

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.

Karen 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.

Karen 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.

Karen 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

Karen 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 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

Benchmark Litigation Asia-Pacific

Intellectual Property 2025 – Litigation Star (2022 - 2025)

- *"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 – 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

The Legal 500 Hall of Fame

Highlighted in the Hall of Fame for Intellectual Property in Malaysia (2020 - 2025)

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

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

- Co-author, Trademark Litigation Handbook - Thomson Reuters, 2022, 2017 and 2013
- 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
- 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