



**LEGALINK**  
INTERNATIONAL BUT PERSONAL

IP/IT Interview  
Series  
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Tim O'Callaghan

– Piper Alderman



**PiperAlderman**

### **Which areas of IP/IT is your firm active in?**

The firm is involved in all aspect of IP and IT. We do corporate and commercial IP and IT transactions and we also litigious work. We have trade mark filing and prosecution practice but we outsource the filing of patents.

### **Who in your firm is dedicated to which area of IP/IT?**

I am litigator and also look after the trade mark filing practice. My team do the filing of trademarks and prosecution of trademark applications and oppositions and trade mark, patents and copyright litigation..

Tim Clark in Melbourne also files trade marks, and is involved in IT transactions and bio-tech. Tim has also a degree in medical science.

James Lawrence in our Sydney office does patent litigation and in particular pharmaceutical patent litigation.

Teresa Nicoletti, who is another partner in our Sydney office, is expert in pharmaceutical regulation work and she and James Lawrence collaborate in pharmaceutical patent issues.

These are the partners in the IPT section of our firm. Those partners are supported by senior associates and trademark attorneys and other lawyers. Piper Alderman specializes in many other areas of commercial law. We have four office in Australia, and about 300 staff in total.

### **Which are the recent major IP/IT matters that you and your colleagues have been working on?**

One project that my team works on in Adelaide is for Bridgestone Tyre company in parallel import work. Our role if to assist Bridgestone to prevent or minimize parallel imports of tyres. This is an ongoing project.

We also assist clients with a monitoring of trade mark infringement. An example of this is Sushi Train Australia Pty Ltd. We were successful in registering the words “Sushi Train” as a trade mark in Australia, which was a great success given the descriptive nature of those words. Our had commenced using the Sushi Train name in Australia about thirty years ago, and has established about forty “Sushi Train” branded restaurants around Australia. We therefore we had enough evidence to satisfy the Trade Marks Office that the trade mark was factually distinctive of our client so as to satisfy the test for registration. Since then we have engaged in a program to prevent other businesses, particularly new organizations, from calling themselves “Sushi Train”.

Tim Clark has been advising a company called TransBio, specializing in identifying bio markers for therapeutic and diagnostic products and we have been advising them for many years. There is a transfer of IP to an Australian bio-tech company and we acted in that transaction.

Teresa Nicoletti has recently been heavily involved in advising government and companies on the issues involved in legalizing marihuana for medical purposes. Our Federal parliament recently took the first step towards creating a medical marijuana scheme, passing an act allowing for cannabis to be cultivated and manufactured by licensed producers.

James Lawrence has as a major client, the Woolworths supermarket group. He is involved in all aspects of IP work for Woolworths. James also advises on the legal issues relating to the use of drones.

**What are your firm's expectations and plans in the area of IP/IT in the future – will there be any interesting developments in your jurisdiction?**

In term of our plans for the future; the Australian government is willing to focus more and more on the topic of innovation and in particular innovation in export.

As Australia moves away from dependence general manufacturing, and establishes itself in the innovative manufacturing, our response is to focus more on innovation. We can assist clients to understand what innovation is, how to identify it, encourage it, protect it and commercialize it.

**What do you like to do in your spare time?**

Most importantly, I am married with four children. My children are twenty-three years old, and fifteen, and thirteen, and nine years old. They take up a lot of my spare time.

Three of my children were adopted from Korea, so we have a connection with Korea, and as a part of that, one of the things that we do, my thirteen year old son and I have been learning taekwondo. In December last year, he and I achieved a black belt in taekwondo.

Another thing which keeps me occupied in my spare time if playing guitar and singing. I was in a band for a long time, but have now retired from that, but I play and sing with my sister and one of my daughters in particular.

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