

Charmaine Koo

Consultant | Intellectual Property | Hong Kong

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Charmaine is Head of IP Commercial and Litigation. She was a Partner at Deacons (2003-2023) and former Co-head of Deacons IP Department (2015-April 2023).

Charmaine is admitted as a solicitor in Hong Kong, Canada and England and Wales. She is also qualified as a barrister in Ontario, Canada. She has a BSc in biology from the University of Toronto, an LLB from Queen's University, an LLM from Cambridge University and a Diploma in IP Law and Practice from the University of Bristol.

Charmaine's wide-ranging practice covers all aspects of IP work from complicated commercial transactions, IT and online business issues, to data privacy and cybersecurity, to advertising, local law compliance and regulatory issues, to anti-counterfeiting strategies and enforcement of IP rights, including complex patent litigation. She has won a number of high profile court cases resulting in ground-breaking decisions in the Hong Kong IP field including *Yakult vs. Yakudo*, *Guccio Gucci S.P.A. vs. Cosimo Gucci and Tsit Wing (Hong Kong) Company Limited vs. TWG Tea Company Pte Ltd.*, which went to the Court of Final Appeal and was voted by Managing IP Magazine as the "Hong Kong IP case of the Year 2013".

She is one of Hong Kong's leading entertainment lawyers and was previously in-house counsel at one of the world's largest entertainment and media companies.

Charmaine also has extensive experience advising on all aspects of data privacy, from data privacy audits and regulatory compliance, to handling investigations by the Privacy Commissioner and appeals against the Commissioner's decisions, as well as handling data breach incidents and strategic advice on complex arrangements regarding sharing and utilisation of data amongst conglomerates and international group companies.

Her clients range from the world's leading internet service providers, to luxury brand owners, major international film studios, television networks and music publishers, to statutory bodies, conglomerates and multinationals across many sectors.

Charmaine is a prolific speaker on a wide range of IP issues and is the author of the Hong Kong chapters of "Patent Litigation Global Guide" and "Copyright Litigation Global Guide" of the *Practical Law Global Guides* published by Thomson Reuters (2018). She is also the author of the Hong Kong chapters of the third edition of "Data Protection & Privacy – International Series" published by Thomson Reuters (2016), "International Advertising Law" published by *Globe Law and Business* (2014), as well as the Hong Kong Chapter of the International Independent Film & Television Alliance's *Arbitration Award and Enforcement Guide*.

Charmaine is an active member of many committees and advisory bodies including the *Advisory Committee on Promotion of Arbitration, Department of Justice (2021-2024)*, the *Design, Marketing and Licensing Services Advisory Committee, HKTDC (2021-2022)* and the *Domain Name Dispute Resolution Panel, HKIAC (2021-2026)*. She was also President of the Licensing Executives Society of China (Hong Kong Sub-Chapter) from 2017 to 2019.

Charmaine is the recipient of many awards and accolades including recognition by Legal 500 as a "Hall of Fame" in IP – Hong Kong (2023), a *Leading Lawyer in IP (2016-2022)* and a *Recommended Lawyer in TMT in Hong Kong (2020-2023)*, by Chambers Asia Pacific and Greater China Region as a *Band 1 Leading Individual in IP in Hong Kong (2017-2023)*, by World Trademark Review 1000 as a *Gold Tier Individual in Enforcement and Litigation in Hong Kong (2016-2023)*, by IAM Patent 1000 as a *Gold Tier Individual in Patent Litigation (2022-2023)* and by Benchmark Litigation as a *Dispute Resolution Star (2019-2021)* and *Litigation Star (2022-2023)* in IP in Hong Kong.



Principal Areas

- Data Protection and Privacy
- Intellectual Property
 - Copyright
 - Enforcement and Litigation
 - Internet and Online Business
 - IP Commercial Advisory
 - Trade Secrets and Confidential Information

Sectors

- Art
- Consumer Goods and Retail
- Technology, Media and Telecom
 - Media and Entertainment

Languages

- English
- Cantonese
- Mandarin

Jurisdictions

- Hong Kong
- England and Wales
- Canada

Highlights

- Successfully defended Alibaba in proceedings commenced in Hong Kong by cosmetics supplier Mary Kay against a number of Alibaba companies and shops on the www.tmall.com platform. The landmark decision clarifies Hong Kong law on parallel imports and liability of online platforms for IP Infringement as well as the jurisdiction of Hong Kong Courts in relation to online sales by platforms based outside of Hong Kong.
- Acting for a world's leading mobile phone and computer manufacturer in patent infringement proceedings commenced by another leading mobile phone manufacturer in relation to cellular technology.
- Representing companies in the Gmedia group in a Hong Kong patent infringement action against Tencent Holdings (the leading mobile internet company in Mainland China) over the use of Gmedia's QR code technology in Tencent's Weixin and WeChat products.
- Successfully acted for Tsit Wing (Hong Kong) Company Limited in its long-running and complex Hong Kong trade mark dispute with TWG Tea Company Pte Ltd, one of the few IP cases to go to the Court of Final Appeal. The case was voted by Managing Intellectual Property Magazine as the "Hong Kong IP case of the Year 2013".
- Successfully represented Google in an appeal against the Hong Kong Privacy Commissioner resulting in a landmark decision where the Administrative Appeals Board confirmed the jurisdictional application of Hong Kong privacy law, and that there is no independent "Right to be Forgotten" under Hong Kong law.
- Advised a leading Chinese multinational technology company specialising in e-commerce, internet and technology on Hong Kong data privacy and consumer protection issues relating to the sale and advertising of consumer products on e-commerce platforms including reviewing and amending terms of service and privacy policies.
- Advised a major Hollywood film studio on all production legal work including drafting relevant documents in connection with a multi-million dollar film production in Hong Kong and China including agreements for production services, crew and equipment, costume design and corporate guarantees.
- Advised the owner of the largest Chinese language film library in Asia and a vertically integrated entertainment studio on various legal issues including rights in film libraries, investment and production, chain of title, copyright infringement matters, production of musical and sale and purchase of remake rights.

More about Charmaine Koo

Accolades

- **Chambers**
 - Band 1 Lawyer, IP, Hong Kong (Greater China Region) (International Firm) (2017– 2023)
- **Legal 500**
 - Hall of Fame, IP, Hong Kong (2023)
 - Leading Lawyer, IP, Hong Kong (2016–2022)
 - Recommended Lawyer in TMT, Hong Kong (2020–2023)
- **Managing IP**
 - Trade Mark Star, Hong Kong (2016–2023)
 - World's Top 250 Women in IP (2016–2019, 2022)
- **World Trademark Review 1000**
 - Gold Tier Individual, Enforcement and Litigation, Hong Kong (2016–2023)
 - Leading Individual, Transactions, Hong Kong (2018–2023)
- **IAM Patent 1000**
 - Gold Tier Individual, Patent Litigation, Hong Kong (2022–2023)
 - Silver Tier Individual, Patent Litigation, Hong Kong (2018–2021)
- **Asian Legal Business Hong Kong Law Awards**
 - Dispute Resolution Lawyer of the Year (2020)
- **Asia IP**
 - IP Expert (2020, 2023)
 - Leading Lawyer, Media & Entertainment, Hong Kong (2014–2018)
 - Leading Lawyer, Trade Mark, Hong Kong (2014–2018)

- **Asialaw Profiles**
 - Elite Practitioner, IP, Hong Kong (2020, 2022)
 - Market Leading Lawyer, IP, Hong Kong (2017–2018)
- **Asia-mena Counsel/ In-house Community Awards**
 - In-House Community Commended External Counsel of the Year, Hong Kong (2019)
- **China Business Law Journal**
 - China's Elite 100 Lawyers (Foreign Firms) on the A- List (2020, 2022)
- **Benchmark Litigation**
 - Litigation Star, IP, Hong Kong (2022–2023)
 - Dispute Resolution Star, IP, Hong Kong (2019–2021)
- **Doyle's Guide**
 - Preeminent Leading Lawyer, IP (2020–2021)
- **Euromoney Legal Media Group's Asia Women in Business Law Awards**
 - Best in IP Litigation in Asia (2018–2019)
 - Best in TMT in Asia – Finalist (2021)
- **Euromoney Legal Media Group's Expert Guides**
 - Global Leader, Telecoms & Media (2023)
 - Global Leader, Data Privacy & Protection (2022–2023)
 - Leading Lawyer, Trade Mark, Hong Kong (2012–2022)
 - Leading Woman in Business Law in Hong Kong (2015–2022)
 - Leading Lawyer, Media and Entertainment, Hong Kong (2020)
- **Who's Who Legal**
 - Thought Leader, Trade Mark, Mainland China & Hong Kong SAR (2023)
 - Thought Leader, Data, Mainland China & Hong Kong SAR (2023)
 - Global Leader, Telecoms & Media (2023)
 - Global Leader, Data Privacy & Protection (2022–2023)
 - Global Leader, Trade Marks (2012–2023)
 - Global Leader, Copyright (2021–2023)
 - Leading Data Lawyer in Hong Kong (2018–2020)
 - Leading Sports and Entertainment Lawyer in Hong Kong (2013–2020)

Appointments/Memberships

- Committee Member, Advisory Committee on Promotion of Arbitration, Department of Justice (2021–2024)
- Committee Member, Design, Marketing and Licensing Services Advisory Committee, HKTDC (2021–2022)
- President, Licensing Executives Society of China, Hong Kong Sub-Chapter (2017–2019)
- Co-chair of Trademarks, Designs, and Merchandising Committee of Lex Mundi
- Secretary, Intellectual Property and Entertainment Law Committee, International Bar Association (IBA)
- Regional Vice Chair Asia Pacific of the Intellectual Property Practice Group, Lex Mundi
- Vice Chairman, Head of Legal Committee of Licensing Executives Society China, Hong Kong Sub-Chapter (2013 & 2014)
- Council Member, The Hong Kong Institute of Trade Mark Practitioners
- Member, Licensing Executives Society of China, Hong Kong Sub-Chapter
- Member, The International Trademark Association
- Member, The Asian Patent Attorneys Association
- Member, The Law Society of Hong Kong
- Member, The Law Society of England and Wales

Education

- Dipl. Intellectual Property Law and Practice, University of Bristol, UK
- LLM, Cambridge University, UK
- LLB, Queen's University, Canada
- BSc, University of Toronto, Canada

Recent Activities

Charmaine is a prolific speaker on a wide range of IP issues, and is the author of the Hong Kong chapters of "Patent Litigation Global Guide", "Copyright Litigation Global Guide" and "Data Protection & Privacy (Third Edition)" published by Thomson Reuters. She is also a contributing author to the Hong Kong chapters of "International Licensing" published by BNA International Inc., the author of "International Advertising Law" published by Globe Law and Business, as well as the Hong Kong Chapter of the International Independent Film & Television Alliance's Arbitration Award and Enforcement Guide.

