

Alvin Lim

SPECIAL COUNSEL ,WITHERS KHATTARWONG* | SINGAPORE

* Withers KhattarWong LLP is a Singapore law practice, affiliated with Withers LLP.

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Alvin is special counsel in the Intellectual Property and Technology team.

An intellectual property specialist since 2007, Alvin was recognized as a leading lawyer in the field of intellectual property in the 2017 and 2018 editions of AsiaLaw Leading Lawyers. He was also cited as a Patent Star in the 2019/20 and 2020/21 editions of Managing Intellectual Property's IP Stars in recognition of his patent litigation, patent strategy and counselling work.

Alvin's areas of practice includes advising clients in all aspects of intellectual property and intangible asset acquisition, management, commercialization, enforcement and protection strategy across a broad range of industries and technologies spanning life sciences, medtech, telecommunications, IT, electronics, semiconductors, FMCG, food and beverage, music, fashion and design, digital technology and artificial intelligence.

Alvin has a strong IP litigation and enforcement practice, regularly acting for clients in patent, trademark, copyright and trade secrets disputes in Singapore and also cross border IP disputes. Alvin's experience in handling pharmacological advisory and patent linkage work has seen him act for multinational pharmaceutical companies such as Eli Lilly, F. Hoffmann-LA Roche AG, OSI Pharmaceuticals, Merck & Co, Bristol-Myers Squibb Pharma Co and AstraZeneca. Other notable clients Alvin has acted for include Nokia Corporation, Asahi Glass, NexPlanar Corporation, Rokko Holdings, JCS Echigo Pte Ltd, Aurigin Technology Pte Ltd, Swiss Ranks Pte Ltd, Staywell Hospitality Pty Limited, ERS Electronic GMBH, Lenzing, Virtual Map, and TMRG Pte Ltd.

Several of the cases in which Alvin has been involved in involve novel issues of law and/or have been reported in the law journals and law reports of Singapore, including:

Sun Electric Pte Ltd v Sunseap Group Pte Ltd and Ors [2020] SGHCR 1;
Sun Electric Pte Ltd v Sunseap Group Pte Ltd and Ors [2019] SGHCR 11;
Novartis (Jiangsu) Pte Ltd v Bristol-Myers Squibb Pharma Co [2018] 3 SLR 1194;
Dr Babor Gmbh & Co KG & Anor v Sante De Beaute Pte Ltd [2018] SGHC 159;
Starwood Hotels & Resorts Worldwide Inc and Sheraton International IP LLC v Staywell Hospitality Pty Limited [2018] SGIPOS 11;
Rohm & Haas Electronic Materials CMP Holdings Inc v NexPlanar Corp [2017] SGHC 310;
Ship's Equipment Centre Bremen GmbH v Fuji Trading (Jiangsu) Pte Ltd [2015] 4 SLR 781;
Invenpro (M) Sdn Bhd v JC Automation Pte Ltd [2014] 2 SLR 1045;
Astra Zeneca AB (SE) v Sanofi-Aventis Singapore Pte Ltd [2012] SGHC 16; [2013] SGHCR 7;
Hoya Corp v Asahi Glass Co Ltd [2010] SGHC 15;
ASM Assembly Automation Ltd v Aurigin Technology Pte Ltd [2010] 1 SLR 1;
Love & Co Pte Ltd v The Carat Club Pte Ltd [2009] 1 SLR 561;
Virtual Map (Jiangsu) Pte Ltd v Singapore Land Authority [2007] SGDC; and
N.V. Sumatra Tobacco Trading Company v British American Tobacco (brands) Inc [2008] SGIPOS1.

The non-contentious aspects of Alvin's practice include conducting IP and intangible asset audits, IP registration and prosecution work, acting for clients in commercial IP transactions, drafting and review of technology contracts, providing advice on regulatory law and compliance in respect of data privacy, medical, advertising and fintech laws. Alvin has also been retained by clients as external "in-house counsel" in diverse fields such as med tech, semiconductor manufacturing, beauty and aesthetics and automation, where he worked directly with and provided legal support to business stakeholders and executives.

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TRACK RECORD

Acted for TMRG Pte Ltd and Luke's Tavern Holdings Pte Ltd as lead counsel against Luke's Seafood LLC and its Singapore franchisee in a trademark infringement and passing off trial in the Singapore High Court. Clients operated a fine dining establishment called "LUKE'S" and had to take action against the American F&B giant Luke's Seafood LLC who started a "Luke's Lobster" franchise in Singapore to avoid confusion and

damage to client's brand and goodwill.

Acted for F.Hoffmann – La Roche AG against Drug Houses of Australia Pte Ltd in a patent linkage dispute relating to a drug used to treat lung cancer and pancreatic cancer. The action resulted in a favourable outcome for client as the Defendant eventually withdrew its product license application.

Acted for Bristol-Myers Squibb Pharma Co in patent linkage proceedings against Novartis (Singapore) Pte Ltd. This case resulted in a Judgment reported as Novartis (Jiangsu) Pte Ltd v Bristol-Myers Squibb Pharma Co [2018] 3 SLR 1194, a high profile decision in relation to whether corrections may be made to the Registrar of Patents in correct errors in the Patents Register that captured the attention of the Singapore Patent Attorney profession.

Member of team advising Nokia Corporation in a complex and multi-jurisdictional patent and licensing dispute in the telecommunications field involving complex issues such as standard essential patents and FRAND licensing. This was a major project involving extensive investigation field work around mobile chipsets and providing validity and infringement opinions in respect of assertable patents in Singapore covering a wide range of technologies.

Member of team acting for AstraZeneca in patent linkage proceedings commenced against Sanofi-Aventis Singapore Pte Ltd for infringement of patents covering a cholesterol drug. Although the matter was eventually settled, this case involved the previously novel issues of whether section 12A of the (old) Medicines Act contemplated an independent cause of action from a patent infringement action under the Patents Act (reported at Astra Zeneca AB (SE) v Sanofi-Aventis Singapore Pte Ltd [2012] SGHC 16), and the extent to which the Plaintiff must provide further and better particulars of the Defendant's alleged infringement (reported as Astra Zeneca AB (SE) v Sanofi-Aventis Singapore [2013] SGHCR 7).

One of the team leaders in team appointed by a global pulp and paper manufacturing giant to carry out a major IP audit project for tax restructuring purposes. This was a two year project requiring team leaders to travel to the client's various international offices, manufacturing plants, plantations, power plants and various business units to interview the client's business leaders, engineers, R&D personnel and other employees for the purpose of the IP audit and recommending follow up action required.

Member of team structuring and executing a global trade secret audit and protection program for a global travel technology company across its various international offices. This project included reviewing trade secrets laws across multiple jurisdictions including UK, USA, Australia, China, Japan, Singapore, Thailand, Philippines, India, France, Germany, Russia, Spain, and Brazil.

Acted for the founder of the local soya bean dessert brand "Lao Ban Dou Hua" in trademark infringement and passing off proceedings filed in the Singapore High Court which resulted in a positive settlement for client.

Acted for a Singapore licensed solar energy retailer in patent infringement proceedings relating to inventions in respect of a power grid system and method of determining power consumption. Judgments in relation to interlocutory applications filed for this case are reported as Sun Electric Pte Ltd v Sunseap Group Pte Ltd and Ors [2020] SGHCR 1 and Sun Electric Pte Ltd v Sunseap Group Pte Ltd and Ors [2019] SGHCR 11.

Advised a multinational pharmaceutical company in respect of the reporting requirements by various industry stakeholders in respect of falsified medicinal products and medical devices under Singapore regulatory laws.

Prepared a comprehensive legal memorandum for a multinational pharmaceutical company advising on all legal issues affecting the conduct of private investigations in Singapore, including criminal law issues, tort laws, personal data protection laws, breach of confidentiality laws, rules of evidence, and laws in respect of specific methods of conducting private investigations. The memorandum was to be used as a guide and brief to private investigators hired for various purposes.

Acted for a leading Japanese fermented drink manufacturer, Kabushiki Kaisha Honsha in a successful trademark opposition filed in Brunei against Societe des Produits Nestle S.A.

Acted for an international manufacturer of fibres and textiles used in FMCG products in successfully enforcing their trademark rights against multiple infringers in Singapore and Malaysia.

Member of team that successfully defended two local SMEs in a High Court action against claims of infringement of trade secrets and copyright by a Malaysian technology company. The High Court's decision is reported as Invenpro (M) Sdn Bhd v JC Automation Pte Ltd [2014] 2 SLR 1045.

Member of team that defended an American technology company against claims of patent infringement by an international manufacturer of chemical products relating to chemical mechanical polishing technology. The High Court Judgment was reported as Rohm & Haas Electronic

Materials CMP Holdings Inc v NexPlanar Corp [2017] SGHC 310.

Member of team that acted for a German technology company enforcing its Singapore patents covering semiconductor technology against a leading service provider of semiconductor packaging design, assembly, test and distribution solutions in Singapore. This "David vs Goliath" action led to a licensing deal being agreed by parties.

Member of team acting for a German manufacturer of ship container lashing equipment in patent infringement proceedings in Singapore and Japan. Although the dispute settled, the Singapore High Court's Judgment in respect of an application to amend the patent in suit was reported as Ship's Equipment Centre Bremen GmbH v Fuji Trading (Jiangsu) Pte Ltd [2015] 4 SLR 781.

Member of team that defended a local map maker against claims of breach of copyright in digital maps. The decision was reported as Virtual Map (Jiangsu) Pte Ltd v Singapore Land Authority [2007] SGDC.

Member of team acting for a hotel group in trademark invalidation proceedings commenced by another leading international hotel group. The decision is reported as Starwood Hotels & Resorts Worldwide Inc and Sheraton International IP LLC v Staywell Hospitality Pty Limited [2018] SGIPOS 11.

Served as de facto "in-house" external counsel over a three(3) year period for a local SME whose founders had invested millions in cutting edge technologies in areas such as medical devices, energy and water desalination. I provided legal services to support the incorporation of the company, the hiring of its first local management and operation teams, acquiring of office premises, negotiations of agreements with contract manufacturers, reviewing of marketing materials to comply with advertising laws, negotiating of distribution agreements, reviewing clinical research agreements and providing other general legal advice to the managing director, operations, human resource director and marketing director until the client had expanded its operations sufficiently to hire its own in-house counsel.

Advised various participants at the Intellectual Property Office of Singapore (IPOS) since 2018.

ADMISSIONS

- Advocate and solicitor (Singapore), 2006

MEMBERSHIPS

- Member, Law Society of Singapore
- Member, Singapore Academy of Law
- Member, Inquiry Panel of the Law Society

TALKS

Moderator and speaker at "Valuation of Technology Companies" presented on 19 May 2021, organized by the Singapore Academy of Law

Speaker at "NSW Going Global Program – Commercial Law and IP Legal Issues Relating to Market Entry and Global expansion", presented on 1 Apr 2021.

EDUCATION

LLB (Hons) National University of Singapore, 2005

LANGUAGES

ENGLISH

DATES

JOINED: 2021

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