

NICHOLAS SMITH
Nicholas Smith IP and Litigation Pty Ltd
PO Box Q1378, Queen Victoria Building
NSW 1230 Australia

Legal Experience

PRINCIPAL, Nicholas Smith IP and Litigation

2017-present

- Principal of boutique IP and Litigation firm providing specialist legal advice and representation to clients engaged in IP disputes
- Specialist expertise in trade mark and domain name issues

HEARING OFFICER, IP Australia (Part-time)

2016-present

- Presided over hearings and reviewed evidence and submissions in oppositions to trade mark registrations and applications for removal of existing trade marks
- Issued published written judgements applying the *Trade Marks Act 1995* and related legislation

CORPORATE COUNSEL, Nine Entertainment (Part-time)

2018-2019

- Supported and advised on the launch of the YourMoney television channel (including acting as temporary corporate counsel) and Future Women online platform
- Negotiated, drafted and advised on key Nine commercial transactions, including sale of Australian Community Media business
- Advised on legal issues including intellectual property, privacy, contracting and competition law

ADJUNCT LECTURER, College of Law

2018- present

- Lecturer in Competition Litigation and Intellectual Property Litigation, courses offered as part of the Masters of Laws program

PANELLIST, WIPO Arbitration and Mediation Center (sic)

2012-present

PANELLIST, Asian Domain Name Dispute Resolution Centre

2015-present

PANELLIST, MFSD IP Dispute Resolution Center (sic)

2017-present

- Reviewed evidence and submissions and issued over 150 published written judgements between trade mark holders and domain name holders under the UDRP. Also accredited to hear URS disputes

LEGAL COUNSEL, Telstra Wholesale

2017-2018

- Supported Telstra's Wholesale business unit (sales and products), responsible for a number of strategic customer accounts including drafting and advising on commercial transactions
- Advised on legal issues relating to telecommunications matters including privacy, confidentiality, contracting and dispute resolution issues

BARRISTER, Blackstone Chambers

2011-2016

- Primarily practised in Commercial Law, Intellectual Property, Contracts and Equity and Trade Practices and Competition

- Advised on prospects, drafted pleadings and evidence, prepared submissions and appeared as trial counsel in cases in the NSW and Federal Courts, before the Trade Marks Registrar and under the Uniform Domain Name Dispute Resolution Policy (UDRP)
- Appeared for and advised clients in relation to settlement conferences, mediation and arbitration; drafted and settled settlement documents
- Provided legal advice to clients on general contractual and legal issues including:
 - how best to protect a client's brands from dilution and infringement
 - rights and remedies arising from use of a brand as part of search engine optimisation and on Google Adwords and
 - options to settle disputes in a commercial manner outside the courts

SOLICITOR, King & Wood Mallesons

2006-2011

- Practised in the areas of Intellectual Property, Dispute Resolution and Banking and Finance
- Acted for retail, media and technology clients in copyright, trade mark and design matters including in respect of customs seizures, trap purchases and urgent injunctions
- Researched and advised clients on issues relating to copyright, trade mark and banking law
- Prepared transaction documents, prepared submissions and appeared on behalf of clients in court

LEGAL OFFICER, WIPO Arbitration and Mediation Center (sic)

2003-2005

- Edited and reviewed UDRP decisions, supervised case managers and managed WIPO's online legal index of UDRP decisions
- Primary author of the first online casebook of UDRP decisions

Education

University of Technology, Sydney

Completed Patent Law as a non-award subject

2012

Columbia University

Master of Laws (LLM) (Harlan Fiske Stone Scholar for academic achievement)

2006

Australian National University

Bachelor of Laws (Honours)

2002

Bachelor of Economics

2001

Selected Publications and Presentations:

- *Updates in WIPO Precedent – the WIPO Jurisprudential Overview 3.0 is released*, Issue 110 Intellectual Property Forum (September 2017)
- *What's changed in Domain Name Disputes – the WIPO Overview 3.0*, presentation to the Intellectual Property Society of Australia and New Zealand, 2 August 2017
- *IP Update 2017*, presented to the College of Law – 16 February 2017

- *In the world of Google AdWords is your competitor's trade mark fair game?* Issue 23, Law Society Journal (June 2016)
- *Misleading and Deceptive Conduct: When copying is not enough* Vol 53, No 4, Law Society Journal (2015)
- *Search Engine Optimisation: How much is too much?* Vol 52, No 5, Law Society Journal (2014)
- *Interlocutory Injunctions: a Guide*, paper presented for the Law Society of NSW – 26 February 2014
- *Settling Proceedings: Tips and Traps*, paper presented for various law societies – October 2012-March 2013