

PROFILE



Partner
Head, Intellectual Property
Head, Japan Desk
Personal Data Protection & Privacy Laws
Technology, Media & Telco
India Desk
Shearn Delamore & Co., Kuala Lumpur, Malaysia
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Qualifications

LL. B (Hons), University of Adelaide, South Australia
Graduate Diploma in Legal Practice, South Australia Institute of Technology
Barrister & Solicitor, South Australia Supreme Court
Advocate & Solicitor, High Court of Malaya
Industrial Design and Trademark Agent
Accredited Mediator of the Malaysian Mediation Centre

Languages

English, Malay

KAREN ABRAHAM

ABOUT KAREN

Karen Abraham is the Head of the Intellectual Property department of Messrs Shearn Delamore & Co. Her practice covers all aspects of Intellectual Property, Technology, Media & Telecommunications, Data Protection and Competition Law. She has more than 30 years of litigation experience in Intellectual Property matters, appearing in the Apex Courts in Malaysia. The Malaysian law journals bear testimony of how she has been instrumental in setting precedent in IP jurisprudence thereby establishing and evolving IP infrastructure in Malaysia over 3 decades. Abraham regularly provides legal counsel on all allied IP rights and advises on compliance and regulatory matters relating to food and drugs, domain name disputes, licensing, franchising, merchandising, commercial sales contracts, sponsorship, advertising and entertainment, and media broadcasting laws. Abraham is also experienced in all aspects of Information Technology (IT), e-commerce, and telecommunications related matters and cyber laws.

Abraham also works very closely with the Malaysian Ministry of Domestic Trade and Consumer Affairs (MDTCA) who are vested with the powers of enforcing IP rights under the existing IP legal regime including under Trademarks and Copyright, Consumer Protection and Trade Description legislations. Her enforcement practice focuses on crafting anti-piracy and anti-counterfeiting programmes for leading companies in the global market, as well as crafting innovative strategies and brand management schemes for global and local IP brands.

Abraham is the first woman in Malaysia to hold a position as Board Member of the International Trademark Association (INTA). Abraham was the Assistant Secretary General of the International Association for the Protection of Intellectual Property (AIPPI) and was the first Malaysian to sit on the Bureau of AIPPI. She also sits as Council member of ASEAN IP Association (AIPA) and in 2021, she was appointed the Asia Pacific Regional Forum Liaison Officer, IBA Intellectual Property and Entertainment Law Committee. Karen is an active committee member of the Asian Patent Attorneys Association, AIPPI and Marques.

Abraham is a Panellist on the Domain Name Dispute panel of the Asian International Arbitration Centre (AIAC) and a Panel member of the Malaysian Mediation Centre. She also serves the IP Committee and the Disciplinary Board of the Malaysian Bar Council.

EXPERIENCE

Litigation

Abraham has handled many high-profile matters including representing multinational conglomerates to Malaysian made corporations. Abraham has made her mark in the Malaysia Courts by being involved and contributing to landmark decisions made by the Courts of Malaysia. The following are instances of the same: -

- **Established a novel point of law in Mead Johnson Nutrition (Malaysia) Sdn Bhd v Public Prosecutor [2020] MLJU 1091**

Successfully acted for the multinational infant milk powder manufacturer, Mead Johnson Nutrition, who is the Defendant in this state action. Two summonses were issued against the Defendant. However, the first charge was never read to the Defendant while the second charge which carries a different punishment was filed and read to the Defendant after the limitation period prescribed time in section 19(2) of the Food Act 1983. The crux of this issue was the validity of the second charge – i.e. if it was an amended charge or a new charge.

A striking out application to strike out the Prosecution's case on the basis that it was instituted beyond the prescribed time period. The strike out application was dismissed by the Magistrates' Court on. On behalf of the Defendant, we appealed against the decision of the Magistrates' Court to the High Court.

At the High Court, amongst others, one of the questions posed to the High Court was whether the failure of the prosecutor to read the original charge to the accused within the time limit implies that the original charge was not activated in law. The High Court decided in favour of the Defendant and reversed the Magistrates' Court's decision to dismiss our striking out application.

- **Represented subsidiary of British American Tobacco (Malaysia) Berhad in an invalidation proceeding**

Acted as counsel for a subsidiary of the leading tobacco company in Malaysia for an invalidation/cancellation proceeding for non-use of a trademark. A novel argument that conducting research and development constitute use of a trademark was raised. The Court ultimately found for the Plaintiffs to the suit.

- **Landmark decision in Tokai Corporation v DKSH Malaysia Sdn Bhd [2016] MLJU 621**

Obtained a landmark decision from the Malaysia High Court by establishing thresholds to be met for survey evidence in trademark cancellation actions. Abraham represented the Defendant, DKSH Malaysia Sdn Bhd, a leading provider in Malaysia of market expansion services for Consumer Goods, Healthcare and Performance Materials.

- **Landmark decision in Agricultural and Processed Food Products Export Development Authority of India (APEDA) & Ors v Syarikat Faiza Sdn Bhd [2011] 2 MLJ 768**

Acted as lead counsel for the Applicants including Agricultural and Processed Food Products Export Development Authority of India (APEDA), a statutory authority under the Government of India which is engaged in the development and promotions of exports of certain agricultural and processed food products from India, including a variety of rice known as Ponni rice. The traditional concept of confusion was invoked in respect of geographical indication. The High Court accepted the argument and found for the Applicants.

- **Landmark decision in Tiga Gajah Cho Heng Sdn Bhd v Majuperak Tepung Beras Sdn Bhd [1997] 4 MLJ 504**

Represented the Applicant, Tiga Gajah Cho Heng Sdn Bhd, before the High Court as well as in the appeal before the Court of Appeal. The High Court established the ingredients required for a Trade Description Orders ("TDO"). The Court of Appeal imposed an unprecedented additional requirement that the Applicant annex the subject mark that was deemed to be a false trade description to the TDO.

Enforcement

Abraham has represented various high-profile luxury brands across the world to ensure the value of their IP rights are not tarnished or diluted by counterfeit products. Joint enforcement programmes and anti-counterfeiting strategies were initiated and carefully engineered by Abraham to sweep through the country to identify and eliminate counterfeit markets.

- **Largest seizure of counterfeit cigarettes with the joint efforts of the Malaysia Ministry of Domestic Trade and Consumers Affairs (MDTCA) and the Royal Malaysian Customs (RMC)**

Successfully facilitated the largest seizure of illicit cigarette in the Malaysian ports where a total of 3.5 million units of cigarettes packets with the estimated value of the total seizure is RM31.5 million. This was the joint efforts of MDTCA and RMC.

- **Federal International Football Association (FIFA)**

Acted for FIFA during FIFA World Cups against various entities based on ambush marketing and unfair competition.

ACCOLADES

Asian Legal Business

Recognised as one of ALB Asia's Top 15 Female Lawyers (2022)

Asialaw Leading Lawyers

Intellectual Property 2023 – Elite Practitioner for 4 consecutive years (2020-2023); Previously Market Leading Lawyer for 3 consecutive years (2017-2019)

- *"Karen Abraham is a trail blazer. Vast knowledge, practical and great social skills!"* – Asialaw Profiles 2023
- *"Karen is an excellent TM and IP attorney. She is extremely knowledgeable in Malaysian IP law. She is an acknowledged dean of the Malaysian IP Bar. A terrific attorney...."* – Asialaw Profiles 2023

- *“Karen is able to provide good insights on enforcement work.”* – Asialaw Profiles 2023
- *“She managed the matter well and I felt she was ‘on top of things’. Energetic.”* – Asialaw Profiles 2023
- *“Karen is a star when it comes to dealing IP matters and is able to provide me with sound commercially sensible options for achieving our goals.”* – Asialaw Profiles 2022
- *“I’ve worked with Karen for many years, both at Teva and at Johnson & Johnson. She is an excellent attorney, always providing sound and efficient counsel.”* – Asialaw Profiles 2020
- Market-leading lawyer Karen Abraham leads *“a large, efficient and knowledgeable group able to handle both the legal and technical side of IP matters”* at Shearn Delamore & Co, according to a client. – Asialaw Profiles 2018
- *“She [Abraham] gives solid advice and provides a reliable service. She is contactable late at night and during the weekends,”* says a client. – Asialaw Profiles 2016
- Abraham is described as *“very client-oriented and efficient,”* and a lawyer who *“shows personal interest and takes initiative to get closer to the client to be able to help more appropriately”*. – Asialaw Profiles 2014
- Abraham is praised for her *“communication and responsiveness.”* – Asialaw Profiles 2015

Acquisition International

Recognised as a Leading Women in IP Spotlight (2019)

Asia Business Law Journal

Listed as one of Malaysia’s Top 100 Lawyers for 3 consecutive years (2019 – 2021)

Asia IP Experts

Recognised as Best 50 “IP Expert” in Malaysia (2020 - 2023)

Asialaw Client Service Excellence

Recognised as an Outstanding Lawyer (2020)

Benchmark Litigation Asia-Pacific

Intellectual Property 2023 – Litigation Star (2022 – 2023)

- *“Karen Abraham is a trail blazer.”* - Benchmark Litigation Asia-Pacific 2022
- *“Excellent communication skills and technical knowledge.”* - Benchmark Litigation Asia-Pacific 2022
- *“Knowledgeable, responsive and accountable.”* - Benchmark Litigation Asia-Pacific 2022

Chambers Asia-Pacific

Intellectual Property 2024 – Band 1 Leading lawyer in Malaysia for 5 consecutive years

- A client appreciates how she *“consistently provides outstanding intellectual property work expeditiously and reaches positive results that assist clients with achieving their business goals.”* - Chambers Asia-Pacific 2024
- It was stated by a client that she *“has excellent knowledge of the law and doesn’t hesitate to think out of the box to build a new strategy.”* - Chambers Asia-Pacific 2024

- A client notes that “*Karen is excellent. She has an awareness to the unique challenges that we face and always explains quite complex matters in a clear and concise way.*” - Chambers Asia-Pacific 2023
- *Another client describes her as “responsive and knowledgeable in IP rights.”* - Chambers Asia-Pacific 2023
- A client lauds her as “a fantastic and very knowledgeable and senior lawyer.” – Chambers Asia-Pacific 2021

Corporate Live Wire Global Awards

Recognised as an IP Lawyer of the Year (2019)

- Highlighted in the 9th edition of the Malaysia Book of Records as the first Malaysian to be appointed on the Board of the Association for the Protection of Intellectual Property (AIPPI) and first Malaysian Woman appointed on International Trademark Association Board of Directors (INTA)

Global Intellectual Property Alliance

Board Member and Executive Committee

Global Intellectual Property Alliance for Asia

Co-chair for Asia

Global Advisory Experts

Intellectual Property Advisory Expert of the Year in Malaysia (2023)

IAM Patent 1000

Silver Individual in Litigation (2023)

Leaders in Law Global Awards

Recognised as an Intellectual Property Expert of the Year in Malaysia for 2 consecutive years (2021-2022)

Managing IP Awards Asia Pacific

Malaysia Practitioner of the Year 2023

Managing Intellectual Property IP Stars

Recognised as one of the Top 250 Women in IP for 8 consecutive years (2016 - 2023)

Recognised as a Trademark Star for 6 consecutive years (2018 - 2023)

Expert Guides

Trademarks 2022 – Leading Practitioner for 4 years (2018 – 2022)

Women in Business Law 2022 – Leading Practitioner for 4 consecutive years (2018 - 2022)

The Lawyer Network Annual Awards

Recognised as an Intellectual Property Advisory Expert of the Year in Malaysia (2022)

The Legal 500 Hall of Fame

Highlighted in the Hall of Fame for Intellectual Property in Malaysia (2020 - 2022)

The Legal 500 Asia-Pacific

Intellectual Property 2020 – Leading Individual for 11 consecutive years (2010 – 2020)

Intellectual Property 2022 – Recommended Lawyer for 2 consecutive years

TMT 2022 – Recommended Lawyer

- *“Karen Abraham is amazing.” - The Legal 500 Asia-Pacific 2023*
- *“Karen Abraham and ... stand out for their expertise, experience and knowledge of trademark law, as well as for their honesty and integrity.” - The Legal 500 Asia-Pacific 2023*
- *“Karen Abraham is the best there is in Malaysia and the region, in my opinion. She is extremely knowledgeable and easy to work with. She employs her wide array of contacts within the TM field to ensure that her clients obtain the best results.” - The Legal 500 Asia-Pacific 2023*
- *“Karen Abraham andare excellent attorneys. Karen is the best there is. Extremely easy to work with, tremendously responsive, and very knowledgeable about all areas of Malaysian IP law.” - The Legal 500 Asia-Pacific 2022*
- *Karen Abraham is an outstanding figure. Her understanding of both the legal as well as the commercial intricacies of the clients’ businesses is unrivalled.” - The Legal 500 Asia-Pacific 2022*
- *“Karen Abraham is the safe hands that leads this team, and she sets the bar extremely high for her team’s performance, in delivering world-class service and advice. She is world-class and an elite amongst IP practitioners.” The Legal 500 Asia-Pacific 2021*
- The eight-partner team is led by IP litigator Karen Abraham and benefits from 'a great depth of knowledge and experience'. The Legal 500 Asia-Pacific 2020

WIPR Leaders

Global IP Leader in Intellectual Property 2023

Who’s Who Legal

IP Trademarks 2023 – Global Elite Thought Leader 2023

Trademarks and Patents 2023 - National Leader (Southeast Asia) (2021 and 2023); Global Leader (2019-2022)

IP Patents 2023 – Global Leader 2023

Patents & Trademarks 2018 – Expert for 6 consecutive years (2013 – 2018)

World IP Review

Identified as one of the 80 Influential Women in IP in 2019

World Trademark Review

Enforcement and Litigation 2022 – Gold Tier for 7 consecutive years (2016 – 2022)

- *“She can move you forward when you’re faced with the most challenging obstacles and supplements her instructive and insightful advice with a deep knowledge of regulatory frameworks.”* - World Trademark Review 2018
- *“highly experienced brands lawyer”* Karen Abraham steers the IP practice with a steady hand. - World Trademark Review 2020
- A client noted that *“Karen is our go-to person for trademark mark matters in Malaysia. She can handle it all and she handles it incredibly well. Her expertise, knowledge and ability to manage complex, multi-jurisdictional trademark projects is just the tip of the iceberg of her strengths, and I especially recommend her for her litigation and advocacy skills. She is a very safe pair of hands for all my trademark matters and she is an incredible person to work with”*. - World Trademark Review 2021
- Another client stated that they *“enjoy working with Karen all the time”* as *“she always has our best interests at heart and her service is not just business to business but person to person. She knows me as well as my brand, going above and beyond to make sure I’m connected to all the best sources in the world. I do not just have the best IP lawyer but a friend in the business”*. - World Trademark Review 2021
- Karen is also known as *“an authority on all things intellectual property, with particular strength in litigation and anti-counterfeiting, Karen is also active in the global IP conversation”* and *“a dynamic expert in IP and TMT matters, Karen’s in-depth practical knowledge coupled with her vast experience in the IP industry makes her a valuable role model to young practitioners”*. - World Trademark Review 2021
- *“Given its close connection to local authorities, high-profile brands often seek out its experts, such as Karen Abraham, to swoop in and eliminate counterfeit markets. Abraham is widely lauded for her ability to dispense astute advice and pay attention to detail without losing sight of the big picture in contentious matters. Karen is extremely bright and talented. Her deep knowledge and expertise allow her to navigate multi-jurisdictional trademark matters with ease. She handles matters with utmost professionalism and dedication, always going above and beyond. Her litigation and advocacy skills elevate her to a class above.”* - World Trademark Review 2022

World Trademark Review: Private Practice

Identified as one of WTR Global Leaders: Private Practice (2019 - 2022)

World Intellectual Property Organization

Accredited Mediator (2022)

APPOINTMENTS/MEMBERSHIPS

- Advocate and Solicitor, Malaysian Bar
- Advocate and Solicitor, South Australia Bar
- Domain Name Dispute Resolution Panellist, Asian International Arbitration Centre (AIAC)
- Accredited Mediator, World Intellectual Property Organization (WIPO)
- Past Board of Director, International Trademark Association (INTA)
- Past Board of Director, International Association for the Protection of Intellectual Property (AIPPI)
- Council Member, ASEAN Intellectual Property Association (ASEAN IPA)

- Co-Chair, Emerging IP Rights committee of the Asian Patents Attorneys Association of Malaysia (APAA)
- Co-Chair, Traditional Cultural Expressions Subcommittee, International Association for the Protection of Intellectual Property (AIPPI)
- Board member and Executive Committee for Global Intellectual Property Alliance (GLIPA)
- Co-chair for Asia, Global Intellectual Property Alliance for Asia (GLIPA for Asia)
- Committee Member, Anticounterfeiting Committee, INTA
- Far East Committee Member, American Intellectual Property Law Association (AIPLA)
- Asia Pacific Regional Forum Liaison Officer, IBA Intellectual Property and Entertainment Law Committee
- Committee Member, Technology Law Committee, IBA
- Committee Member, Anticounterfeiting Committee, MARQUES
- Committee Member, IP and GRTK Standing Committee, International Association for the Protection of Intellectual Property (AIPPI)
- Committee Member, Event Committee, Malaysia Australia Business Council (MABC)
- Committee Member, Intellectual Property of the Malaysian Bar Council
- Committee member, Mediation Committee of the Malaysia Bar Council
- Associate Member, UK Chartered Institute of Arbitrators
- Panel of Accredited Mediators of Malaysia
- MCN Accredited Member, Federation of Integrated Conflict Management (FICM)
- Member, IBA
- Member, Inter-Pacific Bar Association (IPBA)
- Member, International Chamber of Commerce (ICC)
- Member, AIPPI
- Member, INTA
- Member, Malaysian International Property Association (MIPA)
- Member, Malaysian Mediation Centre
- Member, Asian Patent Association Attorneys (APAA)
- Member, Licensing Society of Malaysia (LES)
- Member, LAWASIA, the Malaysian Invention and Design Society (MINDS)

PUBLICATIONS

- Manual for the Handling of the Applications for Patents, Trademarks and Designs (Brown Book), 2022
- Law Business Research Ltd: The Intellectual Property Review, Tenth Edition, 2021
- Brexit and Your Marks in the UK: A Brief Report, 2021
- Lexology - Arbitrating Intellectual Property Disputes: Lessons from Hong Kong and Singapore, 2020
- Author, Industrial Design Rights: An International Perspective (3rd Edition) – Wolters Kluwer, 2020
- Co-author, AIPPI Law Series: Genuine Use of Trademarks – Wolters Kluwer, 2020 and 2018
- Co-author, Chambers Global Practice Guide 2019 Malaysia Pharmaceutical Advertising: Q&A
- Co-author, International Comparative Legal Guide to: Trademarks 2019 - Global Legal Group, 2019
- Co-author, International Comparative Legal Guide to: Trademarks 2018 - Global Legal Group, 2018
- Co-author, Sweet & Maxwell: Domain Name Dispute Resolution, 2018
- Author, Managing IP: Monetising IP assets – Malaysia, 2018
- Co-author, Managing IP: ASEAN Proposes Pan-ASEAN Trademark System, 2018
- Co-author, Managing IP: Asia-Pacific IP Focus, 2018
- Author, INTA ASEAN: IP and the latest developments, 2017
- Author, Asia IP: GIs and the Road Ahead, 2017
- Co-author, International Patent Litigation: Malaysia Chapter - Bloomberg BBNA, 2017
- Co-author, Trademark Litigation Handbook - Thomson Reuters, 2022, 2017 and 2013

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- Author, World Trademark Review: Anti-Counterfeiting Guide, 2017, 2016, 2015, 2014, 2013, 2012, 2011 and 2010
 - Author, Arbitration in Malaysia: A Practical Guide - KLRCA, 2016
 - Co-author, World IP Review - Newton Media Limited, 2016, 2015, 2014, 2013 and 2012
 - Author, Managing IP: APAC IP Focus, 2015
 - Author, Center for International Legal Studies: World Intellectual Property Rights and Remedies, 2015
 - Author, Thomson Reuters: Copyright Litigation, 2015 and 2010
 - Author, The European Lawyer Reference: Copyright Litigation, 2015 and 2010
 - Author, The European Lawyer Reference: Trademark Litigation, 2013
 - Author, Acquisition International: Intellectual Property through M&A, 2012
 - Author, Managing IP: Managing IP in the Credit Crunch, 2009
 - Author, Managing IP: Top of the to-do List, 2008
 - Author, Asian Counsel: Employment Special Report, 2007
 - Author, Asian Counsel: Changing the laws by which we work, 2007
 - Author, Managing IP: Zero tolerance for infringement, 2007
 - Author, AIPPI Newsletter: Landlord liability in Intellectual Property, 2006
 - Author, Managing IP: Malaysia's IP Shopping List, 2006
 - Author, Managing IP: Brand Management Focus, 2005
 - Author, Managing IP: Legislative changes boost IP enforcement, 2004
 - Author, Asian IP: Price fixing - The next frontier in combating piracy, 2003