

Jian Hui Gu

Lawyer

Melbourne +61.3.9205.2043

Jian.Gu@klgates.com

OVERVIEW

Jian Hui Gu is a lawyer in the intellectual property (IP) group focusing on IP procurement and portfolio management. Jian is an experienced IP practitioner, with significant experience assisting clients in the development and protection of their IP rights a range of industries. She also has contentious trade mark experience and has advised clients on various strategies for protection of their trade mark rights worldwide. In particular, she has a managed trade mark filings and prosecution matters in Australia, Singapore, Malaysia, Brunei, New Zealand and the World Intellectual Property Organisation (WIPO).

PROFESSIONAL BACKGROUND

Jian began her career in law at a leading boutique IP and technology law firm in Singapore where she developed and managed the trade mark portfolios of some of the world's most successful brands, including those owned by Fortune 500 companies, luxury fashion labels and a tech giant. After relocating to Melbourne and prior to joining K&L Gates, Jian worked at a specialist and multi-disciplinary firm where she gained experience in technology, IP commercialisation and IP litigation. She has also assisted various start-ups and small to medium businesses from the initiation of their IP protection through to the enforcement, maintenance and use of their IP.

ACHIEVEMENTS

Postgraduate Intellectual Property Law Teachers' Prize, University of Manchester, 2011

PROFESSIONAL / CIVIC ACTIVITIES

- Law Institute of Victoria
- The Honourable Society of the Middle Temple

EDUCATION

- Bar Professional Training Course, BPP University, 2015
- LL.M., University of Manchester, 2011
- LL.B., University of Manchester, 2010

ADMISSIONS

- Barrister, Middle Temple
- Supreme Court of Victoria

LANGUAGES

- Chinese (Mandarin)
- English
- Malay
- Chinese (Cantonese)

THOUGHT LEADERSHIP POWERED BY HUB

- 13 December 2023, Walking the Fine "Broken" Line in Designs
- 24 November 2022, Singapore Maintains Hard-Line Take on Goodwill in Million-Dollar Wonton Noodle Feud

OTHER PUBLICATIONS

Intellectual Property Office of Singapore Public Consultation on Proposed Amendments of the Patents Act, Mediation Option in Trade Mark and Proceedings Case Law Developments, Journal of the Intellectual Property Society of Australia and New Zealand Inc., Issue 88, 2012

AREAS OF FOCUS

IP Procurement and Portfolio Management

REPRESENTATIVE EXPERIENCE

Managed the trade marks portfolio and assisted in negotiations and contentious trade mark actions, agreement drafting and coordination of enforcement strategies for a tech giant.

K&L GATES

- Handled clearance searches, filing, prosecution and management of trade marks and designs for a global transportation company.
- Assisted and advised a global coffee house chain in trade mark clearance searches and trade mark opposition and invalidation actions.
- Developed strategies for the protection, enforcement and use of trade marks for a well-known international gaming company.
- Assisted in the filing and prosecution of designs for an award-winning Australian furniture manufacturer, designer and retail chain.
- Assisted and acted for a Victorian wine company in a brand enforcement dispute in the Federal Court.
- Assisted and advised a not-for-profit public company responsible for the governance of various Catholic schools in Australia in the protection and licensing of their trade marks.
- Assisted and advised a manufacturer of cybersecurity technology on a technology contract worth around AU\$20 million.
- Advised and assisted various start-ups and small to medium businesses with the protection, enforcement, maintenance and use of their trade marks.
- Managed the trade marks and industrial design portfolios of a luxury fashion house.