



## **PAUL MALLON**

**Principal, Mallon & Co**

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### **Contact Numbers**

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### **Languages**

English (native), Mandarin (basic)

### **Admissions**

Admitted in England and Wales, and in Western Australia.

### **Nationality**

United Kingdom & Australian.

### **EMPLOYMENT**

1989: Associate to Justice Kennedy, Supreme Court of Western Australia

1990-1991: Minter Ellison, Perth, Western Australia

1991-1992: Clifford Chance, London

1993-1997: Phillips Fox, Perth, Western Australia

1997-2005: Senior Associate Clayton Utz, Perth, Western Australia

### **PROFESSIONAL EXPERIENCE**

#### **- General**

Paul practises as a "general practitioner" in intellectual property and information technology law. He handles both contentious and non-contentious matters with a slight "bias" towards non-contentious matters.

Paul's practice includes business disputes concerning technology and intellectual property rights as well as a range of commercial transactions relevant to the acquisition and commercialization of intellectual property. Paul also advises on organizational structures for technology related businesses. He handles intellectual property matters before all Courts, the Australian Trade Mark Office and the Australian Patent Office. Paul's practice has been ranked Premier in Legal Profiles in Intellectual Property, Information Technology and E-Commerce (where it was ranked first).

#### **- E-Commerce**

Paul has advised on the legal framework for B2B portals and eBusiness, privacy advice, internet security, website development, maintenance and hosting agreements, domain name disputes, and online alliance or "partnering" agreements.

#### **- Trade Marks**

Paul is familiar with all trade mark proceedings before the Trade Marks Registrar. Paul also advises on domain name disputes.

#### **- Patent Litigation**

Paul is currently acting on a number of significant patent opposition, rectification and infringement matters before the Australian Patent Office and the Federal Court of Australia. Paul regularly advises Patent Attorneys with regard to potential litigation.

### **RECENT EXPERIENCE**

#### **- Technology Transfer / Patent Acquisitions**

Paul acted for a listed Australian corporation on the acquisition of drilling technology developed in the United States.

Paul acted on the acquisition of its world wide patent portfolio and in licensing the technology throughout the world Paul also drafted a number of joint venture, confidentiality and consultancy agreements relevant to the transaction.

- Copyright

Paul regularly prepares copyright agreements including:

- \* Software development and licensing agreements
- \* Database licensing agreements
- \* Sound recording production and distribution agreements

Paul has also advised on, negotiated and prepared numerous copyright production, publishing, and related contracts for worldwide copyrights.

- Designs

Paul has acted for foreign and local companies in relation to infringement proceedings in the Supreme Court of Western Australia.

- Trade Marks

Paul has acted for foreign corporations in Federal and Supreme Court proceedings for breach of confidence, passing off, misleading and deceptive conduct and breach of copyright, involving the company's brands in Australia and internationally. Recent matters involved complex issues of domain name registration, and trade mark infringement over the Internet

Paul has acted for a number of major Western Australian corporations in Supreme Court proceedings for passing off and trade mark infringement.

- Merchandising Rights & Sponsorship Rights

Paul has acted for Western Australia's two Australian Football League Clubs on merchandising and sponsorship rights.

- Trade Secrets

Paul has advised on a number of complicated transactions involving the protection of confidential information, cross border protection of trade secrets, protection of trade secrets in the defence industry. He has prepared appropriate non-disclosure agreements for pre-contractual disclosure, technology evaluation, and for consultants.

- Computing & E-Commerce

Paul has advised numerous e-commerce businesses on the protection of their intellectual property rights from inception to their initial public offering. Particular aspects of advice include e-branding, international trade mark protection, the patenting of e-commerce business systems, and cross-border intellectual property issues relevant to the use of the Internet.

- Hybrid Transactions

Paul has advised a major publicly listed diversified mining company on conflict issues associated with the use of nickel processing technology. The advice involved complex issues concerning patent, design and copyright protection.

- Technology Commercialisation

Paul has advised a major electrical power utility on capturing and exploiting its meter reading technology including appropriate R&D joint venturing agreements and appropriate ownership and royalty regimes.

- Technology Venture Capital Funding

Paul has advised small to medium sized corporations on intellectual property aspects relevant to listing on the Australian Stock Exchange (ASX). Paul has advised on all aspects of the intellectual property due diligence process including due diligence for e-commerce and internet based businesses. He has advised on "e-branding issues" and the development and protection of a corporate identity on the Internet.

- Universities

Paul acts for a range of universities on the exploitation and commercialization of public research and ownership issues between academics, members of staff, PhD students and students generally.

- Information Technology

Paul has acted for major government authorities in relation to the acquisition and maintenance of information technology systems. In some cases, the transactions represented the most significant IT acquisition for the authority.

Paul acts for Western Australian based software development companies in relation to their software development contracts, and hardware acquisition contracts. Paul also acts for software distributors in Australia in relation to their distribution and dealer networks.

Paul acts for a major supplier of software for the healthcare sector in relation to the licensing, and maintenance agreements for its primary health management application.

**INTERNATIONAL EXPERIENCE**

- UK & Europe

Clifford Chance 1991 - 1992

- USA

Patent and technology acquisitions; technology licensing; software agreements.

- South Africa

Patent and technology acquisitions; technology licensing; breach of confidence litigation.

#### **PROFESSIONAL QUALIFICATIONS**

- Barrister and Solicitor of the Supreme Court of Western Australia.

- Solicitor, England & Wales.

#### **PROFESSIONAL ASSOCIATIONS**

- Member of the Licensing Executives Society (Australia & New Zealand).

- Member of the Committee of the Intellectual Property Society of Australia and New Zealand Incorporated.

- Member of the Western Australian Chinese Chamber of Commerce

#### **INTERESTS**

- Hockey

Ex-first grade player (Australian combined Universities touring side, 1987); assistant first grade coach, Suburban Hockey Club, 2002