

Jeffrey McLean (Jeff)

Partner | Intellectual Property | Hong Kong

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Jeff is the Head of the Patents and Designs Practice.

Jeff has a unique background as he is a Hong Kong qualified lawyer as well as a Registered Australian/New Zealand Patent Attorney and Registered Australian Trade Mark Attorney. He holds a BSc and a LLB (Hons) from the University of Queensland in addition to a Master of Information Technology from Queensland University of Technology and a Master of IP Law from University of Technology Sydney. Jeff is also admitted as a solicitor in Queensland and NSW and practised with a leading national firm prior to joining Deacons.

Jeff has also worked as a Patent Examiner with the Australian Patent Office (IP Australia), examining and conducting searches on patent applications as an examiner in the electronics and computing section, which gives him insights into the patent examination process.

His dual technical tertiary qualifications uniquely equip him in the provision of strategic commercial advice in diverse technical areas, including recently advising on the following:

- Biochemistry: stem cells, cancer immunotherapy / CAR-T cells, gene therapy, monoclonal antibodies genetic diagnosis, biomarkers and synthetic biology, bioinformatics; consumer products and diagnostic devices.
- Computer-related: computer data structures, fintech applications, gaming machine technology, distributed ledger software (blockchain), applied big data analytics, artificial intelligence including machine learning protocols and applications, medical imaging devices and imaging algorithms.
- Mechanical: general electro mechanical inventions, including medical devices, metrology probes, microfluidics, consumer goods, construction products, protective equipment, photonics and small household appliances.

Jeff's broad practice includes patent drafting and strategic advice on filing and prosecution strategies in China, Europe, United States, Hong Kong, Australia and other substantive jurisdictions, and general patent portfolio and renewals management. He has also worked with our contentious team in providing litigation support and strategic advice for numerous patent and design infringement cases. He routinely provides freedom-to-operate advice, including for listing purposes.

Jeff has been recognised as a Gold Tier Leading Individual in Patent Prosecution in Hong Kong by *IAM Patent 1000* (2014-2021), as a World's Leading Patents Agent by *Who's Who Legal* (2016-2021) and a Next Generation Partner in IP in Hong Kong (2021) by *Legal 500*.

Highlights

Strategic Patent Projects and Drafting

- Analysis (landscaping and freedom-to-operate), drafting, prosecution and filing strategy for cardiovascular medical and surgical products.
- Portfolio management and prosecution of entire Chinese Patent Portfolio of FTSE listed precision electronics company.
- Advising a well-known transportation services operator on patent and design protection strategies relating to various innovations including drafting, prosecution and landscape analysis for various inventions including escalator monitoring systems, train control systems and the use of Internet of Things and AI technology in train line operations.
- Advising a well-known transportation services provider in protecting aspects of automated imaging devices for maintenance operations, immigration and infrastructure monitoring including drafting, prosecution and landscape advice.
- Drafting and prosecution of patent applications for SME's, universities and various multinational corporations in China, Europe and United States including for major HK



Principal Areas

- Intellectual Property
 - Designs
 - Patents

Sectors

- FinTech
- Life Sciences and Healthcare
- Technology, Media and Telecom
- Transportation and Logistics

Languages

- English

Jurisdictions

- Hong Kong
- New South Wales (Australia) (non-practising)
- Queensland (Australia) (non-practising)

universities, consumer appliance and household item manufacturers.

- Drafting and prosecution of patent applications for the Hong Kong branch of multinational corporations in China, Europe and United States in multiple technical areas outlined above.
- Providing freedom-to-operate opinions and protection advice for major health services operator, including in respect of procurement policies and emergency access to medicines.

Patent Enforcement and Litigation

- Providing litigation support, infringement and validity analysis in relation to DNA sequencing technology in HK Court Proceedings.
- Providing litigation support, infringement and validity analysis in relation to network infrastructure technology in HK Court Proceedings.
- Providing litigation support, infringement and validity analysis in relation to patent infringement action on behalf of an international supplier of household appliances.
- Strategic infringement and enforcement advice in relation to multi-jurisdictional electronic devices.
- Freedom-to-operate opinions in mechanical devices, network hardware, medical devices, consumer products and mechanical inventions.

More about Jeffrey McLean (Jeff)

Accolades

- *Legal 500*
 - Next Generation Partner in Intellectual Property: Hong Kong (2021 – 2022)
 - Recommended Lawyer in Intellectual Property: Hong Kong (2021-2022)
- *IAM Patent 1000*
 - Gold Tier Individual in Patent Prosecution in Hong Kong (2019 – 2021)
 - IAM Global Leader: Hong Kong (2020)
- *Who's Who Legal*
 - World's Leading Patents Lawyer (2016 – 2021)

Appointments/Memberships

- Council Member and Chair Patents Sub-Committee, The Hong Kong Institute of Trade Mark Practitioners (HKITMP)
- Committee Member, The Asian Patent Attorneys Association (APAA) Hong Kong
- Council Member, Patents Committee, The Asian Patent Attorneys Association (APAA) Hong Kong (2018 – 2020)
- Member, Fédération Internationale des Conseils en Propriété Intellectuelle (FICPI)
- Member, The Law Society of Hong Kong

Education

- BSc (Biochemistry), University of Queensland
- Master of Information Technology, Queensland University of Technology
- Master of Intellectual Property Law, University of Technology Sydney
- LLB (Hons), University of Queensland

Publications

- Co-Author, "Patent issues reviewed by Hong Kong Court of Appeal", *Intellectual Property Magazine* (2016)

