国际商标协会年会开幕

第136届国际商标协会（INTA）年会于今年上午在香港会议展览中心开幕。大会邀请了香港特别行政区财政司司长曾俊华致开幕辞。曾俊华在发言中表示，随着近年来中国专利及商标申请量屡创新高，这对于香港的知识产权业者带来了无限契机。

曾俊华提到，香港特别行政区从各个方面继续推动知识产权保护体系，包括支持知识产权的开发及项目研发；加强知识产权保护的人力资源；提高各领域的服务质量，例如金融、尽职调查、仲裁；并加强企业，尤其是国有企业的知识产权组合的意识等。

今年是香港特别商获批商标的40周年纪念。据了解，由香港贸发局（Hong Kong Trade Development Council, HKTDC）推出的免费知识产权网络平台Asia IP Exchange (AsiaIPEX)目前已有超过8,500名与会者。今年的论坛将于12月初举行。

亚看出国际商标协会（INTA）是一个全球性的知识产权组织，其成员包括来自全球各地的知识产权专业人士。INTA的年会是全球知识产权界的一大盛事，吸引了来自世界各地的知识产权业者参加。

曾俊华在发言中表示，随着近年来中国专利及商标申请量屡创新高，这对于香港的知识产权业者带来了无限契机。今年是香港特别商获批商标的40周年纪念。据香港贸发局（Hong Kong Trade Development Council, HKTDC）推出的一个免费知识产权网络平台Asia IP Exchange (AsiaIPEX)目前已有超过8,500名与会者。今年的论坛将于12月初举行。

INTA的主席Mei-lan Stark及首席执行官Sanz de Acedo分别开幕发表演讲。斯登（David Stone）。本届年会为期5天，吸引了超过8,500位知识产权专家及60多名演讲人。今年的论坛将于12月初举行。

亚看出国际商标协会（INTA）是一个全球性的知识产权组织，其成员包括来自全球各地的知识产权专业人士。INTA的年会是全球知识产权界的一大盛事，吸引了来自世界各地的知识产权业者参加。

曾俊华在发言中表示，随着近年来中国专利及商标申请量屡创新高，这对于香港的知识产权业者带来了无限契机。今年是香港特别商获批商标的40周年纪念。据香港贸发局（Hong Kong Trade Development Council, HKTDC）推出的一个免费知识产权网络平台Asia IP Exchange (AsiaIPEX)目前已有超过8,500名与会者。今年的论坛将于12月初举行。

亚看出国际商标协会（INTA）是一个全球性的知识产权组织，其成员包括来自全球各地的知识产权专业人士。INTA的年会是全球知识产权界的一大盛事，吸引了来自世界各地的知识产权业者参加。
INTA and HKIPD sign MoU

INTA and the Hong Kong Intellectual Property Department yesterday signed a memorandum of understanding at the Annual Meeting.

Speaking at the signing ceremony INTA CEO Etienne Sanz de Acedo commented: “This MoU is going to be a starting point for further cooperation and for further interaction between INTA and HKIPD.”

Peter Cheung, director of the HKIPD, said that over the years he had undergone a shift in mindset that tied in with the spirit of the MoU: “When I used to attend INTA activities, I would think when I met people: ‘what can you do for me?’ But several years ago I changed to saying: ‘what can I do for you?’”

Commenting on the MoU he went even further: “It is not what you can do for me or what I can do for you, it is how we can work together. What we are doing is institutionalizing all our common goals, and trying to move to the next level.”

Cheung retires on Wednesday. He has been with the department since April 2011 and has pushed to develop Hong Kong as an IP center. “I find myself linked to INTA because my last day of service falls on Wednesday, so I take that as a good omen,” he said.

Concern over plain packs

Panels at a session yesterday on plain packaging were united in their concern about the impact of standardized packaging on trademarks and trademark owners.

“Plain packaging is the most restrictive subset of standardized packaging,” said Paul Kilmor of Holland & Knight. “The government takes over the whole pack and dictates how—or if—the trademark can be used.”

Trevor Stevens of Davies Collison Cave outlined Australia’s experience of plain packaging rules for tobacco, introduced over one year ago. “There was considerable political mileage in taking on big tobacco. It was a win-win situation for the government.” But he questioned whether the law met the TRIPS Agreement criteria of being necessary and justifiable, given that rates of smoking were already falling in the country.

Myrrha Hurtado Rivas of Novartis Pharma explained how strict regulations require pharmaceutical companies to provide patient information on their packaging. “That trade dress deserves protection,” she said. When it comes to new laws to regulate packaging, Hurtado Rivas wondered aloud: “Who is going to tell us how far is too far?”

Today’s quiz question | 测试

Which architect designed the famous HSBC Building, completed in 1985? 请问是由哪位建筑师设计完成?

Send your answer to contest@inta.org by midnight tonight. Winner announced on Wednesday.

We don’t just practice Mexican IP Law.

We help shape it.

In an uncertain legal environment, we are one law firm that is not content simply to accept the status quo. We work constantly to influence the evolving body of Mexico’s intellectual property laws, with the goal of ultimately bringing them in line with international standards. While we continue to make great strides in this regard, clients from all over the world rely on us to prosecute, manage, and defend their IP portfolios under the laws that exist today. In other words, we work effectively within the system, even as we seek to change it.

olivlaw@olivares.com.mx | Tel: +52 55 5322 3000 | www.olivares.com.mx

Managing Intellectual Property


Photography by Graham Uden.
Printed by ieMedia Asia Limited.
The INTA Daily News is also available online at www.inta.org and www.managingip.com.
© Euromoney Institutional Investor PLC 2014. No part of this publication may be reproduced without prior written permission. Opinions expressed in the INTA Daily News do not necessarily represent those of the INTA or any of its members. Full production credits at www.managingip.com/about-us.html
The latest developments on ICANN, the Trademark Clearinghouse (TMCH) and the Uniform Rapid Suspension (URS) tool were discussed in yesterday’s session on trademarks and new gTLDs. Sarah Deutsch of Verizon Communications warned that brand owners are likely missing lots of cybersquatting, especially in internationalized domain names (IDNs).

Vicki Folens of Deloitte, which runs the TMCH, said that ongoing notifications have been added as a free service, but said that trademark holders have to opt-in. She added that TMCH renewals will start on November 5 this year, and revealed that there are plans to accept mixed script trademarks from the end of May.

Moderator Kristina Rosette of Covington & Burling provided some pointers on bringing URS cases, noting that the evidence standard is high, but that you can amend evidence once submitted. She also encouraged trademark owners to participate in the upcoming reviews of the new gTLD program and the UDRP: “It’s important to have data—how did you participate? How much did you spend?”

Meet the Intellectual Property Constituency at 10:30 am and the Brand Registry Group at 1:00 pm on Wednesday May 14 in Room N101A.

Representatives from the Chinese government gave INTA attendees an update on the status of trademark protection in China. Judge Yin Shaoping of the Supreme People’s Court discussed judicial mechanisms for protecting intellectual property, while Zhang Feifei of the Ministry of Public Security gave an overview of China’s successful anticybersquatting campaigns. Li Zhenzhong of the National Leading Group on the Fight Against IP Infringement and Counterfeiting provided information about plans to strengthen IP protection at the local and provincial levels, while Professor Tao Xinliang of Shanghai University and Dacheng Law Firm Shanghai Office talked about some of the changes in China’s Trademark Law.

New gTLD latest

The developments on ICANN, the Trademark Clearinghouse (TMCH) and the Uniform Rapid Suspension (URS) tool were discussed in yesterday’s session on trademarks and new gTLDs. Sarah Deutsch of Verizon Communications warned that brand owners are likely missing lots of cybersquatting, especially in internationalized domain names (IDNs).

Vicki Folens of Deloitte, which runs the TMCH, said that ongoing notifications have been added as a free service, but said that trademark holders have to opt-in. She added that TMCH renewals will start on November 5 this year, and revealed that there are plans to accept mixed script trademarks from the end of May.

Moderator Kristina Rosette of Covington & Burling provided some pointers on bringing URS cases, noting that the evidence standard is high, but that you can amend evidence once submitted. She also encouraged trademark owners to participate in the upcoming reviews of the new gTLD program and the UDRP: “It’s important to have data—how did you participate? How much did you spend?”

Meet the Intellectual Property Constituency at 10:30 am and the Brand Registry Group at 1:00 pm on Wednesday May 14 in Room N101A.

Members of the Brand Registry Group will lead you through all of the changes of the past year and all of the changes which are ahead for .brand applicants and for potential Round 2 .brand applicants in a unique session tomorrow.

In an earlier session, the ICANN Intellectual Property Constituency will hold an open meeting to discuss trademark and copyright issues as they pertain to ICANN’s coordination of the Domain Name System.
Digital Asia: is your brand Internet-ready? | 数字亚洲：你的品牌做好互联网准备了吗？

The first phase of the Internet revolution created a wealth of both opportunities and challenges for brand owners and legal practitioners. How will the continuing development of the digital economy shape the landscape in Asia and what do companies need to do to protect and develop their brands? Peter Leung reports.

Speakers on today’s panel “IP Issues in the Digital Era: Impact of the Digital Revolution” will discuss what the continued growth and development of the Internet will mean for brand owners, especially those looking to expand their presence in Asia. According to moderator Chandir Lall of Lall & Sethi Advocates in New Delhi, many of the effects of digitization won’t necessarily be felt just within the confines of trademark law, but in how brand owners will structure their businesses in growing markets like India and China.

History will not repeat itself
While the World Wide Web gained mainstream acceptance in countries such as the U.S. and UK in the 1990s, the shift came a bit later in Asia. Because of this, Lall points out that the development patterns here will not be a rehash of what happened in Europe or North America.

For example, Lall explains that the story of Internet retailers and marketplaces like Amazon and eBay in the U.S. has been one of shift and disruption, namely away from that of big-box stores. While large physical-space oriented retailers like Wal-Mart are still prominent in the U.S., online competitors have forced them to adapt, usually by increasing their own online presence. However, the development patterns in a country like India will be different. “Countries like India don’t have existing big brick and mortar chains and the associated infrastructure, like Wal-Mart in the United States,” he says. “It’s jumping straight to Internet shopping.”

The form of Internet access will be much different as well. Though countries like China and India are still considered by some to be “developing,” Internet use has been increasing rapidly. Moreover, many of these new users are going online through mobile devices such as smartphones, bypassing the personal computers that U.S. consumers used in the ‘90s. Similarly, the more developed markets in the region, like South Korea and Hong Kong, have some of the most advanced and affordable mobile internet access networks in the world.

This too will have a big effect on how retail grows in these markets and the innovations that develop. Lall points to South Korea as an example, where subway riders can shop for groceries from kiosks with QR codes for various products. After scanning the codes with their phones, shoppers can arrange for delivery to their homes.

This new and developing business reality will have a considerable effect on how companies protect and promote their brands. While it is a given that laws are often playing catch up to developments in business, this is especially true when businesses themselves are trying to adapt to changes driven by the Internet.

Traditionally, anticounterfeiting work involved tracking down and gathering evidence against counterfeiters in the physical space. Counterfeiters often peddled their wares in marketplaces and bazaars, such as Beijing’s Silk Market, and...
Today’s discussions on “Digital Era” will focus on intellectual property issues, including the challenges of cross-border enforcement. Professionals will explore how to effectively trace and intercept counterfeit goods, especially online, where the traditional methods may not be as effective. The panel will examine the evolving landscape of digital commerce and the implications for brand protection.

Panelists will discuss the impact of digital technologies on business models and the importance of adapting to the changing digital environment. They will explore the role of traditional enforcement methods versus emerging digital tools and techniques.

The session will also address the unique challenges of brand protection in the digital era, including the need for cross-border cooperation and the importance of early detection and response strategies. The panel will consider the implications of emerging technologies, such as artificial intelligence and blockchain, in combating counterfeit products.

The discussion will conclude with a summary of key takeaways and recommendations for businesses and enforcement agencies to navigate the complexities of the digital age.
Work with authorities in China

IP owners who want the Chinese authorities to prosecute counterfeiters under the criminal law face a number of challenges. Panelists at a session today will explain ways of overcoming them, says Emma Barraclough.

When it comes to fighting counterfeiters, trademark owners want the criminal law—and the police—on their side. Finding the makers of fakes is arduous, often dangerous work, and without the threat of time in jail there may be little incentive for counterfeiters to stop what can be a very lucrative trade.

There are few places where trademark owners have been more keen to see robust criminal measures in force to support their fight against knock-offs than China. But many brand owners have long complained that Chinese law makes it hard for the police and prosecutors to investigate and prosecute suspected IP infringers.

Panelists at a session today on criminal enforcement will explain how China’s criminal law can be used against infringers and what recent changes to the country’s trademark law mean for IP owners. The session will be moderated by Yunze Lian of Hylands Law Firm. Lan Li of Baker & McKenzie will discuss China’s rules on thresholds and explain how IP owners can initiate criminal proceedings, and two in-house counsel, Steven Wang of Philips Intellectual Property & Standards and Edward Haijiang Yang of Nokia, will outline some trends in the way that IP crimes are handled and explain what recent court rulings tell us about judicial thinking on criminal enforcement.

Thresholds
The issue of minimum thresholds for criminalizing trademark infringement has long frustrated IP owners in China. Chinese officials have argued that these thresholds are justified given that China has a multi-pronged approach to enforcement of its IP laws: the police and public prosecutors tackle serious counterfeiting, while agencies such as the Administration for Industry and

Enforcement agencies are becoming increasingly willing to accept evidence that the value of the case or the illegal turnover meets the thresholds for a criminal prosecution.
Criminal action

IN THE DAILY NEWS

Tu esday, May 13 2014

COMMERCIAL AND THE QUALITY AND TECHNICAL SUPERVISION BUREAU DEAL WITH SMALLER-SCALE INFRINGEMENTS. TRADEMARK OWNERS, HOWEVER, ARGUE THAT ONLY THE JAIL SENTENCES HANDED DOWN BY JUDGES WILL DETER COMMITTED COUNTERFEITERS.

THE FORMULA FOR CALCULATING THE THRESHOLDS FOR CRIMINALIZATION TAKES IN A NUMBER OF VARIABLES. FOR TRADEMARK COUNTERFEITING, THE BASIC THRESHOLD IS RMB50,000 (USD8,000). THIS FALLS TO RMB30,000 (USD4,800) IF TWO OR MORE TRADEMARKS ARE BEING COUNTERFEITED BY THE SAME PRODUCER. THE THRESHOLDS CAN ALSO TAKE INTO ACCOUNT THE AMOUNT OF MONEY MADE BY THE INFRINGER. ALTHOUGH THESE THRESHOLDS ARE OFTEN LOWER, IP OWNERS GENERALLY STRUGGLE TO PROVE HOW MUCH PROFIT THE INFRINGER HAS MADE FROM MAKING FAKES.

THE THRESHOLD TO BRING A CRIMINAL CASE BASED ON UNSOLD GOODS IS RMB150,000 (USD22,800). A JUDICIAL INTERPRETATION ISSUED BY THE SUPREME PEOPLE’S COURT, SUPREME PEOPLE’S PROCURATORATE AND MINISTRY OF PUBLIC SECURITY IN 2011 CLARIFIED THAT EVEN IF A LABEL HAS NOT YET BEEN FIXED TO UNSOLD GOODS, THOSE GOODS CAN STILL BE TAKEN INTO ACCOUNT FOR THE PURPOSES OF CALCULATING THRESHOLDS.

THE 2011 INTERPRETATION ALSO MAKES IT CLEAR THAT REVENUES AND PROFITS GENERATED FROM SEPARATE IP INFRINGEMENTS IN THE PAST TWO YEARS CAN BE ADDED TOGETHER TO MEET THE THRESHOLDS FOR AN IP CRIME AS LONG AS THE INFRINGER HAS NOT ALREADY FACED ADMINISTRATIVE OR CRIMINAL PUNISHMENT.

BUT LI LAN OF BAKER & MCKENZIE SAYS THAT WHILE THIS INTERPRETATION OF THE LAW REPRESENTS A “SUBSTANTIAL STEP FORWARD” IN REMOVING SOME OF THE CONSTRAINTS ON PROSECUTING IP-RELATED CRIMES IN CHINA, THE CURRENT THRESHOLDS “STILL FUNCTION AS A SEVERE BARRIER TO INVOLVEMENT OF CHINESE POLICE IN THE INVESTIGATION OF IP CRIMES.”

REASONS TO BE CHEERFUL

ALTHOUGH IP OWNERS WHO WANT TO USE CHINA’S CRIMINAL LAW AGAINST TRADEMARK INFRINGERS CERTAINLY FACE CHALLENGES, THERE ARE PLENTY OF POSITIVE DEVELOPMENTS FOR IP OWNERS. EDWARD YANG OF NOKIA WILL EXPLAIN TODAY HOW ENFORCEMENT OFFICIALS WITHIN CHINA ARE GETTING BETTER AT COOPERATING WITH COLLEAGUES IN OTHER AGENCIES AND WITH THOSE BASED IN OTHER REGIONS OF CHINA. HE WILL ALSO PRAISE OFFICIALS FOR BEING INCREASINGLY LIKELY TO LOOK AT THE BIGGER PICTURE DURING ANTI-COUNTERFEITING WORK, CONSIDERING HOW THE ENTIRE SUPPLY CHAIN WORKS RATHER THAN FOCUSING ON JUST ONE POINT ALONG THE CHAIN.

YANG ALSO SAYS THAT THERE HAVE BEEN MORE SUCCESSFUL CASES CRIMINALIZING THE COUNTERFEITING OF COMPONENTS IN RECENT YEARS. THIS HAS BEEN A LEGAL GRAY AREA THAT HAS LONG FRUSTRATED BRAND OWNERS. CHINESE LAW HAD TRADITIONALLY BEEN INTERPRETED AS SAYING THAT COUNTERFEITING COULD ONLY BE A CRIMINAL OFFENSE IF THE GOODS WERE COMPLETED PRODUCTS. YANG WILL EXPLAIN HOW A SERIES OF DECISIONS IN 2012 INVOLVING NOKIA-BRANDED GOODS HAS HELPED RESHAPE INTERPRETATIONS OF THE LAW IN TRADEMARK OWNERS’ FAVOR.

ANOTHER TREND WHICH SHOULD MAKE LIFE EASIER FOR TRADEMARK OWNERS WHOSE MARKS HAVE BEEN INFRINGED IN CHINA IS THAT ENFORCEMENT AGENCIES ARE BECOMING INCREASINGLY WILLING TO ACCEPT EVIDENCE THAT THE VALUE OF THE CASE OR THE ILLEGAL TURNOVER MEETS THE THRESHOLDS FOR A CRIMINAL PROSECUTION. CHINA IS OFTEN REGARDED AS HAVING VERY TOUGHER RULES ON EVIDENCE—EVIDENCE CAN BE DIFFICULT TO OBTAIN AND THE FORMAL REQUIREMENTS FOR SUBMITTING IT TO THE COURTS OFTEN POSE PROBLEMS, PARTICULARLY FOR FOREIGN IP OWNERS UNFAMILIAR WITH CHINESE JUDICIAL RULES. BUT YANG WILL EXPLAIN HOW THE AUTHORITIES ARE INCREASINGLY LIKELY TO ACCEPT EVIDENCE THAT INFRINGEMENT SATISFIES THE THRESHOLD REQUIREMENTS BY ADMITTING RECORDS OF BANK TRANSACTIONS AND LISTS OF PRIOR SALES, CORROBORATED BY STATEMENTS FROM THE PARTIES INVOLVED.

CTO2 – CRIMINAL ACTION AGAINST COUNTERFEITERS IN CHINA: 10:15 am to 11:30 am today

Hong Kong highlights

CHEUNG CHAU ISLAND

A SHORT FERRY RIDE FROM CENTRAL TAKES YOU TO CHEUNG CHAU ISLAND, WHICH CAN FEEL WORLDS AWAY FROM THE HUSTLE AND BUSTLE OF HONG KONG. CHEUNG CHAU IS A POPULAR DESTINATION FOR HIKING AND SEAFOOD, AND IN FACT MANY OF ITS RESIDENTS MAKE A LIVING AS FISHERMEN. CHEUNG CHAI IS ALSO KNOWN FOR PAK TAIP TEMPLE, ONE OF THE OLDEST TEMPLES IN HONG KONG. PICTURE © ROMAIN CLERCQ-ROQUES

AVENUE OF THE STARS

HONG KONG IS RIGHTLY KNOWN FOR ITS SKYSCRAPERS. WHILE MOST VISITORS HAVE A CHANCE TO LOOK OVER THE HARBOUR TO THE KOWLOON SKYLINE, MANY DO NOT TAKE THE TIME TO CROSS OVER FOR A VIEW OF HONG KONG ISLAND AND ITS ICONIC BUILDINGS. THE AVENUE OF THE STARS IN Tsim Tsa Tsui, JUST A SHORT SUBWAY RIDE UNDER THE WATER, IS AN IDEAL SPOT FOR THIS. THE AVENUE OF THE STARS ALSO SERVES AS A TRIBUTE TO HONG KONG CINEMA, AND IS A MUST SEE FOR FILM BUFFS. PICTURE © ADTEASDALE @Flickr

Your reliable partners for intellectual property matters in Pakistan, South East Asia, Arabian Gulf, Middle East & Africa

UNITED TRADEMARK & PATENT SERVICES

International Intellectual Property Attorneys

Trademark, Patent, Design, Copyright, Domain name registration, litigation & enforcement services

Head Office: (New Postal & Visiting Address)
85 - The Mall Road, Lahore 54000 Pakistan (Opposite Ferozesons books store / adjacent radio time center)
TEL: +92-42-36285588-90, +92-42-36285581-84
FAX: +92-42-36285585, 36285586, 36285587
Email: UnitedTrademark@UnitedTm.com
Websites: www.utmps.com and www.unitedip.com

DUBAI (UAE) Sykes 41-402, Al-Hafez Tower Sheikh Zayed Road, Dubai Tel: +971-4-3437-544 Fax: +971-4-3437-546 Email: Dubai@UnitedTm.com
JORDAN (Amman) Suite 7, 2nd Floor 6th Floor, Suite Al-Ghazal Blvd., Chicago Building, Al-Abbadi, Tabariri, Bekaa, Lebanon Tel: +961-5-683098 Fax: +961-2-683098 Email: Jordan@UnitedTm.com
LEBANON 59, Rue Ibn Battuta, PFT, No. 4, 1st Floor, Etage Casablanca, Morocco Tel: +212-977-3009 Fax: +212-977-3009 Email: Lebanon@UnitedTm.com
SAUDI ARABIA Suite 203, Al Burj Al Maktoum 30th Street, Citysia, Riyadh 11444 Tel: +966-55-461517, 4655477 Fax: +966-55-461516 Email: SaudiArabia@UnitedTm.com
SHARJAH (UAE) Suite 703, Al Rahba Building Sharjah Corniche, Sharjah Tel: +971-6-572742 Fax: +971-6-572743 Email: UAE@UnitedTm.com
SUDAN (Khartoum) Hart No. 1, 3rd Floor, Al Hantya St., Saudi Arabia, Brothers Blvd. Tel: +212-67-450344 Fax: +212-67-450325 Email: sudan@UnitedTm.com
TANZANIA Shaur Moyo Area, Dar-Es-Salaam Dar-Es-Salaam Tel: +255-22265290 Email: Tanzania@UnitedTm.com
OMAN Satwa Suite 702, 7th Floor Oman Commercial Centre, Road Tel: +968-24-78555, 704788 Fax: +968-24-79447 Email: Oman@UnitedTm.com
YEMEN 6th Floor Ideal Clinic Building Hadh Ermel, Sana’a, Yemen. Tel: +968-931-962 Email: yemen@UnitedTm.com

INTRA Daily News Tuesday, May 13 2014
www.managingip.com
What does your work cover and how big is your team?
I have a small team here in China and we work closely with, and as part of, a larger team of lawyers who deal with trademark matters on a global basis. We are a great team. I am responsible for the Greater China region. I oversee all IP matters throughout the region except for invention patents and utility model patents. This includes trademarks, copyrights and designs. My team in Shanghai is responsible for all aspects, including advice, filings, enforcement (both administrative and criminal), litigations, cross-border protection and dealing with online infringement.

About 80% of my work concerns trademark-related matters and we are seeing an increasing number of matters related to design patents. We have some copyright work as well, which we view as a supplementary form of IP protection backing up our registered trademarks and designs.

What are the main brands you have?
Jaguar Land Rover is the UK’s largest automotive manufacturing business, built around two iconic British car brands: LAND ROVER, the world’s leading manufacturer of premium all-wheel drive vehicles and JAGUAR, one of the world’s premier luxury sports saloon and sports car marks. Under each brand, we also have several key marks. For Jaguar, we have the JAGUAR word mark. We also have the Leaper device and the Growler device, which are very important for the brand. For Land Rover, the LAND ROVER word mark, the LAND ROVER with oval logo and RANGE ROVER are our key marks. We have several other marks that are also important such as the model names, including EVOQUE, DISCOVERY, FREE-LANDER and DEFENDER, XJ, XK, XF and F-TYPE.

What sorts of counterfeiting challenges do you face?
As mentioned above, the manufacturing of counterfeit goods, such as counterfeit parts and accessories, is a common problem for producers of high quality items. Preventing sales of those counterfeit items can also be challenging at times, particularly with the advent of the Internet which provides an accessible global platform for onward sale and export.

Has the brand protection environment improved in China? Does the new Trademark Law help?
China is definitely improving in terms of both the legal framework and the quality of enforcement and I am happy to see this. One of the most significant improvements in deterrence is the increase of the maximum statutory damages, from RMB 500,000 to RMB 3 million (USD80,000 to USD480,000), I anticipate that there will be further increased levels of enforcement and deterrence against infringers in the future as well.

I also think that the provisions on well-known trademarks are good. For example, historically there were inconsistent views about the function of well-known trademarks. Local companies tended to use the well-known trademark in their own business advertising. This resulted in some marks being given well-known status even though the marks were not well known at all. The competent authorities became reluctant to grant recognitions as a result.

The new law addressed this situation by prohibiting the use of well-known trademark status for advertising, enabling truly well-known marks to be granted well-known status and enjoy their corresponding protections.

What qualities do you look for in outside counsel?
I look for two things: commercially focused, high-quality advice and proactive, helpful service and client care.

Helen Xu of Jaguar Land Rover shares her thoughts about brand protection in China, and how the Trademark Law will help prestigious brands protect their rights.
How to fight online infringement in China

Kai Yang, Peng Zheng, and Wen Zhong of Liu, Shen & Associates discuss how to combat online infringement in China and why brand owners need to take the fight to counterfeiters in the physical realm.

What legal provisions are there for rights holders to stop counterfeiters online? Does the new Trademark Law or implementing regulations have made it easier for rights holders to protect their brands online?

Kai Yang: There are no specific provisions that apply to internet trademark infringement in China’s Trademark Law, but there is also nothing stopping rights holders from relying on the general provisions regarding trademark infringement and legal remedies to stop internet infringement. For example, rights holders can file a civil litigation action with the courts, or file an administrative complaint with the local Administration of Industry and Commerce (AIC).

Furthermore, China’s Tort Liability Law also covers internet infringement and remedies, including internet trademark infringement, which can be handled by either party. According to Article 36 of the Tort Liability Law, there are two main forms of internet infringement: direct infringement by the internet user or internet service provider (ISP), or the ISP’s tort liability for another party’s direct infringement.

The first form, direct infringement, is not much different from common trademark infringement. The second form applies when an internet user is infringing upon another party’s trademark right via the ISP’s service. The right holder has the right to require the ISP to take necessary measures to stop the infringement. If the internet service provider refuses to do so, it will also be subjected to joint and several tort liability along with the direct infringer.

Wen Zhong: There are several provisions concerning domain name infringement in the relevant trademark regulations and judicial interpretations. The Interpretation of the Supreme People’s Court Concerning the Application of Laws in the Trial of Cases of Civil Disputes Arising from Trademarks provides that the registration of the same or similar words of another party’s trademark as the domain name and using such domain name for the trade of relevant goods or services shall be recognized as trademark infringement.

Meanwhile, the Interpretation of the Supreme People’s Court on Application of Laws in the Trial of Civil Disputes over Domain Names of Computer Network specifies that if the registrant of the domain name has the bad faith to register the domain name which or the main part thereof constitutes the imitation or copy of another party’s well-known mark, or is the same or similar to the other party’s trademark which is likely to cause confusion among the relevant public, such action will be recognized as trademark infringement, and the trademark holder can file a civil case with the court against the domain name registrant.

Peng Zheng: The new Trademark Law did not have a specific provision on internet trademark infringement; however the new Implementing Regulations to the Trademark Law promulgated on April 30, 2014 gives the related provision on the internet trademark infringement: “Article 75. To provide any other person with storage, transportation, postal service, concealment, business place or online trading platform in his infringement of the exclusive trademark right, belongs to the acts of ‘providing facilities’ in Article 56(6) of the Trademark Law”, and therefore shall constitute the trademark infringement.

What should an effective anti-online counterfeiting program look like?

Kai Yang: For an effective anti-online counterfeiting program, the right holder needs to gather information about the online infringer. In some circumstances, an investigation may be needed. Once a right holder has found and saved evidence of the infringement, it may attempt to take down the infringing site by sending an infringement notice to the internet service providers first, together with the trademark registration certificate, identity certificate of the claimant, the infringers’ web addresses where the counterfeits are being sold, basic information about the counterfeiter and grounds to prove that the sold products are counterfeits. Furthermore, it is better to do a notification of the webpage where counterfeits are sold in advance. Notice may be given by mail, email, fax, or on the specific webpage. Rights holders should keep in communication with the ISP. Once the ISP receives the notice, it will then review the complaint, contact the suspected infringer about the matter, and make comments or decisions on the matter. The ISP may or may not take actions to stop the accused of infringement based on their own judgment on the matter.

Should an anti-online counterfeiting action try to trace the counterfeiter to their physical suppliers and warehouses? If so, what is the best way of doing that?

Kai Yang: When preparing for an anti-online counterfeit action, it is always advisable to be prepared to trace the counterfeiters to the physical suppliers and warehouses, because this is the most effective way to prevent the infringing acts. If the right holder cannot fix the physical location of the counterfeiters, the infringers can simply establish a new online store to continue to sell the fake goods even if the old online store is closed.

Wen Zhong: To trace the goods back to the counterfeit suppliers, the right holders may, by itself or via a third party or a professional investigator, contact the counterfeiter online first, using a hidden identity, to trace the logistics, suppliers, warehouses, and suppliers step by step. Peng Zheng: During the process, fixing the infringing evidence is the most important. There are many ways of fixing the evidence, such as having evidence of the online trade notarized, including evidence of payments and purchases, as well as any receipts.

There are other methods as well. For example, the investigator can also offer to place a big order, in order to arrange meetings with the suppliers and request to visit the factory and warehouse of the counterfeiter.

Do big online markets such as Taobao have anti-counterfeiting programs? If so, how do they work and how can brand owners take advantage of them?

Kai Yang: Yes, many big online markets in China such as Taobao have anti-counterfeiting systems. For example, if the right holder finds that there are counterfeits on Taobao, the rights holder can send the infringement notice to Taobao, together with the trademark registration certificate, identity certificate of the complainant, the infringers’ web addresses, basic information about the counterfeiter and written grounds to prove that the sold products are counterfeits.

Taobao will then review and check the infringement notice, notifying the accused infringer of the complaint for a response, and if Taobao believes the complaint is justifiable, it will remove the specific counterfeiting URLs. In some instances, for example if a particular online store on Taobao sells a large number of counterfeits, or if it is found to be committing other severe acts of trademark infringement, Taobao may find that this online store has violated the site’s terms and conditions, and will impose punishment, such as limiting or even closing the business of the online store.

Wen Zhong: The trademark owner is advised to maintain a close relationship with big online markets such as Taobao, via its own IP team or trusted IP lawyers who are expected to have expertise on handling trademark infringement matters. This is because online infringement varies a lot and often takes on new patterns. Some of the infringers are walking subtly in the grey area, which from time to time brings the ISP difficulties in determining whether certain online activities constitute trademark infringement. Quite often, the accused infringers will respond to a complaint,
coming back with arguments and excuses which make it difficult for the ISP to make a determination.

Peng Zheng: Furthermore, the costs in taking online anti-counterfeit action is comparatively very low, so we highly recommend that trademark owners keep a close watch on the internet to find online counterfeit sales. Whenever counterfeiters are found, the trademark owner should take immediate action. If more such action is taken, the internet service provider will pay more attention to infringement notices.

Can brand owners take advantage of criminal provisions to stop online counterfeiters? If so, what do brand owners need to do to make an anti-counterfeiting case a criminal case?

Kai Yang: Articles 213 and 214 of the Criminal Law contain provisions concerning crimes relating to trademark infringement. For those who use the identical trademark without the trademark owner’s permission, if the circumstances are serious, they shall be sentenced to a fixed-term imprisonment of not more than three years or criminal detention or be fined or both. If the circumstances are very serious, they shall be sentenced to a fixed-term imprisonment of no less than three years but not more than seven years and shall also be fined. For those who knowingly sell counterfeit goods, if the amount of sales is relatively large, the infringer shall be sentenced to a fixed-term imprisonment of not more than three years or criminal detention or be fined or both. If the circumstances are very serious, they shall be sentenced to a fixed-term imprisonment of no less than three years but not more than seven years and shall also be fined. According to the related judicial interpretations, the starting point to prosecute the criminal trademark infringement cases is where the trademark owner’s registration is valued at RMB 50,000 ($8,000).

What tips do you have for working with the government, such as law enforcement and administrative agencies in fighting online counterfeiting?

Kai Yang: Generally speaking, the administrative handling of online counterfeiting cases is similar to that in normal counterfeiting cases. Like a criminal complaint, it is necessary to know the counterfeiter’s true name and address to file the administrative complaint, and then file the trademark infringement complaint with the local AIC that has the territorial jurisdiction over the counterfeiter.

Wen Zhong: The document submitted to the AIC normally should contain the following: trademark registration certificate, notarized identity certificate of the trademark owner or its exclusive licensee, basic facts of the infringement, the name and address of the counterfeiter, and a written statement if any to establish that the products being sold are counterfeit and if possible samples of the genuine and counterfeit products. If the trademark owner hires an agent to file the administrative complaint, a notarized power of attorney is also needed.

Peng Zheng: Know as much as possible about the infringer via investigation first. Fixation of evidence through a notary public is recommended if the situation allows. Also, contact the authority on document and establish any needed power of attorney before the action and quickly move to file the action with the authority so as to ensure a higher likelihood of seizing the infringing products on the spot. Furthermore, brand owners should prepare in advance if appraisal on trademark infringement is required, and urge the authority to take the action as quickly as possible by persuading the officials that the case is urgent or for certain reason you could not afford waiting long. Finally, it is important to always keep a positive attitude towards the officials even if the result is not to your expectation and believe that the officials are on your side.

For unfair competition cases, Mr. Yang has handled cases on behalf Danfoss, LEGO, Budweiser, BASF, etc., including false advertisement cases (Danfoss v. Shandong Danfoss), conflict of trade name right and trademark right cases (BASF v. Tianjin BASF), protection of the peculiar package and decoration of well-known products cases (LEGO v. Concord, Budweiser v. Helbei Lanbao, Chivas v. Yantai Chivas) and trade secret cases (Fiber Optic Design v. Chihua).

Up to 2014, he has handled more than 300 trademark opposition and invalidation cases, over 30 trademark infringement cases, about 10 copyright infringement cases, over 15 unfair competition cases, jointly handled several patent infringement cases, etc. The companies he has ever represented are BBC Broadcasting, Adobe, Lego, Elle, Hugo Boss, Paws Incorporate, Fine Art, BASF Chemicals, Schneider Electric, Danfoss, Panasonic, Hitachi, Daikin, DC Shoes Inc., Toyo Tire, Japanese Tobacco, JFE Steel Corporation, Realnetworks, as well as ABB.
<table>
<thead>
<tr>
<th>Time</th>
<th>Event</th>
<th>Location</th>
</tr>
</thead>
<tbody>
<tr>
<td>10:00 am - 4:00 pm</td>
<td><strong>REGISTRATION</strong></td>
<td>Mezzanine &amp; Convention Hall Foyer</td>
</tr>
<tr>
<td>7:30 am – 5:00 pm</td>
<td><strong>HOSPITALITY</strong></td>
<td>Hall 3FG</td>
</tr>
<tr>
<td>7:30 am – 5:00 pm</td>
<td><strong>INFORMATION BOOTH</strong></td>
<td>Mezzanine</td>
</tr>
<tr>
<td>8:00 am – 4:00 pm</td>
<td><strong>BREAKFAST TABLE TOPICS</strong></td>
<td>N201</td>
</tr>
<tr>
<td>8:00 am – 10:00 am</td>
<td><strong>COMMITTEE MEETINGS</strong></td>
<td>N101-N102, N103</td>
</tr>
<tr>
<td>8:30 am – 10:30 am</td>
<td><strong>ROUNDHOUSE BREAKFAST</strong></td>
<td>N104</td>
</tr>
<tr>
<td>10:15 am – 11:30 am</td>
<td><strong>CONCURRENCE SESSIONS</strong></td>
<td>Convention Hall A</td>
</tr>
<tr>
<td>11:15 am – 3:15 pm</td>
<td><strong>SPEAKER BIBLIOGRAPHY</strong></td>
<td>Grand Hall</td>
</tr>
<tr>
<td>12:00 pm – 1:00 pm</td>
<td><strong>LUNCH BEIGNET TABLE TOPICS</strong></td>
<td>Convention Hall BC</td>
</tr>
<tr>
<td>1:00 pm – 4:00 pm</td>
<td><strong>COMMITTEE MEETINGS</strong></td>
<td>Hall 3FG</td>
</tr>
<tr>
<td>1:30 pm – 3:15 pm</td>
<td><strong>CONCURRENCE SESSIONS</strong></td>
<td>Convention Hall Foyer</td>
</tr>
<tr>
<td>2:00 pm – 3:00 pm</td>
<td><strong>JOINER MEETING</strong></td>
<td>Theatre 1</td>
</tr>
<tr>
<td>3:00 pm – 4:00 pm</td>
<td><strong>SPEAKER BIBLIOGRAPHY</strong></td>
<td>Convention Hall A</td>
</tr>
<tr>
<td>4:00 pm – 5:45 pm</td>
<td><strong>COMMITTEE MEETINGS</strong></td>
<td>Hall 3FG</td>
</tr>
<tr>
<td>5:00 pm – 6:00 pm</td>
<td><strong>HOSPITALITY</strong></td>
<td>Mezzanine</td>
</tr>
<tr>
<td>5:00 pm – 6:00 pm</td>
<td><strong>BRIDGEHEAD TABLE TOPICS</strong></td>
<td>N201</td>
</tr>
<tr>
<td>5:15 pm – 6:00 pm</td>
<td><strong>COMMITTEE MEETINGS</strong></td>
<td>N101-N102</td>
</tr>
<tr>
<td>5:30 pm – 6:20 pm</td>
<td><strong>INFORMATION TELEPHONE</strong></td>
<td>Convention Hall B</td>
</tr>
<tr>
<td>6:00 pm – 7:00 pm</td>
<td><strong>GOVERNMENT OFFICIALS RECEPTION</strong></td>
<td>N205</td>
</tr>
</tbody>
</table>

Today’s Schedule | Tuesday, May 13, 2014

All events take place at the Hong Kong Convention and Exhibition Centre (HKCEC) unless otherwise indicated. Consult the Final Program for times and locations of invitation-only events.