



Horace Lam

Partner

**CO-HEAD OF IPT, ASIA
CO-COUNTRY MANAGING PARTNER, CHINA**

horace.lam@dlapiper.com

Beijing

T: +86 10 8520 0600

F: +86 10 8520 0700

M: +86 18 6012 50454

Horace Lam is the Co-Country Managing Partner in China, and Co-head of the Intellectual Property and Technology (IPT) group in Asia. He leads a strong team of dedicated IP lawyers with full Greater China coverage across Beijing, Shanghai and Hong Kong, and throughout Asia.

Horace advises multinational companies on all types of IP issues in China, and regularly assists Fortune 500 companies in developing and executing their IP strategies tailored to their Asian business. He has extensive experience advising on complex IP matters, including pan-Asia brand protection strategies, cross-border IP litigations, infringement and enforcement, multi-jurisdictional technology and know-how transfer and licensing matters, and complex IP structuring and transactions.

Horace has managed numerous IP disputes in China and other parts of Asia, including licensing, trademark, copyright, patent, confidential information, trade secrets and design rights matters. Horace also advises clients on IP issues relating to R&D collaborations including technology and know-how licensing and transfer, and inventor remuneration issues.

Horace is recommended by Chambers Asia and Legal 500 as being a "top-notch" and "highly regarded" "leading IP lawyer" with "wide-ranging experience", and is "especially praised for his copyright-related work". The WTR1000 (The Guide to the World's Leading Trademark Professionals) hails Horace as having a "total command of the practice area" with an "excellent reputation", "steeped in regional knowledge" and a "clear-thinking strategist". Horace is recognised as an "extremely smart and professional" lawyer who "provides creative solutions with a thoughtful and strategic understanding of the market", and a client oriented approach that "always looks out for the best interests" of patrons.

Horace's IP experience extends across a number of key sectors, including consumer products, luxury goods, hospitality, aerospace, automobiles, tobacco, spirits and beverages, oil and gas, high-technology, computer and software products, and telecommunications.

Horace is the former Chair of the China Sub-committee, Anti-Counterfeiting and Enforcement Committee of the International Trademark

- Intellectual Property and Technology
- Media, Sport, Gaming and Entertainment
- Technology Transactions and Strategic Sourcing

- Consumer Goods, Food and Retail
- Technology
- Life Sciences
- Energy and Natural Resources
- Industrials

Chinese (Cantonese)
Chinese (Mandarin)
English

Association (INTA). He is a member of INTA, and he regularly contributes to publications on the developments of IP law.

LANGUAGES SPOKEN

- Chinese (Cantonese)
- Chinese (Mandarin)
- English

EXPERIENCE

- Advising a global luxury automobile manufacturer in successfully obtaining a US\$1.5 million judgment in a trademark and counterfeiting case brought against a Chinese online platform in the Northern District of California (BMW, et al. v. DinoDirect Corp., et al., Civil Action No. 3-11-cv-04598 (N.D.Cal) (Judge Alsup)
- Advising a major Chinese high-technology company in defending a series of cross-border litigations initiated by a large U.K. multi-media company in Spain, Italy, Germany, and several other European jurisdictions. Assisting the client to devise comprehensive global offensive and defensive strategies
- Devised and handled a China-wide anti-counterfeiting program for the world's largest publicly traded oil and gas company, including successfully pursuing parallel cross border litigations, criminal actions and administrative enforcement programs. Successfully obtained a well known trademark recognition via civil litigation in China. Also assisted the client on all trademark related prosecution and advisory matters in China
- Advising one of the world's largest and most-innovative technology companies in several global trademark disputes with its major competitors, with parallel proceedings in China, Taiwan, the U.S., Russia, to name a few
- Advising a global technology company in relation to comprehensive brand protection enforcement actions across China and Hong Kong, including civil litigations, criminal actions and Customs seizures
- Advising a leading spirits manufacturer in successfully obtaining well known trademark recognition through a trademark infringement litigation against a Chinese company
- Advising a large Chinese technology company on various trademark and trade name litigations in Europe, relating to its house brand
- Advising one of the largest online media company's in China on parallel disputes relating to its social media brand across multiple jurisdictions including Asia, U.S. and Europe
- Advising the world's leading commercial aircraft engine manufacturer on IP issues relating to the licensing of its technology and products, in a multi-billion dollar contract for building the largest commercial airliner in China
- Advising a global U.S. airliner on issues relating to prize promotions, incentives and various sponsorship arrangements in China, dealing with some highly complex and regulated regulatory issues in the aviation sector

CREDENTIALS

Professional Qualifications

- Solicitor of the High Court of Hong Kong
- Solicitor of the Supreme Court of New South Wales

Recognitions

Horace is recommended by Chambers Asia and Legal 500 as a "top-notch" and "highly regarded" "leading IP lawyer" with "wide-ranging experience", and is "especially praised for his copyright-related work". The WTR1000 The World's Leading Trademark Professionals hails Horace as having a "total command of the practice area" with an "excellent reputation", commanding "immense respect by peers and brand owners".

Consistently being ranked as a leading lawyer in China by multiple independent legal directories since 2010, including Asia Pacific Legal 500, World Trademark Review, Managing Intellectual Property IP Stars, and Chambers, Horace is recognised as an "extremely smart

and professional" lawyer who "provides creative solutions with a thoughtful and strategic understanding of the market", and a client oriented approach that "always looks out for the best interests" of patrons.

Education

- University of New South Wales, B. Com (Finance) with merit and LL.B.

INSIGHTS

Publications

Chinese court rules in first NFT copyright infringement case

9 June 2022

The sales of NFTs have resulted in a billion-dollar sized market; yet the laws and regulations around this specific asset class are failing to keep up with the fast pace of development and fall short in addressing many key legal issues and controversies surrounding NFTs in traditional legal areas, notably in copyright law.

The time has come for trademark hijackers to pay the price

25 April 2022

Trademark hijacking in China is notorious and has been a mission impossible for brand owners for many years, despite the continuous efforts from both the China National Intellectual Property Administration (the "CNIPA") and the Chinese courts.

China's campaign to strengthen IP enforcement: What's going on and what will impact foreign rightsholders

19 October 2021

In recent years China's top leaders have urged a whole-of-government push for strengthened IP protection at an almost unprecedented scale.

Lost in translation: Chinese versions of Western brands

14 May 2021

China's first-to-file trademark system means trademark piracy continues to be problem for brand owners. However, a less well-known problem occurs where a Western brand owner has registered its Western brand but has not devised and registered a Chinese equivalent.

One size may not fit all: International registrations in China

14 May 2021

When protecting a brand in China, a brand owner can choose either to file a national Chinese trademark application at the China National Intellectual Property Administration (CNIPA) or file an international registration (IR) through the World Intellectual Property Organization (WIPO), which designates China.

PROTECT™ - Overview

14 May 2021

PROTECT™ is DLA Piper's unique service which "stress tests" your brand and gives you peace of mind that it is "fit" for the China market.

What is worth copying is worth protecting: Brand protection through copyright

14 May 2021

The problem of trademark piracy in China continues to plague brand owners. Most brand owners are aware of the need to register their core brands in China at the earliest possible opportunity.

When West Goes East: Chinese trademark classification

14 May 2021

Once brand owners have their brands registered in China, many think that they are safe from the clutches of brand pirates. Yet brand owners are often lulled into a false sense of security about the extent of their trademark protection in China.

China's Revised Regulations on Medical Devices: Good News for Industry Stakeholders?

21 April 2021

On 9 February 2021, the PRC State Council issued the revised PRC Regulations on the Supervision and Administration of Medical Devices (the Revised Medical Device Regulations), which will become effective on 1 June 2021.

China signs off on PRC Biosecurity Law: What this means for industry players in China

21 October 2020

The Biosecurity Law establishes a comprehensive framework replacing the current somewhat piecemeal legislation.

- *Stricter PRC online advertising regulation in response to search scandal*, 11 August, 2016
- *Intellectual Property and Technology News (Asia Pacific)*, 1 August, 2016
- *Important revisions to the anti-unfair competition law proposed*, 29 April, 2016
- *IP developments in Greater China*, 26 January, 2016
- *China's new Intellectual Property Courts: the wait is finally over*, 21 November, 2014
- *The Golden Rules of Trademark Strategy, China Law & Practice*, March/April 2014

NEWS

China and Hong Kong partners recognised in IP Stars 2022

8 June 2022

IPT partners Edward Chatterton (Hong Kong) and Horace Lam (Beijing) have once again been recognised in IP Stars 2022 by Managing Intellectual Property as industry leaders.

China and Hong Kong partners recognised in IP Stars 2021

8 July 2021

We are delighted to announce that IPT partners Edward Chatterton (Hong Kong), William (Skip) Fisher (Shanghai), and Horace Lam (Beijing) have been recognised in IP Stars 2021 by Managing Intellectual Property.
