

Stephen Stern

Partner



Area of expertise

- Intellectual Property litigation and advice

Qualifications

- Bachelor of Arts, Monash University (1977)
- Bachelor of Laws (Hons), Monash University (1979)
- Master of Laws, Monash University (1984)

Career Summary

Stephen is the National Practice Group Leader of the Corrs Intellectual Property & Technology Section. He is experienced in all aspects of intellectual property law and is widely consulted for his expertise in patent and trade mark litigation including anti-counterfeiting. Stephen has been nominated as Australia's foremost trade mark lawyer and as one of the world's top 20 trade mark law practitioners by *Managing Intellectual Property* in May 2006, as an IP Luminary in June 2007 by Trademark World, Patent World & Copyright World and amongst the top 25 Trade Mark experts in the world by the *Expert Guides to the World's Leading Lawyers - Best of the Best 2007* and again in *Best of the Best 2009*.

Stephen acts for a wide range of clients, such as luxury goods manufacturers, clothing, footwear and textile producers, film and radio industry members, machinery manufacturers, pharmaceutical manufacturers, watch makers and wine producers, protecting all aspects of their intellectual property portfolios against misuse.

He is a very senior and experienced litigation lawyer with wide experience in large scale intellectual property litigation. Stephen's practice has required him to work at every level of the Australian court hierarchy with most of his work being in the superior courts (i.e. the various Australian State Supreme Courts and the Federal Court). He has also run appeals to the Full Court of the Federal Court of Australia and to the High Court.

Stephen makes appearances regularly as an advocate before superior courts (unusual for an Australian solicitor) and, on numerous occasions, he has appeared personally to seek and obtain both interim and interlocutory injunctions.

Throughout his career Stephen has been regularly involved in large scale international litigation for a range of multi-national clients, such as Caterpillar, Inc, Pfizer, Inc, Lacoste, Research In Motion Limited (BlackBerry), H. Lundbeck Pharma A/S and the Foster's Group. All of this work involves close co-ordination with the teams of lawyers working in other jurisdictions.

He is also entrusted by various French Government organisations with the management of their litigation in the Asia-Pacific region and has thus worked on matters in countries such as Japan, Malaysia, the Philippines, Indonesia, Singapore, Thailand, Korea and Vietnam.

Stephen prepares opinions on infringement and conducts litigation to protect and enforce all aspects of intellectual property rights. Stephen's enforcement practice regularly involves seeking not only permanent injunctions, but also temporary injunctions and search and seizure orders on short notice.

He has sought and obtained innumerable Anton Piller orders (akin to civil search warrants), obtaining the first such injunction ever granted in the Australian Federal Court and ex parte interim and interlocutory injunctions. He has also been appointed by the Federal Court to supervise the execution of various Anton Piller orders as the court appointed independent solicitor on several occasions.

Other relevant experience

Trade Marks

Stephen's work in the trade mark field incorporates all facets of trade mark law and he is widely consulted for his expertise in trade mark litigation. He also prepares opinions on infringement, conducts litigation, advises on licensing, franchising and the transfer of intellectual property and know-how and prepares licenses, distribution and supply agreements for use both on a national and international basis.

He also currently manages the Australian trade mark registration portfolios for a number of major international corporations.

Stephen has run for many years and acts in the trade mark litigation in Australia for such clients as Nokia, Louis Vuitton Malletier, Lacoste, Cartier, Brother, Alfred Dunhill, Caterpillar, Hugo Boss, Cadbury Schweppes, Ferrari, Gucci, Christian Dior, Fosters, Tommy Hilfiger, Versace, DreamWorks, Research In Motion (BlackBerry), Cartier, Nike, Maserati, Mont Blanc, Emenegildo Zegna, Vans, Baume & Mercier, Grand Marnier, Fendi, Oakley, Veuve Clicquot, Moet & Chandon, Nokia, the French Government Cognac Office and many others in relation to the protection and enforcement of their trade mark portfolios. He has run numerous trade mark oppositions both for applicants and opponents and countless trade mark infringement proceedings. He has obtained registrations for shapes and colours (including some of the first such registrations in Australia) and is also widely consulted for his expertise in areas such as parallel importing, geographical indication registration and protection and franchising.

Patents

Stephen has been practising in the patent law area since 1979. He specialised in his law degree at Monash University in Intellectual Property and his Honours Thesis was on patent law.

Stephen's experience in the patent law area incorporates all facets of practice with a specific focus on litigation. His experience includes advice work, drafting and advising on licences for both licensees and licensors on almost every continent, obtaining search and seizure orders against infringers and running full patent infringement actions.

Stephen's experience in patent litigation matters spans a wide range of industries and technologies, including the automotive, agricultural, horticultural, medical, pharmaceutical and many other industries.

The patent litigation which Stephen has run has included the full range of litigious matters including infringement advice (for both Plaintiffs and Defendants), letters before action,

settlement discussions and negotiations leading to resolutions (including the drafting of patent licences), and running full patent infringement actions through to trial.

Recent important matters that Stephen has run include complex multi-party patent litigation for Pfizer in relation to the Viagra patents in Australia and New Zealand, patent oppositions for H. Lundbeck Pharma A/S (a pharmaceutical manufacturer) against generic pharmaceutical manufacturers in relation to methods of manufacturing a well known anti-depressant and patent litigation for Caterpillar against John Deere relating to the undercarriage for tractors. Each of these cases has been fought as part of a major international dispute, involving multi-jurisdictional litigation requiring careful co-ordination.

He was appointed a Chevalier of the Ordre du Mérite Agricole by a decree of the French Republic dated 17 July 2006.