

DAVID L. MARRIOTT – Barrister

Background and Qualifications

Born 9th March 1966.

British Citizen (New Zealand Permanent resident since 1973)

LL.B BCom (Canterbury University)

Commercial and intellectual property litigation and dispute resolution specialist

Employment history:

- Barrister, Auckland (August 2009 – present)
 - Intellectual property, employment and commercial litigation
 - Strengths include trial and appellate advocacy, including proceedings involving subject matter of a complex and/or technical nature including proceedings involving expert witnesses and evidence (scientific: biotechnology, chemical and physical sciences, engineering and/or pharmaceutical)
- James & Wells Lawyers, Auckland (November 2000 – August 2009)
 - Intellectual property litigation
 - Partner 2004 to 2009
- Joynt Andrews, Barrister & Solicitors, Christchurch (December 1996 to November 2000)
 - Civil and commercial litigation
- Previous non-legal employment
 - NZ Army Officer/Senior Non-commissioned Officer (including appointment as Officer Commanding Medical Officer Training Unit)
 - Retail manager LD Nathans Ltd (Lion Nathan)/DEKA
 - Sales & marketing NZ Post Office/Telecom

Practice

Civil and commercial litigation including interlocutory matters, trials, appeals, arbitration and litigation support. Employment litigation. Negotiation, mediation and alternative dispute resolution.

All intellectual property law issues including patents, trade marks, designs, copyright, fair trading/passing off, trade secrets, IP licensing and confidential information. Patent and trade mark oppositions.

Represents clients in the High Court, Court of Appeal, Supreme Court, the Employment Court and before the New Zealand Intellectual Property Office (IPONZ) and Employment Relations Authority.

Expertise

- Skilled at working with highly technical subject matter and expert witnesses
- Able to rationalise large volumes of material

- Skilled communicator, approachable and engaging
- Skilled cross-examiner and inquisitorial investigator
- Skilled report and opinion writer
- Experienced in quasi-judicial roles
- Employment history demonstrates broad range of leadership, teaching and management roles and experience

Publications

Former contributing author to Brookers' *Intellectual Property Law in New Zealand* electronic text and to Thomson Brookers *James & Wells Intellectual Property Law in New Zealand*.

Contributing author to New Zealand Intellectual Property Journal (NZIPJ)

Current Volunteer Positions & Committee Memberships

- New Zealand Law Society, (Auckland) Standards Committee
- New Zealand Law Society (CLE), Litigation Skills Faculty
- New Zealand Law Society, Intellectual Property Law Reform Committee
- Board of Trustees, Ponsonby Intermediate School
- New Zealand Bar Association – mentor programme volunteer

Current Organisational Memberships

- New Zealand Law Society
- New Zealand Bar Association
- Intellectual Property Society of Australia and New Zealand (IPSANZ)

Examples of recent and significant litigation experience (reported judgments in bold)

- **Arrow Pharmaceuticals (NZ) v Sanofi Aventis [2008] 77 IPR 657**
 - Sole Counsel for Arrow. Successful application for declaration of non-infringement under s75 of the **Patents Act** in respect of the drug clopidogrel. Clarified use and scope of previously almost unused provision.
 - “One of the stand out pieces of litigation for the year” according to international publication *Managing Intellectual Property*
- **Bagley v Deloitte Ltd (as Trustee for the Deloitte Trading Trust) [2019] NZERA 427**
 - Represented applicant in proceedings before Employment Relations Authority seeking to have settlement agreement under s159 declared invalid.
- **Briggs v Hutton [2013] NZHC 1938, [2014] NZCA 392,**
 - Sole Counsel High Court and Court of Appeal
 - Breach of contract, guarantee relating to sale of large commercial premises.
- **British American Tobacco Brands Incorporated v NV Sumatra Tobacco Trading Co [2008] NZHC 1732, [2010] NZCA 24, (2010) 86 IPR 206**
 - Sole Counsel High Court and Court of Appeal
 - Appeal against decision of Commissioner of trade marks regarding similarity to LUCKY STRIKE trade mark .
- **Chettleburgh v Seduce Group Australia Pty Ltd (2012) 98 IPR 306**
 - Sole Counsel before Commissioner of trade marks and in High Court appeals (x2) regarding application for declaration of invalidity of trade mark registration.
- **Corrick & Others v Silich & Others [2017] NZHC 1630, [2017] NZHC 2033, [2018] NZCA 221**

- Sole Counsel for Defendants in High Court trial, Court of Appeal (x2)
- Successful defence of claims of breach of contract, tortious interference, breach of fiduciary duty and conversion, relating to the sale of a vintage military aircraft.
- ***Doug Andrews Heating and Ventilation Limited v Dil & Others*** [2015] NZCA 122, [2015] NZSC 141, **(2014) 104 IPR 482**
 - Senior Counsel, High Court trial, Court of Appeal, Supreme Court (application for leave to appeal)
 - Patent infringement and invalidity.
- ***Dreamtech Designs & Productions Pty Ltd v Clownfish Entertainment Limited*** [2015] NZHC 1143, [2015] NZCA 491, [2015] NZCA 593, **(2015) 23 PRNZ 141**
 - Sole Counsel High Court, Court of Appeal (x2)
 - Copyright infringement. Successful opposition to application for interim injunction.
- ***Flujo Holdings Pty Ltd v Merisant Company Inc & Others*** [2016] NZHC 1779, [2017] NZHC 811, [2017] NZHC 1656, [2017] NZHC 2069, [2017] NZHC [2018] NZCA 226, **[2017] NZAR 1395**
 - Passing off/breach of s9 Fair Trading Act 1986 relating to product get-up.
 - Sole Counsel for Flujo in High Court, Court of Appeal.
 - Application for interlocutory injunction.
 - Application to set aside discontinuance.
 - Appeal concerning award of partial indemnity costs.
- ***Flujo Sanguineo Holdings Pty Ltd v Merisant Company Inc & Others*** [2018] NZHC 54, **[2018] NZAR 189**
 - Sole Counsel for Flujo Sanguineo in High Court, Court of Appeal.
 - Passing off/breach of s9 Fair Trading Act 1986 relating to product get-up.
 - Appeal concerning application for stay of proceeding (decision pending).
- ***Fredco Trading Ltd v Miller (2004) 65 IPR 653***
 - Counsel High Court trial.
 - Trade mark in 3D shape of vine tie.
- ***Gachot v Sanson*** [2009] NZCA 86, **[2009] NZCCLR 27**
 - Counsel High Court trial, Senior Counsel Court of Appeal
 - Construction and enforcement of personal guarantee.
- ***G-Star Raw C.V. v Jeanswest Corporation (New Zealand) Limited*** [2015] NZCA 15; **(2015) TCLR 787**
 - Senior counsel for G-Star in High Court applications, trial and Court of Appeal
 - Successful claim for primary and secondary infringement of copyright in iconic jeans design.
 - Obtained significant award of \$50,000 additional damages on appeal.
- ***Henkel v Holdfast NZ Limited*** [2006] NZSC 102, **[2007] 1 NZLR 336**, **[2007] 1 NZLR 577**
 - Infringement of copyright in product packaging.
 - Counsel in High Court trial, Court of Appeal and Supreme Court.
 - The first copyright case in the Supreme Court and only the second IP case to be determined in that forum.
- ***Holdfast v Selleys (2004) 17 PRNZ 897 (CA)***
 - Civil procedure. Senior counsel in appeal against an award of indemnity costs. Clarified the limited circumstances in which such awards may be granted in future and the appropriate quantum of such uplifts.
- ***Inverness Medical Innovations v MDS Diagnostics*** [2010] NZHC 1070, **(2010) 93 IPR 14**
 - Senior counsel High Court (Four-week trial, complex technical evidence, instructed at very short notice), sole counsel Court of Appeal.
 - Infringement of copyright in medical device.
- ***Lee v Composite Cladding and Signage Manufacture and Installations Limited*** [2013] NZHC 1652
 - Senior Counsel for successful respondent in appeal in relation to defective building cladding claims.
- ***Mechanical Plastics Corp v Holdfast New Zealand Ltd*** [2012] NZHC 592 and [2013] NZCA 335, **(2013) TCLR 582**
 - Successful claim for breach of the Fair Trading Act 1986 in respect of product packaging.

- Senior counsel in High Court trial, Court of Appeal.
- ***Merial v Virbac SA*** [2013] NZHC 2773, [2014] NZCA 619, [2015] NZAR 427, (2014) 110 IPR 224
 - Senior Counsel in High Court and Court of Appeal
 - Successful appeal against decision on opposition to application for trade mark registration.
- ***Nestle SA*** [2002] NZIPOTM 45
 - Sole Counsel. Successfully argued against registration of the shape of the KITKAT chocolate bar as a trade mark. Decision reformed the law relating to registration of shape marks in New Zealand (ultimately reversed by the introduction of the Trade Marks Act 2002).
- ***New Zealand Institute of Chartered Accountants v The Chartered Institute of Management Accountants*** [2015] 3 NZLR 692, (2015) 113 IPR 571, (2015) PRNZ 583
 - Senior counsel before Commissioner of Trade Marks and High Court
 - Successful response to appeal against decision to allow cross-examination of deponent before Commissioner of Trade Marks. Significantly modified existing practice and clarified future procedure.
- ***Norbrook Laboratories v Bomac Laboratories*** [2004] 3 NZLR 49 (CA), [2006] UKPC 25
 - Misuse of confidential information relating to the formulation of veterinary pharmaceuticals.
 - One of counsel in High Court trial, Court of Appeal, Privy Council.
- ***N V Sumatra Tobacco Trading Co v British American Tobacco (Brands) Inc*** [2010] NZCA 24; (2010) 86 IPR 206
 - Sole Counsel in High Court and Court of Appeal
 - Appeal against successful opposition to application for trade mark registration.
- ***Pacific Software Technology v Perry Group*** [2004] 1 NZLR 164, (2003) 57 IPR 145 (CA)
 - Counsel in High Court trial and Court of Appeal. Believed to be the first case in the Commonwealth to hold that it is possible to unlawfully convert and detain intangibles such as copyright in computer software (as opposed to the physical medium on which that intangible is stored).
- ***Prada S.A. v The Farmers Trading Company Limited*** [2010] NZHC 1888
 - Sole Counsel for Prada in appeal against decision of Commissioner of trade marks.
- ***Royal New Zealand Yacht Squadron v Daks Simpson Group*** [2002] NZAR 187
 - Sole Counsel for RNZYS, appeal to High Court.
 - Removal of a trade mark for non-use. Still cited in relation the discretion to allow a mark to remain on the Register even where non-use is proven.
- ***Taylor v Jaydee Home Solutions Ltd*** (2012) 13 NZCPR 206
 - Successfully opposed application for interim injunction and sought summary judgment on behalf of defendant in respect of default under “shrink wrap” mortgage.
- ***Tidd Ross Todd v Steelbro*** [2007] NZCA 486
 - Infringement of copyright in complex engineering design for heavy lift crane.
 - Counsel in High Court trial, Court of Appeal.
- ***University of Waikato v Business Benchmarking*** [2004] NZCA 90; (2004) 8 NZBLC 101,561
 - Senior Counsel for University in High Court, Court of Appeal
 - Infringement of copyright in a business benchmarking survey. Notable for successful argument that summary judgment could be appropriate when copyright infringement has been alleged.
- ***Valley Girl v Hanama Collection Pty Ltd*** (2005) 66 IPR 214
 - Senior Counsel in High Court appeal against decision of Commissioner of trade marks.
- ***Virbac S A v Merial*** [2014] NZCA 619, [2015] NZAR 427, (2014) 110 IPR 224
 - Senior Counsel in High Court and Court of Appeal.
 - Appeal against decision of Commissioner of trade marks.
- ***Waite v Global Integrated Solutions & Others*** (2011) NZHC 1243
 - Sole Counsel for two of ten defendants in significant litigation involving multiple claims of unjust enrichment, constructive trust, breach of fiduciary duty, breach of s 301(1) of the Companies Act 1993.

- ***Yellow Holdings Ltd v Eurobelt Ltd*** [2016] NZHC 1448
 - Sole Counsel for Yellow Holdings (Yellow Pages) in High Court.
 - Successful application for interlocutory injunction relating to registration of domain name conflicting with Yellow Pages' domains.