

## Challenges of IP protection in China

Case study & tips

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# **General**

Tips & comments

# General

## Tips & comments

- Develop your IP strategy with care
- Register trademarks, invention patents, design patents, utility models and copyright in China
- Employ local experts
- Put in place watch services & procedures to monitor trade fairs, online sellers, and any other areas where infringing products might be sold or marketed
- Gather evidences with care
- Consider secrecy & protect yourself with contract
- Respect differences
- All types of enforcement actions can be combined to achieve optimal results

# Trademark example

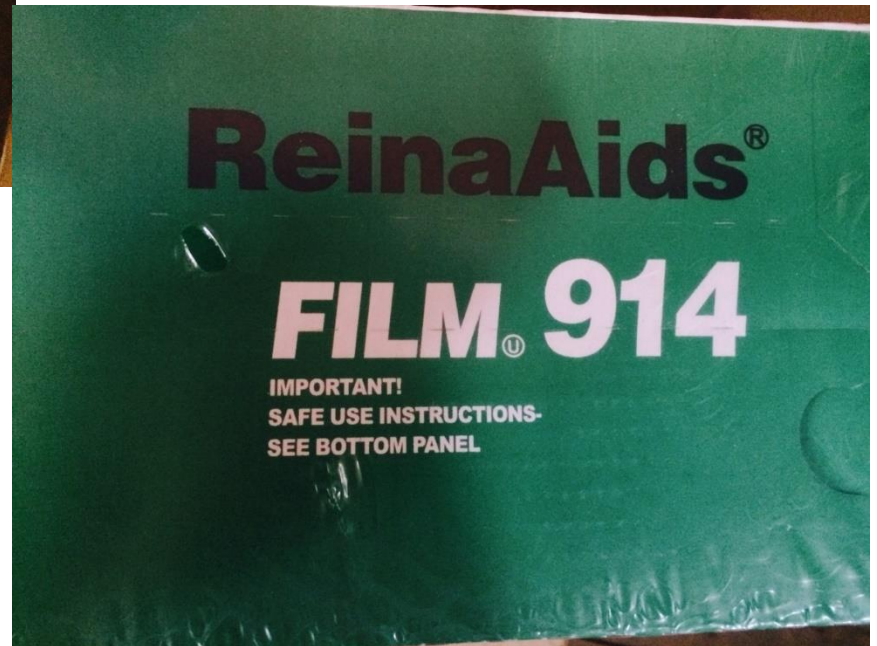


# **Case Study No 1**

Trademark infringement

# Reynolds trademark

Administrative & criminal proceedings combined



## **Case Study No 2**

Bad faith trademarks

## Bad faith trademark

### Roi Jaguar

Dutch company produces their additives in China under the trademark «Roi Jaguar»

Local chinese manager was asked to take care of the registration of the «Roi Jaguar» trademark in China and did it in his own name

When local chinese manager left the company, the dutch company found out that Indian company is producing additives under the trademark «Roi Lynx»

Administrative proceedings were initiated against the dutch company for unauthorized use of the «Roi Jaguar» trademark in China

The dutch company was required to object the registration of the «Roi Jaguar» trademark in China and to rebrand while the trademark was effective



## **Case Study No 3**

Bad faith trademarks

## Bad faith trademark

### IPHONE

Apple had submitted a trademark application for «IPHONE» on October 18, 2002, and received a registration on November 21, 2003 for goods in Class 9 only, namely, computer hardware and computer software.

Apple first announced their iPhone in public on 9 January 2007 at the Macworld Expo in San Francisco. The first iPhones were available later that year in the U.S., but did not arrive in China until 30 October 2009.

On September 29, 2007, Xintong Tiandi Technology (Beijing) Co., Ltd. submitted a trademark application for «IPHONE» in Class 18 for leather goods.

Apple objected the registration, claiming that «IPHONE» is a well-known trademark in China. But was it at the time when the opposed application was filed?

Beijing High People's Court upheld the validity of objected trademark application for «IPHONE» covering leather goods, including, cell phone cases.

# Bad faith trademarks

## IPHONE



# **Case Study No 4**

Trade secrets

## Trade secrets

### Wuvio

Wuvio – a market leader in producing chemicals to combat dust for construction sites, energy producers, mining and dry bulk companies

Active on the market for 11 years before coming to China without any registered patent

Did not want their chemical solution formula to become available to the public in 20 years

Did not have enough money to chase infringers – prevention was the key

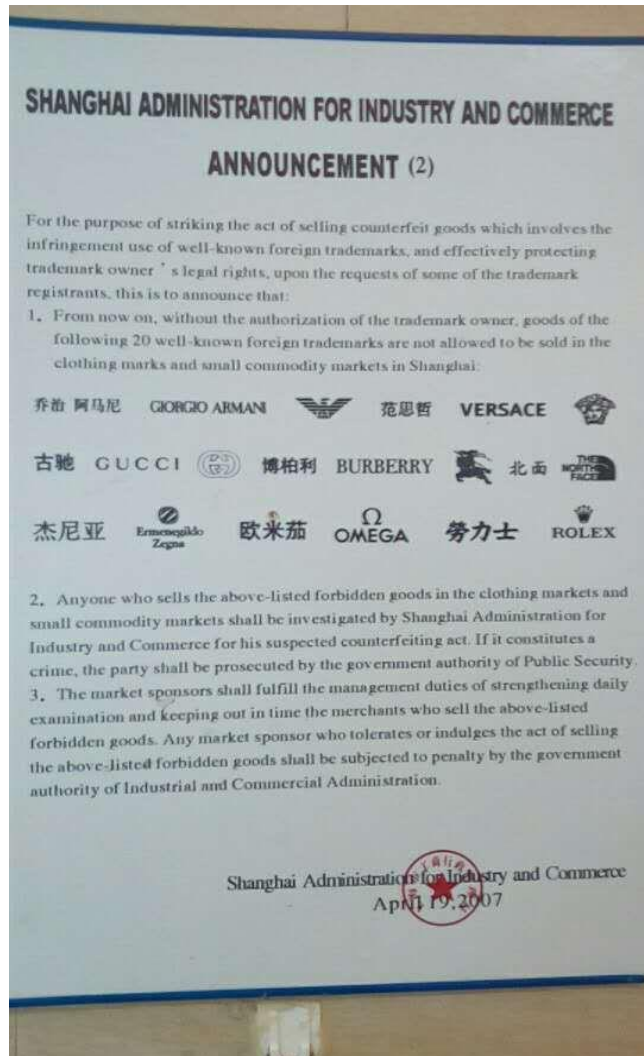
Checked whether the formula of their solutions could be easily retrieved through reverse engineering, but the attempts were not successful thus protection is gained through secrecy

## **Recent observations**

Possible infringements

# Government efforts

At the entrance of AP Plaza (fake market) in the Science and Technology Museum metro station foyer in Shanghai





# Trademark infringement

## New Balance/ Newbelatuk





**How can we help?**

In more than 30 countries

# Eversheds Sutherland

## International full service law firm

- Eversheds Sutherland has 62 offices in more than 30 jurisdictions, including, China, Hong-Kong, Eastern and Western Europe, United States, and in many African and Asian countries
- One point of contact, international coverage, which includes the same corporate values and quality standards
- The only law firm with such international coverage present on the market in Baltic region
- Strong IP practice amongst other sectors – complex advice on all legal aspects



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