

## WIPO LIST OF NEUTRALS

### BIOGRAPHICAL DATA

Warwick A. ROTHNIE  
C/-BCS  
Owen Dixon West  
Melbourne, VIC  
Australia



Nationality: Australian

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### EDUCATIONAL AND PROFESSIONAL QUALIFICATIONS

PhD, University of London, London, 1991;  
B.A., LLB (Hons), Monash University, Melbourne, 1985;  
Barrister and Solicitor, Supreme Court of Victoria, since April 1986; High Court of Australia May 1985.

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### LANGUAGES

English

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### PRESENT POSITION

Barrister.  
Senior Fellow, Law School, University of Melbourne.

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### PROFESSIONAL EXPERIENCE BEFORE PRESENT POSITION

Partner, Mallesons Stephen Jaques Solicitors, 1997-2002;  
Senior Associate, Mallesons Stephen Jaques Solicitors, 1991-96;  
Member, Commonwealth Attorney-General's Copyright Law Review Committee April 1999 – 2000 and April 2001 – 2002;  
Senior Fellow, University of Melbourne, (teaching Copyright /Copyright and Designs in LLM Program since 1994;  
Consultant, Australian Law Reform Commission inquiry into Law of Industrial Designs, 1993-95.

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February 24, 2020

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### AREAS OF SPECIALIZATION

Trade mark, copyright, patents and other intellectual property advice and litigation.  
Trade practices (antitrust/competition and unfair consumer practices).  
Telecommunications.

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### MEMBERSHIP IN PROFESSIONAL BODIES

Member, Intellectual Property Committee of the Law Council of Australia;  
Member, Intellectual Property Society of Australia and New Zealand;  
Member, Copyright Society of Australia;  
Member, AIPPI (Australian chapter).

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### EXPERIENCE IN INTELLECTUAL PROPERTY

Conduct of litigation;

Advising clients in relation to:

- Australian and global trade mark and branding strategies including trade mark filing and prosecution;
  - use of intellectual property on the internet and in networked environments;
  - intellectual property licensing; exploitation and dispute resolution;
  - information technology contracts and dispute resolution including software -development and licensing; support agreements, escrow arrangements;
  - business method patent disputes;
  - intellectual property, competition and trade issues.
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### EXPERIENCE WITH RESPECT TO DOMAIN NAMES

Conduct of numerous domain name disputes in the courts and the UDRP;  
Advising clients in development of domain name registration and protection strategies;  
Registration of domain names on behalf of clients.

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### MAJOR PUBLICATIONS

*Parallel Imports, Sweet & Maxwell*, London, 1993;  
*Exclusive Dealing Agreements in the EEC*, (Valentine Koran and Warwick A. Rothnie), 2 edn, *Sweet and Maxwell*, London 1992;  
"Moral Rights: Consents and Waiver", *Copyright Reporter* 145, Vol. 20, 2002  
"Idea and Expression in a Digital World", *9 Journal of Law and Information Science* 59, 1998;  
"Trade, Competition and Intellectual Property" *Prometheus*, Vol. 16, No. 3, 1998;  
"The Future of Fair Dealing" in *Saunders and Sherman* (eds), "From Berne to Geneva: Recent Developments in International Copyright and Neighbouring Rights", Australian Key Centre for Cultural and Media Policy, Brisbane, 1997, 83;  
"Gray Goods Billow on to the Open Main: Section 123 of the Trade Marks Act 1995," *Australian Intellectual Property Journal* 87, 1996;  
"Parallel Imports", in Hugh C Hansen (ed.), *1 Intellectual Property Law & Policy*, *Juris Publishing*, New York 311, 1996;  
"EC Competition Policy, the Commission and Trade Marks", *19 International Business Lawyer* 495, 1991;  
"HAG II: Putting the Common Origin Doctrine to Sleep", *EIPR* 24, 1991;.

### Papers presented include:

"Intellectual Property and Competition Law", *Federal Court Judges' Intellectual Property Workshop*,

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Sydney, March 22, 2002;  
"Legal Issues in Domain Names", *Television Education Foundation*, Melbourne, October 24, 2000;  
"Parallel Imports", *INTA Annual Conference*, Denver, May 2000;  
"Patents and Parallel Imports", *LES International Convention*, Melbourne, 1999;  
"Trade Marks and the Internet" at *Qantm Going Digital Seminar*, RMIT, Melbourne, November 19, 1997.

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#### **EXPERIENCE IN COURT LITIGATION**

Copyright, trade mark and patent litigation in Federal Court of Australia and State Supreme Courts.

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