



Michelle G. W. Yee

Partner

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Overview

Michelle is a partner in the IP group and is the head of JSM's Brand Management. Her practice covers all aspects of brand management work such as global trade mark prosecution, opposition, revocation/invalidation and cancellation actions, copyright and design registrations, intellectual property licences and assignments, franchise agreements, sponsorship agreements, non-disclosure agreements and data protection matters. Michelle has a strong track record advising both multinational and Asian businesses with a particular focus on Hong Kong and Greater China. She regularly assists clients with effective, practical and cost-efficient brand management strategies with the goal to strengthen and maintain their intellectual property portfolios in Asia and globally. Michelle holds a chemical engineering degree with a focus in biotechnology. Prior to her legal career, she held roles in biotechnology research and chemical engineering in the oil and gas sector. Her past experiences have provided the leverage for her to furnish clients in the science, engineering and technology sectors with strategic IP protection advice tailored to their specific industry needs with an emphasis on new and emerging technologies. Michelle's prior experience as a regional in-house legal counsel with a global skincare and cosmetics conglomerate allows her to provide clients with practical legal advice that takes into account commercial realities and new ways of doing business, such as online/offline retail models and virtual "try-on" solutions for cosmetics and fashion products. Michelle has conducted in-depth IP audits for multinational corporations to identify gaps in protection, and advises a number of institutional clients on global and regional brand protection strategies across Greater China and Southeast Asia. Michelle is highly skilled in handling trade mark prosecution matters in China and works closely with JSM's Beijing trade mark agency to provide practical legal solutions to clients to navigate the constantly evolving legal landscape in this challenging market. In addition to her depth of experience in brand management work, Michelle is an avid writer and has authored numerous articles on trade mark law within the region, including updates on the introduction of the Madrid international trade mark registration system in Hong Kong, new guidelines issued by the China National Intellectual Property Administration on bad faith filings and blacklisting of trade

mark squatters, and the new trade mark law in Myanmar. She is a regular speaker at multiple industry events on brand management topics, including strategies to deal with the increasing use of mobile apps and social media, and potential issues relating to business expansion into the metaverse and NFTs. A long-time member of the Hong Kong Institute of Trade Mark Practitioners, she was also named Rising Star 2020/21 by *Managing IP Stars* (2020).

Experience

- Advised leading global and Hong Kong financial institutions on trade mark and IP matters, including managing their regional and global trade mark portfolios, conducting clearance searches for new business lines and advising on strategic filings to cover digital banking solutions.
- Advised a pan-Asian FMCG retail and wholesale group on branding strategy and securing trade mark registrations for their innovative consolidated customer loyalty rewards programme covering their extensive retail and food and beverage businesses across Hong Kong.
- Advised a leading Hong Kong-listed real estate group on their global trade mark portfolio, with a particular focus on contentious and non-contentious trade mark matters in Greater China.
- Advised various entities and business units (including businesses in real estate development, hospitality, food and beverage, aviation and shipping) of a Hong Kong- and London-based diversified conglomerate on their global trade mark portfolio. Key types of trade mark work include prosecution, oppositions, invalidations, cancellations / revocations, licensing, assignments and enforcement matters.
- Acted for a UK insurance and financial services conglomerate on contentious and non-contentious trade mark issues worldwide, including prosecuting their worldwide portfolio, preparing trade mark opposition and cancellation actions, advising on company name hijacking, trade mark infringement and enforcement matters.
- Advised a US scouting organisation on a comprehensive filing strategy, potential infringement risks and licensing issues in relation to its trade mark portfolio in Hong Kong and China.
- Advised a US financial and insurance provider on its trade mark portfolio in various Asian jurisdictions, including Hong Kong, Taiwan, Singapore, Malaysia and Thailand.
- Advised a Canadian clothing manufacturer on unfair competition, trade mark infringement, domain name and regulatory compliance issues in various Asian jurisdictions, including China, South Korea, Japan and Indonesia.
- Advised a Hong Kong-listed Chinese technology company on mobile phone and web application agreements and policies, IP license agreements, advertising, copyright and passing off issues, celebrity endorsement agreements, data privacy compliance and trade promotion competition matters in Hong Kong.
- Advising an automobile manufacturer on a number of IP issues following an Asia-wide audit of existing trade mark portfolio which identified gaps in the portfolio and articulated a prosecution strategy, as well as the actions to take

to build brand awareness and carry out effective enforcement in Asia.

- Advised a Japanese technology company on data privacy, telecommunications licensing, copyright and consumer protection issues relating to mobile phone applications in Hong Kong.
- Acted for an international pharmaceutical company on patent matters, including preparing and negotiating patent and technology transfer licence and related agreements with a China pharmaceutical manufacturer.
- Acted for an international fast food company on franchise matters, including preparing and negotiating franchise and related agreements for a new Hong Kong franchisee, preparing template franchise documentation for Asia.
- Advised a Canadian engineering company on patent infringement and breach of confidentiality matters in China.
- Advised a Canadian energy company on intellectual property licensing issues relating to a joint venture with a Chinese company.
- Advised an Australian online advertising agency on unfair competition and copyright infringement matters in China, including preparing cease and desist letters and takedown notices.

Recognition

- Notable Practitioner – Hong Kong – *Managing IP IP Stars* (2023, 2024)
- Ranked *World Trademark Review (WTR) 1000: China and SARs: Hong Kong* (2023)
- Rising Star – Intellectual Property, Hong Kong – *The Legal 500 Asia Pacific* (2023, 2024)
- IP Rising Star – *Euromoney Legal Media Group Women in Business Law Awards for APAC* (2022)
- Recommended – Individuals: Transactions, Hong Kong – *IAM Patent 1000* (2022)
- Rising Star 2020/21, Hong Kong – *Managing IP IP Stars* (2020)

Qualifications

Education

- The University of Hong Kong, PCLL
- University of Oxford, BA, Jurisprudence
- University of British Columbia, BAsc, Chemical Engineering

Admissions

- Hong Kong

Languages

- Cantonese
- English
- Mandarin
- French
- Shanghainese

Professional & community involvement

- Member of The Hong Kong Institute of Trade Mark Practitioners

Related content

- Johnson Stokes & Master promotes seven lawyers to partner and counsel, 2 January 2025
- JSM highly ranked in The Legal 500 Asia Pacific: Greater China 2025, 29 November 2024
- JSM recognised in Managing IP's 2024 "IP STARS", 7 August 2024
- Legal 500 Asia Pacific 2024 ranks JSM in 24 practice categories and recognizes 21 lawyers, 19 January 2024
- JSM recognised in the 2023 edition of IAM Patent 1000, 29 June 2023
- Legal 500 Asia Pacific 2023 ranks JSM in 20 practice categories and recognises 20 lawyers, 16 January 2023
- JSM recognised in Women in Business Law Awards 2022, 16 September 2022
- JSM recognised in IAM Patent 2022, 12 July 2022