

WIPO LIST OF NEUTRALS

BIOGRAPHICAL DATA

Douglas CLARK
Partner, Tanner De Witt
Adjunct Professor,
University of Hong Kong
Hong Kong, China



Nationality: Australian

EDUCATIONAL AND PROFESSIONAL QUALIFICATIONS

Fellow, Hong Kong Institute of Arbitrators (HKI Arb), 2012;
CEDR Accredited Mediator, 2012;
Solicitor, High Court of Hong Kong, 1996 – 2011 and 2020 – present;
Solicitor Advocate, High Court of Hong Kong, 2021 – present;
Barrister, High Court of Hong Kong, 2011 – 2020;
Barrister & Solicitor, Supreme Court of Victoria*, Australia, 1995 – present;
Solicitor, Supreme Court of England & Wales*, 1998 – present;
* Currently non-practicing.

Post Graduate Certificate in Laws, City Polytechnic of Hong Kong, 1994;
BA (Asian Studies), Australian National University, 1993;
LLB (Hons), Australian National University, 1993;
Graduate Certificate Chinese and Chinese Law, Fudan University, Shanghai, 1990.

Level 3 (Professional Level) Certification as Japanese to English and Chinese to English Translator from National Accreditation Agency for Translators and Interpreters, Australia (1991 and 1992).

Awards/Accolades:

Over the years has been named as a leading IP Practitioner in Hong Kong/China in Legal directories including Chambers, IAM, Global, Who's Who Legal, Asia Pacific Legal 500, World's Leading Patent Practitioners, World's Leading Trade Mark Practitioners.

LANGUAGES

English, Mandarin Chinese and Japanese

PRESENT POSITIONS

Partner, Tanner De Witt, Hong Kong;
Adjunct Professor, Faculty of Law, University of Hong Kong;
Deputy Chairman, Inland Revenue Board of Review, Hong Kong.

PROFESSIONAL EXPERIENCE BEFORE PRESENT POSITION

Managing Partner, Douglas Clark LLP, Hong Kong, 2021 – 2023;
Global Head of Dispute Resolution, Rouse, 2020 – 2022;
Barrister, Hong Kong, 2011 – 2020;
Head of Mainland China Intellectual Property, Managing Partner, Lovells (now Hogan Lovells), Shanghai office, 2003 – 2010;
Partner, Lovells Hong Kong, IP Department (based in Shanghai), 2001 – 2003;
Solicitor Lovells Hong Kong IP Department 1996 – 2001.

AREAS OF SPECIALIZATION

Intellectual Property, in particular, patents and technical copyright.

MEMBERSHIP IN PROFESSIONAL BODIES

Member:

Fellow, Hong Kong Institute of Arbitrators;
Asian Patent Attorneys Association (APAA):
 Emerging IP Rights committee, 2021 – present;
 Dispute Resolution committee, 2021 – present;
 Patents committee, 1998 – 2007;
 Copyright committee, 2007 – 2010.
Hong Kong Institute of Trade Mark Practitioners (HKITMP);
International Trade Marks Association.

EXPERIENCE IN INTELLECTUAL PROPERTY

Handled over 3,000 patent, trade mark, copyright and passing off/unfair competition litigation cases in Mainland China and Hong Kong as well as a numerous international arbitrations relating to IP as both arbitrator and counsel. Acted as mediator in WIPO mediation and US International Trade Commission cases and acted as counsel in a number of international and local mediations.

Numerous patent cases and technology disputes relating to biotechnology, pharmaceutical and telecommunications patents (in particular FRAND issues).

Non-contentious experience includes advising on technology transfer and conducting patent and other intellectual property audits as well as freedom to operate analyses.

EXPERIENCE WITH RESPECT TO DOMAIN NAMES

WIPO Domain Name Panelist since 2008 – over 430 decisions rendered in English, Chinese and Japanese;
 ADNDRC Domain Name Panelist since 2010 – over 40 decisions in English and Chinese;
 HKIAC .cn Domain Name Panelist since 2015 – 10 decisions in English and Chinese.

MAJOR PUBLICATIONS

Books:

- Intellectual Property in Hong Kong, LexisNexis, 2nd Edition, 2022 – Including a chapter on Arbitration of IP Disputes (also published 3 times a year as a loose-leaf service);
- Intellectual Property Law in China, 2nd ed (Max Planck Institute), 2021 (co-author);
- Patent Litigation in China, Oxford University Press, 2nd Ed, 2015;
- Civil Litigation in Hong Kong, 6th Edition, Sweet & Maxwell, 2021;
- Gunboat Justice, British and American Law Courts in China and Japan (1842 – 1943), Earnshaw Books, 2015. (A legal history of extraterritoriality in China).

Articles/Book Chapters:

Contributed numerous articles or chapters in various publications on intellectual property including the following articles:

- Hong Kong Civil Procedure (“White Book”), co-author of commentary on Competition Tribunal Rules and procedural provisions of Competition Ordinance (with Knut Fournier) (2021);
- Bullen, Leake and Jacobs, Precedents and Pleadings – Hong Kong, co-author of chapters on patents, copyright, trade marks, registered designs, confidential information and passing off. (2020);
- “After *Unwired Planet*: Why it’s now over to China’s courts to set global FRAND rates”, IAM, September 26, 2020;
- “Private But Not Confidential: The Impact of the PJS case in Hong Kong”, Hong Kong Lawyer, September 2016;
- “Patent Protection in the Hong Kong SAR”, Chapter in Patent Law in Greater China, Edward Alger, 2014;
- “Intellectual Property Litigation in Hong Kong: Are the Courts Up to the Challenge?”, Hong Kong Lawyer, July 2014;
- “Towards a New World IP Order: China’s Impact on IP Worldwide”, Chapter in IP Client Strategies in Asia, 2010, Aspatore Books;
- “China’s New Patent Regime”, China Business Review, May-June 2010 (with Geoffrey Lin and Alex Xia).

Seminars:

Regular speaker on intellectual property (in English, Chinese and Japanese) at conferences and seminars.

EXPERIENCE IN COURT LITIGATION

As Tribunal Chair/Member:

Deputy Chairman, Hong Kong Inland Revenue Board of Review since July 2023. Tribunal member from 2017 to 2022.

As Counsel:

Personally handled or supervised numerous IP litigation cases in Mainland China and Hong Kong and other jurisdictions, including the following:

- Enforcement of DIS arbitration award in Hong Kong;
- *Wong To Yick v. Singapore Medicine*, solicitor advocate before Court of Appeal; counsel for Defendant in trial in Hong Kong for trade mark infringement and passing off; (2019-present);
- *Two Way Media v. PCCW*, acting as counsel and solicitor advocate, on patent infringement proceedings relating to multi-casting (2019 – 2021);
- Advising on dispute regarding patents for non-invasive prenatal test for screening for chromosomal aneuploidies. (One part of this case was reported as *Xcelom v. BGI* [2017] 1 HKLRD 421);

- *Nagravision v. Zhuhai Gotech*, acting for Plaintiff in action to enforce US\$100 million US judgment in Hong Kong and for breach of anti-circumvention provisions of Copyright Ordinance including obtaining ex-parte Mareva and ancillary injunctions (2016 – 2019);
- *Nokia v. TCT Mobile*, acted for Nokia in patent licensing dispute in Hong Kong High Court. (2017 – 2019);
- *Celltrion v. Genentech*. Acted for Genentech in actions seeking to invalidate Hong Kong patents relating to Dosages for Treatment with Anti-ErbB2 Antibodies. (2015 – 2016);
- *Tsit Wing Group v. TWG Tea* - Acted for Defendants in appeal to Hong Kong Court of Final Appeal in trademark infringement and passing off case (led by Martin Howe QC) (2015 – 2016);
- SNE Engineering v. Hsin Chong Construction & Anor*, acted for Plaintiffs trial (led by Winnie Tam SC) and appeal in High Court and Court of Appeal of Hong Kong (Patent Infringement) (2012 – 2015);
- *Stichting BDO v. BDO Unibank, Inc*, counsel for Plaintiffs in trial in High Court of Hong Kong in trademark Infringement and passing off case (2011) (led by Winnie Tam SC);
- *ZTE v. Vringo*, Shenzhen Intermediate Court Acted for defendant for alleged breach of PRC Anti-Monopoly Law in FRAND Licensing (2013 – 2016);
- *Qualcomm v. Nokia*, Shanghai Intermediate Court, Beijing Higher People's Court (Patent Infringement) (2006 – 2008).

PROFESSIONAL TRAINING IN MEDIATION

Lecturer in WIPO and HKIARB International Arbitration and Mediation for Intellectual Property Disputes Training Programme, 2022 and 2023;
 WIPO Advanced Course on Arbitration and Mediation, 2008;
 CEDR Mediation Training Course, 2012.

EXPERIENCE IN MEDIATION

Acting as mediator in WIPO mediation involving cross border trademark disputes (2024);
 Appointed mediator in WIPO mediation (2022);
 Acted as mediator in US ITC proceedings (2019);
 Acted as counsel in international mediation under SIMC Rules (2019);
 Acting as counsel in Hong Kong court-annexed and ad hoc mediations (2017 and 2021);
 Acted as international counsel in court assisted mediation in China (Numerous occasions).

PROFESSIONAL TRAINING IN ARBITRATION

Acting as mediator in WIPO mediation involving cross border trademark disputes (2024);
 WIPO Advanced Course on Arbitration;
 Hong Kong Institute of Arbitrators, Fellowship Assessment Course;
 WIPO Advanced Course on Arbitration and Mediation.

EXPERIENCE IN ARBITRATION

As arbitrator

- Dispute over software licensing royalties, ICC, 2024 – present, sole arbitrator;
- Dispute over distribution agreement for snow field equipment in China, HKIAC, 2021 – 2022, substitute sole arbitrator;
- Dispute over software pre-loading and distribution agreement, HKIAC, 2021 sole arbitrator;
- Breach of patent and know how license, HKIAC 2019 – 2021, sole arbitrator;
- Trade secrets, HKIAC, 2017, co-arbitrator in dispute alleging misuse of trade secrets;
- Patent infringement allegations, HKIAC, 2015 – 2018, co-arbitrator in three arbitrations alleged infringement of patents in USA and Mainland China.

As counsel

- Acted for Respondent in claim regarding ownership rights of intellectual property under supply and distribution agreement, 2024;
 - Acted for Claimant in crypto currency close out disputes, HKIAC, 2024;
 - Acted for Claimant in dispute over alleged breaches of Technology Transfer Agreement, HKIAC, 2020 – 2021;
 - Acted for Respondent in claim for misuse of transferred technology and patent infringement allegations, HKIAC, 2019 – 2021;
 - Acted for Claimant in 2 separate cases claim relating to breach of franchise agreements in Taiwan and Hong Kong HKIAC, 2020 – 2021;
 - *TM Systems v. Huajin Crane*, SIAC, 2010, lead counsel for Claimant in claim for breach of investment and technology transfer agreement;
 - *Alstom v. Zhejiang Insigma*, SIAC, 2008, co-counsel acting for Claimant in claim for breach of know-how and patent license.
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