

**Sim Sook Eng****Partner since 2022**

Intellectual Property

Competition Law &amp; Antitrust

sookeng@shearndelamore.com

T +603 2027 2922

F +603 2072 2758

**Qualifications**

L.L.B (Hons), University of Hertfordshire

Certificate in Legal Practice

Advocate &amp; Solicitor, High Court of Malaya

**Languages**

English, Malay, Chinese, Japanese

## SIM SOOK ENG

### ABOUT SOOK ENG

Sook Eng practices in all areas of IP, both contentious and non-contentious matters. Her prosecution portfolio includes trademark and industrial design prosecution work. Vis a vis industrial design prosecution, Sook Eng handles and has handled the bulk of the industrial design prosecution work of the firm since 2012. She also renders IP advisory work in various IP related areas including but not limited to trademarks, copyright and industrial designs. Apart from doing IP related due diligence, Sook Eng's non-contentious practice includes the drafting and vetting of various IP and IT related agreements. Sook Eng has also been actively involved in foreign trademark prosecution and has provided assistance to clients on the conduct of their foreign trademark portfolio. Some of these matters have also led to contentious disputes in various jurisdictions. In terms of her contentious portfolio, she has appeared as co-counsel in IP disputes at the High Court, Court of Appeal and Federal Court.

She has also been actively involved in IP enforcement through relevant government agencies. Apart from IP related issues, she also advises on compliance and related work in the areas of data privacy, competition and antitrust.

### EXPERIENCE

Sook Eng has been involved in various IP litigation cases across all levels of the Malaysian courts. Set below are some of the notable cases that she was involved in.

- Munchy Food Industries Sdn Bhd v Huasin Food Industries Sdn Bhd
  - *[Kuala Lumpur High Court Civil Suit No. WA-22IP-12-03/2016] (High Court, Court of Appeal, Federal Court)*
  - Acted as co-counsel for the Plaintiff since its inception in the High Court right through to the substantive appeal to the Federal Court. This case was originally heard in the High Court where the Plaintiff initiated a writ action against the Defendant for trademark infringement and passing-off. The Defendant subsequently appealed against the decision of the High Court which decided in favour of the Plaintiff and during the appeal, the Court of Appeal overturned the decision of the High Court. In reversing the High Court's decision, the Court of Appeal imposed additional conditions for claimants to establish in actions for infringement and passing-off. Leave to appeal to the Federal Court was subsequently granted and the Federal Court reinstated the test and threshold for trademark infringement and passing-off in Malaysia.

- This case is of enormous significance as it restates the principles of law applicable in an action for trademark infringement and passing-off and consequently, reverses a trend of jurisprudence which had been introduced in a few prior cases in the Court of Appeal. Being a decision from the apex court, this case would now stand as a landmark decision on the applicable test for trademark infringement and passing-off.
- DJ Auto Components Manufacturing Sdn. Bhd. v. FBK Systems Sdn. Bhd
  - *[Kuala Lumpur High Court Civil Suit No. 22IP-36-08/2012] (High Court, Court of Appeal, Federal Court)*
  - Was engaged in this case since the trial stage at the High Court all the way through to the drafting of the relevant leave questions for appeal to the Federal Court. This matter involved complex arguments as to whether the sale of assets without liability would be sufficient to transfer goodwill which was essentially accepted as inseparable from a business.
- Chongqing Rato Power Co. Ltd. v MP Machinery (M) Sdn Bhd & Registrar of Trade Marks
  - *[Originating Summons No. 24IP-11-03/2014] (High Court, Court of Appeal)*
  - Acted as co-counsel for the 1<sup>st</sup> Defendant from the commencement of the proceedings in the High Court to the appeal in the Court of Appeal. The case concerned an action for expungement of a trademark and the live issues of the case revolved around the relevant time to show grievance to pass the locus standi threshold, competing rights to the trademark concerned, the territoriality of trademark rights as well as circumstances where an importer could claim ownership to a trademark.
- Mesuma Sports v Olympic Council of Malaysia
  - *[Kuala Lumpur High Court Civil Suit No. NCV 415-08/2015] (High Court, Court of Appeal)*
  - Acted as co-counsel for the Plaintiff in this case that was originally heard in the High Court and was subsequently appealed to the Court of Appeal. This case considered the right of first refusal in a sponsorship agreement and the continued use of the Olympic logo.
- Montfort Service Sdn Bhd v USA PRO IP Limited
  - *[Originating Summon No: 24IP – 9 – 03/2014] (Federal Court)*
  - Acted as co-counsel for the Respondent in defending the leave application by the Appellant in the Federal Court and was successful in resisting the leave application by the Appellant.

## ACCOLADES

### **Managing IP Stars (2021 - 2022)**

“Rising Star”

### **The Legal 500 Asia-Pacific (2021-2022)**

“Rising Star”

## APPOINTMENTS/MEMBERSHIPS

Member, Malaysian Bar

Member, International Bar Association (IBA)

## PUBLICATION

- Co-author: “Stamping Out Illegal Streaming Technology – Recent Amendments To The Copyright Act” – Legal Era Publication, July 2022
- Co-author: “Biscuits Bi'te Back!!!” - Legal Era Publication, January 2022
- News Analysis - According to a New Study, Malaysian Companies Likely to Experience Data Breach, September 2021
- Co-author: “Malaysia: Does the new Trademarks Act 2019 advantage plaintiffs?”, Managing IP, November 2019
- Co-author: “Malaysia: Cyberspace is the fastest growing sphere for counterfeit trade”, Managing IP, February 2019
- Industrial Design Rights: An International Perspective, Third Edition - Brian W. Gray (Malaysia Chapter) (Contributor)
- Co-author: “Industrial Design Protection in Malaysia- An Update” Asia IP, November 2013