

Tom Cleary

PROFESSIONAL EXPERIENCE

Barrister, *Mills Lane Chambers* 2026 –

- Advocate specialising in civil and commercial disputes, intellectual property, defamation, privacy, consumer protection and trust litigation
- Strategic adviser on strategies to protect intellectual property and media law matters, including pre-publication review or crisis management
- Ranked by Doyle's Guide and Managing IP

Lawyer, *Chapman Tripp & Chapman Tripp Patents* 2018 – 2026

- Senior Solicitor (2018 – 2019) and Senior Associate (2019 – 2026) in top tier litigation and intellectual property teams
- Ranked by Chambers & Partners, the Legal 500, Managing IP and Asia IP

Junior Barrister, *Shortland Chambers* 2015 – 2018

- Worked with leading advocates in a wide range of disputes

Judges' Clerk, *High Court of New Zealand* 2013 – 2014

- Clerked for Justice Andrews and Justice Asher
- Clerk to the Rules Committee

PROFESSIONAL QUALIFICATIONS

- Barrister & Solicitor of the High Court of New Zealand
- Registered Patent Attorney (New Zealand and Australia)
- Registered Trade Marks Attorney (Australia)

MEMBERSHIPS

- New Zealand Bar Association
- New Zealand Intellectual Property Attorneys
- Intellectual Property Society of Australia and New Zealand
- International Association for the Protection of Intellectual Property
- Communications and Media Law Association

EDUCATION

University of Melbourne

2020 – 2023

- Master of Laws, specialising in intellectual property and defamation law

University of Otago

2007 – 2013

- Master of Bioethics and Health Law (Distinction)
- Bachelor of Laws (Honours)
- Bachelor of Science in Biochemistry

PUBLICATIONS

- Tom Cleary, “Part 2 – Infringement of copyright” in *Intellectual Property Law* (LexisNexis)
- Clive Elliott KC and Tom Cleary, “Part 4 – Infringement, other patent proceedings and matters affecting patent ownership” in *Intellectual Property Law* (LexisNexis)
- Clive Elliott KC and Tom Cleary, “Recalibrating IPONZ’s Practice and Procedure for Patent and Trade Mark Oppositions” (2025) 139 *Intellectual Property Forum* 42
- Tom Cleary and Janko Marcetic, “Chapter 14 – Distributions to Shareholders” in *Morison’s Company Law* (LexisNexis)
- Co-editor and co-author of “Unlocking Prisons: How we can improve New Zealand’s Prison System” (JustSpeak, 2014)
- Mark Henaghan and Tom Cleary, “The State in Action – An Insider’s View of How the State Regulates the Use of PGD with HLA Tissue-Typing in New Zealand” in Sheila AM McLean and Sarah Elliston (eds) *Regulating Pre-Implantation Genetic Diagnosis: A Comparative and Theoretical Analysis* (Routledge, Abingdon, 2013), chapter 9, 199
- Tom Cleary, “A Curious Exception: (No) Legal Remedies for Negligent Pre-Birth Genetic Testing” (2013) *Journal of Law and Medicine* 102

PRESENTATIONS

- Justin Graham and Tom Cleary, “Deploying Expert Evidence in IP Disputes: Reflections on Four Recent Cases” (Legalwise, 2024)
- Justin Graham and Tom Cleary, “Navigating Defamation Law: Strategies and Recent Developments” (ADLS, 2019)

SELECTED CASES

- *ResMed Pty Ltd v Fisher & Paykel Healthcare Ltd* [2026] NZIPOPAT 6: lead counsel for FPH successfully opposing a patent application for dual therapy respiratory apparatus.
- *Rascals International Ltd v Taylor* [2026] NZHC 2279: junior to Campbell Walker KC and Justin Graham for Rascals, concerning breaches of confidence, directors' and fiduciary duties, and dishonest assistance arising from the disclosure of information and the acquisition of the Treasures brand and business opportunity.
- *Zuru New Zealand Ltd v Lego Holdings A/S* (2025) 190 IPR 201 (CA); (2023) 173 IPR 146 (HC): junior to Julian Miles KC and Justin Graham for Zuru, confirming that Zuru's use of "Lego" in a compatibility statement did not constitute trade mark infringement, did not breach the Fair Trading Act 1986 or amount to passing off.
- *Beca Carter Hollings & Ferner Ltd v Wellington City Council* [2024] 1 NZLR 438 (SC): junior to Michael Ring KC and John McKay for Beca, concerning whether the Building Act's longstop applied to contribution claims.
- *Sunbow Investment Ltd v Sunbow Ltd (in liq)* [2024] NZCA 305: co-counsel for the appellants concerning whether formal proof should have been entered for a \$2.54m debt and responding to the defence of illegality arising from a high-profile murder.
- *Dew v Discovery NZ Ltd* [2024] 2 NZLR 153 (CA): junior to Davey Salmon KC and Justin Graham for Warner Bros. Discovery, blocking Cardinal Dew's application for an interim injunction application designed to stop reporting of serious allegations of sexual abuse.
- *Inguran, LLC v CRV Ltd* [2023] NZHC 3692: junior to Jack Hodder KC for the plaintiffs, obtaining an interim injunction for patent infringement against a competitor in relation to sex-selection flow cytometry technologies. Also, resisting a challenge to jurisdiction.
- *Philip Morris Products SA v Puff Mart Trading Ltd* [2021] NZHC 2824: junior to Matt Sumpter, securing an interim injunction for Philip Morris to stop misleading practices arising from using a similar trade mark.
- *ResMed Pty Ltd v Fisher & Paykel Healthcare Ltd* [2021] NZIPOPAT 10: lead counsel for FPH opposing a patent application for dual cycle controls for a respiratory apparatus.
- *Re Darlow* (2021) 5 NZTR 31-016 (HC): junior to Michael Arthur for the trustees of the Hugh Green Trust and Hugh Green Property Trust, obtaining the Court's approval of variations to, and the reorganisation of, the Trusts.
- *Waitakere Group Ltd v James Hardie New Zealand Ltd* [2021] NZHC 722, 1052, 1111, 1403: junior and sole counsel for the defendants in procedural disputes in a multi-million dollar building practices, alleged product negligence and Fair Trading Act 1986 claims.
- *Craig v Stringer* (2020) 25 PRNZ (CA): junior to Stephen Mills KC in a successful challenge to a stay based on the *Henderson v Henderson* principle.

- *Craig v Slater* [2020] NZCA 305: junior to Julian Miles KC in a successful and complex defamation appeal covering most aspects of defamation practice, including addressing the public interest communication defence and its limits.
- *Ross v Mediaworks Holdings Ltd* [2021] 2 NZLR 114 (HC): junior to Justin Graham for Mediaworks, defeating an application by then-politician Jami-Lee Ross for an urgent interim order blocking NewsHub’s “Powerbrokers Debate”.
- *Driver v Radio New Zealand Ltd* [2020] 3 NZLR 76 (HC): junior counsel to Robert Stewart for RNZ, Stuff and MediaWorks in successfully striking out defamation and novel invasion of privacy claims.
- *Craig v Williams* [2019] 1 NZLR 457 (SC): junior to Stephen Mills KC for the appellant, setting aside a jury’s record defamation liability and damages verdict for misdirections on the law of qualified privilege.
- *Mediaworks TV Ltd v Staples* [2019] NZCA 273: junior to Julian Miles KC for Mediaworks, securing a claim to journalistic source protection.
- *ResMed Ltd v Fisher & Paykel Healthcare Ltd* [2018] NZHC 2875: junior to Matt Sumpter for Fisher & Paykel Healthcare, leading arguments resisting further discovery in complex patent infringement and revocation proceedings.
- *McAlister v Lai* (2018) 14 TCLR 765 (CA): junior to Bob Hollyman, establishing that a law firm and its director were liable under the Fair Trading Act 1986 for misleading actions and omissions for their role in acting on an investment in Orcon’s purchase.
- *Horsfall v Potter* [2018] 1 NZLR 638 (SC): junior to John Billington KC for the respondent, successfully defending the Court of Appeal’s judgment concerning whether a transfer of a commercial property to a trust was captured by s 44 of the Property (Relationships) Act 1976. This decision is the leading case on illegality.
- *Kuwait Finance House (Bahrain) BSC v Teece* [2018] 2 NZLR 257 (HC): junior to Stephen Mills KC and Bob Hollyman, concerning whether a Bahrani arbitration centre’s default decision was a binding judgment enforceable in New Zealand.
- *van Heeren v Kidd* [2017] 3 NZLR 141 (CA): junior to Stephen Mills KC and Brent O’Callaghan, in successfully resisting a challenge to the High Court’s decision that an issue estoppel arose from foreign proceedings and a USD 25m payment was owed.
- *Cornwall Park Trust Board Inc v Chen* [2016] 2 NZLR 637 (CA): junior to Bob Hollyman, concerning the termination and remediation provisions in Glasgow leases. Leave to appeal was granted by the Supreme Court.
- *Ambrose v Key* [2015] NZHC 3242: junior to Bruce Gray KC for the then-Prime Minister in an interlocutory dispute in defamation proceedings concerning the “Tea Pot Tapes”.