



Kuek Pei Yee
Partner

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“Kuek Pei Yee is a litigator in Kuala Lumpur with a solid reputation, frequently acting on patent infringement cases. She also represents clients in trade mark and copyright action.”

Chambers Asia-Pacific 2022

Pei Yee is a partner in the Intellectual Property and TMT practice and her work focuses on intellectual property disputes. She advises and represents local and foreign clients across numerous industries concerning a multitude of IP subject matters, including patents, trademarks, industrial designs and copyright. She has acted as lead counsel in litigation matters that cut across all IP subject matters, some of which have served to define milestones in the Malaysian IP landscape.

Besides contentious matters, Pei Yee regularly advises clients on transactions involving IP subject matters. Her work in this area includes drafting and reviewing agreements relating to assignment, licensing, research and development, brand endorsement and others. She also assists clients in refining their IP protection strategies and policies.

Key Practice Areas

IP Litigation and Enforcement
Advertising and Product Liability
Consumer Protection Disputes
IP Registration and Prosecution
TMT Disputes

Selected Experience

IP Litigation and Enforcement

- ❖ Represented Syarikat Faiza Sdn Bhd, a Malaysian producer and distributor of rice, in a claim for trade mark infringement, copyright infringement, passing off and unlawful interference with trade. In this case, the High Court accepted arguments with respect to the issue turning on the availability of a trade description order (prescribed under the Trade Descriptions Act 2011) as a

relief where a plaintiff succeeds in proving trade mark infringement under the Trade Marks Act 1976. This was the first case in which a court of law in Malaysia had ruled on this interplay between the provisions of the Trade Descriptions Act and the Trade Marks Act.

- ❖ Represented Wieland Electric GmbH, a German manufacturer of electrical components, in an action commenced at the High Court for the cancellation of a trade mark wrongfully registered in the name of its Malaysian agent or licensee. The Malaysian Court held that an agent or licensee of a foreign principal cannot claim to be entitled to the trade mark registration in Malaysia.
- ❖ Represented a general merchant in an ownership dispute over a trade mark applied to industrial rubber gloves and successfully expunged trade mark registrations in the name of the supplier engaged by the general merchant to manufacture the gloves.
- ❖ Represented F Hoffmann La Roche AG in an action for patent infringement against Celltrion Healthcare Malaysia Sdn Bhd for the importation and sale of Celltrion's Truxima product and obtained an ex-parte interlocutory injunction that prevented Celltrion from importing, selling and offering for sale products that infringe F Hoffmann La Roche's patents relating to rituximab.
- ❖ Represented Nuctech Company Limited in a multi-tiered patent invalidation and infringement dispute. The patent is concerned with a system for security inspection and imaging of moving objects, such as cargo vehicles, and a method of dodging in the scan imaging system. We successfully obtained judgment in favour of our client in two separate suits against similar parties, including the Government of Malaysia, and successfully resisted all appeals up to the Federal Court.
- ❖ Represented Nokia Technologies Oy in a patent infringement suit telecommunications brand Vivo, as part of a global litigation for infringement of Nokia's Standard Essential Patents for mobile devices. This was the first suit in Malaysia involving novel issues relating to FRAND principles. Parties settled out of court.
- ❖ Represented a local palm oil mill operator in successfully defending against a claim for patent infringement of a vertical steriliser apparatus.

- ❖ Represented the Malaysian distributor of Joyoung Co. Ltd., a leading kitchen appliances company in China, in relation to non-infringement for patents. The decision is important as the Court of Appeal: (1) accepted the application of the Improver questions as an aid to the construction of patent claims, and (2) confirmed that in doing so, all the three Improver questions have to be answered and not just one or two of them.
- ❖ Represented a foreign manufacturer of semiconductor devices testing machines and equipment against employees and former employees for copyright infringement, breach of confidential information and breach of fiduciary duties, obtained and executed an ex parte Anton Piller and interlocutory injunction order.
- ❖ Represented an integrated e-commerce securities trading solutions provider in a copyright infringement and breach of confidential information dispute between competing software developer companies. We succeeded at the Federal Court on a novel point of law concerning whether a spent and executed Anton Piller Order may be set aside, and continue to represent the client in the High Court trial.
- ❖ Represented a number of UK registered Design holders in a class action and obtained a declaration in respect of the extension of the validity of their registered designs for a 25-year period.
- ❖ Represented a trade association in the cancellation of two industrial designs for prayer coils and joss-sticks, on a pro bono basis.
- ❖ Represented a local motorcycle assemblers and distributors in its defence to a copyright infringement suit over a motorcycle design brought by a foreign motorcycle producer and in response to the subsequent appeal.
- ❖ Represented various local and foreign clients, in raids and investigations carried out by regulatory authorities. The clients span across a range of industries, including fashion, footwear, apparel, electrical and electronics, pharmaceutical and healthcare, automotive, food and beverage and fast moving consumer goods.

TMT Disputes

- ❖ Represented an international telecommunications company with Standard Essential Patents and FRAND issues.

- ❖ Represented a telecommunications patent holder in enforcing its Standard Essential Patents against several network equipment manufacturers.
- ❖ Represented a hospital management IT systems solutions provider in a claim against a private hospital for breach of contract and defending against a counter-claim for defective implementation.
- ❖ Represented a social security organisation in a claim against an IT integration solutions provider for failure in design and implementation.

Media & Entertainment Advisory & Enforcement

- ❖ Representing a global entertainment conglomerate in negotiations with local production companies for the production and development of local film and TV projects.
- ❖ Represented a global entertainment conglomerate in music licensing negotiations for the launch of their SVOD service in Malaysia.
- ❖ Conducted an IP due diligence for a local entertainment company for IP risks arising from the termination of their partnership with an international media company.
- ❖ Advised a leading local entertainment company on securing movie licensing rights from the relevant collective management organisation for the public performance of copyrighted movies at an outdoor event.

Advertising and Product Liability

- ❖ Advised clients on legal compliance relating to advertisements for various products and services, including pharmaceutical products, food and beverage, apparel, automobiles, toys and others.

Consumer Protection Disputes

- ❖ Advised and represented clients in matters arising from consumer claims against supplier or manufacturer of various goods, including fast moving consumer goods, automobiles, electrical goods and others.

- ❖ Represented foreign automobile manufacturer in product liability claims by consumers.

Qualifications & Professional Affiliations

Qualifications:

Registered Patent Agent
Registered Trade Mark Agent
Registered Industrial Design Agent
Advocate and Solicitor of the High Court of Malaya (2000)
LL.B (Hons), The University of Melbourne (1999)
Bachelor of Commerce, The University of Melbourne (1999)

Professional Affiliations:

Committee member, Malaysian Bar Intellectual Property Committee
Committee member, ICC Intellectual Property Committee, Malaysian Chapter
Member, Malaysian Intellectual Property Association

Accolades

- ❖ Described as a “*home-grown talent*” who is “*a steady anchor*” in the field, by IAM Patent 1000.
- ❖ Ranked Band 3 in Chambers Asia-Pacific 2021 – 2026
- ❖ Ranked as an “*Up-and-Coming*” lawyer in Chambers Asia-Pacific 2020
- ❖ Ranked as a Notable Practitioner in AsiaLaw Profiles 2022
- ❖ Ranked as a Distinguished Practitioner in AsiaLaw Profiles 2023
- ❖ Listed as “*Next Generation Partner*”, Legal 500 Asia-Pacific 2022 – 2023
- ❖ Listed as “*Leading Individual*”, Legal 500 Asia-Pacific 2024
- ❖ Listed as “*Future Star*”, Benchmark Litigation Asia-Pacific 2020 – 2022
- ❖ Listed as “*Litigation Star*”, Benchmark Litigation Asia-Pacific 2023 – 2024

