



Karen Fong Consultant Solicitor

Jurisdiction: England & Wales

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Overview

Karen is a specialist intellectual property (IP) and commercial lawyer with an abundance of international experience. She is recognised as a leading practitioner by various legal directories and has practised in London, Hong Kong and Singapore.

Karen has advised well-known international IP owners as well as start-ups and creative individuals on all aspects of business issues which involve the protection and exploitation of IP rights in the UK and internationally in a broad range of industries. She has particular expertise in the fashion and beauty, technology, food and beverage and media sectors. Her non-contentious practice includes work from brand management and protection, product development, IP audits, licensing and sponsorship, to IP elements of business sale and purchase and other exploitation of IP rights. She also provides bespoke IP training to clients.

In addition to her non-contentious work, Karen is highly experienced in conducting litigation dealing with disputes at all court levels in the UK, particularly those involving trade marks, copyright, designs, database rights, confidentiality and trade secrets. She has built up considerable experience in the IP Enterprise Court (IPEC) and also advising and managing international disputes on behalf of clients.

Karen is also skilled in the use of alternative approaches to dispute resolution including mediation and arbitration. She is a domain name panelist for the World Intellectual Property Organization (WIPO), Asian Domain Name Dispute Resolution Centre (ADNDRC) and Hong Kong International Arbitration Centre (HKIAC), and is accredited as a mediator by the Centre for Effective Dispute Resolution (CEDR).

Expertise

- Trade mark infringement and passing off
- Copyright and database right infringement
- Patent infringement and validity
- Design infringement
- Global branding strategy

- Brand management, protection and exploitation
- Anti-counterfeiting strategy and enforcement
- Managing international disputes especially in China and South East Asia
- Protection of know-how and confidential information
- IP due diligence
- Assignment and licensing of IP rights and other IP agreements
- Audits of IP rights
- Website and social media issues including domain name disputes
- Resolving IP and IT disputes
- IPEC and High Court litigation
- Arbitration and mediation
- Advertising clearance
- Language skills – Mandarin, Cantonese and Italian

Cases

Intellectual Property

- Represented a major US defence contractor in a multijurisdictional technology arbitration
- Led a team which advised a major US car manufacturer on all aspects of European brand protection and enforcement including civil and criminal disputes involving patent, designs, trade marks, copyright, confidential information, database rights as well as advising on block exemptions, advertising clearance and IP agreements
- Obtained the first judgment in connection with a trade mark infringement and passing off case at the renamed IPEC in favour of major pharmaceutical client
- Acted as lead IP advisor to a leading English weekly newspaper
- Acted as lead IP advisor to a British regulatory body
- Acted as a special advisor to a US global confectionary company on using civil litigation as an enforcement tool in China including providing strategic advice on overall strategy and using specific tactics in individual cases
- Acted as supervising solicitor in connection with search and seizure orders
- Advised a well-known actor-turned-director in relation to a copyright claim against him and a production company in connection with a West End play including dealing with on-stage disturbance on the opening night
- Assisting a London law firm in defending a challenge by another law firm over the use of its name which the latter claims is too close to its own name.

Retail

- Advised a number of well-known high-end brands of European multinational luxury goods company on trade mark prosecution matters, trade mark, designs and copyright disputes in multi jurisdictions
- Advised a UK fashion brand on IP strategy, prosecution of trade marks and designs, an anti-counterfeiting

programme including working with Trading Standards and using Customs measures to enforce rights as well as civil actions and domain name disputes

- Advised a luxury cult perfume brand in a passing off action including the related breach of director's duties claims
- Advised a major American cosmetics, skincare and fragrance company on European trade mark portfolio work and soft IP disputes as well as regulatory work
- Advised a British multinational retail company on all aspects of IP work globally including overall IP strategy, trade mark, patents and design prosecutions including obtaining well-known mark status for a house mark in China, drafting of IP and other commercial agreements, patent, copyright, trade marks and design disputes in the UK, China, Hong Kong and other parts of Europe and delivering IP training for staff
- Advised a British kitchen supplier on overall global IP strategy, trade mark prosecution, domain name disputes, civil disputes including a UK trade mark and passing off dispute with fraud elements
- Assisted an established trading company and one of its employees in a claim by a supplier of design right infringement and breach of confidential information in relation to a handbag range that the parties were co-creating together.
- Assisted an established trading company in a threatened trade mark infringement and passing off claim by a brand owner in relation to its the sale of beach clogs.

Technology, Media and Telecoms

- Advised a leading US technology company in IP disputes, brand enforcement, domain name issues and IP agreements
- Advised a leading online gaming company on global IP strategy, trade mark prosecution, domain name issues and IP disputes, data protection issues, and collaboration agreements with different Asian partners
- Advised a leading web services provider on sponsorship and ambush marketing issues
- Acted for The Economist in leading trade mark case (High Court and Court of Appeal) *The European v The Economist* (European Voice)
- Advised a US technology multinational specialising in Internet-related services and products on a number of trade mark and copyright issues
- Advising an app developer in a potential dispute against their former partner in relation to the ownership of the copyright in the software created by the various parties.

Food and Beverage

- Advised a US coffee company and coffeehouse chain with worldwide locations on trade mark, passing off, designs, domain name and copyright disputes
- Advised an energy drinks giant on trade mark, passing off, designs and copyright disputes
- Advised a multinational alcoholic beverage company on trade mark and passing off disputes
- Advised a multinational beverage company in a passing off action in relation to brand of bottled water

- Successfully acted for United Biscuits in a well-known reported UK High Court case, *United Biscuits v Asda* (penguin/puffin case)

Healthcare

- Advised a British pharmaceutical chain in a patent dispute in connection with ocular equipment
- Advised a multinational in the pharmaceutical industry on trade mark and domain name disputes in relation to a well-known branded product
- Advised a publishing company in the pharmaceutical industry in connection with trade mark, passing off, copyright and domain name issues
- Advised a multinational bio-pharmaceutical company on trade mark and domain name issues
- Advised a medical device company on a series of design disputes

Recognition

'A global IP thinker...' **WTR 1000, 2018**

Leading practitioner (trade marks), **Women in Business Law 2017 Experts Guide**

'The "fabulous" Karen Fong wins plaudits for her prowess in the strategic and transactional sphere.' **WTR 1000, 2015**

'... is praised by sources for her commerciality and responsiveness.' **Chambers UK, 2014**

'In addition to her "good advice" she gains market recognition for being "very commercial"' **Chambers Global, 2014**

'...Her efforts centre on transactional matters and dispute resolution.' **WTR 1000, 2014**

'...excels in understanding the nature of corporations' business; her understanding of international requirements is pivotal in helping brand owners understand how to respond to issues as they arise. Patrons conclude that "*through her leadership and extensive knowledge of UK and more broadly Asian legislation, she has placed us in the most advantageous possible position*". **WTR100, 2013**

'...taking a strong interest in co-ordinating many of the...largest litigation instructions. She also advises clients on their world-wide IP interest.' **Chambers UK, 2013**

'... advised on a brand protection and enforcement strategy for Paul's Boutique.' **Legal 500, 2013**

'... enjoys an outstanding reputation for dispute resolution across a range of soft and hard IP matters, and regularly advises high-profile clients on such issues.' **Chambers UK, 2012**

'... organised and flexible approach even when dealing with multiple time zones' **Chambers Global, 2011**

'... popular with clients for being flexible and responsive' **Chambers UK, 2011**

'... she is admired by clients for her "*detailed and dedicated*" approach.' **Chambers UK, 2010**

"*very knowledgeable*" **Legal 500, 2010**

Managing Intellectual Property: 'IP Star 2016-2018'

Managing Intellectual Property: 'IP Star 2014'

Chambers Global, 2014: Recommended as a 'Regional Expert in China'

WTR 1000, 2014: Recommended as a 'Leading individual'

Chambers Global, 2013: Recommended as a 'Leader in their field'

Chambers UK, 2013: Recommended as a 'Leader in their field'

WTR 1000, 2013: Recommended as a 'Leading individual'

European Women in Business Law Awards, 2012: won 'Best in Trade Marks' category

WTR 1000, 2012: Recommended as a 'Leading individual'

Chambers Global, 2012: Recommended as a 'Leader in their field'

Chambers UK, 2012: Recommended as a 'Leader in their Field'

Chambers UK, 2011: Recommended as a 'Leader in their Field'

Chambers Global, 2011: Recommended as Band 1 Regional Expert in Hong Kong and China

Chambers UK, 2010: Recommended as a 'Leader in their field'

Career

2018 **Keystone Law** | *Consultant Solicitor*

2015-2018 **Collyer Bristow** | *Partner, Head of Brands and Retail*

2004-2015 **Rouse Legal and Rouse & Co International Ltd, London** | *Consultant then Partner then Managing Partner then Global Compliance Standard and Ethics Partner*

2002-2003 **Dawsons, London** | *Senior Associate*

- 2000-2002** **Denton Wilde Sapte, Hong Kong** | *Consultant*
- 1996-1999** **Willoughby & Partners and Rouse & Co International Ltd, London** | *Associate then Partner*
- 1994-1995** **Barlow Lyde & Gilbert, Hong Kong** | *Solicitor/Associate*
- 1993-1994** **McKenna & Co, Hong Kong** | *Foreign Legal Consultant*
- 1987-1991** **Drew & Napier, Singapore** | *Pupil then Advocate and Associate*
- 2018** Appointed as Hong Kong International Arbitration Centre (HKIAC) panelist
- 2017** Appointed as Asian Domain Name Dispute Resolution (ADNDRC) panelist
- 2010** Appointed as World Intellectual Property Organization (WIPO) panelist
- 2004** CEDR Accredited Mediator
- 1994** Admitted as a solicitor of the High Court of Hong Kong
- 1994** Admitted as a solicitor of the Senior Courts of England and Wales
- 1989** Admitted as an Advocate & Solicitor of the Supreme Court of the Republic of Singapore