

SPRUSON &

FERGUSON

ABOUT  
SPRUSON & FERGUSON  
LAWYERS





Spruson & Ferguson Lawyers was the first law firm in Australia to specialise exclusively in IP law and is widely recognised for its expertise in trade marks, patents, designs and copyright law. It has been involved in many ground-breaking Australian IP cases.

We act for a large number of local and international companies across a broad range of industries including information technology, telecommunications, mining, medical devices, pharmaceuticals, biotechnology, and consumer products. Many of our clients are referred by other patent attorney firms or by law firms with a more general practice who recognise the need for specialist IP services.

### We provide IP litigation and commercial legal services in Australia including:

- IP litigation and dispute resolution
- Challenging the validity of monopoly rights
- Advice on IP ownership
- Breaches of confidence and misleading conduct actions
- IP licensing and technology transfer
- Structuring, negotiating and drafting agreements relating to research and development and joint venture opportunities
- Due diligence and IP audit services
- Establishment and structuring of new entities and corporate groups
- Advice on product offering, including advice on the Australia Consumer Law, regulation of labelling requirements and privacy
- Dispute resolution of business and domain names

## IP LITIGATION & DISPUTES

**Spruson & Ferguson Lawyers has a depth of experience in IP litigation that is unparalleled in Australia.**

Our association with Spruson & Ferguson Patent and Trade Mark Attorneys gives us immediate access to specialised scientific and technical expertise, providing our clients with integrated solutions in the management and protection of their IP rights. This resource has proved particularly useful in the many complex patent cases we have conducted in the Federal Court.

### Our Litigation and Conflict Resolution Services

Intellectual property is a significant asset in business and our aim is to achieve the best possible commercial result for our

clients. In litigious matters, this could mean adopting a robust and aggressive style or, alternatively, a conciliatory stance to achieve a commercially desirable settlement. Where possible, we seek to position our clients in any IP rights conflict to achieve a time and cost effective resolution of the conflict through direct negotiations or mediation.

### Our litigation work includes court proceedings to restrain and/or defend actions for:

- The infringement of trade marks, copyrights, domain names, patents or designs
- Breaches of the misleading or deceptive conduct provisions of the **Australian Consumer Law** where others have adopted similar trade marks, products, or packaging
- Breaches of confidence or disclosure of trade secrets

- Challenging the validity of monopoly rights to enable clients to manufacture and sell products or use trade marks that they would otherwise be prevented from selling or using and includes, when necessary, urgent interlocutory injunctions, including *ex parte* injunctions

### COMMERCIAL TRANSACTIONS & ADVICE

**Spruson & Ferguson Lawyers provide intellectual property and commercialisation advice to some of Australia's foremost innovative technology companies and research institutions, as well as to Australian Government agencies.**

The Commercial Transactions and Advice team helps clients to optimise the management of their IP portfolios, manage risks and to extract maximum commercial returns from their R&D investment.

We pride ourselves on providing practical, commercially relevant and executable advice based on a shared understanding of our clients' commercial goals and needs. We tailor our commercial advice to reflect the particular business needs and objectives of our clients. Our Principals and professional staff have in-house business management and IP management experience, and are frequently called on to lead commercial negotiations and to provide practical and proactive assistance to clients to help them achieve optimum commercial outcomes.

The Commercial Transactions and Advice team, in collaboration with Spruson & Ferguson, were selected in a competitive tender by the Attorney-General's Department to develop the "IP Manual for Australian Government Agencies" for use by all Commonwealth departments and agencies.

#### Our IP and Commercialisation Services

Our team's experience places it at the forefront of Australian practice in the field of IP.



Our Principals and professional staff have in-house business management and IP management experience, and are frequently called on to lead commercial negotiations and to provide practical and proactive assistance to clients to help them achieve optimum commercial outcomes.

Our clients pursue a variety of commercialisation strategies to achieve the most from their innovations. This is reflected in the range of advisory and transaction services we provide, which include:

- Structuring, negotiation and drafting of IP related agreements including IP assignments, licensing agreements for copyright, trade marks, patents and software and franchising agreements
- Intra-group arrangements with respect to IP and revenue and service charges for transfer pricing purposes across jurisdictions
- Advice on developing strategies and processes to optimise creation, management, protection and exploitation of IP
- Preparation of research services and collaboration (including private/public collaborations), joint venture and confidentiality agreements
- Advice on early stage research transactions and services, including advice with respect to investment readiness for high-technology companies, the formation of start-up and spin-off companies and facilitating relationships between start-up companies and investors
- Advice on the regulation of technology products
- Performing IP due diligence, including for M&A transactions and initial public offer
- IP portfolio management including IP ownership, reviews, policy and process development and IP audit services

Our team is also highly experienced in more general commercial transactions and has extensive experience in the preparation, negotiation and interpretation of commercial contracts. We can provide high level overview advice regarding existing or proposed contractual arrangements as well as assist with the subtle details of legal drafting. Our services include the provision of advice on and the preparation of agreements relating to:

- Supply and purchase arrangements, standard terms and conditions of sale, agency and distribution arrangements
- Contractor and consultancy arrangements

## ABOUT SPRUSON & FERGUSON LAWYERS

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- Procurement arrangements
- Product development and manufacturing arrangements
- Sale and purchase of business assets and companies
- Formation of new companies including the preparation of relevant shareholders and subscription agreements
- Contractual arrangements affecting brand protection and strategy
- Sponsorship and affiliation arrangements and trade promotions.

### COMPETITION, CONSUMER PROTECTION AND PRIVACY LAW

Spruson & Ferguson Lawyers have extensive experience in advising on matters arising under the Australian Consumer Law (ACL) and related legislation, and handling matters of consumer protection across of wide range of industries, including a background in acting for major clients in fast moving consumer goods industries. In particular, we regularly provide advice on compliance of obligations under ACL in the area of consumer guarantees, warranty against defects, unfair business practices, unfair contract terms and product safety.



Spruson & Ferguson Lawyers have extensive experience in advising on matters arising under the Australian Consumer Law (ACL) and related legislation, and handling matters of consumer protection across of wide range of industries, including a background in acting for major clients in fast moving consumer goods industries.

Our firm regularly advises with respect to privacy and data protection obligations, including with respect to the amendments to the Privacy Act 1988 (Cth).

We have advised on marketing and labelling in a variety of industries, including textile, fashion and related industries, and have recently completed a worldwide labelling review for a major Australian client. We also have expertise in providing legal advice on cosmetics and skincare marketing, labelling laws and product development.

### ANTI-COUNTERFEITING

Spruson & Ferguson Lawyers provides valuable assistance to our clients in developing and implementing brand protection and anti-counterfeiting strategies, including working closely with the Australian and New Zealand Customs Services on the seizure of counterfeit goods. In addition, we regularly advise on and assist our clients devise and implement strategies to combat parallel importation of genuine products.

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[www.spruson.com](http://www.spruson.com)

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