

WIPO LIST OF NEUTRALS

BIOGRAPHICAL DATA

Douglas CLARK
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Date of Birth: January 9, 1967

Nationality: Australian

EDUCATIONAL AND PROFESSIONAL QUALIFICATIONS

Fellow, Hong Kong Institute of Arbitrators (FHKI Arb), 2012;
CEDR Accredited Mediator, 2012;
Barrister, High Court of Hong Kong, 2011 – present;
Barrister & Solicitor, Supreme Court of Victoria, Australia, 1995 – present;
Solicitor, Supreme Court (now High Court) of Hong Kong, 1996 – 2011;
Solicitor, Supreme Court of England & Wales, 1998-present;

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:

Named as a leading IP Practitioner in Hong Kong/China in Legal directories including Chambers, IAM, Global, Asia Pacific Legal 500, Asia Law and Practice, World's Leading Patent Practitioners, World's Leading Trade Mark Practitioners.

LANGUAGES

English, Mandarin Chinese and Japanese

PRESENT POSITIONS

Barrister, Hong Kong;
Adjunct Professor, Faculty of Law, University of Hong Kong.

PROFESSIONAL EXPERIENCE BEFORE PRESENT POSITION

Head of Mainland China Intellectual Property, Managing Partner, Lovells (now Hogan Lovells) Shanghai office, 2003-2010;
Partner, Lovells Hong Kong, IP Department, 2001-2003;
Solicitor Lovells Hong Kong IP Department 1996-2001.

AREAS OF SPECIALIZATION

Intellectual Property, focused on contentious IP.

MEMBERSHIP IN PROFESSIONAL BODIES**Member:**

Hong Kong Bar Association;
Fellow, Hong Kong Institute of Arbitrators;
European Chamber of Commerce in China, IP Working Group;
Co-Chair (2006 – 2011); Vice Chair (2011 – 2013);
Asian Patent Attorney's Association (APAA);
APAA patents committee, 1998 – 2007;
APAA copyright committee, 2007 – 2010;
Hong Kong Institute of Trade Mark Practitioners.

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 including numerous patent cases relating to pharmaceutical and telecommunications patents.

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 – close to 300 decisions rendered in English, Chinese and Japanese
ADNDRC domain name panelist since 2010

HKIAC .cn domain name panelist since 2015

MAJOR PUBLICATIONS

Books

Intellectual Property in Hong Kong, LexisNexis, 1st Edition, 2019 (also published 3 times a year as a looseleaf service);
Patent Litigation in China, Oxford University Press, 2nd Ed, 2015;
Civil Litigation in Hong Kong, 4th Edition, Sweet & Maxwell, 2012;
Gunboat Justice, British and American Law Courts in China and Japan (1842 – 1943), Earnshaw Books, 2015

Articles/Book Chapters

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

“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 Member

Member, Hong Kong Inland Revenue Board of Review.

As Counsel

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

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 (2016-present);
Nokia v TCT Mobile, acted for Nokia in patent licensing dispute in Hong Kong High Court. (2017-2019);
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);
Bulova v San Ma Industrial - Acted for Plaintiff in threats action to restrain unjustified threats of patent infringement proceedings (2013-14);
Stichting BDO v BDO Unibank, Inc, Acted for Plaintiffs in High Court of Hong Kong in trademark Infringement and passing off case (2011);
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

WIPO Advanced Course on Domain Name Arbitration and Mediation;
CEDR Mediation Training Course.

EXPERIENCE IN MEDIATION

Acting as counsel in court-annexed mediation (2017) and international mediation (2019);
Acted as international counsel in court assisted mediation in China.

PROFESSIONAL TRAINING IN ARBITRATION

WIPO Advanced Course on Domain Name Arbitration and Mediation;
WIPO Advanced Course on Arbitration;
Hong Kong Institute of Arbitrators, Fellowship Assessment Course.

EXPERIENCE IN ARBITRATION

Breach of patent and know how license, HKIAC 2019-present, sole arbitrator in claim for breach of patent and know how license;
Trade secrets, HKIAC, 2017, co-arbitrator in dispute alleging misuse of trade secrets;
Patent infringement allegations, HKIAC, 2015-2018, co-arbitrator in 3 arbitrations alleged infringement of patents in USA and Mainland China;
TM Systems v Huajin Crane, SIAC, 2010, lead counsel in claim for breach of investment and technology transfer agreement;
Alstom v Zhejiang Insigma, SIAC, 2008, co-counsel in claim for breach of know how and patent license.

ARBITRATION EXPERIENCE

SUMMARY TABLE

Type	Administering Institution		Role			
	Name	Number of Arbitrations	Presiding Arbitrator	Sole Arbitrator	Co-arbitrator	Counsel
International Arbitrations	HKIAC	7		1	4	2
	SIAC	2				2
	AAA					
	ICC					
Number of cases: sub-total		9		1	4	4
Domestic Arbitrations	AAA					
	Ad Hoc					
Number of cases: sub-total						
TOTAL		9		1	4	4

MEDIATION EXPERIENCE**SUMMARY TABLE**

Type	Administering Institution		Role	
	Name	Number of Mediations	Mediator	Counsel
International Mediations	SIMC	1		1
	Ad hoc			
Number of cases: sub-total		1		1
Domestic Mediations (Estimates)	AAA			
	Court-annexed	1		1
	Ad Hoc			
Number of cases: sub-total		1		1
TOTAL		2		2