

Craig Smith

Victorian Bar – Dever’s List

Bachelor of Engineering (Chemical) (Honours, Owen Potter Award for top graduate)
Monash University

Bachelor of Laws (Honours) Monash University

Master of Laws (H1 average) Melbourne University

Professional experience (intellectual property)

From 1998 to February 2009 I worked in the litigation and intellectual property groups at Freehills (now Herbert Smith Freehills), from 2004 as a Senior Associate.

Since coming to the Bar in May 2009 I have appeared in a wide range of commercial disputes including in the Federal Court of Australia, State courts, and the Patents and Trade Marks Offices. I have also assisted with resolving a large number of disputes before trial.

Patent, trade mark and *Australian Consumer Law* disputes form a large component of my practice, but I also have substantial experience in relation to registered designs, copyright, and confidential information as well as contract and other commercial disputes.

A common feature of many of the intellectual property disputes that I act in, as well as many commercial disputes, has been the need to familiarise myself with different areas of technology, and work with expert witnesses in a range of different fields. I summarise some of my experience below.

The following are examples of some recent matters that I have acted in.

Patents

I have acted in a wide range of patent disputes, acting for patentees, patent applicants, opponents and parties seeking to contest the validity or infringement of patents.

Some recent patent hearings that I have conducted unled in the Federal Court of Australia include:

- *Axent Holdings Pty Ltd v Compusign Australia Pty Ltd* [2020] FCA 1373, acting for the respondents to a patent infringement proceeding
- *Boehringer Ingelheim Animal Health USA v Intervet International BV* [2020] FCA 1333, acting for the patent applicant in an appeal from an opposition
- *CSIRO v BASF Plant Science GmbH* [2020] FCA 328, acting for the patent applicant in an appeal relating to an amendment

I have appeared at opposition hearings (predominantly unled) in respect of more than 38 patent applications, in addition to assisting with the settlement of many more oppositions before hearing.

I have acted and advised in relation to patents in diverse fields of technology, including biotechnology/life sciences, pharmaceuticals, chemistry, chemical engineering, mining, mechanical inventions, electronics, food processing, physics, and electronics.

Some more recent examples of some of the oppositions and court proceedings I have acted in include:

Biotechnology/Life sciences

- For BASF Plant Science GmbH, in an appeal from an amendment decision in relation to a patent for the inclusion of exogenous genes in plants for the generation of long-chain PUFAs
- For Ariosa Diagnostics, Inc in Federal Court proceedings relating to a non-invasive prenatal diagnosis method based on specific methods of amplifying and analysing cell-free foetal DNA
- For Dow AgroSciences LLC, in a number of patent opposition proceedings, involving herbicide resistance genes, and the introduction of exogenous genes for fatty acid production
- For SpeeDx Pty Ltd in an opposition proceeding relating to primer design
- For Cargill Inc and Branhaven LLC, defending a patent opposition relating to a method of identifying traits in a bovine from nucleic acid samples
- For Meat and Livestock Australia, opposing a patent application in respect of a method of calculating estimated breeding values by inferring missing genotype information

Pharmaceutical

- For Apotex, in various Federal Court proceedings involving product formulations, dosage regimes, polymorphs, salts, indications and particle size distributions
- For Juno, in relation to a Federal Court proceeding relating to a formulation
- For Intervet, in two Federal Court proceedings relating to the formulation of different veterinary products
- Acting in a number of patent oppositions, and settled court proceedings, relating to pharmaceutical formulations

Chemical

- For Construction Research and Technology GmbH (part of the BASF Group), in relation to a chemical accelerator for use in sprayed concrete

- For Rio Tinto, in an opposition proceeding in respect of aluminium alloys
- For Dow AgroSciences LLC in relation to herbicidal formulations

Mechanical

- For Blue Gentian in Federal Court proceedings relating to an extendible garden hose
- For Artcraft Pty Ltd, in Federal Court proceedings in relation to street lights
- For NSL Engineering Pte Ltd in Federal Court proceedings in relation to equipment for handling shipping containers
- For Caterpillar in relation to a bulldozer track design, and in relation to wear members for excavating equipment
- For Bombardier Transportation GmbH in relation to rolling stock connections
- For Icon Plastics Pty Ltd in relation to plastic air-conditioning ducts

Electrical, physics and other

- For Vector Corrosion Technologies Ltd in Federal Court proceedings in relation to cathodic protection systems for preventing corrosion of steel
- For Voxson Pty Ltd in relation to mobile telephone communication systems
- For Innovia Securities Pty Ltd/CCL Secure Pty Ltd, acting in nine separate opposition proceedings in relation to optical security devices for use in bank notes and other security documents
- For Fugro Airborne Surveys Corp, in relation to a transmitter assembly for conducting electromagnetic surveys
- For Leprino Foods Company, in respect of a process of cheese manufacturing methods

Trade Marks

I have acted in a wide range of trade mark disputes in the Federal Court, the majority of which have been resolved before trial. This has included trade mark infringement and cancellation proceedings, appeals from the Registrar of Trade Marks, and opposition hearings before the Trade Marks Office, in addition to a wide range of advices.

Those proceedings have involved a diverse range of issues, including non-use and parallel importation issues. The following are some examples of trade mark proceedings I have acted in.

- For Toast Sales Pty Ltd, defending a Federal Court proceeding brought by G-Star Australia for trade mark and copyright infringement
- For Flexopack Australia Pty Ltd, defending trade mark infringement and ACL proceeding

- For Sportsbet, obtaining an interlocutory injunction to prevent the use of Sportingbet, and acting in a separate proceeding in relation to the use of a Sportsbetting.com.au trade mark
- For Bega Cheese Ltd in Federal Court proceedings addressing issues relating to infringement of registered trade marks, and issues relating to the assignability of unregistered trade mark rights
- For each of Autumnpaper and Red Energy in appeals from the Trade Marks Office
- For Wolverine Outdoors Inc (owner of Merrell trade marks) in an appeal from a trade mark opposition, and defending a non-use proceeding that was elevated to the Federal Court
- For Benefit Cosmetics LLC in an appeal from a trade mark opposition
- For Nimble Pty Ltd defending allegations by Cash Converters Pty Ltd of trade mark infringement involving the use of trade marks as part of search engine optimisation strategies
- For Loddon Mallee Housing Services, defending proceedings for trade mark infringement and misleading and deceptive conduct
- For Lion Capital in an appeal from an opposition proceeding, contesting ownership
- For Creative Nail Design Inc in proceedings alleging infringement of trade marks for nail care products
- For Plumbfirst Pty Ltd in Federal Court proceedings alleging trade mark infringement by Plumbfast Pty Ltd
- For the Squires Loft chain of restaurants, alleging trade mark infringement by Squires on Queen Pty Ltd

Copyright

- For Australian Council for Educational Research Ltd, including on appeal, defending allegations of copyright infringement in the Federal Court
- For Toast Sales Pty Ltd in defending a Federal Court proceeding brought by G-Star Australia for copyright infringement

Registered designs

- For Roadvision defending, at first instance and on appeal, a registered design infringement case in the Federal Court in relation to truck lights, and defending a tortious inducement of breach of contract claim
- Acting for Archies in relation to infringement of registered designs relating to an arch-support thong

- Acting for two manufacturers of side-tipping trucks defending allegations of infringement of registered designs

Confidential information

- For Core Desktop, defending proceedings for breach of confidential information in relation to the provision of cloud computing services
- For Vector Corrosion Technologies Ltd, in relation to allegations of breach of confidence by former employees

Australian Consumer Law

- For Bega Cheese Limited in Federal Court proceedings relating to the use of an unregistered trade mark, and statements made in advertisements
- For the ACCC in proceedings including (all in the Federal Court):
 - Against Kingisland Meatworks Pty Ltd, obtaining orders including a financial penalty, in relation to geographic origin claims
 - Against Hooker Meats Pty Ltd, in relation to geographic origin claims
 - Against Pepes' Ducks Ltd, in relation to representations about the production methods used for ducks
 - Against BAJV Pty Ltd (Europcar franchisee), in relation to allegations of misleading representations and unconscionable conduct involving the cost of repair to rental vehicles
 - Against Luv-a-Duck Pty Ltd, in relation to geographic origin claims
- For Nimble Pty Ltd in the Federal Court defending allegations by Cash Converters Pty Ltd of contravention of s 18 Australian Consumer Law

Interlocutory applications

I have acted in a broad range of interlocutory applications, including:

- obtaining and resisting orders for interlocutory injunctions
- obtaining search orders
- having proceedings struck out as an abuse of process
- resisting joinder applications
- setting aside default judgments
- obtaining summary judgments
- setting aside subpoenas
- obtaining orders for pre-action discovery
- attending mediations, prehearing conferences and case management conferences

Selected publications

'Likely to cause confusion: The section 120(2) Trade Marks Act defence', Volume 78 *Intellectual Property Forum* (September 2009)

'Patents covering enantiomers: case note Lundbeck v Alphapharm', Volume 22 Number 3 *Australian Intellectual Property Law Bulletin*, 2009, pages 49-50

'Trying to Fence in a Monopoly? S 25 of the Trade Marks Act', Volume 20 Number 10 *Australian Intellectual Property Law Bulletin*, 2008, pages 150-1

'Contemplating Reflections', Issue 204 *Patent World*, 2008, pages 18-20 (a comparison of the UK and Australian Lundbeck decisions)

'A real state: the Colorado case', Volume 20 Number 8 *Australian Intellectual Property Law Bulletin*, 2008, pages 129-131

'Still all at sea? Works of artistic craftsmanship after Burge v Swarbrick', Volume 20 Number 3 *Australian Intellectual Property Law Bulletin*, 2007, pages 37-40

Co-author of Australia chapter of *Copyright, Getting the Deal Through*, 2007 and 2008 (with Kristin Stammer)

'Trade Mark Protection for Product Shape - Where Does the Public Interest Lie?', Volume 63 *Intellectual Property Forum*, December 2005. (This article won the IPSANZ Essay Prize for 2005)

'Recognising a valuable lost opportunity to bargain when a contract is breached', *Journal of Contract Law*, Volume 21 Number 3, November 2005, page 250. (This article won the Melbourne University Law School's Student Published Research Prize, postgraduate division for 2005)

'Concrete meaning? Claim construction in Australia', (with S. McVicar), *Patent World* Issue 175, September 2005, page 22

'Warding off internet trade mark infringers', *Computers & Law*, Vol. 60, June 2005, page 18