



Arbitration of IP disputes in Hong Kong – An alternative to Litigation 以仲裁解決香港知識產權爭議 – 一個訴訟以外的選擇



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香港是一個仲裁便利的城市，而政府不斷改進其知識產權制度，為這個城市成為亞洲知識產權貿易中心作好準備。在這背景下，“仲裁（修訂）條例”於2017年6月14日在立法會通過後，已在2018年1月1日生效。該修訂條例澄清所有與知識產權（IPRs）有關的爭議均可通過仲裁解決，無論這些知識產權是否已在香港註冊或存在。

根據香港國際仲裁中心（HKIAC）的統計數據，該中心於2017年度共有500多件仲裁案件，其中70%案件涉及國際仲裁。然而，在“修訂條例”實施前，尚未確定知識產權爭議可否在香港通過仲裁解決，因為原先的“仲裁條例”並沒有相應的明確規定。在那情況下，訴訟是對立兩方解決知識產權爭議的常用途徑。通過司法程序來解決爭議表示各方當事人對於訴訟程序和結果的自主權相對較低。此外，當事人的保密信息可能會在訴訟中向公眾披露，這有機會對當事人的業務帶來不利影響。而且，知識產權爭議涉及多個管轄地區的情況在現實中是十分常見的，這些管轄地區的法院可能會作出不同的，甚至相互矛盾的判決。基於上述原因，要解決知識產權爭議對有關當事人而言是個難題。


根據修訂條例，仲裁範圍涵蓋所有類型的知識產權，包括專利、商標、外觀設計、商業秘密和版權等。可仲裁的知識產權爭議包括知識產權可否強制執行、知識產權侵權、知識產權的存在、有效性、擁有權、範圍、期限或其他方面的爭議，以及知識產權的交易或支付補償的爭議。修訂條例還指出，強制執行知識產權爭議相關的仲裁裁決並不違反香港公共政策。仲裁裁決是最終的，對爭議雙方具有約束力，且通常不對第三方具有約束力。

透過仲裁解決知識產權爭議有以下幾個好處：

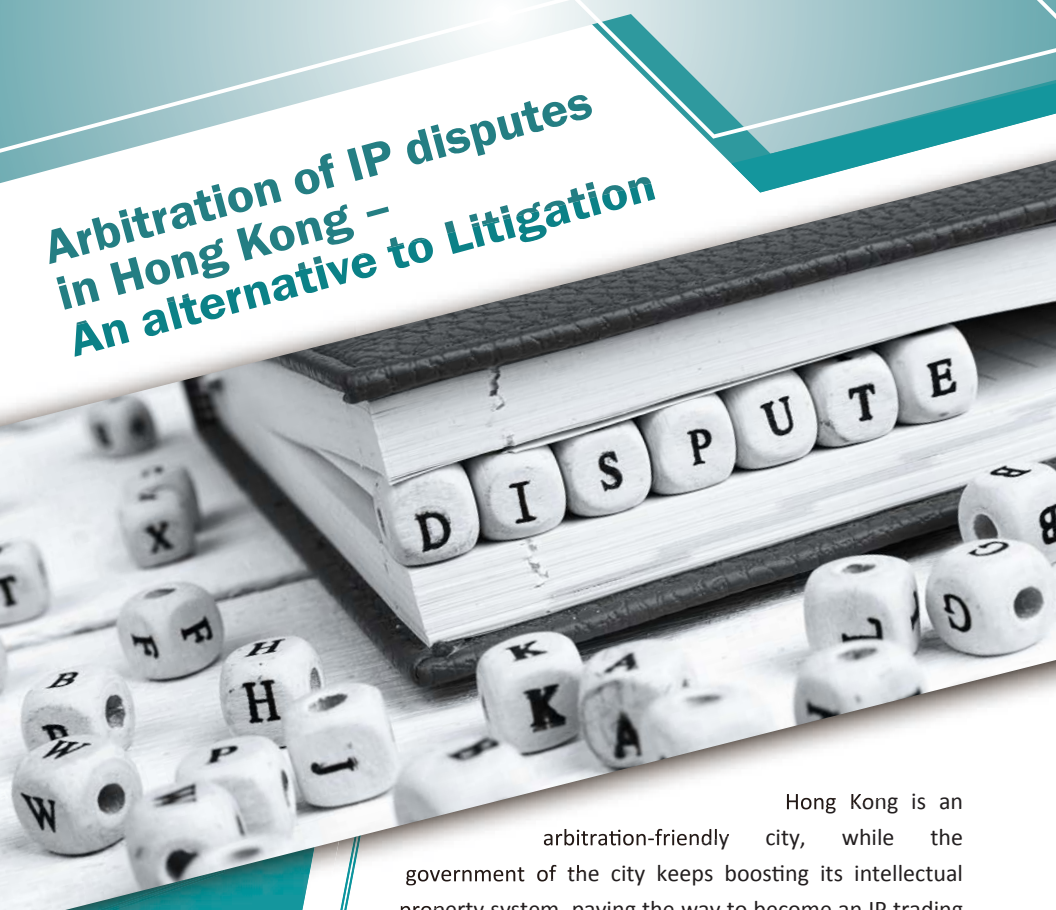
- 更程度的自主** – 各方當事人可協商選擇仲裁員、適用法律、仲裁範圍和程序。
- 避免在多個管轄地區的司法程序** – 當事人可在單一仲裁中解決爭議，而不需要進行多次可能會產生相互矛盾結果的訴訟。
- 需時較短且成本較低** – 可以避免昂貴和耗時的司法程序。

- 較高保密性** – 仲裁程序和仲裁裁決是保密的，因此對各方當事人聲譽的負面影響減至最小。
- 專業和中立的仲裁庭** – 各方當事人可選擇一名或多名具有合適專業知識且更傾向於對當事人保持中立的仲裁員。

根據當事人的意願並在其自主下，在各方同意以仲裁解決爭議後，可由當事人決定仲裁程序、仲裁範圍、仲裁庭組成、開庭日期和地點、證據交換及任何其他細節。當事人可以選用由一個或多個在法律或其他領域的專家作為仲裁員組成仲裁庭。在仲裁的最後階段，仲裁庭可判給與香港法院能命令判給的相同補救或救濟，除非雙方同意限制該補救或救濟。香港作為一個便於仲裁的管轄地區受廣泛承認，而無論在香港或其他管轄地區作出的仲裁裁決亦可在香港強制執行。有關裁決只能在若干情況下被撤銷，例如當裁決違反公共政策時、爭議根據香港法律是不能仲裁的、仲裁協議無效或者仲裁所用程序與協議有衝突。由於香港加入了“紐約公約”，因此在香港作出的仲裁裁決可在其他締約國或管轄地區得到認可並能強制執行。此外，根據“關於仲裁裁決的相互強制執行的安排”，香港和中國大陸作出的仲裁裁決可在兩地強制執行。

對於任何有關知識產權的協議，當事人可以在發生爭議時考慮以仲裁解決。當雙方在起草仲裁條款作為協議的一部分時，應當多加注意，以確保他們考慮了仲裁細節和相關的適用範圍，如語言、程序、適用法律等。還可以在爭議發生之前或之後達成獨立的仲裁協議。無論屬哪種情況，特別在各方當事人願意有誠意地坐下協商時，仲裁都能夠作為解決爭議的一種選擇。





Arbitration of IP disputes in Hong Kong – An alternative to Litigation

Hong Kong is an arbitration-friendly city, while the government of the city keeps boosting its intellectual property system, paving the way to become an IP trading hub in Asia. In that context, the Arbitration (Amendment) Ordinance has come into effect on 1 January 2018, after it was passed by the Legislative Council on 14 June 2017. The

Amendment clarifies that all disputes relating to Intellectual property rights (IPRs) can be arbitrated, whether or not the IPRs are registered, or subsist in Hong Kong.

According to the statistics of Hong Kong International Arbitration Centre (HKIAC) in 2017, there were more than five hundred cases of arbitration, 70% of which involved international arbitration. However, before introduction of the Amendment Ordinance, in Hong Kong, it was uncertain whether IP disputes can resort to arbitration as there was previously no corresponding explicit provision in the original Arbitration Ordinance. At

that juncture, litigation was a common means for the contending parties to resolve their IPR disputes. Resolution via judicial proceedings implies that there will be relatively less autonomy given to the parties regarding the course and outcome of proceedings. In addition, litigation may disclose confidential information of these parties to the public, which can be detrimental to their businesses. Besides, for IP disputes involving more than one jurisdiction, which are quite common in reality, the court decisions of these jurisdictions can be different or even contradicting one another. Owing to the above, resolution of IP disputes can be a pickle for the parties involved.

According to the Amendment, the scope of arbitration covers all types of IPRs including patents, trademarks, designs, trade secrets, copyrights and etc. Arbitrable IPR disputes can be disputes regarding enforceability, infringement, subsistence, validity, ownership, scope, duration or any other aspect, as well as transaction or compensation payable of IPRs. It also states that it is not contrary to the public policy of Hong Kong to enforce an arbitral award regarding IPRs disputes. An arbitral award is final and binding on the disputing parties and is generally not binding to third parties.

There are a couple of advantages of resolving IPR disputes using arbitration:

Higher degree of autonomy – The parties can negotiate to choose arbitrator(s), applicable law, scope and procedure of arbitration.

Avoid judicial proceedings in multiple jurisdictions – The parties can resolve the disputes in a single arbitration instead of multiple litigations which may give conflicting results.

Shorter length of time and lower cost – Expensive and time consuming judicial proceedings can be dispensed with.

Higher confidentiality – The procedures of arbitration and arbitral award are confidential so that there will be minimal negative impact on the reputation of the parties.

Professional and neutral arbitral tribunal – The parties can choose one or more arbitrators with appropriate expertise and with higher tendency to be neutral to the parties.

In accordance with the parties' free will and autonomy, after the parties agree to come to arbitration for their disputes, the procedures of arbitration can be decided by the

parties, regarding scope of arbitration, constitution of arbitration tribunal, date and venue of hearing, exchange of evidence and any other details. The parties can appoint an arbitration tribunal which consists of one or more experts in legal or other professional fields as arbitrators. At the end of the arbitration, the arbitration tribunal can award the same remedy or relief that can be ordered by the courts in Hong Kong, unless the parties agree to limit the remedy or relief. As Hong Kong is considered generally as a pro-arbitration jurisdiction, an arbitral award, which is either made in Hong Kong or other jurisdictions, is enforceable in the city. The award can only be set aside under several circumstances, for instance, when the award is contrary to the public policy, the dispute is considered unarbitrable according to the laws of Hong Kong, the arbitration agreement is invalid or the procedures conducted are not consistent with agreement. Since Hong Kong is a party to the New York Convention, Hong Kong arbitral awards can be recognized and enforced in other signatory countries or jurisdictions. Besides, arbitral awards can be enforceable between Hong Kong and Mainland China based on the Arrangement Concerning Mutual Enforcement of Arbitral Awards.

For any agreement regarding IPRs, the parties can consider arbitration in the case of disputes. The parties shall pay attention when they are drafting the arbitration clause as a part of the agreement, to make sure they have considered some details of arbitration and the relevant scope of application, such as language, procedures, law to be applied and etc. A separate arbitration agreement can be reached before or after the occurrence of disputes. In any case, arbitration can be an option to resolve disputes, especially if the parties are willing to sit down and negotiate in good faith. 