

PROFILE

**Partner****Data Compliance & Cybersecurity****Healthcare & Life Sciences****Intellectual Property****Telecommunications, Media & Technology (TMT)****Shearn Delamore & Co., Kuala Lumpur**

michelle.loi@shearndelamore.com

T +603 2027 2885

Qualifications

LL.B (Hons), Uni of London (External, 2002)

Certificate in Legal Practice (2003)

Registered Patent

Industrial Design and Trademark Agent

Languages

English, Malay, Chinese

MICHELLE CHOI
YOKE
LOI

ABOUT MICHELLE

Michelle is a Partner in the IP Department of Shearn Delamore. Michelle represents clients in all areas of IP litigation namely, trademark, copyright, design, passing-off, geographical indication, trade secrets as well as complex patent cases involving pharmaceutical/life sciences, medical devices, oil palm and gloves, amongst others. She is often involved in precedent-setting cases in the Federal Court. She also advises and defends clients in prosecution matters involving amongst others, Control of Drugs and Cosmetic Regulations 1984. Her experience in IP litigation gives her added insight and context when it comes to advising her clients on other IP areas including trademark prosecution, advisories/agreements, and enforcement.

Vis-à-vis advisories/agreements, her experience includes not only IP-related agreements but also e-commerce and IT/software agreements. Michelle also advises on domain name disputes, franchising (compliance), gaming and food regulations and personal data protection. She has been invited to speak on personal data protection on numerous occasions including conducting refresher courses on this topic.

Michelle was a STAR scholar with a Second Class Upper Honours in law from the Uni of London in 2002. She was one of the top students in the Certificate in Legal Practice with a Second Upper in 2003. She was called to the Bar of the High Court of Malaya in August 2004.

Michelle is the immediate Past President of the Licensing Executives Society of Malaysia. She is also a trainer in the Advocacy Training Course organised by the Bar Council as well as one of the Asian

Arbitration International Centre (AIAC)'s Panelists of the Domain Name Dispute Resolution for the term 2021-2024. She is also actively involved in the IP Committee of the Bar Council.

Michelle Loi is The Legal 500 Asia-Pacific's recommended lawyer for 2014, 2017, 2018 and 2019 and is also named by Asia IP (2015) as one of the 50's Asia-Pacific's "Licensing Lawyers You Should Know". Recently, she was accorded Silver Tier by the World Trademark Review in enforcement and litigation. Michelle is a regular contributor for the Malaysian Chapter for Katzarov's Manual on Industrial Property. She also co-authored the Malaysian Chapter of Franchising in Asia published by Lex Foundation (2015) and has been consistently requested to provide updates for franchise in Malaysia.

EXPERIENCE

Michelle has been involved in IP precedent-setting cases in the Federal Court.

Litigation

- ***Merck Sharp & Dohme Corp v. Hovid Berhad [2019] 9 CLJ 1, Federal Court***

Was successful in reversing the Federal Court's very own decision in the SKB Shutters Manufacturing Sdn Bhd v. Seng Kong Shutters Industries Sdn Bhd & Anor [2015] 6 MLJ 293 which held that the validity of a dependent claim will automatically fall upon the substantive finding of invalidity of its independent claim. On 21 August 2019, the majority of the Federal Court, in allowing Merck Sharp & Dohme held that the validity of dependent claim had to be separately evaluated. Following this latest ruling, the determination of the dependent claims (remitted issue) is now back in the High Court for determination.

Having the Federal Court revisit its previous decision is extremely rare. According to LexisNexis and the Current Law Journal search, there were only 5 cases since 1967 before this case where the Federal Court expressly overruled its own decisions with this case being the first in the IP arena. This case finally did away the precarious position of a dependent claim previously created by the SKB Shutters Ruling and the far-reaching effects created by the SKB Shutters Ruling. Patentees are comforted by this case and can now file their patents with dependent claims without the fear of having the dependent claims being automatically invalidated merely upon the invalidation of its independent claim. Potentially 100,000 patents in Malaysia have been positively impacted by this decision.

- ***Mesuma Sports Sdn Bhd v. Majlis Sukan Negara [2015] 9 CLJ 125, Federal Court***

The Federal Court in this case clarified that a claim for common law ownership over an indicator as a trade mark or source identifier is answered by asking who was the first in time to use said indicator or source identifier as a trademark in a trade mark sense in the course of trade; rather than who had designed or re-conceptualised the said indicator or source identifier. This has a far reaching effect on the relation between trademark and copyright ownership of a trademark or source identifier though in practice, the ownership tend to be common of the same proprietor.

- ***Liwayway Marketing Corporation v. Oishi Group Public Co. Ltd [2017] 5 CLJ 133, Federal Court***

Was successful in overturning both the High Court and Court of Appeal decisions on the facts. This was largely due to the Federal Court's acceptance of the question of law posed, to wit, In this precedent-setting decision, the Federal Court set out the requirements for market survey often used by party ("person aggrieved") to support its case of non-use of a trademark by a registered proprietor.

The Federal Court held that compliance with the Whitford guidelines does not automatically translate the 'person aggrieved's' case into one where the prima facie burden of proving non-use has been discharged. Fulfilment of the Whitford Guidelines was not enough as that only addressed the form of a market survey report (or in other words, what a market survey report ought to contain). The substantive

aspect of the market survey report is equally important as well. The Federal Court clarified that it is only when both aspects are fulfilled can a person aggrieved be said to have discharged its prima facie burden of proving non-use.

- ***Maestro Swiss Chocolate Sdn Bhd v. Chocosuisse Union des Fabricants Suisses de Chocolat & Ors & Another Appeal [2016] 4 CLJ 345, Federal Court***

The Federal Court in this case recognised the concept of extended form of passing-off but rejected the need for two separate and distinct misrepresentation and confusion tests for both classical and extended forms of passing-off. The Federal Court clarified that if at all, for passing off in extended form there is the need for 'modification necessary to cater for the specific factual situation arising from the descriptiveness of the term or name to be protected'. The Federal Court further agreed that a trade association, who does not itself manufacture and sell products of the trade mark in dispute (in this case, chocolate and chocolate-related products), does not have the requisite locus standi to sue for common law tort in passing off, whether in its classical or extended form.

This is also one of the rare case that involved consideration of the Geographical Indications Act 2000, namely, section 27 of the Act.

- ***Asia File Products Sdn Bhd v. Brilliant Achievement Marketing [2019] 1 LNS 259, High Court***

Having successfully brought an infringement action against Brilliant Achievement (see the reported decision of the High Court in *Asia File Products Sdn Bhd v. Brilliant Achievement Marketing [2012] 1 LNS 1470*; affirmed by the Court of Appeal in 2012), the matter was then set down for assessment of damages hearing.

One of the rare patent cases on assessment of damages, this case also affirmed the accepted principle that wherein an amendment affects substantive rights as opposed to being merely matters of procedure, said amendment will not have retrospective effect. Therefore the effect of the amended Rules of Court 2012 (Order 37 rule 1(1)), which came into force from 1 August 2012 and which sought to bind the applicant with a one-month rule to seek instruction from the court was found not to apply in this present case which was commenced way before 1 August 2012.

The High Court nonetheless ruled that the stringent rule of Order 37 would not apply any way as in this case, the winning party had been granted the election between assessment of damages and account of profit (as opposed to one without election, as envisaged by Order 37 rule 1(1)). On the same vein, the High Court acknowledged the need for the said party to have the necessary time (which could extend beyond the one-month period envisaged by Order 37 rule 1(1)) to make an informed election.

The counterparty appealed to the Court of Appeal against the quantum of the damages, but the matter was resolved before the hearing.

- ***EI Baik series of cases***

Diligently pursued cases for EI Baik including the following:

- (i) ***Kuala Lumpur High Court Originating Summons No.: WA-24IP-4-01/2019 [EI Baik Food Systems Co. S.A. v Registrar of Trade Marks, Malaysia and Al Baik Fast Food Distribution Co. S.A.E.]***

Was successful in overturning the Trade Mark Registrar's decision with costs. In finding for EI Baik, the High Court recognised spillover concept of goodwill, i.e. that goodwill can transcend borders. This case is also important as it sets out circumstances where fresh evidence and new grounds of challenge can be raised during the appeal from the Registrar's decision's stage.

(ii) Kuala Lumpur High Court Originating Summons No.: WA-24IP-17-08/2019 [El Baik Food Systems Co. S.A. v Al Baik Fast Food Distribution Co. S.A.E.]

Successfully cancelled Al Baik Fast Food Distribution Co. S.A.E.'s trade mark registration for a trademark which is identical and/or confusingly similar to the Plaintiff's ALBAIK Trade Mark from the Register of Trade Marks.

(iii) Kota Kinabalu High Court Suit No: BKI-22NCvC-114-12/2019 [El Baik Food Systems Co, S.A. v Q Baik (Malaysia) Sdn Bhd]

This is an ongoing action. El Baik filed an action at the Kota Kinabalu High Court for passing off, relief under section 70B of the now repealed Trade Marks Act 1976 and copyright infringement in respect of QBaik (Malaysia) Sdn Bhd's ("QBAIK") use of the QBAIK trademark (which is confusingly similar with the Plaintiff's ALBAIK Trade Mark) in Malaysia. The High Court recently dismissed QBAIK's striking out application and the matter is currently going through pre-trial case management motions.

• ***Dorpan, SL & Anor v. Nusajaya Sunrise Sdn Bhd [2019] 8 CLJ 475***

Was successful in obtaining an injunction against the defendant, a well-known local developer, over its use of the word MELIA. The action was premised on the Plaintiff's entitlement of the right to use the word MELIA. The High Court decision is crucial in the following respects:

- (i) The High Court recognised the principle that common field of activity is not a pre-requisite in establishing the element of misrepresentation in a passing-off action. A party is able to lay claim against a third party in another field of activity provided it could show trends of diversification into the latter field. The High Court recognised the possibility of diversification and natural extension from one business to the other. Such trends no doubt are factual and evidence-heavy.
- (ii) House brands and sub brands are in law stand-alone trade marks with their own distinctiveness and are thus capable of performing their respective source identifications. Confusion is not necessarily eliminated just because the "MELIA RESIDENCES" mark is used together with the Defendant's house marks.

Whilst the Defendant filed an appeal to the Court of Appeal against the decision of the High Court, the appeal was subsequently withdrawn. Hence, the decision of the High Court remains final and conclusive.

• ***Ranbaxy (Malaysia) Sdn Bhd v. E.I. du Pont de Nemours [2012] 9 CLJ 79, Court of Appeal***

Was successful in defending the validity of certain claims of E.I. du Pont Nemours' patent for losartan potassium in crystalline salt. Ranbaxy in its defence against infringement counter-claim, claimed that it had obtained the necessary marketing approval under Regulation 7(1) (a) of the Control of Drugs and Cosmetics (Amendments) Regulations 1984 (the 1984 Regulations) from the then National Pharmaceutical Control Bureau (NPCB), and as such, is entitled to market its generic product in question even during the subsistence of the validity of the relevant patent. The High Court disagreed with this contention and ruled there is no nexus between regulation 7(1) (a) the 1984 Regulations and the Patents Act 1983. The criteria for the regulatory approval and registration of pharmaceutical products for human use are found in the Drug Registration Guidance Document. The High Court stressed the importance that, the NPCB had not concerned itself with any patent protection aspects of the drug nor does it purport to grant any authorization to work the patent [2011] 1 LNS 16. The matter went on substantive appeal and was dismissed by the Court of Appeal.

- ***Adabi Consumer Industries Sdn Bhd v. Sri Nona Food Industries Sdn Bhd & 2 Ors [2017] 4 CLJ 600, High Court; Court of Appeal***

Represented Sri Nona Industries Sdn. Bhd., Sri Nona Food Industries Sdn. Bhd. And Lee Shun Hing Sauce Industries Sdn. Bhd. (“the Defendants”) in defending a civil action claim by Adabi Consumer Industries Sdn Bhd (“the Plaintiff”) in the High Court. The main causes of action were trade mark infringement and passing off and the Plaintiff further sought to cancel the ‘Adabi’ trade marks registered and/or pending for application in the name of the Defendants in respect of “oyster sauce”. The determination of these causes of action involved as well, the construction of a contract entered into between parties in 1998 and 2003.

The High Court judge found mainly in favour of the Plaintiff. Both parties appealed against the decision. Both appeals were ordered to be consolidated and heard over the course of 3 days. In essence, the Appeal required the Court to reaffirm the role of the Court vis-à-vis pending trade mark applications, the differences between assignment of common law rights as opposed to trade mark registration as well as significance and role of disclaimers in a registered trade mark.

The Appeals were subsequently withdrawn by both parties following a settlement, which terms are confidential.

- ***Winthrop Pharmaceuticals (Malaysia) Sdn Bhd v. AstraZeneca UK Limited [2015] 1 LNS 9***

Represented AstraZeneca in defending invalidation challenges levelled against its patent. This is one of the few cases that dealt with invalidation on the ground of rightful entitlement.

ACCOLADES

Asia IP

Best 50 IP experts in Malaysia in 2023

Chambers Asia-Pacific

Intellectual Property 2024 – Band 4 lawyer for 2 consecutive years (2023 and 2024)

- A client is of opinion that Michelle is “*absolutely fantastic in everything, including research, advice and litigation.*” – Chambers Asia Pacific 2024
- “*Michelle consistently delivers a high level of service. Her expertise, attention to detail and dedication ensures that clients receive thorough and effective legal support.*” – Chambers Asia Pacific 2024

I AM Patent 1000

Litigation 2023 – Silver Individual

- Michelle Loi is another “*competent litigator who is growing in court experience*”. – IAM Patent 1000 2021
- “*Ms Loi is not hesitant to go into every detail of the matter and always seek for clarification to substantiate her advice.*” - IAM Patent 1000 2022

The Legal 500 Asia-Pacific

Intellectual Property 2023 – Other Key Lawyer, previously Recommended Lawyer (2014, 2017-2019, 2021 and 2022)

- “*Michelle provides excellent, insightful advice and counsel.*” - The Legal Asia-Pacific 2022

- ‘Michelle Loi Choi Yoke is an upcoming lawyer.’ – The Legal Asia-Pacific 2020
- ‘Michelle Loi Choi Yoke offers a business-friendly advice at a reasonable cost.’ – The Legal Asia-Pacific 2020
- ‘keen and hardworking’ – The Legal Asia-Pacific 2018

Managing Intellectual Property IP Stars

Trademark Star (2021-2023)

World Trademark Review

Silver Tier in Enforcement and Litigation (2020-2022)

- “.....and Michelle CY Loi, should be the first ports of call for those seeking tailored litigation strategies.” – WTR 2022

Intellectual Property Asia IP

One of 50’s Asia and the Pacific’s Licensing Lawyers You Should Know (2015)

APPOINTMENTS/MEMBERSHIPS

- Immediate Past President, Licensing Executives Society of Malaysia
- Member, Intellectual Property Committee of the Bar Council Malaysia
- Trainer, Advocacy Training Course, Bar Council, Malaysia
- Panelist, Domain Name Dispute Resolution (2021-2024), Asian Arbitration International Centre (AIAC)
- Member, Competition Committee of the International Chamber of Commerce (ICC) Malaysia
- Member, Bar Council Malaysia

PUBLICATIONS

- For the past at least 5 years, Michelle is a regular contributor for the Malaysian Chapter for Katzarov’s Manual on Industrial Property.
<https://www.katzarov-manual.com/> (Upon subscription)
- Michelle co-authored the **Shaping Up Trademark Laws A Good Sign? (Aug 2021)**
<https://www.legaleraonline.com/intellectual-property/shaping-up-trademark-laws-a-good-sign-770560?infinitescroll=1>
- **The Rise of Merck and the Fall of SKB Shutters (Oct 2019)**
<https://www.shearnandelamore.com/whatnews/the-rise-of-merck-and-the-fall-of-skb-shutters/>
This article chronicles the challenges faced by patentees following the decision in SKB Shutters and the important decision handed down by the apex Court in the MSD case that expressly overruled SKB Shutters insofar as the state of a dependent patent claim is concerned.
- **Malaysia: Merck finally shuts the door of SKB Shutters (Oct 2019)**
<https://www.ipstars.com/NewsAndAnalysis/Merck-finally-shuts-the-door-of-SKB-Shutters/Index/4418>
This article touched on the very important (if not, most important) patent decision in Malaysia handed down by the Federal Court in the MSD case last year, of which the co-author represented MSD.

- **Copyright Issues Arising from Photos of Architecture (Mar 2019)**

<https://www.managingip.com/Article/3865422/Malaysia-Copyright-issues-arising-from-photos-of-architecture.html?ArticleId=3865422>

- **MALAYSIA: Court Rules on Sections of TMA and Goodwill Across Borders (Sept 2018)**

<https://www.managingip.com/article/b1kbprvxp8qr5m/malaysia-court-rules-on-sections-of-tma-and-goodwill-across-borders?ArticleId=3831228>

- **Malaysia-Market Surveys After Liwayway (Nov 2017)**

<http://www.conventuslaw.com/report/malaysia-market-surveys-after-liwayway/>

The preference for market surveys - what are the disadvantages? What gives? This article explores the Federal Court decision on the requisites to follow and the no-no's of a market survey.

- Michelle co-authored the **Malaysian Chapter of Franchising in Asia published by Lex Foundation (2015)**

Loi, M. (2015). Malaysia. In T. H. Kendal, Franchising in Asia 2015: Legal and Business Considerations (pp. 170-184). USA: LexNoir Foundation.

- **Franchising in Malaysia (Franchising in Asia, Legal & Business Considerations) (Oct 2013)**

https://www.nixonpeabody.com/-/media/Files/Alerts/165117_Franchise_Alert_30OCT2013.ashx

- **Malaysia Resists International Influence**

<https://patentlawyermagazine.com/malaysia-resists-international-influence/>