

# Sam Hallahan



+61 2 8066 6175

sam.hallahan@5wentworth.com

## Areas of Practice

- Intellectual property
- Consumer protection
- Corporate/commercial
- Equity

## Education

**University of Sydney – Bachelor of Arts (Hons.)**

2001 – 2004

**University of New South Wales – Bachelor of Laws (Hons.)**

2006 – 2008

**University of Technology Sydney – Master of Industrial Property**

2009 - 2012

## Experience

**Barrister, 5 Wentworth Chambers** | May 2016 – Present

**Sessional Academic, University of New South Wales** | 2017 – 2019

- LAWS8017/JURD7617 – Intellectual Property
- A comprehensive intellectual property law subject for Masters of Law and Juris Doctor students.

**Associate, Corrs Chambers Westgarth** | August 2013 – April 2016

- Intellectual Property Litigation

**Associate, Deutche Miller** | September 2011 – November 2012

- Commercial Litigation

**Solicitor, Shelston IP Lawyers** | June 2009 – September 2011

- Intellectual Property Litigation

**Trade Marketing Attorney, Spruson & Ferguson** | January 2009 – June 2009

## Appointments

**Member of the New South Wales Bar Association**

**Intellectual Property Society of Australia and New Zealand**

**Copyright Society of Australia**

	<p><b>Barrister, NSW</b> 2016</p> <p><b>Solicitor, NSW</b> 2009</p>
<b>Recognition</b>	<ul style="list-style-type: none"> <li>▪ Doyle’s Guide: Leading Intellectual Property Law Barrister – Australia (2021)</li> <li>▪ Doyle’s Guide: Leading Intellectual Property Law Barrister – New South Wales (2020, 2021, 2022)</li> <li>▪ Doyle’s Guide: Emerging Intellectual Property &amp; TMT Junior Counsel – Australia (2017)</li> </ul>
<b>Selected Cases</b>	<p><b>Patents</b></p> <p><i>Bush Pharmacy Pty Ltd ats Hood</i> <i>Down Under Enterprises International Pty Ltd ats Hood</i> <i>New Directions Australia Pty Ltd ats Hood</i> NSD265/2021 (appeal) (2020) 158 IPR 229 (first instance)</p> <ul style="list-style-type: none"> <li>▪ Appeared for three respondents in separate proceedings commenced by patentee alleging infringement under s 117 of the Patents Act, and cross-claiming invalidity of the patent (essential oils and methods of use)</li> <li>▪ Appeared for respondents on appeal to Full Court</li> <li>▪ Led by ADB Fox; briefed by Gadens</li> </ul> <p><i>System Stormseal Pty Ltd v C&amp;N Roofing Pty Ltd</i> NSD582/2021</p> <ul style="list-style-type: none"> <li>▪ Appeared for Stormseal in bringing allegations of patent infringement and contravention of the Australian Consumer Law</li> <li>▪ Unled; Briefed by Banki Haddock Fiora</li> </ul> <p><i>Dr Reddy’s Laboratories ats Helsinn Healthcare SA</i> NSD2121/2016 (settled)</p> <ul style="list-style-type: none"> <li>▪ Appeared for Dr Reddy’s in defending allegations of patent infringement, and cross-claiming invalidity of the patent (palonosetron; commercial name Aloxi)</li> <li>▪ Led by T Cordiner QC; briefed by Mills Oakley</li> </ul> <p><b>Copyright</b></p> <p><i>Hampden Holdings I.P. Pty Ltd v Aldi Foods Pty Limited</i> NSD64/2022</p> <ul style="list-style-type: none"> <li>▪ Appearing for Hampden Holdings in bringing allegations of copyright infringement in relation to packaging artwork</li> <li>▪ Unled; briefed by Gestalt Law</li> </ul> <p><i>Cheap Thrills Cycles Pty Ltd v Zoetop Business Co. Limited &amp; Ors</i> MLG160/2022</p> <ul style="list-style-type: none"> <li>▪ Appearing for respondents defending allegations of copyright infringement, trade mark infringement and contravention of ACL/passing off in relation to clothing</li> </ul>

- Unled; briefed by Gadens

*QAD, Inc v Shepparton Partners Collective Operations Pty Ltd* NSD85/2020

- Appeared for SPC in defending allegations of copyright infringement, and cross-claiming against another party for breach of contract
- Led by R Hollo SC; briefed by Chedid Storey Legal

*Career Step, LLC v TalentMed Pty Ltd* [2018] FCA 132

- Appeared for TalentMed in defending allegations of copyright infringement and breach of contract, and cross-claiming for breach of contract
- Led by J Baird SC and ADB Fox; briefed by Arnold Bloch Leibler

*NorvaNivel Pty Ltd v Officemax Australia Ltd* NSD554/2017

- Appeared for NorvaNivel in bringing proceedings for infringement of copyright, and passing off and contravention of Australian Consumer Law
- Led by JS Cooke; briefed by Robinson Legal

**Trade marks and consumer protection**

*Puma SE v Caterpillar Inc.* VID522/2021

- Appeared from Puma in appeal from Federal Court decision refusing trade mark application
- Led by ADB Fox SC; briefed by Griffith Hack

*Bangkok Broadcasting & TV Co. Ltd v Seven Network (Operations) Ltd*  
NSD848/2021, NSD1097/2021

- Appearing for Bangkok Broadcasting in appeal from rejection of trade mark application, and defending cross-claim for removal of registered trade mark for non-use and cancellation
- Led by JS Cooke; briefed by Davies Collison Cave

*Tarte Inc v Mco Beauty Pty Ltd & Anor* SYG417/2021

- Appeared for Tarte in proceedings alleging misleading and deceptive conduct and passing off in relation to cosmetic products
- Unled; briefed by Clayton Utz

*iNova Pharmaceuticals (Australia) Pty Ltd & Ors v Baxi Health Pty Ltd & Ors*  
SYG3343/2019

- Appeared for seventeenth to nineteenth respondents with respect to allegations of selling counterfeit goods
- Unled; briefed by Gadens

*Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2019] FCA 1084

- Appeared for MSD in defending claims for breach of contract and trade mark infringement, as part of global dispute between over “Merck” name and trade mark

- Led by MJ Darke SC and PW Flynn; briefed by Corrs Chambers Westgarth

*James Glen Pty Ltd v J. Blackwood & Son Pty Ltd* NSD384/2019

- Appeared for J. Blackwood & Son in defending claims for trade mark infringement and contravention of the Australian Consumer Law
- Unled; briefed by Corrs Chambers Westgarth

*Anchorage Capital Partners Pty Ltd v ACPA Pty Ltd* (2018) 259 FCR 514

- Appeared for Anchorage Capital Partners in appeal concerning trade mark ownership and infringement
- Appeared in High Court in application for special leave
- Led by MJ Darke SC and PW Flynn; briefed by Corrs Chambers Westgarth

*Trident Seafoods v Trident Foods Pty Ltd* (2018) 137 IPR 65, (2019) 143 IPR 1

- Appeared for Trident Seafoods in appealing decisions of the Trade Marks Office in proceedings for removal of trade mark for non-use and opposing registration of trade mark
- Led by ADB Fox; briefed by Terry Trade Mark Attorneys

*Tim Ho Wan Pty Ltd v Viadar Holdings Pty Ltd* NSD554/2018

- Appeared for Tim Ho Wan in dispute with former franchisee
- Claims for breach of franchise agreements and trade mark infringement
- Led by ADB Fox; briefed by LegalVision

*Hospital for Special Surgery v Hospital for Specialist Surgery Pty Ltd & Ors* NSD1457/2016

- Appeared for Hospital for Special Surgery (New York) in bringing proceedings for trade mark infringement, passing off and contravention of Australian Consumer Law
- Led by MJ Darke SC; briefed by Corrs Chambers Westgarth

**Designs**

*Richemont Australia Pty Limited & Ors v Duo Jewellery Pty Ltd* SYG353/2022

- Appearing for respondents defending allegations of design infringement, contravention of the Australian Consumer Law, and passing off
- Unled; briefed by Baybridge Lawyers

*Hunter Pacific International Pty Ltd v Martec Pty Ltd* [2016] FCA 1041

- Appeared for Hunter Pacific in claim for design infringement
- Led by JS Cooke; briefed by Corrs Chambers Westgarth

**IP Australia hearings**

**Patents**

*Brown & Watson International Pty Ltd v The NOCO Company* [2022] APO 24

*RYW Holdings Pty Ltd* [2022] APO 20

### **Trade marks**

*Crescent Wealth Investments Australasia Pty Ltd* [2021] ATMO 63

*Accolade Wines Australia Limited and Grant Burge Wines Pty Ltd v Burge Family Wine Estates Pty Ltd* [2020] ATMO 146

*Tarte, Inc v The Boots Company PLC* (2019) 153 IPR 481

*Xero Limited v Muneebuddin Mohammed* [2019] ATMO 178

*Salesforce.com, Inc. v Intygrate Pty Ltd* (2019) 144 IPR 274

*Major League Baseball Properties Inc v Philip Morris Brands Sarl* (2019) 152 IPR 92

*Bluescope Steel Limited v Spanline Weatherstrong Building Systems Pty Ltd* (2019) 146 IPR 429

*M Malmsten AB v Competitor Swim Products Inc.* (2018) 141 IPR 560

*Tru Blu Beverages Pty Limited v TGLSC Holdings Pty Ltd* [2018] ATMO 107

*Patrón Spirits International AG v Fernbrew Pty Ltd* (2018) 138 IPR 376

*Coca-Cola Co v Vitasoy International Holdings Ltd* (2017) 128 IPR 384

*Gaseosas Lux S.A. v Chris Alexander Sanson* (2017) 132 IPR 474

*Celestial Seasonings Inc v Paul, Kerry and Krystle Holzberger* [2017] ATMO 53

*HS TM LLC v Schein Orthopadie-Service KG* (2016) 122 IPR 345

### **Designs**

*Request for examination of design numbers 201817089, 201817090 and 201817092 in the name of Mann + Hummel GmbH* [2020] ADO 5

### **Corporate, commercial and other matters**

*Allied Farms Pty Ltd v Providore Global Pty Ltd* 2020/182016 (Supreme Court)

- Appeared for Providore in defending proceedings for unpaid invoices and in bringing cross-claim for breach of contract
- by PW Flynn SC; briefed by Resolve Litigation Lawyers

*Secure Logic Pty Ltd v Noble* [2021] NSWSC 675

- Appeared for Secure Logic in bringing proceedings relating to misuse of confidential information, and defending cross-claim for breach of contract
- Led by MR Elliott SC; briefed by McCabes

*John Barry Sutton v Grayphine Pty Ltd trading as Agrivet Business Consulting* 2020/00155444 (Local Court)

- Appeared for Grayphine defending claim based on alleged “total failure of consideration”, and prosecuting cross-claim for breach of contract and quantum meruit
- Unled; briefed by Oakbridge Lawyers

*McLeod v McLeod* [2019] NSWSC 804

- Appeared for defendant (pro bono) defending claim for breach of mortgage
- Led by S Kaur-Bains; briefed by McCabes

*Fujian Xingxing Restaurant Pty Ltd v Meetfresh Franchising Pty Ltd* NSD1567/2019 (Federal Court)

- Appeared for applicant to obtain urgent interlocutory injunction to restrain termination of franchise agreement and licence to occupy premises
- Unled; Briefed by WB Legal

*Garside v Carroll* [2019] NSWCATAP 4

- Appeared for carpenter (Carroll) defending NCAT proceedings brought by former client
- Appeared at first instance and on appeal
- Unled; briefed by LHD Lawyers

*Karam ats Khoury* 2014/377266 (Supreme Court)

- Appeared for defendants in relation to allegations of shareholder oppression
- Led by G Drew; briefed by McDermott Associates

*Coral Air Conditioning Pty Ltd ats Powerhouse Technology Pty Ltd* 2016/366044 (Local Court)

- Appeared for Coral Air Conditioning in defending allegations of breach of contract and unpaid invoices
- Settled during hearing
- Unled; briefed by Forum Law

### **Practice and Procedure**

*Cruz Industries Pty Ltd v Sunny Girl Pty Ltd* [2017] FCA 1343

- Appeared for Cruz Industries in resisting application for security for costs
- Unled; briefed by Gestalt Law