

## Winnie Tam SBS, SC, JP

Senior Counsel, Hong Kong Bar

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Barrister-at-Law, England and Wales  
Door Tenant, 8 New Square, Lincoln's Inn, London  
Solicitor and Advocate, Singapore  
Solicitor and Advocate, Australian Capital Territory

### Year Of Call:

1984 (Hong Kong Bar)

1988 (English Bar)

2006 (Hong Kong Silk)

**Practice Areas:** Intellectual Property, Commercial Law,  
Arbitration, Mediation, Corporate Law, Entertainment and  
Media, Tech and Innovation, International Arbitration &  
Mediation

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## Directory Quotes:

Winnie Tam SC is endorsed for her “great gravitas” and “specialist knowledge in IP,” and is described as “excellent tactically” and an “outstanding advocate, at the top of her field.” She maintains a focus on impressive high-profile cross-border cases and acts on both litigation and arbitration proceedings, acting on behalf of clients from a diverse range of sectors. “Winnie is the name for IP,” and she is also described as “a really impressive senior counsel and obviously an IP expert who is very knowledgeable and commercial, and very good on her feet.”

Chambers & Partners Asia Pacific (2021)

‘ Excellent: one of the best if not the best barrister for IP in Hong Kong, you can always rely on her to do her very best and fight hard in court. ’ Winnie Tam SC is accredited as a Leading Silk for Intellectual Property.

Legal 500 Asia Pacific HK Bar (2021)

Winnie Tam SC, JP of Des Voeux Chambers combines a busy IP practice with her role as

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chair of Hong Kong's Communication Authority and continues to be seen as one of the most accomplished counsel in the space. One source identifies her as “one of the two acknowledged leaders of the Bar” there and adds: “If anyone's looking for an IP silk, it's Winnie Tam or John Yan.” Other interviewees describe her as an especially “expert and excellent advocate,” one reporting: “She's very sharp and quick on her feet and has the ear of the judge.” Particularly well known for her handling of cross-jurisdictional cases.

#### Chambers & Partners Asia Pacific (2020)

Winnie Tam SC of Des Voeux Chambers is consistently identified by interviewees as “one of the leading silks for IP in Hong Kong,” one source maintaining that she was chosen to act on a particular matter because she was “the top specialist” in the jurisdiction, the same referee going on to say: “Everything she provides is just excellent and she was absolutely invaluable to the proceedings.” Sources further characterise her as an “extremely strong advocate who has the patience and skill to explain complex IP laws, will fight as hard as she can and has managed to turn around a number of difficult court cases successfully.” A notable feature of her practice is her strong focus on cross-jurisdictional disputes and readiness to appear in both litigated and arbitrated IP disputes.

#### Chambers & Partners Asia Pacific (2019)

Winnie Tam SC of Des Voeux Chambers enjoys tremendous respect in this area. Sources describe her as “an excellent advocate who knows IP law very well and is a pleasure both to work with and to instruct.” Her broad practice covers all the key IP issues and extends across an impressive range of industry sectors. She acted for Tsit Wing in long-running and ultimately successful trade mark litigation against TWG Tea.

#### Chambers Global (2018)

Ms Winnie Tam SC, JP has been recognised by WWL Trademarks 2019 as a Global Leader in the field of Trademarks (2019)

#### WWL Trademarks 2019

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## Expertise:

### Professional Appointments and Memberships

- 2006 Appointed Senior Counsel by the Chief Justice of HKSAR
- 2015-2017 Chairman of the Hong Kong Bar Association
- 2017-2019 Chairman of the Standing Committee on China Practice Development of the Hong Kong Bar Association
- Chairman of the Committee on Intellectual Property of the Hong Kong Bar Association
- Recorder of the Court of First Instance, High Court of HKSAR
- Co-Chair of Women In Arbitration, HKIAC
- Member of the Appointments Committee, HKIAC
- Overseas Bencher of the Middle Temple Society of England
- Chairman of the Hong Kong Advocacy Training Council
- Member of the Law Reform Commission
- Chairman of the International League of Competition Law (LIDC), Hong Kong Chapter
- 2017-2018 Co-Chairman, Forum for Barristers and Advocates, IBA
- Member, Policy Sub-Committee, Bar Issues Commission, IBA
- Member, China Working Group, Asia Pacific Forum, IBA
- Officer, Diversity and Inclusion Council, IBA
- Vice Chairman, Women Business Lawyers Committee, IPBA
- Member of the Board of Advisors, Shenzhen Lanhai Research Institute on Legal Services in the Greater Bay Area
- Member of the New Intellectual Property Rights Committee, Asian Patent Attorneys Association

### Arbitration Appointments and Memberships

- HKIAC's Intellectual Property Specialist Panel
- HKIAC's Domain Name Dispute Panel member
- Member of the HKIAC's Appointments Committee
- Hong Kong Bar Association Arbitration Panel member
- Director of eBram International Online Dispute Resolution Centre Limited
- CIETAC Panel Arbitrator
- SCIA High Technology & Intellectual Property Arbitration Centre, Member of Expert Committee
- South China International Economic and Trade Arbitration Commission, Panel Arbitrator
- Member of the Chartered Institute of Arbitrators
- Fellow of the Hong Kong Institute of Arbitrators
- World Intellectual Property Organization, Panel Mediator
- JAMS/SCMC, Panel Mediator
- Hong Kong Mediation Council Panel Mediator under the Mainland and Hong Kong CEPA Investment Agreement

- Mainland - Hong Kong Joint Mediation Center Panel Mediator
- Shanghai Commercial Mediation Center (SMAC) Panel Mediator

## **Selected Recent Appointments in Arbitrations**

- Appointed as presiding arbitrator in a private equity investment dispute in Mainland China, conducted the arbitration in both Chinese and English under HKIAC Rules
- Appointed as co-arbitrator in two foreign-related investment disputes and participated the arbitration in both Chinese and English under HKIAC Rules
- Appointed by party as co-arbitrator in a complex dispute involving multi-jurisdictional arbitrations and litigations between the parties in a claim exceeding US\$200M under HKIAC 2013 Rules with the seat of arbitration in Hong Kong.
- Appointed presiding arbitrator in an arbitration under HKIAC Rules 2013. The dispute arose from a joint venture between a Hong Kong company and a major machinery manufacturing company from Northern Europe to the value exceeding USD 200M in which technology transfer was the crux of the parties' dispute. Issues involve complex international issues as well as issues on China law and Hong Kong law.
- Appointed as presiding arbitrator under the ICC Rules working with leading international arbitrators in the region. The claim is one on licensing and development of game software to involving a claim of at least USD 100M and the first stage award on the merits has been issued.
- Designated by party as Co-arbitrator in an arbitration under HKIAC rules in a dispute over a pharmaceutical distribution agreement.
- Designated by party as a Co-arbitrator in an arbitration under HKIAC rules in a joint venture dispute.
- Designated Co-arbitrator by a party in an ICC arbitration under Austrian, in which the arbitration seat is Vienna, law on a dispute over alleged misuse of technology and know how relating to the construction of manufacturing plants.
- Appointed as presiding arbitrator by (CIETAC) Hong Kong Arbitrator Center in a dispute over the sale of goods and consultation services. The arbitration is conducted in Chinese and the arbitration award has been issued.
- Appointed as presiding arbitrator by (CIETAC) Hong Kong Arbitrator Center in a dispute over an international sales contract. The arbitration is conducted in Chinese and the ruling on the jurisdiction challenge has been made.
- Appointed as co-arbitrator by the Shenzhen International Arbitration Centre (formerly SCIA) in a cross-border sale of goods dispute worth roughly RMB 30M. Complex issues of company insolvency law are involved. The arbitration is conducted under SCIA Rules.
- Appointed as co-arbitrator to work with international arbitrators in the region in a major dispute between a mainland Chinese company and Japanese companies arising out of an OEM manufacturing agreement. The core allegation is breach of confidence in technology relating to the making of machinery. The arbitration is under UNCITRAL rules. A large amount of technical information is involved.
- Appointed as lead Counsel to attend court to obtain ancillary relief in aid of arbitration in a

case involving a dispute between the franchisor and licensee to a popular show.

- Appointed as lead Counsel to represent a manufacturer of hi-tech apparatus in multiple number of disputes with its competitor in China. Acted as co-lead counsel with US patent counsel in two arbitrations under UNCITRAL rules for clients in the same group of companies. The core allegations related to infringement of multiple patents and use of confidential information by former technical employees. Emergency arbitration procedure was involved in one set of the proceedings.
- Appointed as lead Counsel to work with American Lawyers on two arbitrations under HKIAC and ICC rules respectively across two jurisdictions in a dispute involving a technology supply joint venture.
- Appointed as Counsel in a HKIAC arbitration involving dispute over the use of telecommunication technology.

## **Other Public Appointments (include)**

- Chairman, Communications Authority
- Chairman, Performing Arts Committee, West Kowloon Cultural District Authority
- Member, Law Reform Commission
- Member, Chief Executive's Council of Advisers on Innovation and Strategic Development
- Member, Board of Directors and Executive Committee of the West Kowloon Cultural District Authority
- Member, Board of Governors, Hong Kong Philharmonic Society Ltd
- Member, Consultative Committee of the Qianhai Special Free Trade Zone (PRC)
- Member, Hong Kong Tourism Board (2014-2019)
- Member, Judicial Officers Recommendation Commission, HKSAR (2016 - 2018)
- Member, ICAC Advisory Committee on Corruption (2013-2018)
- Member, ICAC Operations Review Committee (2007-2012)

## **Selected Cases**

- ABG Juicy Couture LLC v Bella International Ltd - HCA 1764 of 2008
- Acron International Technology Ltd v Chan Yiu Wai and Law Sui Chun - FAMV 13/2018
- Alviero Martini SPA v Bubble Retail Management Ltd - HCA 1937/2008
- Apple Daily Ltd v Oriental Press Group Ltd - HCA 1396/2009
- Bruce James Stinson V Gu Ming Gao - HCA 2352/2012
- California Red Ltd v Gold Typhoon Entertainment Ltd - HCA 2684/2008
- Chor Ki Kwong David v Lorea Solabarrieta Cheung - HCA 1870/2012
- Christie Manson & Woods Ltd v Chritrs (Group) Ltd - HCA 1418/2011
- Gmedia Technology (Beijing) Co Ltd v Tencent Holdings Ltd - HCA 495/2017
- Guccio Gucci SpA v Cosimo Ludolf Gucci - HCA 1582/2008
- Horner Resources (International) Co Ltd v Savvy Resources Ltd - HCA 335/2010
- Hugo Boss Trade Mark Management GmbH & Co KG v Britain Boss International Co Ltd

- CACV 114/2015
- L’Oreal (UK) Ltd, Yves Saint Laurent (YSL) v YLS Brands HK Ltd - HCA 2814/2017
- Louis Vuitton Malletier SA v Marco Leather Goods Ltd - HCA 1511/2009
- Louis Vuitton Malletier v Cuvee XLV French Wine Ltd - HCA 1900/2013
- M.G.X. Asia Ltd v China Way Global Co Ltd - HCA 2001/2013
- Menfond Electronic Art & Computer Design Co Ltd v Wong Wang Tat Victor - HCA 293/2011
- Midland Business Management Ltd v Lo Man Kui - HCA 1599/2010
- Nerium Biotechnology Inc v Nerium International, LLC - HCA 1188/2016
- N.V. Sumatra Tobacco Trading Co v Nanyang Brothers Tobacco Co Ltd (Triple Happiness - TM No.300982350
- OPG Human Resources Ltd v Apple Daily Ltd - HCA 481/2009
- Oriental Food Industries Sdn Bhd v Sze Hing Loong Development Ltd - HCA 2094/2011
- Pan Chung Pat Wo Tong (HK) Ltd v Law Yan Wai t/a Singapore Medicine Co - CACV 239/2013
- In the matter of an application by Ping An Securities Ltd - HCMP 2788/2004
- Ringier Print (HK) Ltd v South China Media Ltd - HCA 2312/2009
- Sky King Machinery Engineering Ltd v Chun Wo Construction & Engineering Co Ltd - HCA 1918/2013
- SNE Engineering Co Ltd v Hsin Chong Construction Co Ltd - HCA 1466/2012 (26.3.2014)
- Star TV Filmed Entertainment (HK) Ltd v Golden Princess Amusement Co Ltd - CACV 61/2007
- Stichting BDO v Banco De Oro Unibank Inc - HCA 1162/2009
- Talpa Global BV v Star China Media Ltd and Meng Xiang Qiang Yin Cultural and Broadcast (Shanghai) Co Ltd - HCMP 121/2016
- Tsit Wing (Hong Kong) Co Ltd v TWG Tea Company Pte Ltd - HCA 2210/2011, CACV 191/2013, FACV 15/2015, FAMV 6/2015
- UMG Recording Inc v Profit Chart Development Ltd - HCA 472/2010
- Wind River Systems Inc v Digital China Holdings Ltd - HCA 1550/2012
- Wong To Yick Wood Lock Ointment Ltd v Singapore Medicine (HK) Co Ltd - HCA 595 and 600/2014
- Xcelom Ltd v. BGI-Hong Kong Co Ltd - HCA 3089/2015

## **Publications, Lectures and Talks**

- **CIETAC-HK (IDRA) 2021** - 22.2.2021

*Law which can only be tentatively identified after a trawl through Extensive authorities must be condemned as not fit for purpose*

- **IDRA 2021 Webinar Series on Decoding Hong Kong Contract Law** - 25.1.2021
- **Hong Kong’s unique role in IP creation, protection and enforcement as well as dispute resolution in GBA and beyond - Arbitration in Intellectual Property** - 4.12.2020
- **BIP Asia Forum 2020** - 2.12.2020

*Challenges and opportunities brought by COVID-19 to the legal and IP fields*



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- **Hong Kong Mediation Conference (Legal Week) - 6.11.2020**

*United Nations Mediation Convention – Challenges to Arbitration*

- **Hong Kong Legal Week 2020 - 3.11.2020**

*Inaugural Rule of Law Congress Towards 2030: A Decade of Action for Rule of Law*

- **Hong Kong Arbitration Week 2020 - 19.10.2020**

*International arbitration in the digital landscape: technology, cybersecurity and data protection  
(In-person and virtual)*

- **Hong Kong Academy of Politics and Public Policy - 10.10.2020**

*The Legal System of Hong Kong*

- **WIA 仲裁生态漫谈 — 男性仲裁员眼中的女性仲裁员 - 9.10.2020**
- **香港国际仲裁中心WIA委员会主办成功仲裁女性炉边访谈 - 3.7.2020**
- **BIP Asia Forum - 6.12.2019**

*Effective Global IP Enforcement Mechanism – How Does HKSAR Contribute to the Cause?*

- **BIP Asia Forum - 5.12.2019**

*Divergence : Unwelcome Uses of Well-Known Copyright Works and Trademarks*

- **Australian Arbitration Week, Brisbane - 18.11.2019**

*Resolution of IP Disputes Through Arbitration – The experience of Hong Kong SAR & China*

- **DLA Piper and DVC - 17.10.2019**

*Inspiration vs Appropriation: Well-known Trademarks in Hong Kong, China and  
around the World*

- **HKTDC - Belt and Road Summit - 11.9.2019**

*Towards a Greater Success of Belt and Road Projects for Sustainable*

*Investment – Hong Kong Can Lead (香港：引領一帶一路項目持續投資及成功發展)”*

- **IBA Conference Seoul 2019 - 24.9.2019**

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*Chaired a session entitled "Global Justice and Globetrotting Judges"*

- **湾区法律服务一体化 - 第二届广东企业法律服深圳蛇口务论坛 - 23.8.2019**

*跨境知识产权争议调解*

- **Inaugural "Mediate First" Pledge event in Shanghai - 20.8.2019**

*商事纠纷 调解为先 - 沪港交流研讨会 (跨境知识产权争议调解)*

- **POLA Annual Conference 2019 (Kunming China) - 2.8.2019**

*Alternative Dispute Resolution for Multi-National Businesses in the  
Greater Bay Area of China*

- **IP Mediation Conference 2019 at Spain - 30 & 31.5.2019**

*China Intellectual Property Commercial Mediation Practice and Thoughts*

- **Legal Tech Forum - 20.5.2019**

*New Technology & Changing Legal Ecosystems*

*The Good, The Bad & The Ugly: Is our IP Law Ready for the Wave of New Technology?*

- **IPBA Conference Singapore - 29.4.2019**

*Arbitrating IP Disputes - Is it the final frontier or the beginning of the journey?*

- **International Resolution Dispute Conference 2019 - 17.4.2019**

*Exploring Aspects of Development of Alternative Dispute Resolution relevant to  
Business in the Greater Bay Area*