). Trade mark proceedings relating to the “Polygon” trade mark. With JS Cooke SC for the Applicant (resolved by settlement).
- *Epic Games v Brandon Despotakis* (FCA, NSD 326/2021). Copyright infringement, inducement of breach of contract, trade mark infringement, and ACL relating to the game *Fortnite*. With JS Cooke SC for the Respondent (resolved by settlement).
- *McDonald Jones Homes Pty Ltd v Glendon Brae Holmes Pty Ltd* (SYG924/2022). Copyright infringement relating to house plans. Unled (resolved at mediation).
- *Australian Karting Assoc Ltd v Karting (NSW)* (FCCA, SYG1649/2019). Copyright and trade mark infringement. With JS Cooke SC for the Respondent (resolved at mediation).
- *Frucor v Doctor V* (FCA, NSD 146/2021). Misleading or deceptive conduct and trade mark revocation proceedings relating to V Energy drinks. With JS Cooke SC for the Applicants (resolved by settlement).
- *Dietitians Association of Australia v ACNM* (FCA, ACD 49/2021). Trade mark proceedings. With JS Cooke SC for the Appellant (resolved by settlement).
- I am also briefed in several led and unled trade mark oppositions. For reported decisions see by way of example: *FurFresh Pty Ltd v David Haythornthwaite* [\[2022\] ATMO 56](#); *AUDI AG v Auditel* [\[2022\] ATMO 207](#); *Rhythm & Blue Inc Limited v The Temple Skincare Pty Ltd* [\[2023\] ATMO 178](#).

Confidential information

- *Epoch Group v Toby Carrodus and Another* (FCA, NSD527/2022). Breach of confidential information, copyright, including *ex parte* search orders. Led by Patrick Flynn SC for Applicants (ongoing). See e.g. *The Epoch Holding Group Pty Ltd v Carrodus* [\[2022\] FCA 947](#); [\[2023\] FCA 1468](#).
- *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).

- *Healthed v Commune Digital and Others* (FCA, NSD 992/2021). Confidential information, ACL. Led by JS Cooke SC for the Applicant (resolved by settlement).
- *Jubilant Generics v Generic Partners Pty Ltd* (FCA, NSD 1342/2020). Confidential information, copyright and contractual claims. Led by JS Cooke SC for the Respondent (resolved by settlement).

Competition & Consumer Law

- *AVI v Strongcast Pty Ltd* (Supreme Court, 2020/1808196). ACL claims, breach of contract. Unled (ongoing).
- *Omari v Skinner & Skinner* (District Court, 2021/00195268). ACL claims, breach of contract, negligence. Unled (resolved by settlement).
- *Venning v Ren* (Federal Circuit Court, SYG18/2020), representing second respondent in relation to enforcement examination with respect to an ACL claim. Unled (resolved).
- *Elite Design v AEV Pty Ltd* (Local Court, 2021/00258109), representing plaintiff, relating to breach of contract and ACL claims. Unled (resolved by settlement).

Contract law

- *Lobster & Co Trading Company v Nisbets Australia* (Local Court, General Division). Contractual dispute, unled for the Defendant. Judgment for the Defendant, with indemnity costs.
- *Lobster & Co Trading Company v Nisbets Australia* (Supreme Court, 2022/343163). Appeal, unled. Judgment: [\[2023\] NSWSC 1179](#).
- *Planet Plumbing v Tradelink & Anor* (Supreme Court, 2022/00196091). Contractual dispute, ACL, estoppel (unled).
- *Veritas Advisory v Aston Chace Group* (Supreme Court, 2021/00307347). Contractual loan dispute, unjust enrichment and other issues. Unled (resolved by settlement).
- *Infor Global Solutions (ANZ) v Tyremax Pty Ltd* (Supreme Court, 2020/00191596). Contract dispute. Led by D Larish on interlocutory disputes (resolved by settlement).
- *Hertog v Sugden* (District Court, 2020/00055545). Contractual loan dispute. Unled (settled on eve of two day final hearing).
- *Change Freight Forwarding v Grocery Delivery E-Services* (Local Court, 2020/00263310). Contractual dispute. Unled (successful in obtaining judgment and costs).
- *Ferrier Silvia v McCall* (Local Court, 2023/00198915). Contractual dispute, unled. Ongoing.
- *Disruptive Packaging v Cosmic Packaging* (District Court, 2022/159641). Contract dispute. Unled (resolved by settlement).

Equity

- *LMC v Carr & Another* (Supreme Court, 2021/00257811). Relief sought for the lodgement of a caveat, and substantive claims relating to misappropriation of funds (representing defendants). Plaintiff discontinued with costs. See *Lake Macquarie Conveyancing Pty Ltd v Carr* [\[2021\] NSWSC 1295](#) per Ward CJ in Eq.
- *Digital Books QLD v Con Ange* (Supreme Court, 2021/00324280). Breach of fiduciary duties by ex-employee, release from *Harman* undertaking. Unled.

Administrative Law

- *DZD20 v Minister for Immigration* (SYG2058/2020). Application for judicial review relating to the *Migration Act*. Unled, appearing *pro bono*.
- *See also* administrative law matters in the sports law context.

Property Law

- *Girardi 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.
- *Raine & Horne v Nellore & Whitning* (District Court, 2023/00235403). Agency dispute (unled). Ongoing.
- *DroneShield Ltd v Bannister Law* (Local Court, 2021/365785). Lease dispute (unled). Resolved by settlement on day of trial.
- *Jaycar Property Group v Jewell* (Local Court, 2022/00188083). Buyers' agent dispute (unled). Resolved by settlement.
- *Jaycar Property Group v O'Connor* (District Court, 2022/327665). Buyers' agent dispute (unled). Resolved by settlement on day of trial.

Sports law

Supreme Court

- Representing Harness Racing NSW in an urgent injunction hearing brought by Mr Peter Russo in the NSW Supreme Court (*Russo v Harness Racing NSW & Anor* (2023/30919)) (injunction resisted).
- Representing Harness Racing NSW in a judicial review proceeding brought by Mr Trevor-Jones in the NSW Supreme Court (*Trevor-Jones v Harness Racing NSW* (2023/179706)).

Tribunals

- 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, including EPO). Unled. Appeal withdrawn on day 4 of hearing by Appellant.
- Representing Harness Racing NSW in appeal brought by Mr Wade (prohibited substance being levamisole) in the *NSW Racing Appeals Tribunal*. Appeal dismissed. Decision available: [Link](#) (Penalty); [Link](#) (breach).
- Representing Harness Racing NSW in appeal brought by Mr John McCarthy (prohibited substance being cobalt). Appeal ongoing in the *NSW Racing Appeals Tribunal*. Decision forthcoming.
- Representing Harness Racing NSW in appeal brought by Mr Peter Russo (prohibited substance being TCO2). Appeal dismissed in the *NSW Racing Appeals Tribunal*. Decision available: [Link](#) (penalty); [Link](#) (breach).
- Representing Harness Racing NSW in appeal brought by Mr Trevor-Jones (prohibited substance being steroids). Appeal dismissed in the *NSW Racing Appeals Tribunal*. Decision available on breach and penalty: [Link](#).
- Representing Harness Racing NSW in appeal brought by Mr Paul Russo (prohibited substance being cobalt). Appeal dismissed in the *NSW Racing Appeals Tribunal*. Decision available on penalty: [Link](#).
- Representing Mr Thomas in respect of Greyhounds NSW disciplinary proceedings (finalised, appeal successful). Decision available from the *NSW Racing Appeals*

Tribunal: [Link](#).

- Representing Harness Racing NSW in appeal brought by Mr Frisby (prohibited substance being levamisole) in the *NSW Racing Appeals Panel*. Decision forthcoming.

Advisory

- Advising professional players associations (including the NRL Players Association) relating to intellectual property issues.

Insolvency

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

Defamation

- *Jennifer Do & Ors v Kolsumdet Pty Ltd* (NSD1355/2021). Representing respondents on interlocutory issues.
- I have also advised clients on several defamation matters that have resolved pre-litigation, including the preparation and responses to concerns notice under the *Defamation Act*.

Tax

- Representing a large multinational software company in relation to ongoing ATO dispute relating to transfer pricing and Part IVA issues.

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.
- Acted for Ariosa Diagnostics in the Federal Court appeal against Sequenom in relation to alleged patent infringement of a cell-free DNA diagnostics patent.
- 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.
- Acted for Apple and Apple Australia in multiple sets of Federal Court of Australia proceedings 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.

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