

PROFILE



Partner
Intellectual Property
Competition Law & Antitrust
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Shearn Delamore & Co, Kuala Lumpur, Malaysia

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Qualifications

LL. B (Hons), University of Leicester

Barrister-at-Law, Lincoln's Inn

Advocate & Solicitor, High Court of Malaya

Advocate & Solicitor of the Supreme Court of the Republic of Singapore

Trademark Agent and Industrial Design Agent

Geographical Indications Agent

Languages

English, Malay

INDRAN SHANMUGANATHAN

ABOUT INDRAN

Indran's practice largely involves seasoned IP litigation relating to Trademark, Copyright, Patent and Industrial Design litigation. Indran regularly appears as Lead Counsel in complex and novel cases some of which now serve as landmark IP cases which encompass cutting edge IP issues in the High Court, Court of Appeal, and the Federal Court (Apex Court). He has also been sought out to do Counsel work for both IP and civil commercial litigation matters.

Indran was the Lead Counsel in a historic landmark case [*MERCK SHARP & DOHME GROUP & ANOR v. HOVID BHD* [2019] 9 CLJ 1] which successfully resulted in the extremely rare occurrence of the Federal Court overturning one of its previous decisions. Given that this feat has been achieved only 6 times in Malaysia's history since 1967, he stands as the first IP lead counsel in the first IP case before the Federal court in Malaysia to achieve this credential. He has also been recognised and listed as one of the "World's leading IP strategists". Indran has been accorded the accolade of "Asialaw Regional Award 2019 for Outstanding Practitioner in Malaysia." He has advised and litigated on IP issues with major industry players from a varied cross section of industries such as major renowned worldwide sporting bodies, pharmaceutical companies, automotive companies, hotels chains, restaurants and various consumer product companies on IP rights and disputes. He continues to be actively involved in IP enforcement and anti-counterfeiting work often collaborating with government bodies.

Indran's varied non contentious IP portfolio often sees him sought out for tailor made niche advisory services to clients which broadly include transactional work, IP registration, due diligence exercises, implementation of IP protection strategies, advisory, drafting and regulatory processes relating to various IP, IT, E-

commerce, Tech and Franchise Agreements, Media Broadcasting (Advertising) and the Communication and Multimedia Act amongst others. His experience further extends to Pharmaceutical and Food Advertising, Domain Name Disputes, licensing, sponsorship, and merchandising matters. He also advises on matters relating to Personal Data Protection & Privacy Laws and on Competition Antitrust related work to compliance including the preparation of competition policy, competition dispute resolution.

EXPERIENCE

He regularly appears as Lead Counsel in complex and novel cases or appeals which encompass cutting edge IP issues across all levels of the Malaysian courts. Over the last 2 decades, Indran is often sought out for his expertise towards formulating litigation strategies and for IP start-up / management issues. Throughout his litigation career, he has worked with various professionals and experts globally, across various industries to formulate bespoke case strategies tailored for the succinct or variable need in the case. To this end, he has obtained recognition as one of the “*World’s leading IP strategists*”. His litigated cases have been reported and have also provided, reference and/or precedent value which have also served as landmark decisions. Here are just some of those reported noteworthy cases:

- **MERCK SHARP and DOHME CORP. (“MSD”) v HOVID BERHAD**
[Federal Court Civil Application No. 08-470-10/2017]
[2019] 9 CLJ 1

Patent Invalidation: Indran acted for the pharmaceutical giant, Merck Sharp & Dohme (MSD), the proprietor of the 194 Patent, and its local licensee, in patent infringement action against Hovid Berhad (“Hovid”). In this case, the High Court and Court of Appeal were bound by the Federal Court case of *SKB Shutters Manufacturing Sdn Bhd v Seng Kong Shutters Industries Sdn Bhd & Anor* [2015] 6 MLJ 293 (“*SKB Shutters case*”). Indran successfully led and argued during the Appeal to the Federal Court, to overturn the binding case on a question of law, where the majority of the Federal Court departed from its own previous decision. Quite apart from the fact that it is indeed very rare for the Federal Court to depart from its previous ruling, the impact of the case, has also proved to be far reaching. Mention must be made that this is only the 6th time in the nation’s history since 1967 where a counsel has been able to persuade the Federal Court to overrule its previous decision to set a new path to the law and this case also remains to be first IP case in the Federal court to be overturned.

Other than the significance in terms of the rarity of the decision as alluded to above, the impact of the decision is also far reaching. The status of dependant claims which were long recognised as a fall back on narrower claims in the event, that the broader independent claims were found to be invalid has now been restored. Potentially, 100,000 patent grants/ applications would have been affected if not for the outcome of the MSD case. In fact, there was lobbying carried out by various quarters in the IP industry to have the Patents Act amended post the SKB Shutters case to deal with the difficulties created by the SKB shutters ruling which now may no longer be necessary.

This decision has been welcomed both locally and globally by practitioners and patentors alike, for the impact it has made in the law. This decision now resolves the dilemma that patent drafters had previously faced on how claims were to be drafted and the level of consistency required between Malaysian patent claims and patent claims in other jurisdictions. This decision resulted in the Malaysian practice to be once again aligned with the position in most jurisdictions. This case, while setting the historic standard is also a reported landmark decision with great precedent value. It has also received extensive global and local attention where the decision has been the subject of commentary and publishing interest.

- **LIWAYWAY MARKETING CORPORATION v OISHI GROUP PUBLIC COMPANY LIMITED**

[Civil Appeal No 02(i)-57-09 of 2015] (Federal Court)
[2017] 4 MLJ 141]

Expungement of trademark under section 46 of the Trademarks Act 1976: Indran was instructed by the Appellant to lead and argue this appeal to the Federal Court on pertinent questions of law surrounding the concept of non-use of registered trademarks under The Trademarks Act 1976. The dispute surrounded competing rights to the trademark OISHI as well as the factors to be considered in expunging a trademark from the register of trademarks on the grounds of non-use. In deciding in favour of the Appellant, the Federal Court considered and provided precedent value for the standard and burden of proof for survey evidence and this case remains the leading authority on survey evidence. Also, of precedent value is the position of the party who is first to assert rights to a trademark in Malaysia although not necessarily being the first party in the course of trade, to use the said trademark.

- **YONG SZE FUN & ANOR (T/A PERINDUSTRIAN MAKANAN & MINUMAN LAYANG-LAYANG) v SYARIKAT ZAMANI HJ TAMIN SDN BHD & ANOR**

[Civil Appeal No W-02–367 OF 2006] (Court of Appeal)
[2012] 1 MLJ 585

Passing Off: Indran represented the Plaintiffs in the Court of Appeal which involved a dispute over the trademark TAMIN. This reported case has provided a good and sound precedent reference for laying down the principles for passing off. The Court of Appeal in finding for the Plaintiffs, set out and confirmed the necessary prerequisites to sustain an action in passing-off. Particularly important is the determination on priority in terms of rights to a trademark or get-up in Malaysia as well as the threshold to show actionable misrepresentation. The case provided further precedent value by stating the circumstances where a licensee could commence an action for passing-off and whether third parties unconnected with the genuine products could rely on the purported relationship between the licensor and licensee as a defence.

- **MEIDI (M) SDN BHD v MEIDI-YA CO LTD, JAPAN & ANOR**

[Civil Appeal No W-02–563 OF 1998] (Court of Appeal)
[2008] 6 MLJ 433

Passing Off: Indran successfully represented the Appellant, Meidi (M) Sdn Bhd in this Appeal which also went on to become a reported decision with precedent value. This decision provided precedent value with regards to the point on the finding of the territorial scope of trademark protection and priority in terms of rights to a trademark in Malaysia. The Court of Appeal further considered the circumstances where trademarks could co-exist both on the register and in the market.

- **MEIDI-YA CO LTD, JAPAN & ANOR v MEIDI (M) SDN BHD**

[Civil Appeal No. 02–8 OF 2007(W)] (Federal Court)
[2009] 2 MLJ 14

Passing-off and framing of questions of law for the determination of Federal Court: This case was an appeal by the Meidi-Ya Co Ltd, Japan against the decision of the Court of Appeal in civil appeal no: W-02-563. In dismissing the appeal, the Federal Court held that the questions for which leave was sought did not pass the then requisite threshold for leave as set out in the Courts of Judicature Act. It should be noted that this reported case carried precedent value for setting the threshold for leave at that time.

- **MCLAREN INTERNATIONAL LTD v LIM YAT MEEN**

[Civil Appeal No 02(f)–2 OF 2008(W)] (Federal Court)
[2009] 5 MLJ 741

Expungement of trademark under section 45 of the Trademarks Act 1976: Indran represented McLaren in this appeal to the Federal Court which was a reported landmark decision as well. The Federal court determined the necessary threshold for *locus standi* as an aggrieved party before a cancellation action could be instituted. The Federal Court held that the Plaintiff in such an action should have used of the trademark in issue or had a genuine trading interest or future interest in the said trademark. The Federal Court also considered what amounted to requisite use of a trademark in the context of an action for cancellation of a registered trademark on the grounds of non-use. It must be pointed out that this reported case still sets the threshold test at present to determine the *locus standi* for an “aggrieved party”.

- **EL BAIK FOOD SYSTEMS CO. S.A. v THE REGISTRAR OF TRADEMARKS AND AL BAIK FAST FOOD DISTRIBUTION CO. SAE**
[Kuala Lumpur Originating Summons No. WA-24IP-4-01/2019] (High Court)
[2019] MLJ 552

Trademark & Copyright: Indran acted for the Saudi based food and beverage outfit El Baik Food Systems Co. S.A. (“**the Plaintiff**”) in an appeal at the High Court from the decision of the Registrar of Trademarks in a Trademark opposition matter. This case was the final saga of an extensive dispute between the Plaintiff and Albaik Fast Food Distribution Co SAE over competing rights to the ALBAIK trademark. The High Court, as a novel point accepted the concept of “spill-over and cross border goodwill” without the necessity of physical business presence in Malaysia. In finding for the Plaintiff, the High Court held that the lack of physical presence did not preclude the Plaintiff from claiming goodwill and reputation in Malaysia thereby granting the Plaintiff priority over the Defendant. This case is also of worthy precedent value and was duly reported.

- **GODREJ SARA LEE LTD v SIAH TEONG TECK & ANOR (PART 2)**
[Originating Motion No. D5–25–2 of the 2007] (High Court)
[2007] 7 MLJ 164

Expungement of trademark under section 45 and 46 of the Trademarks Act 1976: Indran represented the Plaintiffs in this matter to lead and argue the case which dealt with the requisite evidentiary standard to show non-use of a trademark to sustain an action for cancellation of a registered trademark. In finding for the Plaintiff, the High Court also addressed the issue of what would amount to special circumstances to excuse the non-use of the trademark. This case carries precedent value and has since been reported.

- **NEW-WEST MANAGEMENT GROUP SDN BHD & ANOR V NG AH KOW & ANOR**
[Suit No. D5-22-1090-2007] [2008]
[2008] 8 CLJ 18

Indran represented the Plaintiff successfully in this action for passing-off and breach of contract. To preserve its position, the Plaintiff applied for an interlocutory injunction to restrain the Defendant from using the offending trademark and tradename. This case is important as the Plaintiffs sought to restrain the Defendants from using their own names in their clinic business after the Defendants had transferred rights to the same to the Plaintiff. The High Court in granting the interlocutory injunction held that notwithstanding the fact that the Defendants were only requiring the use of their own names, they were not entitled to derogate from a grant that they had contractually given to the Plaintiffs for good and valuable consideration. The High Court in finding for the Plaintiff also set out and reaffirmed the necessary requisites for interlocutory injunction. This reported case is also important for precedent value as it sets out the exceptions under the Contracts Act where terms in restraint of trade could be enforced.

- **USA PRO IP LIMITED v MONTFORT SERVICES SDN BHD**
[Originating Summon No: 24IP - 9 - 03/2014] (High Court, Court of Appeal and Federal Court)

[2015] MLJ 454)

Expungement of trademark under section 46 of the Trademarks Act 1976: Indran represented the Plaintiffs in this case which was originally heard in the High Court where the Plaintiff applied to expunge the Defendant's registered trademark on the grounds of non-use. In finding for the Plaintiff, the High Court set out the requisite burden and standard of proof necessary to show non-use. The High Court further clarified the relevant period of non-use and whether the absence of survey evidence was fatal to such application thereby setting crucial precedent value. The Defendant's appeal to the Court of Appeal was dismissed and leave to appeal to the Federal Court was not granted thereby affirming the decision at first instance.

ACCOLADES

Benchmark Litigation Asia-Pacific

Intellectual Property 2025 – Litigation Star for 5 consecutive years (2021 – 2025)

Intellectual Property and Dispute Resolution 2020 – Litigation Star

Chambers Asia-Pacific

Intellectual Property 2025 – Band 1 lawyer (2024 - 2025), previously Band 2 Leading individual for 5 consecutive years (2019 - 2023)

- *"Indran possesses exceptional qualities in critical thinking, domain expertise, and collaboration and communication. His adeptness at collaborating and effectively communicating with others makes him an invaluable asset in solving intricate legal challenges."* - Chambers Asia-Pacific 2024
- *"He is a very sought-after IP lawyer with vast experience and in-depth knowledge. He is accessible and very good at building a relationship with his clients."* - Chambers Asia-Pacific 2024
- Another client notes that *"Mr Indran defines professional."* – Chambers Asia-Pacific 2023
- A client lauds him as *"Indran has done a great job in court. He is thoughtful, organised and a pleasure to work with. He is able to argue very complex issues and does not shy away from complex legal arguments."* – Chambers Asia-Pacific 2023
- A source describes him as *"excellent in litigation and very thorough."* – Chambers Asia-Pacific 2022
- A client praises him for being *"accessible, extremely prompt in responding and so experienced and knowledgeable, with the ability to provide an in-depth perspective on issues involved."* – Chambers Asia-Pacific 2021
- *"Indran Shanmuganathan is a respected litigator who regularly receives instructions on trademark, patent and copyright infringement matters. He represents several leading global clients, as well as local corporates."* – Chambers Asia-Pacific 2020
- Indran Shanmuganathan is described by a client as *"a lawyer who is able to provide balanced advice based on his vast experience,"* and they also highlight his *"high level of integrity, being accessible when required, with very prompt follow-ups."* – Chambers Asia-Pacific 2019
- Clients are quick to confirm that he is *"very experienced and knowledgeable,"* and *"provides sound advice."* – Chambers Asia-Pacific 2018

Legal 500 Asia-Pacific

Intellectual Property 2025 – Leading Individual (2021 - 2025)

Intellectual Property 2020 – Recommended Lawyer for 5 years (2014, 2017 - 2020)

- *“Indran and his team act in the best interests of the client. They commit their time and ensure that they have sufficient resources to provide their best advice to the client. Mr Indran is an exceptional figure in providing constructive advice.”* – The Legal 500 Asia-Pacific 2022
- *“Indran Shanmuganathan has great court presence, good at cross examining and thoughtful before the court.”* – The Legal 500 Asia-Pacific 2022
- *“Indran Shanmuganathan is an experienced lawyer with good tactical knowledge and intimate awareness of legal complexities”.* – The Legal 500 Asia-Pacific 2021
- *“Mr. Indran Shanmuganathan – A well experienced IP lawyer who is accessible, honest with his legal opinions, professional and easy to work with. He is prompt with his advise and always on top of all matters”.* – The Legal 500 Asia-Pacific 2021
- *“Indran Shanmuganathan is a well-experienced IP practitioner who is very knowledgeable, willing to share his experience, provides honest view of the case, easily accessible and very down to earth.”* – The Legal 500 Asia-Pacific 2020
- *“... the ‘highly experienced’ Indran Shanmuganathan handles a range of trademark, copyright, patent and industrial design litigation...”*
- *“the ‘passionate, straightforward and candid’ Indran Shanmuganathan is ‘a sheer pleasure to deal with’.*

APPOINTMENTS/MEMBERSHIPS

- Council Member, Asian Patents Attorneys Association of Malaysia (APAA)
- Member of Governing Council, Asean Legal Information Centre (Asean LIC)
- Member, Malaysian Bar
- Member, The Honourable Society of Lincoln’s Inn
- Member, International Bar Association (IBA)
- Member, International Trademarks Association (INTA)
- Member, Malaysian Intellectual Property Association (MIPA)
- Member, Pharmaceutical Trademarks Group (PTMG)
- Member, The Honourable Society of Lincoln’s Inn Alumni Association, Malaysia
- Member, University of Leicester Alumni

PUBLICATIONS

- Co-edited: Law and Practice of Intellectual Property in Malaysia ” Thomson Reuters (2025)
- Co Author: To Split or Not To Split: Bifurcated Trials in Intellectual Property Matters ” The Law Review by Sweet & Maxwell Asia [2025] LR 79
- Co Author: A Primer on Fair, Reasonable and Non Discriminator y (FRAND) Licensing ” The Law Review by Sweet & Maxwell Asia [2023] LR 277 (September 2024)
- Co Author: The Interplay between Patents and Trade Secrets ” The Law Review by Sweet & Maxwell Asia [2023] LR 88 (April 2024)
- Contributor: The Legal 500: Patent Litigation Country Comparative Guide (Malaysia) Malaysia)” Legal 500 (2024)
- Author: “The Annotated Trademarks Act 2019” – Sweet & Maxwell (2021)

- Author: “Trademarks Act 2019 with Overview by Indran Shanmuganathan” – Sweet & Maxwell (2020)
- Co-author: “Trademark Litigation Handbook” – Thomson Reuters (2013, 2017 and 2022)
- Co-Author: “ChatGPT: The Pandora’s Box Opened?” – Legal Era Publication (October 2023)
- Co-Author: “ChatGPT: The Next Step in Evolution or an Intellectual Property Minefield?” – The Law Review by Sweet & Maxwell Asia [2023] LR 133 (July 2023)
- Co-Author: “Blinding Colours: Should Single Colour Trademarks Be Registrable?” – The Law Review by Sweet & Maxwell Asia [2023] LR 272 (April 2023)
- Co-Author: “The Position of Trade Mark Disclaimers” – Chambers and Partners Practice Guide (February 2023)
- Co-author: “The POSITA Position – Ordinary Person or Ordinary Skill?” – Chambers and Partners Practice Guide (January, 2023)
- Co-author: “Copyright Act 1987 – An Overview of Sections 13A and 13B” - The Law Review by Sweet & Maxwell Asia [2022] LR 350 (January 2023)
- Co-author: “The Role of Patent Specification in Claim Construction: A Comparative Overview” – The Law Review by Sweet and Maxwell Asia [2022] (2) LR 277 (August 2022)
- Co-author: “A Crumbs Up from the Federal Court: Munchy Food Industries Sdn Bhd v Huasin Food Industries Sdn Bhd [2021] 8 AMR 405; [2022] 1 MLJ 377” – The Law Review, Volume 1 (2022)
- Co-author: “Copyright and the Non-Fungible Tokens (NFTs)” – Legal Era Publication (March 2022)
- Co-author: “Biscuits Bi’te Back!!!” – Legal Era Publication (January 2022)
- Co-author: “Viability of Celebrity Endorsement Restored” – INTA Publication (August 2021)
- Co-author “Dependent Claims Fully Restored (Merck Part 2)” – Legal Era Publication (November 2021)
- Co-author: “Shaping Up Trademark Laws A Good Sign?” – Legal Era Publication (August 2021)
- Co-author: “The Rise and Fall of SKB Shutters Case: A Brief Look at the Recent Federal Court Case of Merck Sharp & Dohme Corp v Hovid Berhad” – Legal Era Publication (November 2019)
- Co-author: “Malaysia: Does the new Trademarks Act 2019 advantage plaintiffs?” – Managing IP (November 2019)
- Co-author: “Merck Finally Shuts the Door of SKB Shutters” – Managing IP-IP Stars (October 2019).
- Co-Author: “Malaysia – Dorpan, S.L. and Melia Hotels International, S.A. v Nusajaya Rise Sdn Bhd [Johor Bahru Civil Suit No.: JA-22IP-05-09/2017]” – Conventus Law (March 2019)
- Co-author: “John Ambulans Malaysia v PJ Uniform Sdn. Bhd. (SAHC 22NCvC-148-02/2013) Civil Appeal No. B-02(NCVC)(W)-2188-11/2016)” – Asia IP (January 2019)
- Author: “In Ratio & Obiter: Lessons from Liwayway Marketing Corporation v. Oishi Public Company Limited” – Asia IP (June 2017)
- Author: “Automobile Component Parts: Registrable Design or Not?” – Asia IP (October 2015)
- Author: “Are Cancellation Actions still a viable option?” – Asia IP (2013)
- Author: “Registered User Conundrum” – Managing IP (July 2013)
- Co-author: “When Fame is Not Enough” – Managing IP (April 2010)
- Co-author: “Use it or Lose it” – Managing IP (December 2009)
- Author: “To Cancel or Not to Cancel?” – Asia IP Focus (October 2009)
- Author: “The Territoriality of Goodwill: The Way Forward in Claims in Passing-off” – Asia IP (2009)
- Author: “Internet Piracy-Copyright Infringement and Adequacy of Malaysian Law” – The Malaysian Accountant (June 2007)