



Gregory Pieris

Partner

Melbourne
+61.3.9640.4412

gregory.pieris@klgates.com

OVERVIEW

Gregory Pieris is an intellectual property partner with particular experience in litigious and non-litigious matters involving trade marks, designs, copyright, confidential information and trade practices law. Gregory works for Australian and international clients in a diverse range of industries, including sports and entertainment, automotive and aerospace manufacturing, agribusiness, medtech, online technology providers, finance, transport and logistics and fast moving consumer goods.

He prosecutes trade mark applications and oppositions before IP Australia and the Intellectual Property Office of New Zealand. He also advises clients on a broad range of intellectual property issues, including IP procurement (in Australia, New Zealand and internationally), portfolio management, registrability of trade marks, licensing, copyright, design registration, protection of confidential information, anti-counterfeiting, parallel importation, enforcement and customs programs. He has developed particular interest in intellectual property issues involving technology and the online environment, which allows him to assist clients to address the challenges of protecting intellectual property in this constantly changing landscape.

ACHIEVEMENTS

- Recognised by *Managing IP STARS* as a Rising Star, 2019-2024
- Listed by *Doyle's Guide* as a Rising Star for Intellectual Property & TMT Law in Victoria, 2022

PROFESSIONAL / CIVIC ACTIVITIES

- Law Institute of Victoria member

EDUCATION

- B.A., University of Melbourne, 2005
- LL.B., University of Melbourne, 2005 (*Honours*)

ADMISSIONS

- Federal Court of Australia
- High Court of Australia
- Supreme Court of Victoria

THOUGHT LEADERSHIP POWERED BY HUB

- 13 December 2023, Aussie Burger Wars Continue: *KFC v. HFC*
- 4 December 2023, A Thorny Issue Resolved as "Flowers For All" Trade Mark Deemed Distinctive
- 1 December 2023, Burger Wars: The Big Beef Between McDonald's and Hungry Jack's—*McD Asia Pacific LLC v. Hungry Jack's Pty Ltd* [2023] FCA 1412
- 22 August 2023, IP Australia Releases Long-Awaited Trade Mark Classification Guidelines on Emerging Technologies
- November 2022, November 2022 Accolades
- 28 October 2022, Who Really Owns Your Business's Trade Mark? Federal Court of Australia Confirms That a Trade Mark Can Be Registered in The Name of a Company's Sole Director and Shareholder
- 4 July 2022, Latvian Citizen Fined US\$4.5 Million and Sentenced to More Than Four Years of Imprisonment for Fraudulent Trade Mark Renewal Scheme
- 5 October 2021, UAE to Join the Madrid Protocol
- 24 August 2021, Full Federal Court Decision Reaffirms That There Is No Infringement By Authorisation Under Australian Trade Mark Law
- 5 July 2021, Planet Plumbing Trade Marks Head Down the Drain
- 27 April 2020, Kraft v Bega: Australian Appeal Court Decision Reaffirms the Perils of Relying on Unregistered Trade Mark Rights
- 1 April 2016, Overseas manufacturers supplying goods for ultimate sale in Australia liable for trade mark infringement under Australian law
- 18 December 2015, The end for the Dallas Buyers Club Dispute and Speculative Invoicing? Or is it Just the Beginning.

NEWS & EVENTS

- 23 October 2023, K&L Gates' Intellectual Property Practice, Lawyers Recognized in 2023 *Managing IP* Magazine's "IP Stars"

- 7 February - 16 February 2023, 2023 CPD Program—Australia
- 19 December 2022, K&L Gates Adds 40 Lawyers to Firm's Partnership
- 6 October 2022, K&L Gates Recognized in 2022 *Managing IP* Magazine's 'IP Stars'

AREAS OF FOCUS

- IP Procurement and Portfolio Management
- IP Litigation

REPRESENTATIVE EXPERIENCE

Sports

- Acting for an international governing body of football in relation to the prosecution of trade marks for two global competitions, including the official competition names, official logos, emblems, slogans, trophy design and mascots.
- Advising the AFL on its global brand portfolio since 2006. This involves protecting the intellectual property of the league and its 18 clubs and advising generally on branding issues for the AFL. In managing this portfolio, we also acted for the AFL in litigation against a national retailer that sold a range of unauthorised AFL merchandise and in a dispute involving unlicensed sports memorabilia. We advised the AFL on the selection of the team names and associated IP for the 17th and 18th AFL teams, the launch of the highly successful AFLW (AFL Womens) competition and numerous other IP related issues.
- Acting for a Dutch registered company of a formula racing car group in a range of trade mark infringement matters in Australia.
- Acting for an Australian motorsports governing body in its successful defence of trade mark oppositions against registration of a formula racing trade mark in Australia and various other copyright and trade mark infringement matters.
- Assisting Cricket Australia with the selection of the names for the eight teams constituting the Big Bash League. The work involved trade mark clearance and searching, filing 19 trade mark applications and prosecuting the marks to registration including the negotiation of numerous trade mark co-existence agreements
- Advising a professional Australian football club on a dispute with a suburban football club
- Advising a sports streaming provided on its global intellectual property and trade mark portfolios.
- Acting for clients in combating online intellectual property infringement, including unauthorised live streaming of copyright broadcasts, issuing Digital Millennium Copyright Act (DMCA) takedown notices and establishing eBay monitoring and anti-counterfeiting programs for various clients.

- Advising on trade mark prosecution and acting in trade mark oppositions before IP Australia for the firm's clients including Google Inc, Cricket Australia and ispONE.

Food & Beverage and Agribusiness

- Advising one of Australia's largest doughnut brands on various trade mark matters in Australia and New Zealand.
- Advising an organic and natural livestock producer and a meat wholesaler on their international trade mark portfolio.
- Managing the IP portfolio of an Australian seed manufacturer.

Finance

- Advising a global asset management business on the global rebrand of its various asset management businesses following its demerger from a multinational bank. This included global trade mark clearance searches in almost all countries, advice on linguistic and foreign transliteration issues, advising on trade mark ownership, assignment and licensing issues, and prosecuting multiple trade mark filing projects in multiple languages across 36 jurisdictions.
- Advising Pinnacle Investment Management and its affiliate businesses on their international trade mark portfolios and various infringement matters

Technology and Manufacturing

- Advising an engineering, management, design, planning, project management, consulting, and advisory company on its global trade mark portfolio.
- Managing the Australian and New Zealand trade mark portfolio of a video game and console publisher and distributor including acting in various trade mark oppositions.
- Advised A2B Australia in litigation against Lime scooters and bicycles (which is owned by Neutron, part owned by Uber) and Lime is taking over Uber's Jump scooter/bike business in Australia.
- Represented GM Holden Ltd in relation to seeking to enforce its design rights against Australia's largest spare parts manufacturer SSS Auto, which was the first case in Australia to consider the spare parts defence to the Designs Act 2003 (Cth).
- Acting as the exclusive outside counsel to Kazia Therapeutics Limited (previously Novogen Limited) in Australia in which, during the course of 2017, we acted in the Federal Court of Australia proceedings relating to an intellectual property dispute: Novogen Limited v Noxopharm Limited & Anor (VID1464/2016).
- Acting for an Australian national manufacturer and retailer in a series of related matters involving claims of misleading and deceptive conduct over the use of a colour. This involved successfully defending claims in the Federal Court of Australia, Full Federal Court of Australia and High Court of Australia, as well as acting in opposition proceedings at the Trade Mark Office.
- Anti-counterfeiting proceedings for leading Australian automotive supplier GM Holden concerning the importation, distribution and sale of counterfeit HSV wheel rims. The Federal Court of Australia proceedings

involved 25 respondents and involved an appeal to the Full Court of Australia on the question of director's liability.

- Managing customs monitoring programs and working with the Australian Customs and Border Protection Service to tackle the importation of counterfeit products manufactured offshore.
- Advising clients on parallel importation protection strategies.