

Chinese Intellectual Property

A Practitioner's Guide

知识产权实务手册

Fian Xu (徐健)
Gordon Harris



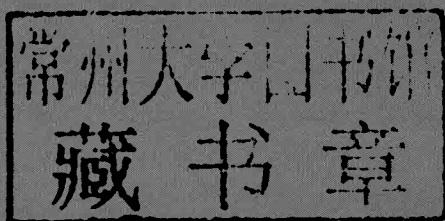
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We would like to thank the Intellectual Property Publishing House for inviting us to write this book of practical advice regarding Chinese intellectual property law. Thanks also to the editors for their hard work in bringing this book to print.

We hope that our readers will find this helpful, practical and interesting as they learn to find their way through the detail of Chinese intellectual property law.

Dr. Jian Xu
Gordon Harris

ABOUT THE AUTHOR



Dr. Jian Xu

Dr. Jian Xu is a dual qualified Chinese lawyer and patent/trademark attorney. He currently heads up the Chinese intellectual property practice at the international law firm, Wragge & Co.

Jian joined Wragge & Co in 2008 and has been in charge of the firm's Chinese IP practice since that date. Prior to that, he was a senior patent attorney at one of the largest domestic IP law firms in Beijing. Jian has handled all aspects of intellectual property in business including drafting, prosecution, enforcement, acquisition and licensing of patents, trade marks and brand, design rights, copyright and content, as well as dealing with unfair competition issues. He has conducted litigation and administrative sanctions in relation to intellectual property disputes all over China. Jian also has a strong background in the chemistry and life science sector, with a bachelor's degree from the Beijing University of Chemical Technology and a PhD degree in Biochemistry from the University of Manchester.

In addition to his focus on intellectual property law, Jian has considerable experience working in both major Chinese and English law firms, advising on various corporate and commercial matters and facilitating understanding across different legal systems.

Jian is a member of several Chinese intellectual property organisations such as All-China Patent Agents Association (ACPAA) as well as international ones such as International Trademark Association (INTA). He is a featured speaker at many IP conferences, and is a guest lecturer on IP topics at the Legend Institute of Chinese Academy of Science.



Gordon Harris

Gordon Harris is the Head of Intellectual Property Law at the International Law Firm, Wragge & Co. He graduated in law from University College London in 1981 and joined Wragge & Co the next year,

becoming a partner in 1990 and Head of IP in 1995. He has conducted litigation in respect of the full range of IP rights on behalf of household name clients from around the world, but is also conscious of the importance of dispute resolution and is one of the most experienced mediators of IP disputes in the UK, accredited by the World Intellectual Property Organisation and the Centre for Effective Dispute Resolution.

As a litigator Gordon has led cases in all the UK courts, including the Supreme Court, and the European Court of Justice in Luxembourg. He has supervised global litigation across a range of jurisdictions including China, the USA, and Australia.

Gordon first visited China in 2002 and five years later was the prime mover in Wragge & Co opening their own office in Guangzhou, where the first employee was Dr. Jian Xu, the co-author of this book. Gordon is now a regular visitor to China and works with many clients to achieve legal solutions in China.

Gordon is a member of various intellectual property organisations including International Association for the Protection of Intellectual Property (AIPPI), Asian Patent Attorneys Association (APAA), International Trademark Association (INTA) and European Patent Lawyers Association (EPLA). He is an Associate of both the Chartered Institute of Patent Attorneys and the Institute of Trade Mark Attorneys. He writes a widely anticipated annual review of patent cases in the UK courts and is a regular speaker on IP matters at conferences and seminars. Under his leadership Wragge & Co's award winning IP team has opened offices not only to China, but also in Germany (Munich) and France (Paris).

FORWARD

It is now over ten years since my first visit to China. I came to look at the possibilities for opening an office there, but was instantly captivated by the sheer energy of this astonishing country, developing at such a remarkable pace. That pace has continued through the last ten years and I have watched with growing awe on each of my regular visits as the infrastructure, architecture and facilities have advanced and developed. China is no longer a developing country – it is a developed country, and its legal system has grown alongside the more obvious manifestations of that development. There is no doubt, China is a great place to do business.

When my firm was in the process of establishing our office in China in 2008, we had a remarkable piece of luck. Out of the blue we received an application from a Beijing based Chinese qualified patent attorney, Dr. Jian Xu, who was keen to relocate to Guangzhou and to gain experience working within our firm.

Jian had achieved his PhD in biochemistry from Manchester University in the UK and was a fluent speaker and writer of English. We happily took him on board and he has been with our team ever since, during which time he has achieved dual qualification as a lawyer also.

What marks out Jian's advice, and which has proved so attractive to clients and fellow professionals across the world, is his intensely practical and commercial style. He is a "solutions person", always looking to see what can be done, not what cannot be done. It is that direct, practical and helpful approach which he brings to this collection of articles and notes to give practical guidance to businesses and professionals regarding the practice of intellectual property in China.

It is nothing more than a myth now that IP rights have no value in China. The IP system, and indeed the court system by which it is enforced, may be no more than teenage in terms of experience, but they are learning fast, and all the time the rough edges are being shaved off the system, and it is working better, faster and more reliably.

On behalf of a wide range of clients, Jian and my firm's team of lawyers, working with local counsel, have achieved many successes in the Chinese IP system. They have taken down literally thousands of offending websites offering infringing goods; they have opposed hundreds of attempts to register competing patents and designs at the Chinese Patent Office (SIPO) by would be competitors and copyists; and they have used the court and administrative systems to obtain injunctions, evidence protection orders, seizure and substantial damages from infringers across China.

As the years go by the obstacles to effective enforcement, and indeed to the operation of a holistic IP strategy in China are coming down. Lessons are learned daily, and procedures are improved and simplified. For sure there are still frustrations, but where in the IP world are there not frustrations and delays from time to time? Even a brief conversation with a European Patent Attorney about European Patent Office (EPO) practice will unleash a stream of issues!

China still has a way to go to achieve parity with the more

experienced systems in Europe and the USA, but it is catching up fast and learning all the time. This collection of short articles by Jian Xu reveals some of the ways in which the Chinese system can be worked to the best advantage of the IP owner.

Among the gems in this book are highly practical guides to the appointment of investigators – a key aspect of protection in China –, tips for combating pirated trade marks – a prevalent problem for brand owners operating in China –, detailed action plans for intellectual property enforcement, as well as the best steps to use the systems in place at the Canton Fair to obtain instant redress. The Canton Fair, which in truth is in fact a series of successive fairs focussing on different product ranges, is the largest trade fair in the world. It occurs twice a year at the massive halls of the Guangzhou Exhibition Centre. It is a wonderful showcase for innovation and design, but can equally be abused as a venue for peddling counterfeit goods. The organisation of the Fair includes specific provision for taking down offending stalls and seizing infringing goods. In his articles on the Fair in this book, Jian gives highly practical advice for formulating a strategy to take on infringers.

The book deals with the full range of IP rights and the full range of situations, from basic advice on registration strategy, to detailed advice on dealing with rights which arise during the course of employment.

Working through the articles and notes to put them into the right format for a predominantly western audience, I have been repeatedly struck by the little insights and points which can be so valuable. I have tried to ensure that the excellent points are not lost in too much detail, but fortunately Jian's style is "spare" and the text is economical and concise.

Chinese IP law and practice is of vital concern to rights owners all round the world. China is now part of the global economy – a big and

growing part. Its vast market, with more consumers entering every year as a result of government policies, is simply too good to miss for businesses globally. But if they are going to make a success of their sales in China, they need to take heed of the dangers posed by failing to register and enforce their rights. The practical advice in this book is a vital tool in their armoury as they look to achieve a proper and effective level of protection.

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