

James Wallace

Senior Associate

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OVERVIEW

James is a patent and trade mark attorney in the Intellectual Property group. He focuses on the prosecution of patents in most technology sectors, but has keen interest and experience in organic chemistry, manufacturing, medical devices, child safety seats, medical pumps, ventricular assist devices, heart catheters, proprietary software, artificial intelligence and mechanical inventions.

James also advises clients on freedom-to-operate, patentability, validity and infringement matters and prides himself on providing strategic and detailed opinions on complex technologies. James also handles opposition matters before IP Australia in all technology areas, and provides litigation support in matters before the Federal Court of Australia.

James is a commercially minded patent attorney, who advises clients on how their patents can fit strategically into their wider intellectual property objectives. James employs a holistic approach when providing patent advice to clients.

PROFESSIONAL BACKGROUND

In 2019, James graduated with a Bachelor of Science with Honours from the Australian National University in Canberra, Australia. His thesis was titled 'Development of an SP-hybridised carbon coupling method inspired by Atom Transfer Radical Polymersation (ATRP)'. Whilst completing Honours, James began a Master of Intellectual Property Law at the University of Technology, Sydney in order to obtain registration as a patent and trade mark attorney.

Prior to joining K&L Gates, James worked as a trade mark and patent attorney at a boutique law firm in Sydney. James has prosecuted a multitude of patent applications across multiple industries before both IP Australia and the Intellectual Property Office of New Zealand.

In addition, he has prosecuted trade mark applications, successfully overcome examiners objections and managed oppositions and non-use applications.

ACHIEVEMENTS

- Finalist, Plan Your Own Enterprise, Certified Practicing Accountants Australia (CPA), 2016
- Honours Financial Scholarship, 2019

PROFESSIONAL / CIVIC ACTIVITIES

- Treasurer, The Royal Australian Chemical Institute (RACI), 2025–present
- Member, The Institute of Patent and Trade Mark Attorneys of Australia (IPTA), 2024–present
- Member, The Intellectual Property Society of Australia and New Zealand Inc (IPSANZ), 2024–present
- Member, The Royal Australian Chemical Institute (RACI), 2020–present

EDUCATION

- Master in Intellectual Property Law, University of Technology, Sydney, 2022
- B.S., Australian National University, 2019 *(Organic Chemistry and Synthesis)*

ADMISSIONS

- Registered Australian Patent Attorney
- Registered Australian Trade Marks Attorney
- Registered New Zealand Patent Attorney
- Registered New Zealand Trademark Attorney

THOUGHT LEADERSHIP *POWERED BY HUB*

- 15 April 2026, Dividing and Conquering: Best Method Obligations Follow Every Divisional Patent Application
- 22 September, All Eyes on EYLEA–Sandoz Defeats Preliminary Injunction
- 17 September 2025, Keep Spinning: Aristocrat Finally Hits the Patent Jackpot
- 11 August 2025, Let's Make it a Date–Best Method and the Filing Date of the Earliest Complete Application
- 4 September 2024, Upcoming Patent and Design Fee Changes, Including Important Excess Claim Fee Modifications: Australia
- 3 June 2024, Historic 27th WIPO Treaty: WIPO Treaty on Intellectual Property, Genetic Resources and Associated Traditional Knowledge
- 15 March 2024, Full Court Parks Trial Judge's Decision in Carpark Patent Fight

- 17 January 2024, PayPal Inc. [2023] APO 54: PayPal Machine Stalls in the Face of Intangible Resistance
- 1 December 2023, Burger Wars: The Big Beef Between McDonald's and Hungry Jack's–*McD Asia Pacific LLC v. Hungry Jack's Pty Ltd* [2023] FCA 1412
- 26 September 2023, In Starch Contrast: Australian Patent Office Makes Key Finding on Use of Trade Marks in Patent Specifications

AREAS OF FOCUS

- IP Procurement and Portfolio Management

REPRESENTATIVE EXPERIENCE

- Advised a geothermal energy company on global patent and trade mark filing and prosecution.
- Represented a leading Australian steel supplier and manufacturer in patent oppositions and other matters.
- Represented a US-based transport company in patent prosecution matters in Australia.
- Advised an agricultural chemical company in commercial negotiations in relation to a major product and assisted it in navigating and minimising IP infringement risks.
- Protected an Australian patent related to an in vitro diagnostic method involving the isolation of biomarkers according to a novel method, such that they are isolated for detection in an enriched isolate.

Experience prior to joining K&L Gates includes:

- Drafted provisional specifications in most technology areas for SMEs, corporates, and international companies.
- Prosecuted multiple applications before IP Australia and the Intellectual Property Office of New Zealand for a leading US security and lock company.
- Provided an infringement and validity search and advice letter with regards to the commercialisation of sporting apparatus intended for use in an international competition.
- Advised a multinational corporation on a freedom to operate search in Australia with respect to a sleep apnea mask.
- Prosecuted local and overseas applications for an ASX-listed client who is focused on green energy, renewables, and innovative refinery systems.