

Monthly Newsletter

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Spring Chang and Michael Wu Honored as IP Stars for Consecutive Years



We are thrilled to announce that **Founding Partner Spring Chang** and **Partner Michael Wu** have once again been honored as **IP Star: Trademark** and **IP Star: Patent**, respectively. Recognized as a leading global IP ranking platform, IP STARS helps businesses and individuals find experienced legal practitioners in the intellectual property field.

In their latest rankings, IP STARS highlighted the outstanding achievements of Spring Chang and Michael Wu, alongside five other Chang Tsi lawyers named as **"Notable Practitioners"**. This recognition underscores Chang Tsi's deep expertise and exceptional performance in intellectual property law.

NOTABLE PRACTITIONER

At Chang Tsi, we pride ourselves on our successful track record and a highly skilled team of lawyers, IP agents, and technical experts. Our commitment to excellence and client service is the cornerstone of our approach, ensuring the best legal outcomes for our clients. We remain dedicated to our mission: "To be the best law firm in China, offering outstanding legal services to maximize our clients' rights". We look forward to continuing to provide top-tier, personalized legal solutions for our clients.

Celebrating Achievements in IAM Patent 1000: The World's Leading Patent Professionals 2024

We are thrilled to announce that Chang Tsi & Partners has once again been recognized in the IAM Patent 1000: The World's Leading Patent Professionals 2024. This prestigious ranking has honored our firm with the Silver award for China: Domestic, reflecting our commitment to excellence in patent practice. Partners Michael Wu has been recommended in Prosecution and Enforcement and David Liu in Prosecution.

IAM Research comments:

'Since its establishment in 2002, Chang Tsi & Partners has built a thriving practice that navigates the vicissitudes of the Chinese IP scene. "Their commitment to excellence, attention to detail and comprehensive understanding of the legal landscape make them a standout choice." The twin pillars of its patent practice are David Liu and Michael Wu. A New York attorney and Chinese patent agent, Liu frequently represents multinational clients in patent and trade secret litigations before the IP courts, CNIPA and Patent Reexamination Board in China, and the US Patent and Trademark Office and Patent Trial and Appeal Board in the United States. Polished litigator Wu is a technical renaissance man who has brought home the wins in conflicts related to mobile telecoms and software.'

We extend our heartfelt gratitude to our clients and colleagues for their continued support and trust. We look forward to maintaining our standard of excellence and furthering our contributions to the field of intellectual property.



Founding Partner Spring Chang Recognized as Word Leader by WTR

Chang Tsi's Founding Partner Spring Chang Recognized as 2024 Word Leader by WTR. WTR Comments, 'Founding partner Spring Chang is widely recognised as a top trademark lawyer in China. Chang takes on prosecution and anti-counterfeiting matters while spearheading the market-leading brand protection practice with the greatest possible delicacy and precision'.

Exciting Expansion : Patent Experts Align with Chang Tsi & Partners

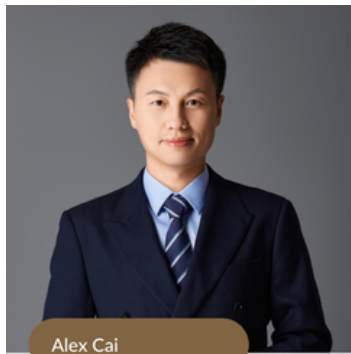
We are pleased to announce significant enhancements to our patent department. **Mr. Philip Qin** and **Mr. Alex Cai** have joined Chang Tsi & Partners as partner and of counsel respectively.

Mr. Philip Qin brings to our firm a wealth of experience in legal and intellectual property affairs, having previously served as Vice President and General Counsel at Alibaba Cloud Computing Group and as Director of Legal Affairs and Intellectual Property at Baidu Group respectively. In addition to leading our Patent Department, Mr. Qin also holds the role of Chief Operating Officer, overseeing the firm's management as entrusted by our Management Board.

Mr. Alex Cai joins us from a distinguished background as a patent examiner at the China National Intellectual Property Administration for 4 years, and in-house counsel at leading tech companies, including Didi, LeEco, and Alibaba Local Services. With his professional expertise and corporate IP management experience, Alex will succeed David Liu in leading our patent department to deliver excellent services and will be your primary point of contact for all future correspondence.



Philip Qin



Alex Cai

Please feel free to contact Philip and Alex at their respective email addresses for any inquiries or assistance you may require:

- **Alex:** AlexCai@changtsi.com

- **Philip:** PhilipQin@changtsi.com

Update on the International Classification of Goods and Services for Trademark Registration in Taiwan

Miffy Yen and Daisy Qin

The International (Nice) Classification of Goods and Services for the purposes of the registration of marks in Taiwan will undergo significant updates in its 12th edition, 2024. According to the latest revision, a total of 114 items will be added or amended, 49 items will be deleted, and 35 category/subcategory names or notes will be modified or removed (see the attached table for details).

These changes will take effect from July 1, 2024. The electronic trademark application system in Taiwan will be updated accordingly to reflect the new specifications for goods/services designated for use in trademark applications. Please note that the official schedule for system updates will be announced by TIPO.

Applicants wishing to utilize the "Fast Track" mechanism in Taiwan after July 1, 2024, are advised to download the latest changes to ensure that the goods/services listed in their applications match those in the updated electronic application system. This alignment is necessary to meet the "Fast Track" criteria and to enjoy the fee reduction benefits. From June 19, the updated version of the "Designated Goods/Services Names for Trademark Application Registration" document for all categories can be downloaded under "3. Goods and Services Name Classification Search" in the trademark search system in Taiwan.

(https://cloud.tipo.gov.tw/S282/OS0/OS0303.jsp?l6=zh_TW&isReadBulletinen_US=&isReadBulletinzh_TW=true)

Thank you for your attention to these updates. We are committed to providing you with the most current and relevant information to support your trademark registration needs in Taiwan. Should you have any questions regarding intellectual property rights in Taiwan, please feel free to contact us at taiwan@changtsi.com or MiffyYen@changtsi.com.

Chang Tsi & Partners Bolsters ITW's Fight Against Counterfeit DEVCON through Administrative Complaints, Criminal and Civil Lawsuits

Illinois Tool Works Inc. and its Chinese subsidiary ITW Performance Polymers (Wujiang) Co., Ltd. (collectively "ITW"), place great emphasis on protecting intellectual property rights and spare no effort in combating counterfeit and infringing products to safeguard the market. DEVCON is one of ITW's famous brands for adhesive products.



Tracy Shen, Partner of Chang Tsi & Partners, and her team members Hermione Zhang, Mia Zhou entrusted by ITW, have been providing long-term legal services to protect ITW's IP rights in China. Recently, this legal team closely collaborated with ITW's legal and business team, employing multi-faceted strategies through **administrative, criminal, and civil channels** to address and dismantle the networks involved in counterfeit DEVCON products. The team's efforts, supported by local authorities, have led to significant legal actions against all parties involved in the infringement chain, including the main distributor, Shanghai Songze Trading Co., Ltd., and other downstream participants (Mr. Zhang and his controlled companies, Sichuan Qinyuan Environmental Engineering Technology Co., Ltd., and another Sichuan company). Notably, Shanghai Songze, an old and stubborn infringer, received deserved punishment in this case. This case has significant implications for combating trademark infringement, especially those involving long-term, complex counterfeit chains and stubborn infringers. It also demonstrates ITW's determination to crack down on infringers, purify the market, and protect their intellectual property.

Detailed Case Analysis

In 2020, ITW discovered that a Sichuan company sold a large quantity of suspect counterfeit DEVCON to a local end user. ITW found no sales records of such products to this Sichuan company, and on-site identification confirmed that the DEVCON products were counterfeits. Tracy Shen and her team meticulously crafted a strategic plan, which included notifying the local market supervision bureau and effectively collaborating with them to trace the counterfeit products back to their source at Sichuan Qinyuan, controlled by Mr. Zhang.

The severity of the case met the threshold for criminal prosecution under Article 214 of Chinese Criminal Law, leading to a criminal investigation by the Public Security Bureau (PSB). During the PSB's investigation the stream of the counterfeits were uncovered, and the main facts and the right owners efforts resulted in a conviction by the People's Court of Yilong County, Sichuan Province. The court convicted Mr. Zhang and Sichuan Qinyuan Environmental Engineering Technology Co., Ltd. of selling goods bearing counterfeit registered trademark, sentencing Mr. Zhang to one year in prison, with a suspended sentence of one year and six months, and imposing fines and confiscating illegal gains.

Chang Tsi & Partners' strategic insight prompted ITW to extend legal actions to include upstream suppliers of the counterfeit goods. After reviewing the criminal case files in detail and identifying the upstream suppliers, the firm advised ITW to file a civil lawsuit targeting all infringers in the chain, especially holding Shanghai Songze accountable. In April 2024, the Intermediate People's Court of Leshan City ruled in favor of ITW, ordering the cessation of infringement and awarding RMB 310,000 in damages and reasonable expenses.

Advantages of Design Patent in Comparison with Other Types of IP Rights in China

Nancy Qu

In China, the right owner of the design of a product has several options to protect its IP rights: design patent, copyright, trade dress, etc. Among other IP rights, design patent has obvious advantages to enforce in China: strong right with low level of evidence requirements, and more options to enforce.

I. Conditions and timeline of Design Patent and other IP rights

For design patent, novelty is a must. China adopts absolute novelty for all kinds of patents (invention, utility model, and design patent). The right owner should file design patent application before the specific design of product is open to the public worldwide. Generally, it will take around 5 months to obtain design patent certificate from CNIPA. For some special design patents which needs to accelerate or delay examination, per the application of the applicant, design patents can be granted in around two months (accelerated) or delayed for 36 months the longest. In China, the protection period of design patent is 15 years from the filing date.

For copyright, creativity is a must. China is one of the members of Burnie Convention, Thus, copyright can be automatically protected from the date when the work is finished. However, it is recommended that the right owner files copyright application in time, to smooth the enforcement proceedings such as online complaints, administrative complaints, trademark dispute cases, or civil lawsuit. If the right owner believes its design of product is an applied art, or a fine art, it can file copyright registration before the China Copyright Protection Center (CCPC). Generally, it will take around 2 months to obtain the copyright certification from CCPC. In China, take corporate work for example, the protection term is 50 years for the work of fine art and 25 years for the work of applied art.

For trade dress, there is no way to register this kind of IP right in China. Trade dress is protected under the Anti-unfair Competition Law as “distinctive packaging or decoration of goods with certain influence” (hereinafter referred to as “trade dress”) stipulated by Article 6.1 of the Anti-unfair Competition Law. In order to establish the right of trade dress, the right owner bears a heavy burden ship to collect sufficient evidence proving its long-term use and extensive promotion of the goods with specific trade dress, and the trade dress had obtained high reputation and distinctiveness to indicate source of goods. There is no specific protection period for trade dress. As long as the right owner can prove it enjoys the right of trade dress, this IP right can be enforced.

2. Brief Comparison on Design Patent and other relevant IP rights

IP rights	Protection Term	Strong or Weak right	Evidence requirement for right basis	Actions
Design patent	15 years from the application date	Strong in general	Low level Certificate + patent evaluation report	<ul style="list-style-type: none"> Online takedown request Administrative Complaint C&D letter Civil lawsuit Border protection
Copyright	<p>E.g., For Corporation Work</p> <p>Fine art: 50 years from the completion of the work</p> <p>applied art: 25 years from the completion of the work</p>	Weak in general	<p>Medium level Certificate + publish evidence + high frame evidence</p> <p>Note: In general, the designs of product are not easy to be protected by copyright in China.</p>	<ul style="list-style-type: none"> Online takedown request C&D letter Civil lawsuit Border protection
Trade dress	No time limit	Strong in general	High level uniquely-designed + high fame evidence	<ul style="list-style-type: none"> C&D letter Civil lawsuit

3. Conclusion

In comparison with other IP rights such as copyright and trade dress, design patent has obvious advantages to enforce in China: strong right with low level of evidence requirements to establish right basis, and more options to enforce. It has been proven that the legal cost for enforce a design patent through civil lawsuit is significantly less than enforce the right of a trade dress, and the chance of success of design patent infringement is more predictable than trade dress infringement.