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C H A N C E

14TH EDITION



GLOBAL INTELLECTUAL PROPERTY NEWSLETTER
IP ARBITRATION AS A MECHANISM TO
RESOLVE IP-RELATED DISPUTES
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14TH EDITION

Welcome to the **14th Edition** of the Clifford Chance Global IP Newsletter. With summer coming up, we want to take a closer look on a hot topic in the World of IP: **IP arbitration**. Hence, this edition provides you with insights from Hong Kong to China, from Australia to Spain and Italy as well as Germany.

First, the newsletter gives an overall view from a German stand point, contrasting IP arbitration with adversary court proceedings as IP Arbitration does not only provide an alternative regime, but also comes with great flexibility to tailor IP dispute resolution out of court.

We then take a look at IP arbitration in Italy and the new Spanish Patents Act. Spain just recently introduced the possibility of out-of-court dispute resolution to resolve patent conflicts. The article will thus discuss the particular strengths and weaknesses that arose in the two months subsequent to the coming into force of the Spanish Patent Act.

But it is not only a question of whether arbitration is generally suitable for resolving IP-related disputes. Also the collection and evaluation of evidence might in some cases need specific attention especially since arbitration usually does not encompass a broad-ranging discovery that is common in court proceedings in common law jurisdictions. Accordingly, the article on IP arbitration in Australia will demonstrate the issues that might arise in connection with satisfying the burden of proof.

Further, with the decision in *Huawei* by the CJEU, FRAND (**F**air, **R**easonable and **N**on-**D**iscriminatory) licenses pose new challenges for arbitration tribunals. Therefore, we will discuss whether arbitration can be an effective instrument to prevent further “patent wars” since arbitration – promoted by key players (such as WIPO, FTC and CJEU) – may cater for the needs of those with large patent portfolios to create efficient multi-jurisdictional dispute resolution.

This edition will then expand on recent legislative developments regarding a new bill to implement IP arbitration in Hong Kong as well as on a current two-year pilot working programme by the Chinese State Intellectual Property Office to develop an IP arbitration and mediation mechanism across China. Finally, we will touch on the IP-related preliminary injunction applications and investigation measures requests filed in connection with the latest Mobile World Congress held in Barcelona, with more than 20 cases solved within just a few days.

We hope you enjoy our latest episode of our Clifford Chance Global IP Newsletter and look forward to receiving your feedback. Enjoy the summer.

Your global CC IP Team

DÜSSELDORF GERMAN PERSPECTIVE ON IP ARBITRATION

The trend for intellectual property (“IP”) disputes to be resolved through international arbitration rather than court litigation is steadily growing.¹ Complex contractual relations with respect to IP rights (e.g. research and development agreements, cross-licensing, etc.)—often involving several parties from different jurisdictions—as well as non-contractual relationships (e.g. infringement proceedings) require a reliable and cost-efficient mechanism to settle any disputes that might arise in connection with the IP rights at issue.

With that in mind, arbitration provides certain advantages over court litigation, in particular with regard to the choice of applicable law, the place of jurisdiction and the arbitrator’s expertise. Issues such as confidentiality and the non-disclosure of sensitive technology (protected through patents or trade secrets for example) might also play an important role in the parties’ decision to submit themselves to a private tribunal of arbitrators. In Germany, the German Institution for Arbitration (*Deutsche Institution für Schiedsgerichtsbarkeit e.V.*, “DIS”) is one of several national and international institutions to which the parties may turn.² Of course it has to be noted that certain decisions for example regarding the validity of the patent can only be made by the respective administrative bodies. The decisions by an arbitral board will also have only inter partes effect.

Key aspects of IP arbitration in comparison to court litigation

Several key factors should be taken into account when considering IP arbitration:

Single proceeding, applicable law, and venue

IP disputes often involve cross-border issues if, for example, an infringement occurs in different countries. Multiple court proceedings under different laws are not unusual, resulting in the risk of conflicting judgments on the same subject matter due to differences in the applicable procedural and material laws. By contrast, IP arbitration lets the parties determine the applicable law as well as the place of jurisdiction (and

Key Issues

- IP arbitration provides an alternative regime to resolve IP related disputes.
- IP arbitration can have advantages over court litigation as it comes with the necessary flexibility to tailor the applicable procedural rules around the specifics of the IP (e.g. patents) at issue.
- However, in Germany the validity of a patent cannot be subject to IP arbitration proceedings.

¹ The IP convention “15th Petersberger Schiedstage 2017” (“Arbitration days of Petersberg”) just had IP arbitration as its general topic; DIS40, a branch of the German Institution to Arbitration for young lawyers, dedicated one of its conventions in May 2017 to issues related to patents in IP arbitration proceedings and FRAND; see *Diehl* in: Milbradt, Patent Litigation in Germany, p. 232 et seq.

² Well known arbitration institutions each with its own sets of arbitration rules are, for example, the International Chamber of Commerce (“ICC”), the Swiss Arbitration Association (“SAA”) or the London Chamber of International Arbitration (“LCIA”). The rules of the WIPO Arbitration and Mediation Center are suitable in particular with regard to IP disputes due to their detailed rules with respect to confidentiality and the law of evidence.

other procedural details such as the responsible arbitrator(s)) beforehand. In consequence, complex IP disputes may be dealt with **one** proceeding in a single forum, avoiding the danger of contradicting court decisions issued in different countries and leading to a higher degree of legal certainty and enforceability.

Flexibility

As the parties may decide on and even modify the applicable rules, IP arbitration can be a highly flexible mechanism. On the other hand, the lack of a detailed procedural framework and a system of precedent may, in some cases, be considered a disadvantage that can only be resolved by an equivalently experienced arbitrator (for example, to deal with possible obstruction of proceedings by one party).³

Limited remedies of arbitral award

Another advantage of arbitration is that the proceedings are generally subject to only one instance, rendering the process more time and cost efficient. Especially with regard to the commercialisation of IP rights, settling an IP dispute quickly and easily should be in the interest of all parties, as further use of a patent, trademark, or similar, before the resolution of the conflict might increase damages.

Court proceedings in Germany usually allow the parties to lodge an appeal, resulting in proceedings litigated through different instances, sometimes spanning several years and further increasing the costs of proceedings.⁴ However, arbitrations seated in Germany, as in all member states of the New Convention on the Recognition and Enforcement of Foreign Arbitral Awards, are only subject to a motion to set aside, which is limited to serious procedural irregularities, jurisdictional issues or serious departures from public policy. Thus, a fully-fledged appeal does not occur. Although in camera proceedings do generally not exist under German law, only for inspection claims, a certain trade secret non-disclosure proceeding exists in German courts.

Confidentiality

One of the most important advantages of arbitration is the confidential nature of the arbitration being process, which can be of particular importance for both parties when highly sensitive technology is at stake and non-disclosure, for example of a trade secret, needs to be ensured. The arbitration clause and any disclosure made during the arbitration, as well as the existence of the arbitration proceeding itself, may be subject to confidentiality obligations of the parties.⁵ This can be enforced, for example, by (i) granting board access only to members of the board and the concerned parties, and/or (ii) requesting that third parties wishing to attend sign confidentiality agreements. Conversely, court litigation usually requires public proceedings, allowing competitors to acquire confidential information, as the prerequisites for the exclusion of the public are usually quite high.

“Claudia Milbradt of

Clifford Chance specialises in patent litigation, where she mainly handles injunction proceedings, invalidity proceedings and nullity actions. Her practice also covers patent licence agreements and the IP aspects of M&A transactions. She represented Hyundai in two patent infringement proceedings and a nullity action against Scania. One client sums up: “She is very experienced, realistic, prepares excellently for court appointments and fights for her client while remaining objective and proper.”

Chambers & Partners 2017: Europe Guide: Germany – Intellectual Property: Patent Litigation

³ *Diehl* in: Milbradt, Patent Litigation in Germany, p. 265.

⁴ For example, in Germany, patent court litigation spanning over three instances may easily take, in some cases, six to eight years or more.

⁵ German patent law however provides the possibility to entrust the court with supervising the procedure of disclosing the infringing technology at issue by the alleged infringer.

Technical expertise

IP disputes often relate to technical issues, including patents and know-how. Usually, the parties may jointly select an arbitrator with a technical background and the required knowledge regarding the specific technology in dispute. An arbitrator situated in the same industry as the parties might have a better understanding of the relevant technical issues (for example when assessing the quality of evidence)—something not all regular judges can provide.⁶ However, arbitrators with technical backgrounds are often not legal experts. In consequence, the parties will likely seek to select more than one arbitrator, to combine technical and legal expertise.

Urgency

Court litigation is usually a drawn-out process, with strict deadlines leaving little room for flexibility. As arbitration offers the possibility of a flexible coordination of the arbitration schedule, the parties may agree on a quick procedure in case a swift decision (for example, to stop an IP infringement) is necessary.

However, a preliminary injunction by a court might still be the more efficient way of proceeding in urgent cases, as it does not require any oral hearing and can be issued within days or even hours without further delays.⁷

Business relations

Another important aspect is that business relations are less likely to suffer in sincere and constructive arbitration proceedings than they might in adversary proceedings before a court. As opposed to a court action, the parties determine the circumstances of the dispute resolution process amicably. In addition, the personality of the arbitrator often has a positive impact on the overall conduct of the proceedings, being entrusted with the arbitration by agreement of the parties. Thus, for example in cases where the parties' long standing joint research activities are at stake, arbitration might be the more sensitive option in order to maintain a unencumbered business relation.

Validity of patents not arbitrable in Germany

As regards patents granted by the German Patent and Trademark office, it should be noted that any alleged invalidity is usually not considered to be arbitrable subject matter due to the "bifurcation" in the patent litigation system, at least in Germany.

Bifurcation in this context means that infringement claims and nullity actions regarding the same patent have to be sued before different responsible courts and cannot be resolved in a single proceeding (for example, by way of claim and counterclaim). This often leads to the stay of the infringement action until the nullity action is decided. One of the reasons for this is that infringement actions are considered to be matters of private law to be decided by an ordinary court, whereas questions of validity concern the *public* nature of the grant of the patent and thus fall under the responsibility of the state (that is, the courts specified in Section 65 of the German Patent Act).

⁶ In order to include the required technical expertise into the decision making process, the soon to be implemented Unified Patent Court will also include judges with a technical background into its panels.

⁷ However, also the DIS for example provides a mechanism similar to preliminary injunctions issued by a court, see Section 20 DIS-Arbitration Rules 98.

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27 June 2017

Client workshop: Disruptive Revolution – The Future was Yesterday

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Event location: Clifford Chance Düsseldorf, Germany

In consequence, according to the current prevailing opinion, the public nature of validity and the state's monopoly on the issuance of patents renders it impossible for private arbitral tribunals to rule on such matters.⁸ However, other commentators still argue for the arbitration of invalidity actions as, for example, any award could merely order the patent owner to apply for the cancellation of the patent at the patent office, but not substitute the necessary public act of cancellation itself (which has to be issued by the Office).⁹ In any case, these restrictions should be kept in mind when agreeing on arbitration of patents in Germany.

Conclusion

Arbitration could provide a viable alternative to resolve IP disputes without turning to a public court where confidentiality, among other things, might be an issue. However, it should be noted that arbitration, due to its procedural particularities, requires a high degree of expertise by attorneys as well as arbitrators. Especially with regard to IP, which is highly dependent on case law even in a civil law country like Germany, the lack of a broad and reliable basis of precedents within the arbitration system might be an issue.¹⁰ In any case, it is safe to say that a thoroughly prepared IP arbitration clause or agreement tailored to the individual case and the type of IP at issue is of utmost importance to avoid any surprises later on.



⁸ This is different with regard to Swiss patents to be arbitrated in Switzerland.

⁹ Haubner, Patentstreitigkeiten und Schiedsgerichtsbarkeit, InTer 4/14, p. 240 et seq.

¹⁰ For the same confidentiality reasons, many of the arbitration cases are never published.

BARCELONA ARBITRATION AND MEDIATION IN THE NEW SPANISH PATENTS ACT: REVIEW OF ARTICLE 136 OF THE PATENTS ACT (*LEY 24/2015, DE 24 DE JULIO, DE PATENTES*)

The new Spanish Patents Act (*Act 24/2015, of 24 July, on Patents*), in force since 1 April 2017, includes, for the first time, the express possibility of resorting to the out-of-court measures of mediation or arbitration to resolve conflicts in relation to patent law. In this article we will provide a brief analysis of the new provisions in this area.

On 1 April 2017, the Patents Act 24/2015, of 24 July 2015, came into force in Spain (the “**New Patents Act**”), replacing the former Patent Act 11/1986, of 20 March 1986 (“**Act 11/1986**”).

One of the changes introduced by the New Patents Act is found in Title XII, Chapter IV, “Out-of-court dispute resolution” (*Solución extrajudicial de controversias*). In addition to the possibility of having recourse to conciliation with regard to employee inventions established previously, the New Patents Act expressly envisages the possibility of submitting patent law disputes to out-of-court dispute resolution.

As a starting point, the first paragraph of Article 136 of the New Patents Act expressly recognises the possibility of parties submitting disputes arising from the exercise of their rights recognised in the New Patents Act not only to mediation, which it now establishes on a general basis, but also, for the first time, to arbitration. These are two means of out-of-court dispute resolution that in practice were already available for settling patent-law related matters. Although the possibility of mediation was already expressly provided in Act 11/1986, it was only envisaged as a means of resolving disputes arising from the grant of obligatory licences. Article 136 also adds some specific features, such as the designation of the Spanish Patent and Trademark Office (“**SPTO**”) as a mediation and arbitration institution.

The New Patents Act also provides clarification with regard to those issues not left to the discretion of the parties and, therefore, excluded from mediation and arbitration. It notes that those disputes related to procedures regarding the grant, opposition or appeal of rights granted under the New Patents Act cannot be submitted to arbitration or mediation when the subject-matter of the dispute is related to administrative procedures. These include the fulfilment of the requirements for the grant, maintenance or validity of the patent. That said, conflicts arising in relation to the infringement of a patent could be the subject-matter of mediation or arbitration.

There are other situations aside from the scenarios envisaged above that could raise certain concerns. For instance, can an arbitrator deal with the nullity or expiry of a patent raised by the defendant, by way of a mere defence, in infringement arbitration proceedings? The New Patents Act seems to be clear that disputes involving the validity of a patent would be excluded (for example, in cases of direct nullity actions or counterclaims with an *erga omnes* effect). However, doubts arise when challenging the validity of the patent and if an effect as between the parties, limited to the specific

Key Issues

- The new Spanish Patents Act expressly envisages the possibility of submitting patent law disputes to arbitration and mediation.
- Administrative procedures regarding the grant, maintenance and validity of patents are subject-matter excluded from arbitration and mediation.
- The Spanish Patent and Trademark Office is designated as an arbitration and mediation institution.

procedure, would be what entails. This is an issue that we hope can be clarified with the New Patents Act's implementation.

As for the procedure to follow for mediation and arbitration, the New Patents Act seems to refer, in general, to the rules governing these two institutions. These are namely, the Arbitration Act 60/2003, of 23 December, and Act 5/2012, of 6 July, on Mediation in Civil and Commercial Matters, without prejudice of the specific provisions set forth in Article 136. These specific provisions include granting the SPTO the power to perform all actions necessary to enforce both (i) final arbitration awards, which will have a *res judicata* effect, and (ii) mediation agreements, provided that they are constituted as an enforceable right by means of a public deed or court approval (*homologación judicial*).

Even though the New Patents Act establishes that the SPTO will be responsible for enforcing arbitration awards and mediation agreements, we understand that this will be dependent on the extent to which such enforcement corresponds to the SPTO (for instance, recording on the relevant registry the cancelation of a licence agreement). However, there will be situations in which the participation of a different body, such as the commercial courts, will be required (for instance, to enforce decisions related to the payment of compensation for damages incurred due to an infringement).

Lastly, Article 136 of the New Patents Act is complemented by the provisions of Royal Decree 316/2017, of 31 March, which approves the Regulation for the enforcement of the New Patents Act. In its Sixth Additional Provision the Royal Decree:

- (i) establishes the requirements to be met by those individuals wishing to hold the position of arbiters or mediators in disputes arising under the New Patents Act. It indicates that, in addition to fulfilling the conditions required by the respective regulations, they must demonstrate that they have at least five years' experience in the field of intellectual property; and
- (ii) envisages the possibility of the SPTO being able to enter into agreements with national, European and international bodies with knowledge of arbitration and mediation, for the purposes of organising and participating in the out-of-court resolution of IP disputes.

Given that two months have scarcely passed since the New Patents Act came into force, it would be too adventurous to predict the effects that this new legislation will have on future patent law disputes. However, there are strong reasons to expect that the new Act will lead to greater use of these two means of out-of-court dispute resolution.

"Definitely an outstanding lawyer," **Miquel Montaña** leads the department from Barcelona and holds a truly enviable reputation in the field of life sciences IP. He is unanimously considered by both peers and clients to be one of the most relevant practitioners currently active, with one source commenting: "As a litigator, he is experienced and impressive; he prepares well for the cases and is very easy to work with." His recent work includes representing Pfizer in several proceedings."

Chambers & Partners 2017: Europe Guide: Spain – Intellectual Property: Patents & Trade Marks, Star Individuals

"**Miquel Montaña** is a leader in patent litigation. He also advises on copyright and trade mark disputes, as well as regulatory concerns. He receives superlative feedback for his practice, with clients noting: "He is very good in his field, knows everybody, and also knows the pharmaceutical industry. He is creative in his approach and knows case law in Spain."

Chambers & Partners 2017: Europe Guide: Spain – Life Sciences: Patent Litigation, Star Individuals

"Market sources are impressed by **Miquel Montaña**'s "impressive ability to learn complex technical matters quickly," adding that he is "always trying to find a friendly way to resolve conflicts." He specialises in IP disputes, for which he is unanimously considered to be one of the leading lawyers in Spain. His additional expertise includes unfair competition, criminal actions and damages claims."

Chambers & Partners 2017: Europe Guide: Spain, Barcelona – Dispute Resolution, Band 1

AUSTRALIA EVIDENCE IN IP ARBITRATION: PROVING THE UNPROVABLE

The very nature of intellectual property (“IP”) is that it generally takes the form of an intangible asset – such as the recipe for super-strength adhesive in the head of one engineer, or a particular approach to project management utilised by one organisation. Whilst mechanisms exist to transform the intangible into the tangible with relative ease, attempting to prove infringement or IP theft is a significant challenge for parties and practitioners alike.

By reference to lessons learned in practice, this article considers the difficulties that can arise in establishing proven facts in the context of IP arbitrations. Further, it aims to provide some guidance to users of arbitration in IP-oriented industries on how to select and craft a procedure that avoids the situation where one party is required to ‘prove the unprovable’.

First, we consider some of the key problems faced by parties trying to prove that a counter-party has infringed, stolen or misused their IP. Next, we consider the position of the party facing such a claim. Finally, we make some practical suggestions regarding best practice, including how IP-oriented businesses can tailor the dispute resolution procedures in their contracts to better suit IP disputes.

Background

Where parties have agreed to have their disputes resolved by arbitration, it can be assumed that they will not have any ‘discovery’ process if they end up in a dispute—at least not the kind of broad-ranging discovery that is common in court proceedings in common law jurisdictions. Instead, document production is ordinarily based on the principles contained in the International Bar Association’s Rules on the Taking of Evidence in International Arbitration (the “**IBA Rules**”). This can be a positive procedural feature and is often one of the reasons why parties prefer to arbitrate: the exclusion of discovery usually leads to savings of time and money.

However, where the arbitration includes an IP aspect, notably with regard to alleged misuse or theft of IP, the preference for limited ‘document production’ in arbitration may result in one of the parties being placed at a forensic disadvantage. For example, to mount an effective misappropriation or conversion claim, the claimant will need to prove that its IP is in the possession of the other side (or a third-party) and, without discovery, the claimant may struggle to get the evidence it needs to succeed in its claim. Even if the arbitral tribunal orders production of documents, the only substantive remedy for non-production is an adverse inference (which the tribunal may draw against the non-producing party, but is not bound to do so). If the defendant alleges it has not stolen the claimant’s IP, the tribunal may be in a bind because innocence is

Key Issues

- Satisfying the burden of proof can be difficult in IP arbitration. In order to bolster a speculative claim, prospective claimants must consider mechanisms which will improve their chances of obtaining evidence of infringement, theft or misuse of IP, which will invariably be in the possession of their opponent and/or a third party.
- Ultimately, there are limits to what arbitrators can do. The claimant may need the assistance of a court to gather evidence, and most of the prominent international arbitration laws and rules permit this (subject to certain conditions). There are ways to tailor an arbitration clause to make it easier to get judicial assistance in the taking of evidence.
- Prospective respondents must consider mechanisms to defeat or narrow requests for documents, as well as strategies for refuting speculative claims.
- Contracting parties in IP or IP-related transactions must take care to draft dispute resolution clauses/arbitration agreements to ensure that the procedure they are buying into is fit for the disputes that may arise.

consistent with non-production (i.e. if you did not steal it, you do not have any documents showing that you do, so you have nothing to produce).

An arbitrator is not a judge and so he or she does not have a judge's coercive powers, including the power of contempt. Instead, the powers of an arbitral tribunal are derived from a contract (the arbitration agreement). It is for these reasons that arbitration is sometimes said to be ineffective against parties who are willing to conceal documents, or simply 'roll the dice' on adverse inferences, and refuse to produce when ordered to do so by the tribunal.

Proving Guilt

Proving infringement of an IP right is often difficult, particularly if the right in question concerns a form of IP that is not reduced to writing. In order to address this issue, IP regimes (and IP-focused contracts) will often require parties to identify the IP in respect of which they assert rights. This usually involves requiring ideas or know-how to be reduced to writing, before they can become the subject of protection. Such a requirement will generally assist a party trying to show that another party has unlawfully taken or made use of its protected ideas or know-how.

However, the burden of proof can still be difficult to discharge. For example, how does a high-tech IT company, with a suspicion that one of its manufacturers has unlawfully taken its confidential know-how, prove such an allegation in arbitration?¹¹ There may be circumstantial evidence, such as a spike in the manufacturer's revenues from a particular date or market rumours, but more is usually required to establish before an arbitral tribunal that protected IP has actually been taken or used unlawfully.

The procedural device available in these circumstances is document production: the IT company could request documents from the manufacturer that would show its possession and use of the protected IP. As noted at the outset, however, document production is much narrower in arbitration than in common law courts. Accordingly, getting the documents needed to make out the claim can be challenging. Although that is not to say it cannot be done.

In considering whether to accede to a party's request for document production, arbitral tribunals will need to balance the potential probative value of the documents requested against procedural efficiency. Therefore, narrow, targeted document production requests are likely to be more successful. A party's ability to make such requests depends to a significant extent on the wording of the IP regime.¹² If the protected IP subject to the relevant contractual regime is defined in terms that have been drafted inaccurately or too broadly, it may be harder to focus on the evidence, in the other side's possession, required to demonstrate infringement. Precision in drafting the IP regime may therefore pay dividends in a dispute situation.

¹¹ Another scenario we have found challenging in practice is establishing expropriation of IP in an investor-state context. For example, how does a mining exploration company evidence that the host state has unlawfully used IP in the form of geological studies that effectively provide a "treasure map" for the state in terms of specifying the location of valuable natural resources?

¹² For a fuller a discussion of strategy regarding document production, see S Luttrell & P Harris, 'Reinventing the Redfern' (2016) 33(4) *Journal of International Arbitration* 353.

However, precision brings its own problems; the requirement for expert evidence and a tribunal that can make sense of such evidence. For this reason, parties to contracts containing the potential for IP disputes may wish to take advantage of one of the key features of arbitration: the ability to make provision in the arbitration agreement that the tribunal be composed of individuals possessing experience within the relevant industry or discipline. It is true that narrowly defining experience requirements limits the pool of available arbitrators (and can endanger the enforceability of the arbitration agreement).¹³ But simply specifying in broad terms that the tribunal ought to have had experience in, for example, software disputes may assist parties by establishing a tribunal that is at least more likely to understand what IP may or may not have been stolen or misused.

It should also be noted that, in a number of jurisdictions, parties to an arbitration may seek court assistance in the taking of evidence, including through the issuance of subpoenas. Judicial assistance of this kind may be necessary where the claimant believes that the respondent has documents that will prove IP infringement, but doubts that they will comply with document production orders from the arbitral tribunal. The problem is that the parties might not store data or have any business presence in the country that they have chosen as the seat of their arbitration. To mitigate this risk, one option is for parties to include in their arbitration clause an agreement to submit to the jurisdiction of the courts of the state where they are domiciled and any other state in which they store data, for the purposes of making or responding to applications for judicial assistance in the taking of evidence in connection with any arbitration.



¹³ For more on this point, see S Greenberg, C Kee and JR Weeramantry, *International Commercial Arbitration: An Asia-Pacific Perspective* (Cambridge University Press, 2011) 260–6.

Proving Innocence

How do you defend an IP claim in arbitration? Take the example of a tech joint venture (“JV”) in the consumer electronics field: one party brings the IP and the other party brings the industrial capacity (for example, the manufacturing company that brings the know-how and facilities needed to put the IP into device form). The manufacturing company faces a claim that it has misappropriated or misused IP owned by its JV partner. It will be difficult for the manufacturing company to prove the negative, for example that it did not misappropriate or misuse the IP. Further, to argue that the burden of proof lies solely with the party making the allegation will usually not be sustainable: if the claimant/alleging party can put on credible evidence, the burden of proof will generally shift to the defending party at some point during the proceedings.

However, the allocation of the burden of proof will depend upon the substantive law that governs the arbitration, and it is usually hard to know if and when the burden has shifted.¹⁴ The burden of proof is, therefore, “invisible comfort”. This problem may become compounded if, during document production, it becomes clear that employees from the manufacturing company have learned or copied techniques from the other party’s engineers (as commonly occurs in tech JVs). Again, if the IP regime is not drafted tightly or is highly technical in nature, it may not be clear to the tribunal what exactly is subject to the IP protection provisions (and what is not)—the classic area of controversy being joint improvements.

In addition to precise drafting, it will be important for the innocent party to defend itself from the kind of document production requests that may provide fuel for the speculative claimant. This can be achieved by appealing to principles of procedural efficiency. In particular, there is a strong argument that it would be unfair and disproportionate for the tribunal to order production of documents based on highly speculative claims. Indeed, the tendency for tribunals not to allow fishing expeditions is already well established.¹⁵ Narrowing down and proposing limitations around the other side’s requests may also be effective.¹⁶

The nature of this type of claim may also impact on the strategy for use of witness evidence. For example, while it is generally advisable in arbitration (as in courts) to limit the number of witnesses to minimise cross-examination risk, facing a claim of the type contemplated may be a time to deploy multiple very limited witness statements. In other words, to combat a speculative claim, numerous witness statements from people prepared to confirm that they did not take or misuse a particular piece of IP may be effective. Other tools available are the instruction of independent third party

¹⁴ For a discussion of the complexities of the burden of proof issue and the limitations to the doctrine of the *onus probandi actori incumbit* (he who asserts a fact must prove it) in international arbitration, see N O’Malley, *Rules of Evidence in International Arbitration: An Annotated Guide* (Routledge, 2012) 202–6.

¹⁵ Article 3.3 of the IBA Rules “is designed to prevent a broad ‘fishing expedition’”: 1999 IBA Working Party & 2010 IBA Rules of Evidence Review Subcommittee, *Commentary on the Revised Text of the 2010 IBA Rules on the Taking of Evidence in International Arbitration* (2010) 8.

¹⁶ For more on this point, see R Marghitola, *Document Production in International Arbitration* (Wolters Kluwer, 2015) 122 [6.06].

witnesses and the use of experiments or observations.¹⁷ The Arbitration Rules of the World Intellectual Property Organisation (the “**WIPO Rules**”), for example, expressly contemplate the performance of experiments.¹⁸

Proof in Practice

The seat of, and rules governing, any arbitration are capable of having a dramatic effect on the likelihood of one party obtaining evidence in another party’s possession. Some rules are particularly suitable for IP arbitrations. For example, the WIPO Rules specifically contemplate disclosure of “*such documents or other evidence as [the Tribunal] considers necessary or appropriate*” and provide mechanisms for the resolution of disputes surrounding such disclosures. The WIPO Rules also provide for protections to ensure maintenance of confidentiality where appropriate.

In IP disputes, it is also worth considering amendments or carve-outs to standard rules or practices within the arbitration agreement to properly align the arbitral procedure with any potential dispute. This can include allowing for third-party joint experts, or arbitrators with industry experience as considered above. In the words of one commentator, “*like a Savile Row tailor, the parties and the arbitrator cut the suit to fit the contours of each contest*”.¹⁹ Tailored options for parties to IP disputes may include specific provisions for qualifications of tribunal members, expert involvement or application of international IP protocols.

Similar considerations apply when determining the seat of the arbitration. For example, whether the arbitration should take place in a common or civil law jurisdiction may have an impact on the arbitral tribunal’s appetite for evidentiary disclosure as well as having an impact on substantive law regarding the burden of proof.²⁰

Link Directory

IBA Rules on the Taking of Evidence in International Arbitration (as at 29 May 2010):
<http://www.ibanet.org/Document/Default.aspx?DocumentUid=68336C49-4106-46BF-A1C6-A8F0880444DC>

Commentary on the Revised Text of the 2010 IBA Rules on the Taking of Evidence in International Arbitration:
<http://www.ibanet.org/Document/Default.aspx?DocumentUid=DD240932-0E08-40D4-9866-309A635487C0>

WIPO Arbitration Rules: <http://www.wipo.int/amc/en/arbitration/rules/>

¹⁷ T Cook and A Garcia, *International Intellectual Property Arbitration* (Kluwer Law International, 2010) 212.

¹⁸ WIPO Rules, Article 51.

¹⁹ W Park, *Arbitration of International Business Disputes*, *Studies in Law and Practice* (Oxford University Press, 2006) 604.

²⁰ J Zammit, T Hambidge and J Hu, ‘Disclosure and Admission of Evidence in the International Arbitration of Intellectual Property Disputes’ in T Halket (ed), *Arbitration of International Intellectual Property Disputes* (Juris, 2012) 365–73.

MILAN THE ITALIAN FRAMEWORK OF ARBITRATION AND IP RIGHTS

Currently, the predominant view that disputes concerning Italian intellectual and industrial property rights („IP Rights“) can be resolved by way of arbitration finds its bases in Italian law. This is namely the notion that IP Rights are disposable and, following a recent change in law, that IP disputes no longer require the involvement of the public prosecutor.

It is also possible to defer to arbitration matters involving liability in tort, subject to an agreement including a specific covenant that expressly provides that *“future disputes relating to one or more specific non-contractual relationships will be deferred to arbitration.”* Often, however, the above wording is not included in arbitration clauses that govern IP licence agreements, which provide for arbitration exclusively in case of disputes arising from the licence agreement.

In addition, providing that arbitration is suitable to resolve IP disputes in tort, the Italian IP Code also sets forth certain „hybrid“ procedures, which straddle the fence between formal arbitration and a contractually-governed decision by an expert/appraiser.

These procedures have limited, if any, practical application, and—notwithstanding the fact that the law erroneously labels them as mandatory—they are optional, meaning that the parties are free to choose whether or not to use them. The parties could instead opt for traditional arbitration or, of course, litigation in court.

Arbitration and IP Rights in Italy: overview

Article 806 of the Italian Code of Civil Procedure allows the parties to a dispute to defer issues involving **disposable rights** to arbitrators.

The **underlying public interest** in IP Rights and the **mandatory nature** of IP provisions are not, *per se*, indicia that IP Rights are not disposable. The fact that current Italian law no longer requires, and in certain cases does not provide for, the involvement of the public prosecutor has been viewed as supporting the opinion that disputes relating to IP Rights can be resolved by arbitration. Indeed, there is no question that IP Rights are disposable. Article 63 of the Italian IP Code defines the rights arising from patents as transferable and freely disposable. Trade marks are similarly deemed transferable pursuant to Article 23 of the Italian IP Code. In theory, these combined provisions allow for the settlement of disputes relating to IP Rights by arbitration.

Although opinions differ on the issue, the most recent consensus is that disputes that involve the validity of registered rights also can be resolved through arbitration.

Key Issues

- Within the Italian legal framework, disputes regarding IP Rights are generally deemed to be deferrable to arbitration. However, no prevalent position has yet taken hold as to whether proceedings that address the validity of an IP Right can be properly deferred to arbitration. This is especially if the resulting decision needs to be valid *erga omnes*, and thus acquire status as a court ruling.
- Arbitration is a faster process than ordinary judicial proceedings, and guarantees the confidentiality of the procedure and award. However, it is advisable to require that the award be anonymised in light of *exequatur*.
- The specific arbitration procedures governed by the Italian IP Code relate exclusively to quantification of the compensation to be paid to the owner of the IP Right. These are triggered only after a court of law or administrative body finds that compensation is due. These procedures are hybrid processes, somewhere between arbitration and contractual expert decision/appraisal, and are very inflexible. The procedures are also complicated, possibly explaining why they are not frequently used. In any event they are optional (despite the law describing them as mandatory); that is to say, they can be used at the parties' sole discretion.

Another issue under debate is whether arbitration awards that declare null a certain IP Right are valid towards all. One position holds that the wording of Article 123 of the Italian IP Code—*“The total or partial invalidity of IP Rights is effective toward all when it is so declared by a final judgement no longer subject to appeal”*—does not allow resolution of a dispute relating to the validity of an IP Right to be deferred to arbitration, and therefore any such resolution will not have the value of *res judicata*.

In accordance with Article 808-bis of the Italian Code of Civil Procedure, it is possible to defer disputes relating to **matters in tort** to arbitration only if a specific covenant is present in the arbitration agreement, expressly providing that *“future disputes relating to one or more specific non-contractual relationships will be deferred to arbitration”*. However, it is rare to find such wording included in arbitration clauses governing agreements for the license of IP Rights, which generally defer only the contractual disputes arising thereunder to arbitration.



In the absence of the above wording, the broadest scope attributed to an arbitration clause that makes reference exclusively to contractual disputes will most likely be one which gives the ordinary courts jurisdiction over “*claims that arise under the contract, as well as claims for which the contract, with other elements, is the basis*” (Italian Supreme Court, Ruling no. 24869, 9 December 2010; Italian Supreme Court *en banc*, 25 November 2011). Obviously, the scope will not be construed such as to defer only the disputes in tort to arbitration. Also included, for example, would be proceedings to ascertain the validity of the IP Rights object of the agreement under (Italian or EU) law.

In Italy, arbitrators cannot issue precautionary and interim measures. Therefore, even if arbitration proceedings are pending, precautionary measures can always be sought in the ordinary court that would have had jurisdiction over the case on its merits. Arbitration for disputes involving IP Rights may have advantages: (i) it is **faster** than ordinary court proceedings, which is particularly important given the length of Italian judicial proceedings; (ii) unlike court proceedings, the arbitration process is **confidential**, although following a procedure for *exequatur*, the award acquires validity as a court ruling, and as such it is no longer confidential. Thus, the arbitration covenant agreed by the parties should provide for publication of the award/ruling in anonymous form, as expressly provided for under the Italian Code of Civil Procedure; and (iii) by allowing the parties to choose the arbitrators, arbitration allows adjudication by **specialists in IP matters** (although, the Specialised Divisions for Enterprises within the Italian ordinary courts also have specialised knowledge of IP matters).

Specific arbitration procedures provided for under the Italian IP Code

The Italian IP Code, in addition to providing for dispute resolution by arbitration, also governs certain specific arbitration or quasi-arbitration procedures, which are considered to be hybrids—somewhere between traditional arbitration and contractual arbitration or appraisal.

The specific provisions set forth in the Italian IP Code are as follows: (i) Article 64, provides the procedure applicable to arbitration to **calculate the amount of the fair reward (*equo premio*)** due to employees for employee inventions; (ii) Article 80 provides the procedure **to calculate the compensation due for a patent license**, if no agreement is reached by the parties; (iii) Article 72 calculates the compensation **due for mandatory licenses**; (iv) Article 96 governs the procedure to calculate **the compensation due for licenses of topographies of products using semiconductors**; and (v) Article 86 governs the **calculation of the compensation due for licences for patents of utility models**.

In addition, Article 143 of the Italian IP Code provides the arbitration procedure to calculate, if no agreement is reached by the parties, the **compensation due for the expropriation of an IP Right** pursuant to Articles 141 and 142 of the Italian IP Code.

Article 194 requires arbitration **to calculate the indemnity due for other expropriation procedures of IP Rights.**

It is now a settled point of law, as affirmed for the first time by the Supreme Court in 1977 (Case no. 127/1977), that calculation of fair reward by arbitration is optional and this principle applies to the other specific hypotheses too.

In proceedings before the Court of Milan, Specialised Section for Business Matters (Ruling of 25 October 2012), the parties expressly waived appointing arbitrators and instead requested that the fair reward be determined by a court-appointed technical consultant. Such choice, in that and many other cases, was likely based on the parties' preference that all decisions, on the merits and on the amount of damages, be made by one single deciding body, be it in court or arbitration.

In practice, use of the above procedures is not frequent, although this analysis can only be based on awards that have been published.

Conclusions

Arbitration as an alternative resolution of disputes that involve IP Rights could offer advantages and may be preferable.

On the other hand, the specific procedures set out in the Italian IP Code are not practical and often not advisable; thus leading to the preferred solution of commencing proceedings in a court of law or traditional arbitration.

Monica Rica – IP Lawyer of the Year in the fashion industry

IP & TMT Awards 2017 by legalcommunity

“Clifford Chance Studio Legale Associato's **Monica Riva** has a broad practice which spans unfair competition, trade marks and advertising. “I am very impressed with her extraordinary commitment to providing excellent client service and her creative problem-solving,” enthuses one client.”

Chambers & Partners 2017: Europe Guide: Italy – Intellectual Property

FRANKFURT FRAND ARBITRATION: THE NEW STANDARD?

Since 2009, courts all over the world—and especially courts in Germany, the United Kingdom and the United States—have dealt with patent infringement suits between smart phone companies as part of the so-called “smartphone patent wars”. Eight years later, the focus of these disputes over standard-essential patents (“SEPs”) has, to a certain degree, changed. It has shifted from infringement suits to disputes concerning the determination of fair, reasonable and non-discriminatory (“FRAND”) license terms. More and more frequently, these disputes, involving frequently technocratic exercises of comparing similar licensing transactions, are decided by arbitral tribunals. This trend will likely continue and maybe become a standard on its own.

Background

SEPs are patents that are essential to implement a certain industry standard; it is not possible to manufacture products that comply with a certain standard without making use of the technologies covered by these patents. This may give companies owning SEPs significant market power. As a result, standards bodies, such as the Institute of Electronic and Electrical Engineers (“IEEE”), generally require their members to commit to license SEPs on FRAND terms.²¹

Very often, a patent holder requests licence rates that the potential licensee considers excessive. The patent owner may then sue this company as an alleged infringer, seeking an injunction and damages. In addition to asserting defences like non-infringement and invalidity of the patent, the accused infringer may counterclaim for violation by the patent holder of FRAND licensing obligations. This then presents the court with multiple challenging questions, such as: Is the patent valid and infringed? Is it properly standard essential and, if so, what is the proper FRAND licensing rate? Has the alleged infringer shown itself willing or unwilling to negotiate on what the court determines to be a FRAND basis and, if unwilling, should it be enjoined from selling its products?

Key Issues

- FRAND disputes are becoming more and more frequent.
- In the *Huawei* decision, the CJEU suggested arbitration for FRAND cases.
- Arbitral tribunals may be better equipped to ensure uniform solutions for multi-jurisdictional problems and to retain confidentiality.

²¹ For example, the IEEE required each participant in establishing the 802.11 wireless standard to either state that it was not aware of any patents relevant to the standard or to provide a “Letter of Assurance.” In the Letter of Assurance, the participant would either disclaim the enforcement of patent claims essential to the standard or commit to provide “a license for a compliant implementation of the standard...on a worldwide basis without compensation or under reasonable rates, with reasonable terms and conditions that are demonstrably free of any unfair discrimination”.

Challenges of FRAND Disputes: complexity and confidentiality

These issues become exponentially more complex when, as is usually the case, the dispute does not involve one single national patent, but a portfolio of many patents all over the world. Further difficulties arise when a number of potential licensees are negotiating and disputing licence terms with the same patent holder and when cross-licences are at stake as well.

Such multi-jurisdictional and multi-issue disputes have until recently been decided by a multitude of courts resulting in a multitude of approaches. Scholars and practitioners, especially those in the United States, have therefore argued for several years that FRAND disputes would be better decided by arbitral tribunals. The debate was further fuelled in 2013 by an article by the US antitrust professors Mark A Lemley and Carl Shapiro arguing that SEP owners should be obligated to enter into binding baseball-style²² (or 'final offer') arbitrations with any willing licensee to determine the royalty rate.²³

One particular issue that arises in FRAND disputes, which may furthermore be better addressed by arbitration, is the preservation of confidentiality over sensitive documents or commercial terms. As part of determining if licensing terms are FRAND, the parties to FRAND court proceedings may be asked to submit proposed licences to the court to show that the terms are fair and not discriminatory. The submissions to the court may, therefore, result in a waiver of confidentiality over those terms. The confidential nature of arbitrations means that such waivers may be less problematic in the context of arbitration.

WIPO FRAND arbitration

As a result of these discussions, the World Intellectual Property Organization ("WIPO") has made available tailored model submission agreements that parties may use to refer a FRAND dispute to WIPO Mediation, WIPO Arbitration or WIPO Expedited Arbitration.²⁴ So far, however, no FRAND arbitration seems to have taken place under the WIPO regime.²⁵ As of May 2017, most FRAND arbitrations that have taken place seem to have been ad hoc arbitrations, or arbitrations pursuant to the Arbitration Rules of the International Chamber of Commerce ("ICC"). For example, Nokia and Samsung agreed on an ICC arbitration to settle a FRAND dispute between them.²⁶

²² In baseball-style arbitration each party presents one number and the arbitrator is tasked with choosing which number is a more accurate representation of the FRAND licensing rate.

²³ See Lemley, Mark A. and Shapiro, Carl, A Simple Approach to Setting Reasonable Royalties for Standard-Essential Patents (November 5, 2013). Stanford Public Law Working Paper No. 2243026. Available at SSRN: <https://ssrn.com/abstract=2243026> or <http://dx.doi.org/10.2139/ssrn.2243026> (last accessed on 6 June 2017).

²⁴ These agreements can be found at: <http://www.wipo.int/amc/en/center/specific-sectors/ict/frand/> (last accessed on 6 June 2017).

²⁵ The WIPO statistics do not mention any FRAND cases. Moreover, at a recent arbitration conference in Germany dealing with IP arbitration, namely the "Petersberger Schiedstage 2017", several speakers doing WIPO arbitration on a frequent basis confirmed that they are not aware of any such dispute.

²⁶ See http://www.nokia.com/en_int/news/releases/2016/02/01/nokia-receives-decision-in-patent-license-arbitration-with-samsung-positive-financial-impact-for-nokia-technologies for Nokia's press release on this dispute (last accessed on 6 June 2017).

Huawei v ZTE: the trigger for arbitrations?

The call for arbitration has become even louder since the summer of 2015: on 16 July 2015, the Court of Justice of the European Union (“**CJEU**”) handed down its long-awaited judgment in *Huawei Technologies Co. Ltd v ZTE Corp., ZTE Deutschland GmbH*.²⁷ The case concerned the potential for enforcement action by SEP holders to infringe EU competition rules against abuse of a dominant position.

The CJEU was asked to answer five questions submitted by the Regional Court of Düsseldorf, Germany. Contrary to recent German case law, but in line with the opinion of Advocate General Wathelet, the CJEU held that an SEP proprietor cannot, without abusing its dominant position, file an action for prohibitory injunction or for the recall of products before—on its own initiative—initiating and working towards the conclusion of a FRAND license agreement. In a much-noticed side note, the CJEU suggested that disputes over FRAND rates shall be decided by arbitral tribunal, and hence followed the example of the Federal Trade Commission in the United States.²⁸

It remains to be seen whether this suggestion will be followed by many companies. This will often only work if companies are in a position to agree on a procedural regime for arbitration despite the fact that initial negotiations concerning FRAND royalties may have failed. Moreover, how arbitral tribunals will deal with the steps necessary in a pre-arbitration phase according to the Huawei ruling, and whether they will even consider to be bound by this ruling, are open questions. For example, according to the CJEU, it is not sufficient for the SEP holder to merely provide the alleged infringer with a list of patents that are alleged to be infringed, but rather it must provide claim charts for the most significant patents explaining the purported infringement. All references to standards need to be specific; it is not sufficient to state that a patent is essential to a standard and the infringing device adheres to the standard.



²⁷ Case C-170/13; see <http://curia.europa.eu/juris/liste.jsf?num=C-170/13> for this judgment (last accessed on 6 June 2017).

²⁸ See Carter, James, FRAND Royalty Disputes: A New Challenge for International Arbitration, in: Contemporary Issues in International Arbitration and Mediation, The Fordham Papers 2013, edited by Arthur W. Rovine, for a detailed description of early initiatives of the Federal Trade Commission to advocate arbitration in the FRAND context.

HONG KONG ARBITRATION IN INTELLECTUAL PROPERTY DISPUTES

A bill presently going through the legislative process in Hong Kong aims to increase the attractiveness of Hong Kong as an arbitration centre of choice for IP disputes. The Hong Kong Government has recently introduced a bill to amend the Arbitration Ordinance (Cap 609) (the Ordinance) to make clear that intellectual property disputes can be settled by arbitration. The amendments put Hong Kong in a leading position in this respect when compared with other countries, many of which do not have specific legislation clarifying the arbitrability of IP disputes.

The move comes as part of the Government's drive to enhance Hong Kong's status as a leading centre for international dispute resolution services in the region. As such, the amendments will only apply to arbitration where Hong Kong has been chosen as the seat of arbitration or Hong Kong law has been chosen as the governing law of the arbitration.

Welcome clarity

Whilst it has always been clear that contractual and/or licensing disputes relating to the use, transfer and/or development of intellectual property rights (IPR) are arbitrable, the arbitrability of IP disputes beyond these issues, such as the validity and infringement of IPR, has remained uncertain.

Section 86(2) of the Ordinance, reflecting Article 34 of the UNCITRAL Model Law, states that enforcement of an award may be refused if: (a) the award is in respect of a matter which is not capable of resolution by arbitration under the law of Hong Kong, or (b) it would be contrary to public policy to enforce the award. There had been concern expressed that enforcement of an arbitral award that affects the validity or infringement of IPR may be refused in Hong Kong under either, or both, of these grounds. The amendments to the Ordinance intend to put the matter to rest, making it clear that disputes concerning the validity or infringement of IPR can be the subject of arbitration.

Broad definitions

The definition of IPR in the bill is broad and wide-ranging. Arbitrable IPR includes patents, trade marks, designs, copyrights, domain names, rights in confidential information, trade secrets or know-how and rights to protect goodwill by way of passing off or similar action against unfair competition, as well as the catch-all "any other IP rights of whatever nature". The bill also states that a reference to IPR in the Ordinance includes all registered and unregistered rights, whether or not subsisting in Hong Kong.

Key Issues

- The amendments to the Arbitration Ordinance (Cap 609) make it clear that IP rights can be settled by arbitration in Hong Kong.
- The new provisions make it clear that enforcing an arbitral award dealing with IP rights would not be contrary to Hong Kong public policy.
- The changes – together with the establishment of a dedicated panel of IP expert arbitrators – are designed to improve Hong Kong's position as an arbitration centre of choice.

In addition, “dispute” is defined broadly as a dispute over the enforceability, infringement, subsistence, validity, ownership, scope, duration or any other aspect of an IPR; a dispute over a transaction in respect of an IPR; and a dispute over any compensation payable for IPR.

Arbitrability of validity and infringement

Whilst the term “arbitrable IPR disputes” includes disputes concerning the validity of an IPR, section 103I also clarifies that the validity of a patent may be an issue in arbitral proceedings. In accordance with section 73 of the Ordinance (which states that an award made by an arbitral tribunal pursuant to an arbitration agreement is final and binding on the parties and any person claiming through or under them), an Arbitrability Working Group set up by the government has advised that the effect of an arbitral award in respect of the validity of an IPR would only bind the actual parties who participate in the arbitral proceedings and would not go beyond that. If the arbitrator decides that a trade mark is invalid, for example, the arbitral award would take effect between the parties to that arbitration only. The trade mark being challenged would remain validly registered insofar as third parties are concerned.

The draft bill also specifies that a licensee (exclusive or not) will not be entitled to the benefits, or subject to the liabilities, of an arbitral award obtained by the owner of the IPR unless the licensee is joined to the arbitration.

One way around this apparent restriction would be for a party to an arbitration who is seeking to challenge the validity of a registered trade mark or patent to frame the relief sought in appropriate terms when bringing an action against the owner of the mark or patent. The challenging party could, for example, seek an order requiring the trade mark owner to assign the mark to it, or to surrender the mark altogether.

Enforcement issues

A key enforcement issue will be whether the law of the place where enforcement is sought recognises the arbitrability of or the enforceability of awards concerning patent validity and infringement and if so, to what degree. There is no uniform answer to this question as the laws of different jurisdictions vary considerably.

The Convention on the Recognition and Enforcement of Foreign Arbitral Awards (the Convention) provides for the ready enforcement of arbitral awards in the territory of any contracting state that were made in the territory of another contracting state. Since virtually all major trading nations are parties to the Convention, the Convention should, in theory, make it easier for a rights holder to take action against an infringer who is making or selling the allegedly infringing products in different national jurisdictions. A special arrangement exists between Hong Kong and China that substantially mirrors the relief available under the Convention.

Enforcement may not always be straightforward in practice, however. The IPR in question needs to be arbitrable not only under the law of the seat of the arbitration but also under the law of those jurisdictions where enforcement would likely be necessary. It may be conceptually difficult to separate an IPR that is by nature territorial, from the set of legal rules established to protect and enforce that right. For example, if the seat

of an arbitration concerning US patents is in Hong Kong, should the applicable law be that of the US or Hong Kong?

If parties have not made a choice of law, the arbitral tribunal must determine which substantive law is to apply. Even where the parties have agreed upon the applicable substantive law, this may not be given automatic effect since IPR are often mandatorily governed by local law which may not be what the parties have chosen.

In addition, enforcement of an award may become a problem in the jurisdiction where the IPR was created, if a law other than the law of that jurisdiction was used to determine its validity. Taking the above example, if Hong Kong law is adopted to determine the validity of a US patent in a Hong Kong-seated arbitration, could the award even be enforced in the US? In another example, again assuming the seat is in Hong Kong, even though an award finding that certain Chinese patents are invalid would be valid under Hong Kong law, the courts in China may not recognise or enforce the award either because: (i) patent validity is not arbitrable in China; or (ii) enforcement of the award would be contrary to the public interests of China.

It is hoped that in time, more internationally co-ordinated rules on enforcement will be developed so that more parties will be encouraged to adopt arbitration as an alternative to civil court litigation, which arguably entails far greater challenges in terms of enforcement.

Dedicated Panel

The Bill was gazetted on 2 December 2016, just months after HKIAC launched a new panel of arbitrators for IP disputes, replicating a similar panel already established by the Singapore International Arbitration Centre. The panel is made up of senior counsels, former judges, experienced solicitors from different jurisdictions and heads of IP professional organisations.

The move is in keeping with the practice of many other global arbitral institutions which can provide parties with specialised IP arbitrators. In the US, for example, the Silicon Valley Arbitration and Mediation Centre publishes an annual “Tech List” of arbitrators with substantial experience in the tech and IP sectors.

International comparison

The changes to the Hong Kong legislation come not before time.

The Singapore Government adopted its “IP Hub Master Plan” in April 2013 as a means of developing Singapore as a single forum to resolve multi-jurisdictional disputes. Since the plan was put into place, more than 450 arbitration and mediation cases have been administered by the World Intellectual Property Organisation’s (WIPO) Arbitration and Mediation Centre in Singapore. The service provided in Singapore also includes a new expert determination option to assist in resolving patent disputes pending before the Intellectual Property Office of Singapore (IPOS) in a joint venture programme with WIPO. Unlike Hong Kong, there is no specific amendment made or being proposed to Singapore arbitration laws clarifying that IP disputes are arbitrable. There remains

uncertainty over the arbitrability of IP disputes in Singapore, particularly disputes involving IP validity.

There seems to be no clear guidance as to the arbitrability of IP rights in China although the general view seems to be that while IP disputes that arise from contracts may be submitted for arbitration, the validity of registered IPs, such as patents and trademarks, cannot be the subject of arbitration as determining such disputes is the sole preserve of the PRC Patent Office, Trademark Office and the courts.

Next steps

The Bill is still going through the legislative process and is presently being considered by the Bills Committee of the Legislative Council.

At present, there is no further word as to when it will come into effect, although it is expected to be late-2017 at the earliest. Even when it is in force, the proposed amendments will only apply to arbitration which has commenced subsequent to the commencement of the amended Ordinance. Despite the long gestation period, it is hoped that when they finally come into effect, the amendments do provide some much-needed clarity on the range and scope of disputes that can be made subject to arbitration in Hong Kong.

Conclusion

Despite issues of enforcement and jurisdiction, arbitration remains preferable to litigation particularly where the dispute covers a range of IPRs in different jurisdictions. Determining infringement (and related validity issues) of counterpart patents, copyrights or trade marks in various countries entails litigation in multiple foreign courts with different judicial systems and judges with varying degrees of experience and qualifications. Such procedures would be costly and much more drawn-out. Arbitration offers a more streamlined and efficient mechanism for resolving IP disputes covering IPRs in different jurisdictions.

With the introduction of the Bill removing any doubts as to the arbitrability of IPRs in Hong Kong, it is hoped that companies will be encouraged to adopt Hong Kong as the seat and Hong Kong law as the substantive law over other jurisdictions where such clarity may be lacking in comparison.

“Ling Ho is head of the firm’s Asia-Pacific IP group and China litigation and dispute resolution practice. She maintains a good reputation for trade mark infringement and unfair competition, as well as portfolio management work. “Ling is very practical and her answers are very quick,” notes one client.”

Chambers & Partners 2017: Asia-Pacific: China – Intellectual Property
(International Firms)

BARCELONA OVERVIEW OF THE IP-RELATED PRELIMINARY INJUNCTION APPLICATIONS AND INVESTIGATION MEASURES REQUESTS FILED IN CONNECTION WITH THE LATEST MOBILE WORLD CONGRESS HELD IN BARCELONA.

From 27 February to 2 March 2017, Barcelona hosted the latest annual Mobile World Congress, the most important international trade fair for the mobile phone industry. More than 108,000 people attended the MWC, surpassing last year's visitor attendance record. The Barcelona Commercial Courts took steps to aid in its success by adopting effective measures to protect the exhibitors' intellectual property rights. This article summarises the outcome of the proceedings handled by these Courts in relation to the most recent MWC.

Year after year, the Mobile World Congress ("**MWC**") continues to beat its own visitor attendance record. In order to prevent any legal issues from diverting visitors' attention away from the global debut presentations of new mobile phones and innovations, the Barcelona Commercial Courts (the "**Courts**") approved, for a third consecutive year, the implementation of a special protocol for MWC 2017 (the "**2017 Protocol**") to ensure the smooth running of the event.

In particular, the Courts undertook:

- (i) to give preferential and priority treatment to urgent interim injunctions related to the MWC;
- (ii) to hand down a decision on interim injunction applications on an *ex parte* basis within two days of their submission to the Courts and, when a "protective letter"²⁹ had been filed, to schedule a hearing and hand down a decision within ten days of its submission at Court; and
- (iii) to admit the submission of protective letters in order to avoid, to the extent possible, granting interim injunctions without hearing the defendant.

In the 2017 Protocol, the Courts also stated that, when assessing the requirement of "urgency" set out in the Spanish Civil Procedure Act for considering the adoption of interim injunctions on an *ex parte* basis, they would take into account the applicant's prior conduct and, in particular, the speed with which it reacted upon becoming aware of the possible infringement and in submitting the application.

Key Issues

- The Barcelona Commercial Court issued a special protocol for MWC 2017 in order to avoid, to the extent possible, granting interim injunctions based on intellectual property rights infringement without hearing the defendant and, at the same time, to guarantee the adoption of effective measures for protecting those allegedly infringed intellectual property rights.
- The outcome of the protocol at MWC 2017 has been positive, with more than 20 cases solved in just a few days.

²⁹ A protective letter is a Spanish legal instrument of anticipatory defence. Where a party is at risk of an *ex parte* injunction, that party can file a protective letter with the Courts, setting out its position prior to the Courts deciding on any measure.

Cases dealt with under the 2017 Protocol framework

MWC 2017 was a great success. More than 108,000 people visited the venues, representing a 7% increase as compared to 2016. This increase also resulted in a rising number of MWC proceedings being brought before the Courts. The Courts admitted and resolved more than twenty cases within the framework of application of the 2017 Protocol.

According to a report issued by the Courts in March 2017, the Courts issued twelve protective orders (last year they issued fourteen). All protective order requests were based on alleged non-infringement of patents and all of them were processed and decided prior to the start of the MWC. The parties making such requests or those potentially affected by the protective orders included well-known technology companies such as Samsung, Nokia, Ericsson, Wiko, ZTE, Sisvel, and ARCHOS, among others.

In addition, the Courts handled seven applications for the adoption of interim injunctions on an *ex parte* basis. This is a significant increase with respect to last year's MWC, when only two applications were submitted. The seven applications were made against eight different companies and all applications were processed and decided within 24 hours. Four out of these seven applications were upheld and three were rejected. Unfortunately, the Courts have not disclosed whether any protective order was issued in relation to cases where an interim injunction application was later filed.



Apparently, one opposition was filed against the adoption of interim injunctions *ex parte* and was also decided within 24 hours. The Courts upheld the opposition and decided to set an amount for a bond, to be posted in substitution of the injunctions.

This year, the Courts also ordered five *ex parte* inspections (to search for and seize evidence) against five different companies in relation to patents. The inspection requests were all processed, admitted and ordered within 24 hours.

In order to notify and enforce the *ex parte* interim injunctions and the *ex parte* inspection orders, the Judges of the Courts went to the venue in person and were assisted by the officers and advisors of GSMA (the event organiser) and Fira de Barcelona (on whose premises the MWC was held). Support was also provided by the Mossos d'Esquadra (regional police force).

Outcome of the 2017 Protocol

In retrospect, it seems that the Courts not only fulfilled, but exceeded their undertaking to rapidly admit and resolve cases arising in relation to the MWC. The Courts undertook to resolve interim injunction applications within two days but solved them in only 24 hours. They also decided an opposition to an *ex parte* interim injunction in just 24 hours. Although surprise inspections were not specifically included in the 2017 Protocol, the Courts also replied to those requests within 24 hours.

Ample consideration was given to the smooth running of the event, whereby technological innovations made the news and not the Judge's decisions. The Courts intended for quick and discreet enforcement action, with as little conflict as possible. As such, judges were present at the MWC to coordinate the notification and enforcement of their decisions, together with officers from GSMA and Fira de Barcelona, with assistance from the regional police.

All in all, the 2017 Protocol had a positive outcome, which leads the Courts to predict that the protocol will remain in place in 2018 and the number of cases will further increase, in terms of both requests for protective orders and applications for *ex parte* injunctions.

However, some improvements can still be made. In particular, some companies, lawyers and court agents have proposed that a registry be created in order to (i) facilitate the notification and execution of *ex parte* injunctions and surprise inspections, and (ii) ensure that companies affected by these measures have immediate access to a lawyer and court agent, thereby enabling them to intervene in proceedings. The Courts are aware of this need and are considering the possibility of making the necessary arrangements in order to guarantee that all the parties' rights will be defended and that the Courts can provide an equally rapid response.

HONG KONG IP ARBITRATION IN CHINA – A WORK IN PROGRESS

China currently does not have an established regime for IP arbitration. Nonetheless, the PRC government is taking steps to promote arbitration, as highlighted recently by an initiative set up by the PRC State Intellectual Property Office (SIPO) on 9 March 2017. SIPO launched a two-year pilot working programme with the goal of developing an IP arbitration and mediation mechanism across China including plans to further develop and set up specialist IP arbitration centres (currently there are IP specialized arbitration centres/tribunals in a few major cities only such as Shanghai and Guangzhou), cultivating expertise, establishing working procedures and generally promoting public awareness of arbitration as a means of dispute resolution.

Key Issues

- The PRC is promoting arbitration as a dispute mechanism across China.
- The bulk of current arbitration work in China focuses on contractual IP.
- Whether IP infringement disputes are arbitrable in China is uncertain.
- It is unclear whether foreign arbitral awards concerning the validity of IPRs can be enforced in China.

Arbitrability of IP related disputes in China

1. Contractual IP disputes

Contractual IP disputes are generally arbitrable in China³⁰. These include, for example, disputes arising from IP licences, technology development or service agreements, publication agreements and so on, provided that the relevant parties agree in writing to submit the dispute to arbitration.³¹

In practice, contractual IP disputes make up the bulk of the work done by existing IP arbitration tribunals and centres. Of the 117 cases reviewed by the Shanghai Arbitration Court of Intellectual Property in 2014, for example, 82 related to licence agreements, 11 to technology development agreements, two to technology consulting agreements, one to a copyright agreement and one to a publication agreement.

2. IP Infringement disputes

Arbitration of IP infringement disputes has been less common in China, despite an opinion of the PRC Supreme Court which suggests arbitration as a possibility, but only if both parties are able to reach a written agreement to arbitrate *after* the

³⁰ Article 2 of the PRC Arbitration Law provides that contractual disputes and other disputes arising from property rights and interests between citizens, legal persons and other organisations of similar legal status may be submitted for arbitration. Article 55 of the PRC Copyright Law provides that copyright disputes may be submitted for arbitration in accordance with the relevant written provision or agreement made by the parties. Article 33 of the PRC Software Copyright Law provides that contractual disputes in respect of software copyright disputes may be submitted for arbitration in accordance with the relevant written provision or agreement made by the parties.

³¹ Article 4 of the PRC Arbitration Law provides that parties seeking to settle disputes through arbitration must reach an agreement to arbitrate on a mutually voluntary basis. An arbitration commission shall not accept an application for arbitration submitted by one of the parties in the absence of such an agreement.

alleged infringement has taken place.³² This does not apply where the infringing act has given rise to a criminal offence such as in cases of serious copyright infringement or misappropriation of trade secrets, since it is felt that this would involve public interest considerations.

3. IP validity disputes

In broad principle, administrative disputes falling within the legal jurisdiction of the relevant administrative authorities may not be submitted for arbitration in China.³³ However, a question still arises as to whether the relevant administration authority enjoys sole jurisdiction to determine such disputes. There are differing interpretations of the PRC law on this.

A popular view is that whilst the validity of unregistered IPs, and trade secrets, may be submitted for arbitration (on the basis that such rights can be created and subsist without the approval by, or registration with, an administrative authority), the validity of registered IPs, such as patents and trademarks, cannot be the subject of arbitration as determining such disputes is the sole preserve of the PRC Patent Office, Trademark Office and the courts.

Another view holds that the validity of registered IPs can be the subject of arbitration as long as the arbitral award only binds the relevant parties and would not be enforced against a third person unless the award has been endorsed by a relevant administration authority.

Unlike in Hong Kong where the amendment bill has made clear that IP validity issues are arbitrable, currently there is no clear answer to this in China.

Cross-jurisdiction enforcement in China

A foreign arbitral award can be enforced in China under the New York Convention. Any refusal to enforce would have to be approved by the PRC Supreme Court. Currently China only adopts the New York Convention in respect of disputes arising from contracts, and perhaps infringement as outlined above (but not for IP validity issues). Awards concerning the validity of IPs, especially registered IPs, pose a more difficult challenge given the existing legal framework in the PRC.

Conclusion

Although it is clear that IP disputes arising from contractual relationships are arbitrable in China, there are still uncertainties as to whether, and how, IP infringement and validity issues may be arbitrable in China. It is hoped that such issues may be further clarified as part of the SIPO's two-year pilot working programme.

³² Shortly after China had acceded to the New York Convention, the Supreme People's Court issued in 1987 a circular (the "**Circular**") setting out the Courts' opinion as to how New York Convention would apply in China. See Article 2 of the Circular, which states that: "*In accordance with the statement made by China when acceding to the New York Convention, the New York Convention shall only apply to disputes arising from any contractual or non-contractual commercial legal relationship*" and it is stated in the Circular that such "*Contractual or non-contractual commercial legal relationship*" includes economic/civil rights and obligations arising from contractual relationships, infringement or any commercial relationships that arise in accordance with the law, such as sale of goods, lease of property, project contracting, processing, technology assignment, joint venture business, joint business operations, exploration and development of natural resources, insurance, credit, labour services, agency, consultation service, marine/civil aviation/ railway/road passenger and cargo transportation, product liability, environment pollution, marine accident, disputes over ownership etc. It does not, however, include disputes between foreign investors and the government of the country in which the investment takes place.

³³ See Article 3 of the PRC Arbitration Law.

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LEGAL 500 2017: Hong Kong – Intellectual property

New PRC Cyber-Security Law comes into Force

The Cyber-security Law of the People's Republic of China took effect on 1 June 2017. The Law applies to everyone who operates networks in the PRC and will have particular impact on multinational corporations. The Cyberspace Administration of China (CAC) has issued a series of regulations implementing the law, and has also asked the public for comments on other proposed implementing rules, including measures affecting the transfer of personal data outside the PRC.

For further details, see our client briefing here: <https://goo.gl/igj5Ve>

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