



Nicholas Tyacke

Partner

Sydney

T: +61 2 9286 8502

M +61 478 491 092

Nicholas Tyacke is a dual-qualified (Australia and the United States) intellectual property litigator. He offers a level of experience unique to the Australian market, having spent many years litigating intellectual property disputes in both the United States and Australia.

Nicholas focuses on advising and acting for local, regional and international clients with respect to all aspects of patent law, particularly in relation to patent issues and disputes in the life sciences and technology sectors, as well as copyright and trade mark law, particularly as they relate to the internet and high technology. He has been involved in a number of Australia's and the United States' leading patent cases and has established a reputation acting as a member of global teams representing clients in complex, multi-jurisdictional disputes.

Nicholas is also a technophile and he has used his knowledge and understanding of technology to help numerous clients resolve multi-million dollar technology related legal disputes.

RELATED SERVICES

- Intellectual Property and Technology

RELATED SECTORS

- Life Sciences

EXPERIENCE

- Advising and acting for an American global pharmaceutical company in relation to patent issues relating to a number of the companies' products. This included acting for the company in multiple proceedings in Australia and co-ordinating proceedings in Singapore as part of a global team involved in multi-jurisdictional patent infringement and revocation proceedings with respect to a family of patents relating to the company's successful anti-cancer treatment product, a nucleoside analogue. In the main Australian proceedings, the company successfully resisted a challenge to the patent term extension of one of the patents-in-suit, successfully amended the claims of that patent in the course of litigation and successfully obtained an interlocutory (preliminary) injunction enjoining the marketing of two generic competitor's products. The proceedings established an important set of guiding principles in Australia for determining when an interlocutory injunction will be granted in pharmaceutical patent infringement cases
- Advising one of the world's top multinational pharmaceutical companies on patent - including patent term extension, patent portfolio management and patent litigation - and non-patent (including data exclusivity) strategies to maximise the commercial life of its product portfolio
- Advising the world leader in implantable hearing solutions on a number of patent issues regarding a family of electrical and

mechanical engineering patents in the field of hearing aids and hearing implants

- Advising and negotiating on behalf of a leading biotechnology company in relation to the licensing of a family of RNAi patents
- Acting for one of the world's premier veterinary pharmaceutical companies in an appeal from the decision of the Australian Patent Office relating to a patent directed to an equine anthelmintic formulation
- Acting for eight of the world's leading manufacturers of bar code scanning technology and one of the world's leading manufacturers of computer vision technology in a patent infringement action brought by a US inventor in relation to a family of patents directed to bar code scanning and machine vision technology. The case, which was appealed to the United States Supreme Court, established an important new defence to patent infringement
- Advising global financial institution in relation to a number of business method patents for the financial services industry

CREDENTIALS

Professional Qualifications

- Solicitor of the Supreme Court of New South Wales, 1992
- Solicitor of the High Court of Australia, 1992

Prior Experience

Prior to returning to Australia, Nicholas practised for seven years in New York at one of the United States' largest and leading specialist patent litigation law firms.

Courts

- Supreme Court of New York
- Supreme Court of the United States
- United States Court of Appeals for the Federal Circuit
- United States Court of Appeals for the Second Circuit
- United States District Court for the Eastern District of New York
- United States District Court for the Southern District of New York

Memberships

- Copyright Society of Australia
- Computer Law Association Inc
- International Trade Mark Association
- Intellectual Property Society of Australia and New Zealand
- American Intellectual Property Law Association

INSIGHTS

Publications

Intellectual Property and Technology News (Asia Pacific) December 2017

7 DEC 2017

Intellectual Property and Technology News Series

Intellectual Property and Technology News (Asia Pacific) is our biannual publication designed to report on worldwide developments in intellectual property and technology law, offering perspectives, analysis and visionary ideas.

Nicholas has written extensively about patent, intellectual property and life sciences issues, including over 50 articles. This includes the following articles.

- "Australia's changing patent law landscape", *DLA Piper Life Sciences Spotlight*, March 2012.
- "The US Food and Drug Administration requests comments on its new draft guidelines on approving biosimilars", *DLA Piper Life Sciences Spotlight*, March 2012
- "Tablet patent wars down under - Apple wins interlocutory injunction and round one against Samsung", *Clayton Utz Insights*, November 2011
- "Federal Court rules on copyright in pharmaceutical product information documents", *Clayton Utz News*, August 2011
- "European Google AdWords case - a win both for trade mark owners and for Google", *Clayton Utz News*, April 2010
- "Enforcing patents likely to get easier in Australia", *Clayton Utz News*, February 2010
- "Patents and the financial services industry - show me the money!", *Clayton Utz Intellectual Property & IT Insights*, June 2008
- "Pharmaceutical patent infringement - interlocutory injunctions now easier to obtain", *Clayton Utz Pharma Insights*, April 2008
- "Can you patent a building? You can bet your house on it!", *Clayton Utz Projects Insights*, September 2007
- "Patenting enantiomers – court decides there is nothing sinister", *Clayton Utz Pharma Insights*, August 2007
- "When does a product contain a pharmaceutical substance for the purposes of a patent extension?", *Australian Health Law Bulletin*, June 2007
- "Business method patents in Australia and the US: the difficulties continue", *Computer Law & Security Report*, June 2007
- "Where the bloody hell are my personality rights?", *Australian Intellectual Property Law Bulletin*, June 2007
- "Can copyright law be used to protect the 'look and feel' of a website?", *Internet Law Bulletin*, May 2007.
- "When does a product contain a pharmaceutical substance for the purposes of a patent extension?", *Clayton Utz Life Sciences Insights*, April 2007
- "Pharmaceutical patent term extensions - the Full Federal Court defines "first regulatory approval date", *Clayton Utz Life Sciences Insights*, April 2007
- "Pharmaceutical patent term extensions: the Federal Court clarifies the eligibility requirements and length", *Australian Intellectual Property Law Bulletin*, March 2007
- "Business method patents in Australia and the US: the difficulties continue", *Australian Intellectual Property Law Bulletin*, January 2007
- "Will springboarding changes have a significant impact on the Australian pharmaceutical industry?", *Clayton Utz Life Sciences Insights*, December 2006
- "Can a pharmaceutical patent term extension, once granted, be shortened or cancelled?", *Clayton Utz Life Sciences Insights*, December 2006
- "Pharmaceutical patent term extensions - eligibility, application deadline and length clarified", *Clayton Utz Life Sciences Insights*, December 2006
- "Wake up and smell the copyright: copyright protection of perfumes and fragrances", *Australian Intellectual Property Law Bulletin*, August 2006
- "Name the Wrong Inventors, Lose your Patent", *Clayton Utz Intellectual Property & IT Insights*, July 2006.
- "Can you patent a method of medical diagnosis or treatment?", *Clayton Utz Life Sciences Insights*, May 2006
- "Interlocutory injunctions for pharmaceutical patent infringement", *Clayton Utz Life Sciences Insights*, February 2006

- "Patent certification registration/listing requirement to be eased", *Clayton Utz Life Sciences Insights*, February 2006
- "Is Australian law on patents and experimental use about to be clarified?", *Clayton Utz Life Sciences Insights*, December 2005
- "Was Grokster really a victory for the entertainment industry?", *Clayton Utz Intellectual Property & IT Insights*, September 2005
- "The experimental use exception to patent infringement - a preview", *Clayton Utz Life Sciences Insights*, July 2005
- "Extending the term of a pharmaceutical patent", *Clayton Utz Life Sciences Insights*, July 2005.
- "Who wants to be a patentee? - Five things executives, corporate counsel and inventors need to know about patents", *Clayton Utz Intellectual Property & IT Insights*, May 2005
- "Internet Law: The legality of internet pop-up ads", *Computer Law & Security Report*, May 2005
- "A Fair Use Doctrine for Australian Copyright Law - A Fairer Deal for All?", *Clayton Utz IP/IT 2005: Year Ahead*, March 2005
- "Searching for trouble - keyword advertising and trade mark infringement", *Computer Law & Security Report*, November 2004
- "I love the smell of copyright in the morning: intellectual property protection of perfumes and fragrances", *Australian Intellectual Property Law Bulletin*, October 2004
- "Australia-US FTA and the evergreening of pharmaceutical patents - much ado about nothing?", *Australian Intellectual Property Law Bulletin*, October 2004
- "The Impact of the US Free Trade Agreement on the Generic Pharmaceutical Industry & the PBS", October 2004
- "The FTA's Impact on Generic Pharmaceuticals and the PBS: Much Ado about Nothing?" *Clayton Utz Intellectual Property & IT Insights*, September 2004
- "The legality of internet pop-up ads", *Clayton Utz Intellectual Property & IT Insights*, June 2004.
- "Patents, An introduction to Australian Intellectual Property law", June 2004
- "Internet Keyword Advertising and Trade Mark Infringement - Searching for Trouble", *Computers & Law*, June 2004
- "How well does our patent regime protect business systems?", *Clayton Utz Intellectual Property & IT Insights*, June 2004
- "Internet search engines, advertising and trade marks", *Clayton Utz Intellectual Property & IT Insights*, March 2004

(Copies of articles are available on request.)

Events

Nicholas regularly presents on patent, intellectual property and life sciences issues.