



香港國際仲裁中心
Hong Kong International
Arbitration Centre

One Stop Shop: IP Dispute Resolution in Hong Kong at HKIAC

[Dr. Prof. Ling Yang](#)

Deputy Secretary-General, Hong Kong International Arbitration Centre

10 June 2020

International Best Practice | Asia Specialist | China Expert





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OVERVIEW



Founded in 1985,
HKIAC has managed
over 10,500 cases to
date



Top 4 arbitral
institutions globally



Independent &
non-profit
organisation



One stop shop
for arbitration, mediation,
adjudication & domain
name disputes

PREMIER ARBITRATION VENUE AND FACILITIES



**PREMIER
LOCATION**



**DEDICATED
SUPPORT**



**CUSTOMISABLE
SPACE**



FUNCTIONS AND SERVICES

Mediation Services

Hearing & Conference Facilities

Adjudication Services

Arbitration Services

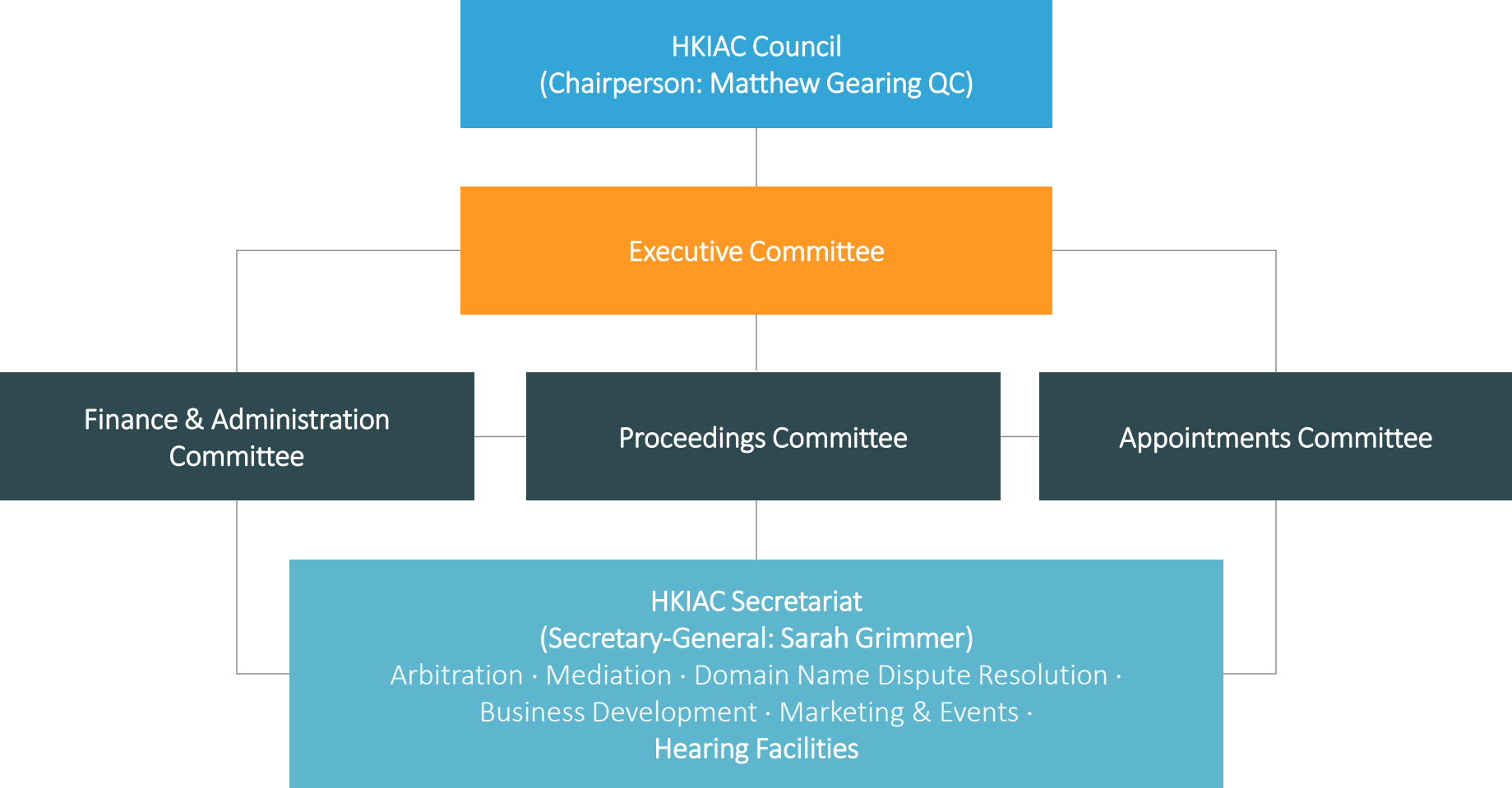
- Case administration
 - HKIAC Administered Arbitration Rules
 - UNCITRAL Arbitration Rules
- Statutory appointing authority under the Hong Kong Arbitration Ordinance (Cap 609)
- Fund-holding services
- Award authentication services
- Tribunal secretary services

Domain Name Dispute Resolution Services



ADR Events & Training

TRANSPARENT ORGANISATIONAL STRUCTURE



SPECIALIST STANDING COMMITTEES



Executive Committee



Matthew Gearing QC

Joseph Wan
Jun Hee Kim
Nils Eliasson

Finance & Administration Committee



Joseph Wan

Anthony Houghton SC
Danny Mok
Kathryn Sanger
Robert Tang GBM, SBS, QC, SC, JP
Matthew Gearing QC

Appointments Committee



Jun Hee Kim

Christopher Boog
John Cock
Vincent Connor
Ronald Sum
Huawei Sun
Winnie Tam SC
Meg Utterback
Ing Loong Yang
Matthew Gearing QC

Proceedings Committee



Nils Eliasson

Victor Dawes SC
Karl Hennessee
Christine Kang
Andrea Menaker
Promod Nair
Friven Yeoh
Matthew Gearing QC

EXPERIENCED INTERNATIONAL SECRETARIAT

ARBITRATION TEAM

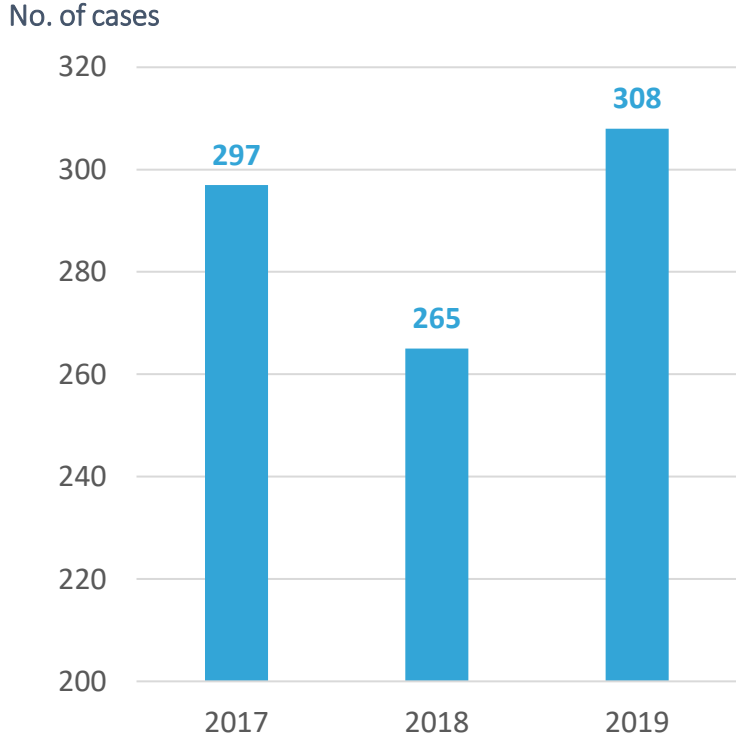
- 10 nationalities; 12 languages (11 nationalities; 12 languages across the Secretariat)
- Experienced in dispute resolution proceedings
 - investment and commercial arbitration, common law and civil law
- Top universities in North America, Europe and Asia



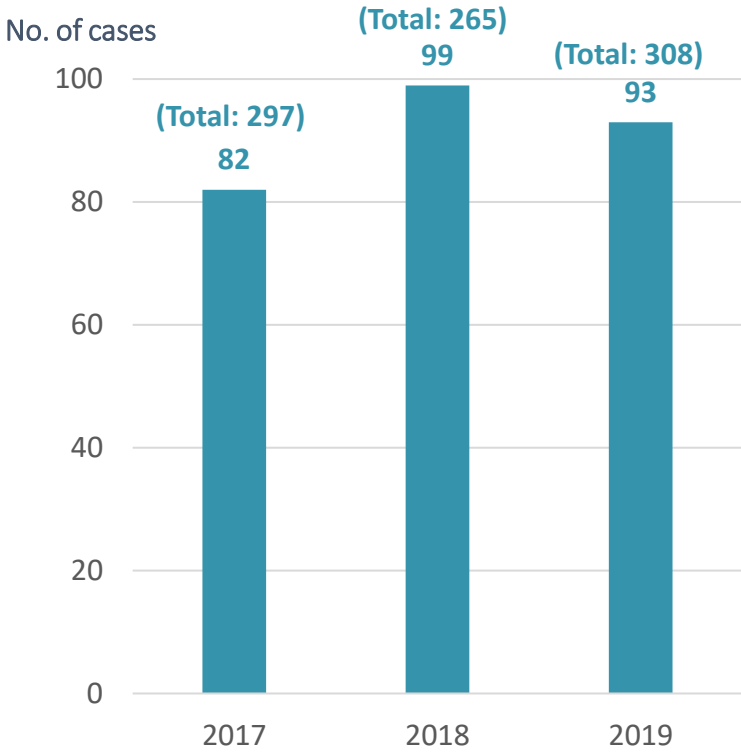
GROWING ARBITRATION CASELOAD



Total HKIAC arbitration cases



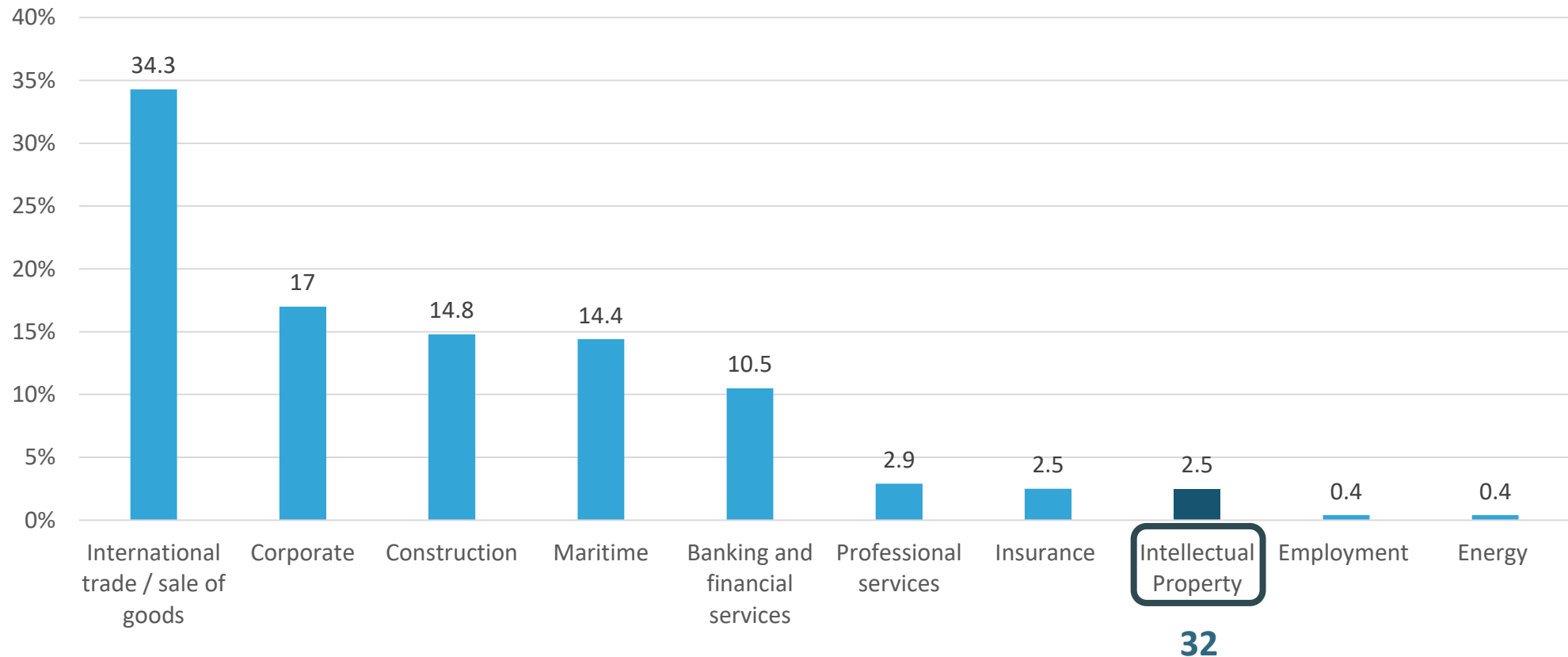
HKIAC arbitration cases commenced with multiple parties or multiple contracts



BREADTH OF INDUSTRY EXPERTISE

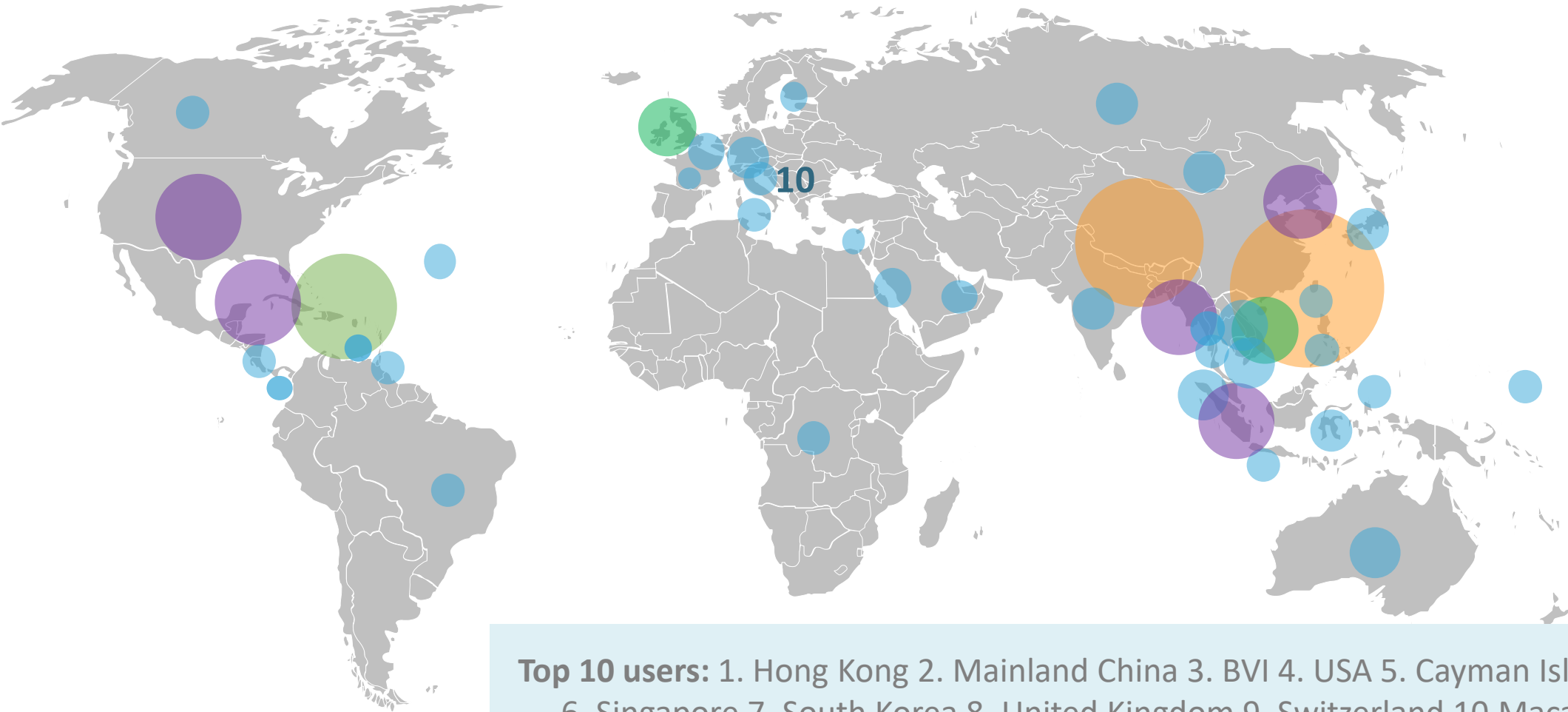


Percentage of HKIAC arbitrations by industry sector 2019



ARBITRATION CASELOAD BY PARTY NATIONALITY 2019

Parties from 56 jurisdictions



ARBITRABILITY OF IP DISPUTES

- Underpinned by One country, Two systems



- **Hong Kong Arbitration Ordinance (Cap 609)**

- Unitary arbitration regime
- UNCITRAL Model Law (2006)
 - Wide range of interim relief
 - Complete protection of confidentiality
 - HKIAC statutory role as appointing authority
- Opt-in mechanism to appeal awards based on a question of law
- Amended regularly to keep pace with important developments
 - Emergency arbitration
 - **IP disputes**
 - Third Party Funding



- **Availability of interim relief in Mainland China**

- **Enforcement of Hong Kong awards**

- New York Convention
- 1999 China-Hong Kong Arrangement
- 2013 Macau-Hong Kong Arrangement



- **Enforcement of awards in Hong Kong**

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- 2017 no awards refused enforcement

- **Set aside of awards in Hong Kong**

- High threshold for set aside

103D. IPR disputes may be arbitrated

- (1) An IPR dispute is capable of settlement by arbitration as between the parties to the IPR dispute.
- (2) In ascertaining whether there is an arbitration agreement between the parties within the meaning of section 19(1) (as it gives effect to Option I of Article 7(1) of the UNCITRAL Model Law), an agreement by the parties to submit to arbitration an IPR dispute is taken to be an agreement by the parties to submit to arbitration a dispute which has arisen or which may arise between them in respect of a defined legal relationship.
- (3) Subsection (1) applies whether the IPR dispute is the main issue or an incidental issue in the arbitration.
- (4) For the purposes of subsection (1), an IPR dispute is not incapable of settlement by arbitration only because a law of Hong Kong or elsewhere—
 - (a) gives jurisdiction to decide the IPR dispute to a specified entity; and
 - (b) does not mention possible settlement of the IPR dispute by arbitration.
- (5) In subsection (4)(a)—

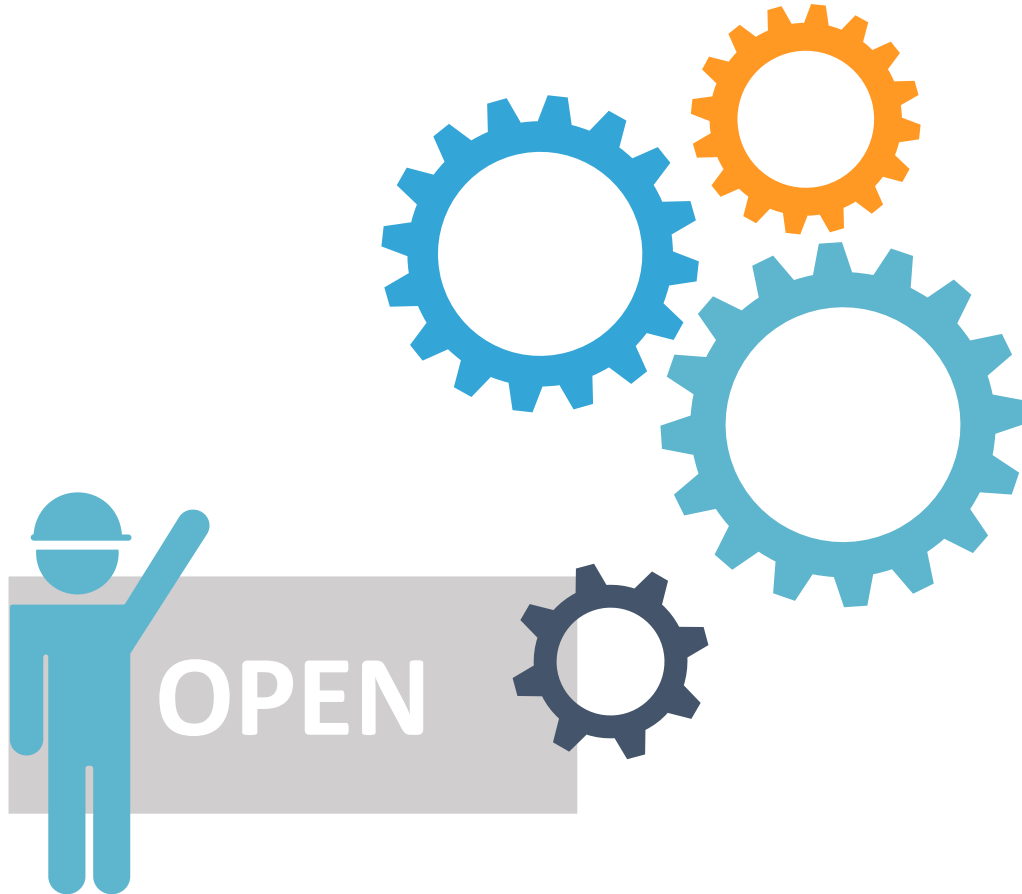
specified entity (指明實體) means any of the following entities under the law of Hong Kong or elsewhere—

 - (a) a court;
 - (b) a tribunal;
 - (c) a person holding an administrative or executive office;
 - (d) any other entity.
- (6) The power given to an arbitral tribunal under section 70 to award any remedy or relief in deciding an IPR dispute is subject to any agreement between the parties to the IPR dispute.

103G. Recognition and enforcement of award involving IPR

- (1) For the purposes of sections 86(2)(a), 89(3)(a), 95(3)(a) and 98D(3)(a), a matter is not incapable of settlement by arbitration under the law of Hong Kong only because the matter relates to an IPR dispute.
- (2) For the purposes of sections 86(2)(b), 89(3)(b), 95(3)(b) and 98D(3)(b), it is not contrary to public policy of Hong Kong to enforce an award only because the award is in respect of a matter that relates to an IPR dispute.

STRONG IP EXPERTISE AND AVAILABILITY OF IP ARBITRATORS



Panel of Arbitrators

List of Arbitrators

Panel of Arbitrators for Intellectual Property Disputes

Panel of Arbitrators for Intellectual Property Disputes

Home > Arbitration > Arbitrators > Panel of Arbitrators for Intellectual Property Disputes

The HKIAC Panel of Arbitrators for Intellectual Property Disputes comprises members who have demonstrated extensive experience and strong expertise in resolving intellectual property disputes.

Last Name	First Name	Firm/Chambers	Practice Location	CV
ALLISON	David	Philip Morris Asia	Hong Kong	↓
BENNETT	Annabelle	5 Wentworth	Australia	↓
Benton	Gary	Gary Benton Arbitration	United States	↓
Brown QC	Neil	N.A	Hong Kong / Australia	↓
Certilman	Steven A	Steven A. Certilman PC	United States	↓
Chua	Yvonne	Wilkinson & Grist	Hong Kong	↓

Arbitrators

- [Panel & List of Arbitrators](#)
- [Panel of Arbitrators for Financial Services Disputes](#)
- [Panel of Arbitrators for Intellectual Property](#)
- [Panel of Emergency Arbitrators](#)
- [Criteria & Application Procedure](#)
- [Guidelines for Renewal](#)
- [Complaints Against Arbitrators](#)

PROTECTION OF CONFIDENTIALITY



- **Hong Kong Arbitration Ordinance (Cap 609)**

- Unitary arbitration regime
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17. Restrictions on reporting of proceedings heard otherwise than in open court

- (1) This section applies to proceedings under this Ordinance in the court heard otherwise than in open court (*closed court proceedings*).
- (2) A court in which closed court proceedings are being heard must, on the application of any party, make a direction as to what information, if any, relating to the proceedings may be published.
- (3) A court must not make a direction permitting information to be published unless—
 - (a) all parties agree that the information may be published; or
 - (b) the court is satisfied that the information, if published, would not reveal any matter (including the identity of any party) that any party reasonably wishes to remain confidential.

- (4) Despite subsection (3), if—
 - (a) a court gives a judgment in respect of closed court proceedings; and
 - (b) the court considers that judgment to be of major legal interest,the court must direct that reports of the judgment may be published in law reports and professional publications.
- (5) If a court directs under subsection (4) that reports of a judgment may be published, but any party reasonably wishes to conceal any matter in those reports (including the fact that the party was such a party), the court must, on the application of the party—
 - (a) make a direction as to the action to be taken to conceal that matter in those reports; and
 - (b) if the court considers that a report published in accordance with the direction made under paragraph (a) would still be likely to reveal that matter, direct that the report may not be published until after the end of a period, not exceeding 10 years, that the court may direct.
- (6) A direction of the court under this section is not subject to appeal.

INTERIM RELIEF FROM MULTIPLE AUTHORITIES



- **Hong Kong Arbitration Ordinance (Cap 609)**
 - Unitary arbitration regime
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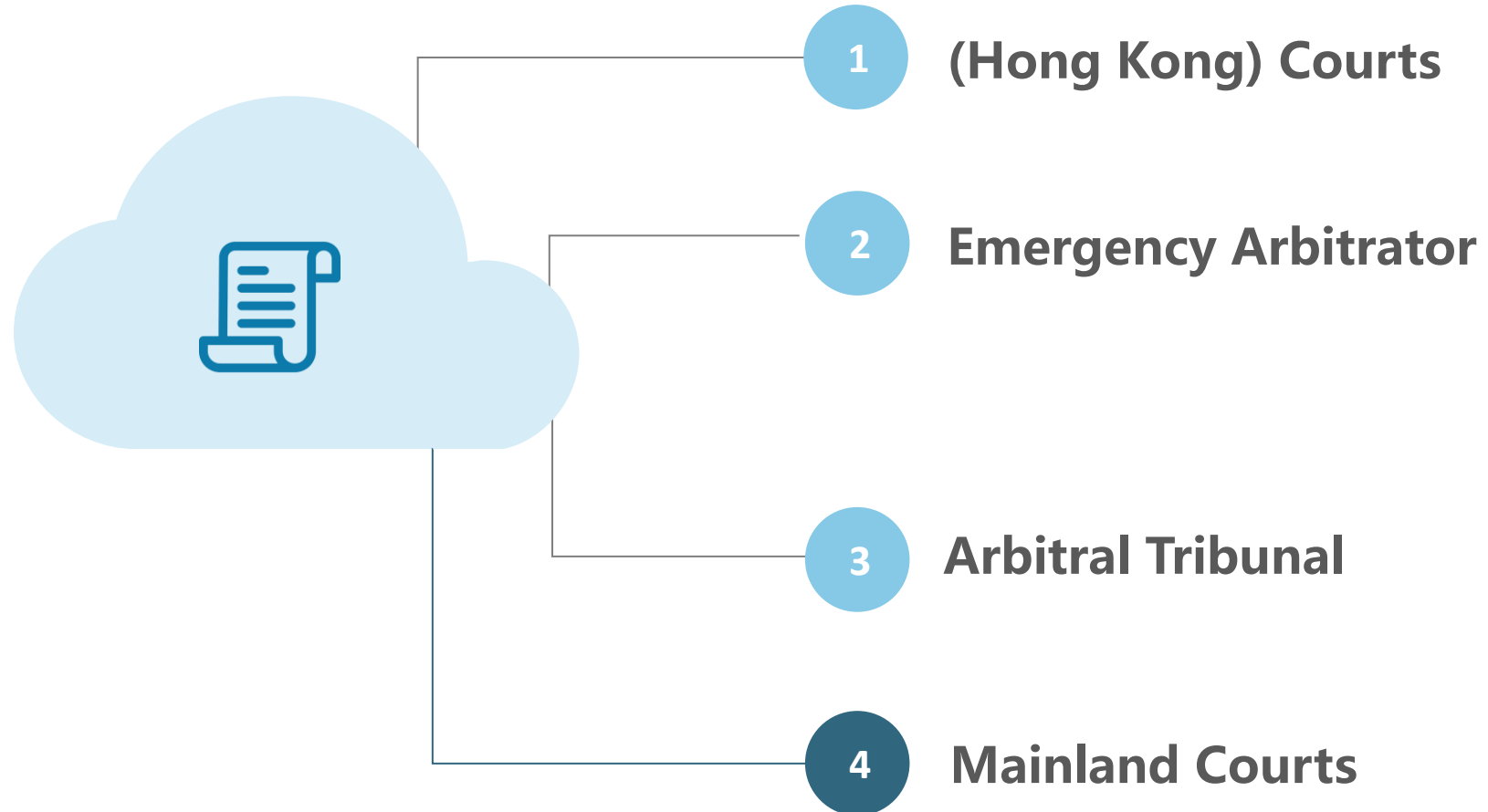


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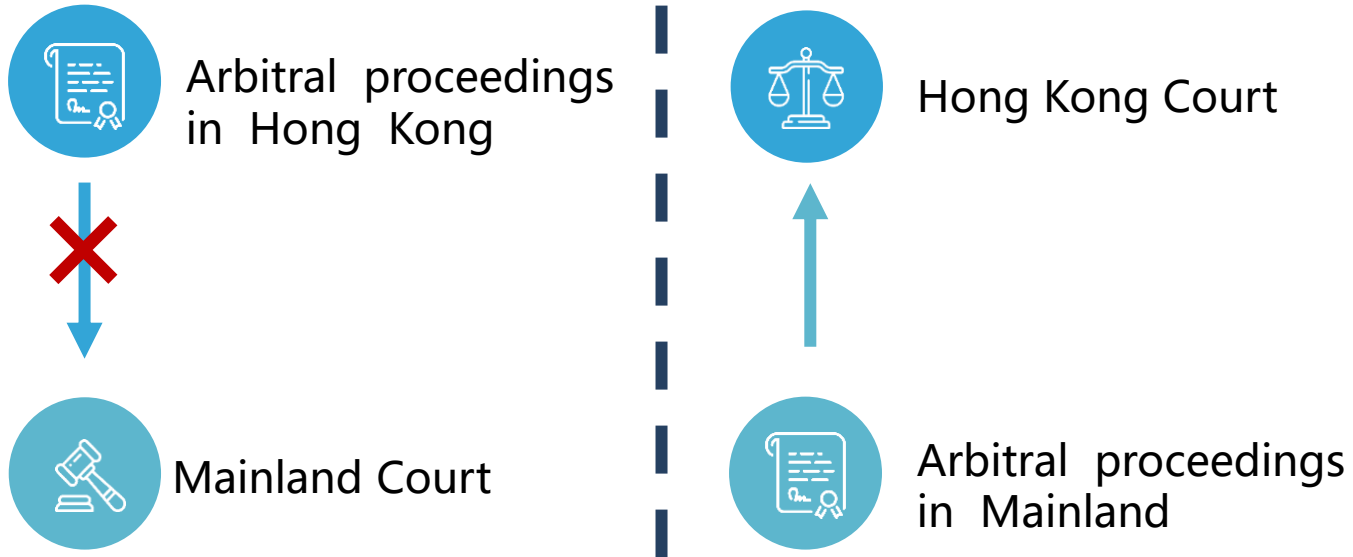


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INTERIM RELIEF FROM MULTIPLE AUTHORITIES



INTERIM RELIEF FROM MULTIPLE AUTHORITIES



Preservation of assets

Preservation of evidence

Preservation of conduct



The key development is access to Mainland Courts for HK-seated arbitrations



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DOMAIN NAME DISPUTE RESOLUTION

HKIAC has one of the largest caseloads in Asia-Pacific

503 new disputes



182 domain
name disputes



308 arbitration cases

- 173 fully administered



12 mediations

DOMAIN NAME DISPUTE RESOLUTION PANEL



Arbitrating IP Disputes | Mediating IP Disputes | Domain Name Dispute Resolution

Domain Name Dispute Resolution Panel

Home > Domain Name Disputes > Domain Name Dispute Resolution > Domain Name Dispute Resolution Panel

The HKIAC Domain Name Dispute Resolution (“DNDR”) Panel comprises individuals who have demonstrated extensive experience and strong expertise in resolving domain name disputes.

If you wish to apply to join the DNDR Panel, the DNDR Panel Criteria and Application Procedure can be found [here](#).

Last Name	First Name	Title	Location	CV
Ali	Shahla	Dr.	Hong Kong	↓
Allison	David	Mr.	Hong Kong	↓
Arnold	Robert A	Mr.	Hong Kong	↓

Domain Name Dispute Resolution

- Domain Name Dispute Resolution Services
- ADNDRC (Hong Kong Office) Background
- DNDR Panel Criteria and Application Procedure
- Domain Name Dispute

Arbitration under the HKIAC Administered Arbitration Rules

Any dispute, controversy, difference or claim arising out of or relating to this contract, including the existence, validity, interpretation, performance, breach or termination thereof or any dispute regarding non-contractual obligations arising out of or relating to it shall be referred to and finally resolved by arbitration administered by the Hong Kong International Arbitration Centre (HKIAC) under the HKIAC Administered Arbitration Rules in force when the Notice of Arbitration is submitted.

The law of this arbitration clause shall be ... [*Hong Kong law*].

The seat of arbitration shall be ... [*Hong Kong*].

The number of arbitrators shall be ... [*one or three*].

The arbitration proceedings shall be conducted in ... [*insert language*].

QUESTIONS



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2018 Administered Arbitration Rules



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