International IP Dispute Resolution: Lessons Learned

国际知识产权争议解决：经验与教训

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Background/背景

- Shanghai Company A and New York Company B entered into a joint development agreement.
  上海公司甲与纽约公司乙签订了共同开发协议。
- Company A has no assets outside of China.
  甲公司在中国境外没有资产。
- Company B has operations in China via several WFOEs.
  乙公司通过数家外商独资企业在中国经营业务。
- Company B transferred certain technologies to Company A for fees.
  乙公司已经向甲公司有偿转让了数项技术。
- "Company B owns the intellectual property rights in all improvements to the transferred technologies without additional fees or consideration."
  "转让技术的所有改进的知识产权均归乙公司所有，乙公司无须额外支付费用或对价。"
- "The Agreement is governed by New York law."
  "本协议受纽约法律管辖。"
- "All disputes relating to this Agreement must be litigated exclusively in the Federal Court for the Southern District of New York."
  "与本协议相关的所有争议必须只能提交纽约南区联邦法院进行诉讼。"

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Hypothetical I/假设情景一

- Company A files patent applications, in its own name, in China and U.S. covering an improvement to the Company B's technologies.
  甲公司以自身的名义在中国和美国提交了保护乙公司技术改进的申请专利。

- Company B demands that Company A assign the patent applications to Company B.
  乙公司要求甲公司向乙公司转让专利申请。

- But Company A refuses. Company B sues Company A in New York for breach of contract, seeking a court order compelling the assignment of the U.S. and Chinese patent applications.
  但是甲公司拒绝转让专利申请。乙公司在纽约对甲公司提起诉讼，声称甲公司违约，要求法院强制命令甲公司转让美国和中国专利申请。

- Likely result: Company B gets the U.S. application but not the Chinese application.
  可能的结果：乙公司取得美国专利申请，但无法取得中国专利申请。

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Choice of Law/管辖法律的选择

– A Chinese party and non-Chinese party can choose non-Chinese law to govern their agreement.
中方和外方可以选择外国法作为协议的管辖法律。

– Notwithstanding choice of foreign law, in order for the agreement to be enforceable in China, mandatory provisions of Chinese laws must be complied with.
即便选择外国法作为管辖法律，为了使协议在中国能够获得执行，仍然必须遵守中国法律的强制性规定。

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More on Choice of Law/管辖法律的选择（续）

– Foreign choice of law often gives MNCs a false sense of security.
选择外国法律作为管辖法律经常给予跨国公司一种虚假的安全感。

- Some MNCs use foreign governing law to bypass Chinese law - but it does not work so long as enforcement will ultimately be sought in China!
  某些跨国公司通过适用外国法来达到规避中国法律的目的 – 但是只要最终的执行须在中国进行，这种规避手段就没有效果。
- Foreign law adds complexity in Chinese litigation.
  外国法增加了中国境内诉讼的复杂性。

– Chinese judges generally have hard times in understanding and applying aspects of foreign law that are inconsistent with Chinese law.
中国的法官通常很难理解和采纳外国法中与中国法不一致的规定。

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Dispute Resolution/争议解决

- Notwithstanding overseas venue for litigation or arbitration, all foreign judgments or awards must be recognized by Chinese courts to be enforced in China.
  即便在境外进行诉讼或仲裁，如果外国判决或仲裁裁决要在中国境内执行，则必须获得中国法院的承认。
- China and U.S. are not a member of any international treaty that recognizes court judgments.
  中国和美国之间并没有相互承认法院判决的国际协定。
  - Chinese and U.S. courts **can but need not** recognize foreign judgments.
    中国和美国法院**可以但不是必须**承认外国判决。
- China and U.S. are a member of the New York Convention on the Recognition and Enforcement of Foreign Arbitral Awards.
  中国和美国均为《联合国承认及执行外国仲裁裁决公约 》（纽约公约）的缔约国。
  - About 142 member countries.
    该公约约有142个缔约国。

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Enforcing foreign arbitral awards in China
在中国执行外国仲裁裁决

- Procedure for enforcing foreign arbitral awards
  外国仲裁裁决的执行程序
  - Applicant directly applies to the intermediate people's court of the place where the adverse party resides or where its property is located.
    申请人直接向被执行人或其财产所在地的中级人民法院申请。
  - The court can (1) either recognize and enforce the award (2) or refuse recognition of the award.
    法院可(1)承认并执行该裁决，或(2)拒绝承认该裁决。
- Grounds for non-recognition
  拒绝承认裁决的依据
  - Invalid arbitration agreement;
    仲裁协议无效；
  - Lack of due process;
    程序不合法；
  - Tribunal beyond authority;
    仲裁庭越权裁决；
  - Improper composition of tribunal; and
    仲裁庭的组成不符合规定；及
  - Non-arbitrability of the dispute;
    争议不得通过仲裁解决；
  - Award in conflict with Chinese public policy
    裁决违背中国的公共政策。
- Pre-reporting to SPC in case of non-recognition
  如果拒绝承认外国仲裁裁决，须事先向最高人民法院汇报。

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Dispute Resolution and Governing Law
争议解决和管辖法律

- Litigation in China/在中国境内进行诉讼
  - Chinese law
    采用中国法律
  - Specify Beijing or Shanghai courts for dispute resolution
    规定在北京或上海的法院进行诉讼
- CIETAC Arbitration/贸仲会仲裁
  - Place of arbitration: Beijing
    仲裁地：北京
  - Place of all oral hearings: outside of China
    所有口头听证地点：中国境外
  - Prefer Chinese law
    优先选用中国法
  - Foreign law is acceptable
    也可以用外国法
- Arbitration in Hong Kong/在香港进行仲裁
  - Prefer Chinese law
    优先选用中国法
  - Foreign law is acceptable
    也可以用外国法
- Arbitration in the rest of the world/在其他国家和地区进行仲裁
  - AAA arbitration where discovery is desired
    根据取证的需要，在美国仲裁协会进行仲裁
  - Foreign law
    采用外国法

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Hypothetical II/假设情景二

- Company A discovers that one of Company B's WFOEs in Shanghai is using Company B's technologies that were transferred to Company A.
  甲公司发现乙公司在上海的外商独资企业在使用已经转让给甲公司的乙公司技术。

- Company A demands that Company B cease using the transferred technologies in China on the basis that Company has an exclusive license in China.
  甲公司以甲公司已经取得该技术在中国境内的独占许可为由，要求乙公司停止在中国境内使用已转让的技术。

- Company B refuses on the basis that it granted a semi-exclusive license to Company A and thus has the right to grant a license to its WFOE to use the transferred technologies.
  乙公司拒绝甲公司的要求，认为甲公司取得为排他许可，因此乙公司有权许可其外商独资企业使用转让技术。

- "This Agreement has a Chinese version and a English version. Both versions have equal force."
  "本协议有中英文两种文本。两种文本具有同等效力。"

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Hypothetical II (continued)/假设情景二（续）

- Company A sues Company B's WFOE in Shanghai for infringement.
  甲公司在上海对乙公司的外商独资企业提起侵权之诉。
- What result?
  结果会如何？
  - Company B wins if "排他许可" is used
    如果使用"排他许可"，则乙公司胜诉。
  - Company A wins if "独占许可" is used
    如果使用"独占许可"，则甲公司胜诉。

- Company A sues Company B in New York for breach of contract.
  甲公司在纽约对乙公司提起违约之诉。
- What result?
  结果会如何？
  - Company A wins if "exclusive license" is used.
    如果使用"exclusive license"，则甲公司胜诉。

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Linguistic Differences/语言差异

- Sole-exclusive License 独占许可
- Semi-exclusive License 排他许可
- Non-exclusive License 普通许可 vs. 非排他许可

➢ Most western licenses only make a distinction between exclusive and nonexclusive but do not further specify the nature of an exclusive license (sole vs. semi).
大多数西方国家的许可仅区别exclusive和non-exclusive许可，而不再对exclusive许可进行进一步区分（独占还是排他）

➢ "Exclusive license" is often translated into Chinese as "排他许可" which allows the licensor to practice.
"Exclusive license"通常被翻译为"排他许可"，因此允许许可方使用。

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Conclusions/结论

- Cross-border technology transactions are full of traps for the unwary
  跨国技术交易充满各种陷阱，一不小心就会身陷其中。
  - Exclusive dispute resolution clause is not always advantageous
    排他性争议解决条款并不一定有利。
  - Choice of law is not less important so long as agreement complies with both Chinese law and U.S.
    在协议同时遵守中国和美国法律的情况下，管辖法律的选择就没有那么重要。
- Arbitration vs. litigation
  仲裁还是诉讼
  - Arbitration is preferred over litigation
    二者之间优先选择仲裁。
  - Interim relief must be explicitly provided
    临时救济必须明确规定
- U.S. litigation is costly and discovery can be abusive
  在美国进行诉讼的成本非常高，而且取证过程可能被滥用
  - Chinese companies should avoid exclusive U.S. litigation or arbitration for dispute resolution.
    中国公司应当避免将美国诉讼或仲裁作为唯一的争议解决途径。
- IP litigation in China is improving
  中国的知识产权诉讼环境正在改善
  - American companies should consider litigation in China for certain disputes.
    美国公司应该考虑将某些争议通过在中国进行诉讼解决。

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Thank You
谢谢！
For More Info, Please Contact
如需了解更多信息，欢迎联系

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