



## Douglas Clark

### Principal, Global Head of Dispute Resolution

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### Professional & Academic Qualifications

- Solicitor, Hong Kong (1996-2010 & 2020-)
- Barrister, Hong Kong (2011-2019)
- Solicitor, England & Wales (2008-present) (currently non-practicing)
- BA (Asian Studies); LLB (Hons), Australian National University
- Post Graduate Certificate (Chinese language and Chinese law), Fudan University, Shanghai
- PCLL, City University of Hong Kong

### Professional Memberships

- Fellow, Hong Kong Institute of Arbitrators
- Member, Asian Patent Attorneys Association (APAA),
- Member, Hong Kong Institute of Trade Mark Practitioners (HKITMP)
- EU Chamber of Commerce in China IPR Working Group

**Doug is a Principal and Global Head of Dispute Resolution with Rouse. He has practiced in Asia for over 25 years.**

Doug is a widely respected, multilingual, litigator and arbitrator with more than a quarter of a century experience handling IP litigation and arbitration in East Asia as well as coordinating global cases. He is fluent in Mandarin Chinese and Japanese.

Doug has significant experience sitting as an arbitrator and acting as counsel in arbitrations. He is also a member of the Hong Kong Inland Revenue Board of Review. His experience includes:

#### As Arbitrator/Panel member

- 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
- 6 Inland Revenue Board of Review cases (2017-20)
- Over 350 domain name dispute decisions

#### As Counsel

- Acting for Respondent in claim for misuse of transferred technology and patent infringement allegations, HKIAC, 2019 to present
- Acting for Claimant in claim over scope of technology transfer agreement, 2020
- Acting for Claimant in claim relating to breach of franchise agreement, 2020
- TM Systems v Huajin Crane, SIAC, 2010, lead counsel for Claimant in claim for breach of investment and technology transfer agreement
- Alstom v Insigma, SIAC co-counsel for Claimant in claim for breach of know how license, 2008

In his career, Doug has handled the entire gamut of contentious IP cases including raiding factories in China (in the early part of his career); obtaining civil search and seizure (Anton Piller) orders and freezing (Mareva) injunctions; establishing new law in relation to anti-circumvention technologies; and, running complex multi-jurisdictional patent litigation.

Doug's non-contentious experience includes advising on technology transfer; conducting patent and other intellectual property audits; and, freedom to operate analyses.

Doug, who is originally from Australia, studied on an exchange at high school in Kobe, Japan and on an Australian/Chinese government scholarship at Fudan University, Shanghai, China. He speaks, reads and write, both Japanese and Chinese.

He began his career in Intellectual Property in Hong Kong in 1993 with international law firm, Lovells. In 2000, he moved to Shanghai where, in 2003, he established and was Managing Partner of Lovells' Shanghai office while also serving in the firm's worldwide partnership council.

In Shanghai, Doug was ranked as a top tier IP lawyer by all the key directories with one of them describing him as "the best IP lawyer practicing in China".

From 2011 to 2019, Doug practiced as an intellectual property barrister in Hong Kong appearing as an advocate in all level of courts, including in the Hong Kong Court of Final Appeal.

Doug is an adjunct professor at the University of Hong Kong where he teaches an LLM/JD course in IP. He is the author numerous articles on IP and of three legal texts: Patent Litigation in China, Hong Kong Intellectual Property and Civil Litigation in Hong Kong. He has also written a three volume history of extraterritoriality in China, Gunboat Justice.

### **Major Arbitration cases**

As Arbitrator/Panel member

- Breach of patent and know how license, HKIAC sole arbitrator in claim for breach of patent and know how license (2019-present)
- Trade secrets, HKIAC, co-arbitrator in dispute alleging misuse of trade secrets (2017)
- Patent infringement allegations, HKIAC, co-arbitrator in 3 arbitrations alleged infringement of patents in USA and Mainland China (2015-2018)
- Over 350 domain name dispute decisions as WIPO and ADNDRC panelist (2008-2020)

As Counsel

- Acting for Respondent in claim for misuse of transferred technology and patent infringement allegations, HKIAC, 2019 to present
- Acting for Claimant in claim over scope of technology transfer agreement, 2020
- Acting for Claimant in claim relating to breach of franchise agreement, 2020
- TM Systems v Huajin Crane, SIAC, 2010, lead counsel for Claimant in claim for breach of investment and technology transfer agreement
- Alstom v Insignia, SIAC co-counsel for Claimant in claim for breach of know how license, 2008

### **Mediation experience**

- Acted as mediator in US International Trade Commission patent infringement case (2019)
- Acted as counsel in mediation involving trademark dispute between two large multinational tobacco companies (2019-20)
- Acted as counsel in mediation involving franchise agreement (2020)

## Quasi-Judicial Tribunal

Doug is a member of the Hong Kong Revenue Board of Review and has been appointed a tribunal member in 6 cases.

## Major Litigation cases

- US Toy Company vs Chinese distributor, Acting for plaintiff in Patent infringement law suit in China (2020)
- *Wong To Yick v Singapore Medicine* – Sole trial counsel acting for defendant in trademark infringement and passing off claim (2019-20)
- *Nokia v TCT Mobile*, acted as counsel for Nokia in patent licensing dispute in Hong Kong High Court. (2017-2019)
- *Tsit Wing Group v TWG Tea Ltd* – Acting as counsel for Defendant (Appellant) in Hong Kong Court of Final Appeal (2014-16). This case is now the leading case in Hong Kong on trademark infringement.
- *ZTE v Vringo*, Shenzhen Intermediate Court. Acted for defendant for alleged breach of PRC Anti-Monopoly Law in FRAND Licensing (2013-2016)
- *Solvay v Yangnong* – Patent infringement cases in Shanghai Higher People’s Court and Tokyo District Court (2012-2014)
- *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 (2016-2019)
- *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*, Acted for Plaintiffs in High Court of Hong Kong in trademark Infringement and passing off case (2011)
- *Qualcomm v Nokia*, Acting for Qualcomm as lead partner in Asia in global standard essential licensing dispute with Nokia (2006 to 2008)

## Interim injunctions

Doug has handled hundreds of interim injunction cases, including:

- *Nagravision v Zhuhai Gotech*, acting for Plaintiff to obtain asset freezing injunction up to US\$100 million to enforce US judgment in Hong. Defended injunction in multiple inter-partes hearings. (2016-19)
- Multinational pharmaceutical company – Acted as counsel on interlocutory injunction for patent at end of life (2018-19)
- *Lego v Wellink*, acted for Plaintiff to obtain asset freezing and other interlocutory injunctions against Hong Kong trading company sourcing from Mainland China (2018)
- *Duracell v Matsushima*, acted for plaintiff to obtain Anton Piller Order in relation to parallel imported batteries as well as disclosure order against suppliers (2017)
- *Dyson v German Pool*, acted for defendants to discharge interim injunction against patent infringement (2016)
- *Pandora SA v Glamulet*, acted for Plaintiff to obtain asset freezing and other interim injunction in Hong Kong in relation to online sales by China based business (2015)
- *Elitt Engineering v SNE Engineering*, acted for Defendant to discharge asset freezing injunction (2012)
- *Sony Computer, Nintendo and Microsoft v Lik Sang*, acted for all three companies to obtain simultaneous Anton Piller Orders and Mareva Injunctions (2007)

## Expert witness

Doug has been appointed an expert witness in the following cases:

- London Court of International Arbitration. Expert witness on Chinese contract and procedural law (2018-19)
- *Chemtall Incorporated v BASF SE & BASF Corporation*, Civil Action No: 4:17-cv-00186-LGW-GRS, Expert Report on whether documents marked “internal circulation” were novelty destroying under Chinese law (2018)
- *Optis Wireless Tech., LLC Et Al v Huawei Techs Co. Ltd et al*, Civil Action No. 2:17-cv-123-JRG-RSP, United States District Court for Eastern District of Texas, Marshall Division – Expert Evidence on PRC litigation procedures and PRC Competition Law. (2017)
- *Major Bravo Ltd v Wolfgang Heinzl*, Opinion for German Court on patent entitlement proceedings under Hong Kong law. (2017)
- *Hong Kong Yaguan Trading v Vinmar International*, United States District Court, Southern District of Texas, Houston Division, Civil Action No. 4:16-cv-03636, Expert evidence on Hong Kong contract law in application to set aside arbitral award (2017)
- *Vringo, Inc. v. ZTE Corporation et al*, United States District Court for Southern District of New York Civil Action No. No. 1:2014cv04988 – Opinion on PRC litigation procedures and PRC and Hong Kong law of privilege. (2015)
- *Johnson Electric Industrial Manufacturing Ltd v Ametek, Inc*, United States District Court District of Connecticut, Civil No. 3:03CV0098(AVC) - Opinion on Chinese law in US patent infringement case including allegations of infringement in China. (2005)

## Publications

### Books

- Patent Litigation in China, Oxford University Press, 2nd edition, 2015
- Intellectual Property in Hong Kong, LexisNexis, 1st Edition, 2019 (also published 3 times a year as a looseleaf service)
- Civil Litigation in Hong Kong, 5th Edition, Sweet & Maxwell, 2017 (with Allan Leung)
- Gunboat Justice, British and American Law Courts in China and Japan, 1842 – 1943, Earnshaw Books, 2015 - A legal history of extraterritoriality in China.

### Selected Articles/Book Chapters

- “Enforcement of IP Rights in China” to be published in the Intellectual Property Law in China, 2nd ed (Max Planck Institute) in 2021
- “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)

### **Academic Scholarships and Prizes**

- Sino-Australian Bilateral Education Scholarship (1988-1990): 2 year fully funded scholarship to study Chinese and Chinese Law in China (8 scholarships per year are awarded)
- Australian Mining Institute Prize for Transnational Foreign Investment Law, ANU – 1992
- Boase & Cohen Prize, City U HK, 1995

### **Professional Language Qualifications**

- Level 3 (Professional Level) Certification as Chinese to English Translator from Australian National Accreditation Agency for Translators and Interpreters ("NAATI"), 1993
- Level 3 NAATI Certification as Japanese to English Translator, 1992