South-East Asia and China IP SME Helpdesks webinar:

«From Europe to China and South-East Asia

Best IP Practices and Market Entry»

Federica De Curtis
China IP SME Helpdesk
January 31, 2024

The South-East Asia and China IP SME Helpdesks in a nutshell

Free of charge, first-line confidential assistance on IP protection, management and enforcement for SMEs from SMP countries (EU, Norway, Iceland, Liechtenstein, Turkey, Ukraine, North Macedonia, Kosovo and Bosnia and Herzegovina)

- working with entities in South-East Asia and China
- established in the target countries
- potentially interested in establishing commercial and R&D activities in these markets

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Geographical scope of the helpdesks

- **South-East Asia**: Vietnam, Thailand, Indonesia, Singapore, the Philippines, Malaysia, Cambodia, Lao, Myanmar, Brunei

- **China**: Mainland China, Macao, Hong Kong, Taiwan

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Snapshot: Helpdesks' Free Services

Enquiry Helpline

Website & Newsletter

Publications

IP Business Tools

IP Helpdesk Website:
https://ec.europa.eu/ip-helpdesk
SEA IP SME Helpdesk Website:
https://intellectual-property-helpdesk.eceuropa.eu/regional-helpdesks/south-east-asia-ip-sme-helpdesk_en
China IP SME Helpdesk Website:
https://intellectual-property-helpdesk.ec.europa.eu/regional-helpdesks/china-ip-sme-helpdesk_en

Training Workshops & Live Webinars

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INTELLECTUAL PROPERTY ADVICE FOR YOUR BUSINESS

Six EU-funded helpdesks offer free resources to your small or medium-sized business to help you manage your intellectual property.

https://ec.europa.eu/ip-helpdesk

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free, fast & confidential

3 days working

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expert@sea-iphelpdesk.eu

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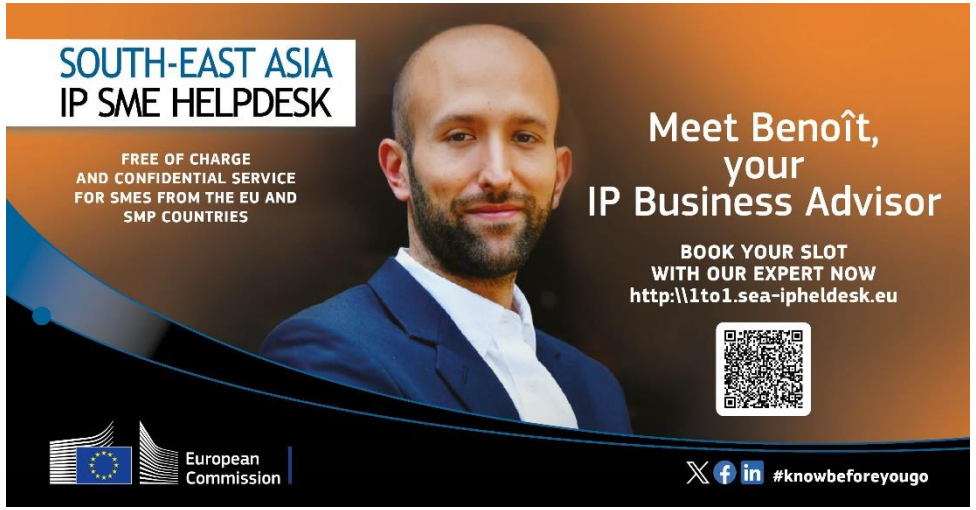
Book a 1:1 consultation!

The SMEs can also request
a free-of-charge 30 minutes 1:1 virtual meeting
with our IP Business Advisors to discuss confidentially how to craft a robust IP strategy in South-East Asia and/or China

South-East Asia: http:\\1to1.sea-iphelpdesk.eu

China: question@china-iprhelpdesk.eu



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Thanks a lot for your attention! We are looking forward to collaborating with you!

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Understanding the importance of IP protection in the South-East Asian market

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31 January 2024

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Introduction

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The Paris Convention / Priority Rights

- Most countries in the world are **signatory parties of the Paris Convention** for the Protection of Industrial Property of 1883.

- On the basis of the Paris Convention, **the owner/applicant applying for the registration of an IP right (filed in one of the Member States of the Paris Convention) may use a priority period of six months (for designs and trademarks) or twelve months (for patents and utility models)** – from the filing date of the application in the Country of Origin – to claim priority date of the first application in the Country of Origin in any other Country that is also member of the Convention, through:

1) filing an international application and designating the country(ies) of interest.

AND/OR

2) filing a national application before the IP Office in the country(ies) of interest.

➔ In this way, the priority date is safeguarded, and it is possible to avoid interferences from third parties.

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How to check your trademark (TM) availability:

- The World Intellectual Property Organization (WIPO) and national/regional IP offices make trademark databases available (for free and without the need to create an account).

- **WIPO's Global Brand Database** is an aggregate search portal; it enables applicants to search for trademarks previously registered under the Madrid system using data from many national IP offices. However, do not forget to check the **online database of national/regional IP offices** as the WIPO's Global Brand Database does not include national trademarks filed directly with some of the contracting parties.

- Other aggregate search portals specific to SEA are **Tmview**, **ASEAN TMview** and the **ASEAN IP Register**

TM availability searches should be performed by IP experts/agents since the results need to be analyzed and, in some countries (such as within SEA), databases are not always up-to-date.

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IP protection in South-East Asia

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Patent in SEA

SOUTH-EAST ASIAN COUNTRY	TYPE	PERIOD OF PROTECTION
Brunei	Patent	20 years from the filing date.
Cambodia	Patent	20 years from the filing date.
	Utility Model	7 years from the filing date.
Indonesia	Patent	20 years from the filing date.
	Simple Patent	10 years from the filing date.
Laos	Patent	20 years from the filing date.
	Petty Patent	10 years from the filing date .
Malaysia	Patent	20 years from the filing date.
	Utility Innovation	10 years from the filing date and extendable for another 2 consecutive 5-year terms.
Myanmar	There is presently no functioning system of patent protection in Myanmar. Myanmar's Patent Bill was passed in 2019 but has not yet been brought into force.	
The Philippines	Patent	20 years from the filing date.
	Utility Model	7 years from the filing date.
Singapore	Patent	20 years from the filing date.
Thailand	Patent of Invention	20 years from the filing date.
	Utility Model/Petty Patent	6 years from the filing date and extendable twice for 2 more years (i.e. maximum of 10 years).
Vietnam	Invention Patent	20 years from the filing date.
	Utility Solution Patent	10 years from the filing date.

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Patent in SEA

- **Myanmar** is not a member of the Paris Convention, nor of the PCT.

- The deadline for entering the national phases of the PCT for Singapore, Cambodia, Brunei, Malaysia, the Philippines, and Thailand is **30 months from the priority date** (first filing). For Singapore, the deadline may be extended by up to 18 months provided the applicant pays the prescribed fee. For the Philippines, the deadline may be extended by 01 month provided the applicant pays the prescribed fee.

- Regarding Laos, Vietnam and Indonesia, the deadline for entering the national phases of the PCT is **31 months from the priority date** (first filing). For Indonesia, the deadline may be extended provided the applicant pays the prescribed fee.

- It is necessary to **appoint a local agent for the national phases of the PCT** in Cambodia, Vietnam, Brunei, Indonesia, Laos, Malaysia, the Philippines, and Thailand. In Singapore, indicating an address for service is sufficient.

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Patent in SEA / Translations and Utility Models

- In Singapore, Brunei, the patent application and its related documents (description, claims, etc.) **must be translated into English**.

- In Malaysia, the Philippines, and Myanmar, either local languages or English **can be used**.

- In other countries, translation into the **local languages** is required: Khmer (for Cambodia), Vietnamese (for Vietnam), Bahasa Indonesia (for Indonesia), Lao (for Laos), and Thai (for Thailand).

- In Cambodia, Indonesia, Laos, Malaysia, the Philippines, Thailand, and Vietnam, the concept of "**simple patents**" exists. These are known as "**Petty Patents**" in Laos, "**Utility Models**" in the Philippines and Cambodia, "**Utility Innovation**" in Malaysia, or "**Utility Solution Patent**" in Vietnam.

- **In some cases, the inventive step is not required** (i.e., in Cambodia, Indonesia, Malaysia, the Philippines, Thailand, and Vietnam); **in other cases, it is required to a lesser extent compared to a "standard patent"** (in Laos).

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Patent in SEA / Duration of the process

- The process to obtain a "simple patent" is generally shorter compared to that of a "standard patent"; however, the duration of protection is also shorter (7 or 10 years depending on the country).

- **In some countries, such as Thailand, it is better to file an application before the local IP office** (instead of using the PCT) as this national procedure allows for faster processing times and more affordable costs.

- **Some SEA Patent Offices (for example, in Cambodia or Indonesia) may expedite patent registration** if the patent has already been granted by other offices in countries with more advanced IP systems (such as the USA, Japan, South Korea, or the EU).

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Acceleration Programmes to speed up patent grant process

1) [International] The Patent Prosecution Highway (PPH)

Between IP Offices where the examination process of a patent application in one IP Office can be accelerated by referencing the examination results from another IP Office.

Allows applicants to obtain faster patent rights at no additional cost.

Brunei	PPH agreement with Japan.
Indonesia	PPH agreement with Japan.
Malaysia	PPH and PCT-PPH[2] agreement with Japan, China, the EPO, and Korea.
Philippines	PPH and PCT-PPH agreement with the US, Korea, the EPO, and Japan.
Singapore	PPH agreement with Brazil, China, Mexico, and the EPO. Also a member of the Global PPH (a plurilateral PPH pilot program covering several types of PPH).
Thailand	PPH agreement with Japan.
Vietnam	PPH agreement with Japan and Korea.

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Acceleration Programmes to speed up patent grant process (Cont.)

2) [Regional] ASEAN Patent Examination Co-operation ("ASPEC")

Regional patent work-sharing programme among 9 participating ASEAN Member States IP Offices (ø MM).

Applicants may use the search and examination (S&E) reports of participating IP Offices to accelerate the patenting process in any of the other participating IP Offices.

Applicants can also rely on two specific programmes (since 2019):

→ ASPEC AIM - a committed turnaround time of 6 months to receive the first office action if an ASPEC request is made for Industry 4.0 patent applications. This industry specific programme was further extended until 26 August 2025. (https://www.aseanip.org/home/2023/08/25/further-two-years-extension-of-aspec-aim-pilot-programme-till-26-august-2025).

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Design in SEA / Duration

Period of protection in SEA

- **[Brunei, Cambodia, Laos, the Philippines, Singapore, Vietnam]**have an initial period of 5-year protection, which can be extendable for 2 periods of 5 years each, up to a maximum of 15 years from the filing date.

- **[Myanmar]** the **Industrial Design Law from 2019 is now in force since October 31, 2023, enabling the protection of industrial designs with a total protection period of 15 years** (5 years from the filing date + renewable twice each time of 5-year period).

- **[Indonesia and Thailand]** have a fixed 10-year protection.

- **[Malaysia]** has protection for up to 25 years (like before the EUIPO).

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Trademark in SEA / Types of trademarks

What can be registered as a TM in SEA

- **[Singapore and Malaysia]** words, names, signatures, numerals, devices, headings, labels, shapes, colours, sounds, scents, holograms, positionings, sequences/motions.

- **[Thailand and Vietnam]** words, names, signatures, devices, headings, labels, shapes, colours, sounds.

- **[The Philippines]** words, names, signatures, numerals, devices, headings, labels, shapes, colours, holograms, positionings, sequences/motions.

- **[Brunei]** words, names, signatures, numerals, devices, headings, labels, shapes, colours, sounds, scents, holograms, sequences/motions.

- **[Laos, Cambodia and Myanmar]** words, names, signatures, numerals, devices, headings, labels, shapes, colours.

- **[Indonesia]** words, names, signatures, numerals, devices, headings, labels, shapes, colours, sounds, holograms.

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Trademark in SEA

- Two options: **local filing** and **international filing** (Madrid system).

- **As of today, Myanmar is the only SEA country which is not a party to the Madrid system.**

- All SEA countries have a **multi-class filing system** (Cambodia recently made the use of this system mandatory i.e. since 1 August 2023).

- **Cambodia, Indonesia, Laos, Thailand, and Vietnam require national applications to be submitted in their respective local languages.**

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Trademark in SEA / Duration, translation and system

- In SEA countries, the duration of the trademark varies: **10 years from the date of filing** (Brunei, Cambodia, Laos, Myanmar, Indonesia, Malaysia, Singapore, Thailand, Vietnam) or **10 years from the date of registration** (the Philippines).

- Linguistic problem -> translation. **Registration in Latin characters does not protect against use or registration in the local language**.

- The procedure to obtain a trademark varies from country to country. Most SEA countries follow the "**first-to-file**" system, where the first person or entity to file a trademark becomes the owner when registration is granted. In these countries, it is important to initiate protection as soon as possible, as IPRs may be compromised if third parties manage to register a trademark before the official owner.

- Other countries, such as **Singapore** and **Malaysia** use the "**first-to-use**" system.

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Enforcement in trade fairs in SEA

1) Before the Fair

➢**Registering one's IPRs in SEA countries or proceeding with an International registration, extended to such country/countries**.

➢**Prepare the necessary documentation to demonstrate ownership of IPRs**:
[Trademarks] original certificate of national registration, certificate of international registration (in the required language) obtained from the Trademarks Office, renewal certificates.
[Patents, utility models, and designs] original certificates of registration, translation into the required language of technical documentation and claims, proof of payment of annual fees.
[Registered Geographical Indications] original registration certificate.

➢**Verify that one's IPRs are not the subject of proceedings or invalidation procedures within SEA**.

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Enforcement in trade fairs in SEA

- **Checking competitors' websites to identify potential cases of counterfeiting**.

- **Applying symbols and phrases related to the rights on the products**:

™ if the trademark is in use or not yet registered, or if the application has been filed but the trademark is not yet registered;
® only in the case of a registered trademark;
“Patent n. ____” if the patent has been granted;
“Patent pending” if the patent application has been filed but the patent has not yet been granted.

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Enforcement in trade fairs in SEA

2) During the fair

➢**Check if the organizers have established a Temporary IPR Bureau Office**. Sometimes, if the fair lasts one or two days and the organizers have not set up a center for complaints, the exhibitor can check if there is any local authority at the fair.

➢**If a suspected counterfeit product is identified, it is important to gather as much evidence as possible** (photographs, brochures, business cards, catalogs, etc.). In order to use evidence in any future legal proceedings, it is recommended to invite a notary to the fair to authenticate and verify the source of the collected evidence.

➢**In the case of suspected counterfeiting, file a complaint** (attaching the collected evidence) with the IPR Bureau, if available, or with the authorities otherwise present at the fair.

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Enforcement in trade fairs in SEA

3) Once the fair is over, it is possible to:

a. Initiate a **civil action, which is available in all countries,** to obtain precautionary measures, injunctions, seizure of counterfeit goods and the machinery used to produce them, or compensation for damages.

Civil litigation generally refers to legal action filed in court where the IP owner seeks compensation for the infringement committed by a third-party. Civil actions are generally more cost and effort intensive, and are therefore best reserved for where the commercial damage sought to be collected is substantial, and where there is indication that the adverse party has the ability to compensate the IP owner at the amount which the IP owner seeks to be compensated.

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Enforcement in trade fairs in SEA

b. Initiate a **criminal action, which is also available in all SEA countries,** that may result in the arrest of the party responsible for the violation or monetary penalties against the same.

The most severe and aggressive approach that an IP owner can take, as it involves the participation of law enforcement and, in some cases, the use of necessary force. This is typically done by way of a "raid" or any similar enforcement action requiring forceful entry to the premises of the suspected infringer.

After a successful raid, infringing items found at the premises will be taken, and on account of which, the infringers may be held liable for criminal penalties. These typically involve the combination of the payment of a fine or imprisonment, or in some cases both, to the discretion of the court or body passing judgment.

Criminal cases are instituted in different ways in South-East Asia, and thus developing a country-specific strategy for criminal actions will be necessary.

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Enforcement in trade fairs in SEA

c. Initiate an **administrative procedure** to obtain injunctions to cease the violation, seizure and destruction of counterfeit goods and the machinery used to produce them, or monetary penalties.

Administrative action are actions filed with an administrative body using its executive authority rather than with a court of law.

When it comes to resolving IP disputes, administrative actions are available in some, but not all, South-East Asian countries (they are available in Cambodia, Indonesia, Laos, Myanmar, the Philippines, Thailand, and Vietnam).

The exact relief that an administrative body may grant in administrative proceedings varies from country to country, although it would typically include:

- Granting an injunction.
- Ordering the disposal of the infringing goods.

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Enforcement in trade fairs in SEA

Generally, **administrative actions** have a lot of **benefits**:

- They can be effective for IPR issues involving complicated technicalities;
- They can be quicker and more cost-effective due to the streamlined proceedings;
- The involvement of government authorities may convince infringers to comply with the IPR owners' demands.

However, administrative actions may not always be the best way to address infringements:

- They may not be suitable for dealing with recurring infringers who may not take administrative notices seriously;
- They may be ineffective if adequate human and financial resources are not available, and if the penalties applicable in a particular jurisdiction do act as a deterrent;
- In some countries (Laos and Myanmar), clear guidelines and procedures have not been set out, and inconsistent application of the law causes uncertainty about the reliability of administrative decisions.

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Alternative Dispute Resolution

ADR is a range of procedures that are used to **resolve disputes as an alternative to going to trial in court**. Many of these procedures involve independent intermediaries such as a **mediator, arbitrator or expert** to facilitate the resolution of disputes.

The **consent** of ALL parties involved is a **key pre-condition** for ADR processes. This can be obtained in writing by drafting an ADR clause into the dispute resolution segment of the parties' contracts. Alternatively, after a dispute arises, parties can also record their agreement to submit their dispute to ADR via a submission agreement.

There are different ADR options:

Negotiation: where the parties reach a settlement amongst themselves without the involvement of a neutral third party. No formal procedures are required.

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Alternative Dispute Resolution

- **Mediation**: where parties agree to allow a neutral third party (i.e. the mediator) to facilitate negotiations. Settlements can be recorded as an agreement to be governed and enforced under contract law. Where mediation is part of a formal court procedure, the outcome can be recorded as a consent order.
  - In **Singapore**, parties can also apply to court to record their mediated settlement agreement as an order of court: with the Mediation Act.
  - In the Philippines, the IP Office encourages resolution of IP-related disputes through its "IPOPHL Mediation Outside of Litigation" service.

- **Conciliation:** a court dispute resolution process for parties to resolve their disputes without going for a trial, whereby parties seek guidance from the judge during a conciliation session.

- **Neutral evaluation**: neutral third party (i.e. an evaluator) will review the case and provide an early assessment of its merits.

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Alternative Dispute Resolution

- **Expert determination**: parties submit a specific matter to one or more experts who decide on the matter. Parties can choose to be bound by the determination.

- **Arbitration:** is a private system of adjudication wherein parties agree to refer their dispute to one or more arbitrators. Parties can choose to agree on the arbitrator(s) to adjudicate their case, as well as the governing law, language and arbitration seat.

ADR procedures are quicker, much cheaper (parties save on the legal fees), can resolve multi-jurisdictional dispute in a single procedure, there is party autonomy, they are confidential procedures and there is jurisdictional neutrality.

ADR options differ in terms of the formality of the procedure, and the degree of choice the parties have over the solution. Negotiation and mediation can be **entered into outside of formal court processes** and, accordingly, **afford parties greater freedom** to design their own creative solutions to their problems. Mediation can also be entered into formally as a part of court processes.

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IP Considerations for entering the China market

Rainy Barlow

31 Jan. 2024

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Working as a trademark attorney for overseas clients from 2004 after graduation for IP Law Master Degree in the UK.

Member of Senior Professional Trademark Experts of China Trademark Association

Committee members of UK and Europe Group of China Trademark Association

IP Experts Council of Tianjin Binhe New District Protection Center

Council of CASSA

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Bad Examples

Case 1: CASTEL & 卡斯特

CASTEL FRERES SAS, owns CASTEL trademarks on wines in Class 33 in China registered on 22 Nov. 2007

卡斯特-used as corresponding Chinese translation to CASTEL registered under a Chinese wine company on 7 March, 2000 then assigned to a Chinese individual LI.

Lawsuit: compensation amount EUR4317440.00 for both first and second instance litigation. Finally compensation in the trial was EUR64000.00

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Bad Examples

Case 2: FERRERO S.P.A. filed application in China on 27 Oct. 2022 on "chocolates, cocoa, candies, confectionery, pastries, biscuits, waffles, ice-cream and etc" and it was rejected finally on 18 Dec. 2023 because it is just a package of the product or decoration, which cannot indicate the origin of the products.

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Bad Examples

Case 3: SAN ANTONIO WINERY, INC. filed application in China 8 Feb. 2023 on “wines” and it was rejected finally on 13 Dec. 2023 because it is considered as misleading to the quality of the products due to the word “naturals”

STELLA ROSA
Naturals

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Successful Examples

Case 1: Shiseido sued for patent design infringement against Chinese cosmetic company in 2021, local IP office accepted the litigation and took legal action to seize the infringement products 12686 bottles/sets from the infringers warehouse.

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Successful Examples

Case 2: Le Pliage received RMB300000.00 for compensation based on the copyright of the bag.

genuine LONGCHAMP

counterfeit with its own mark

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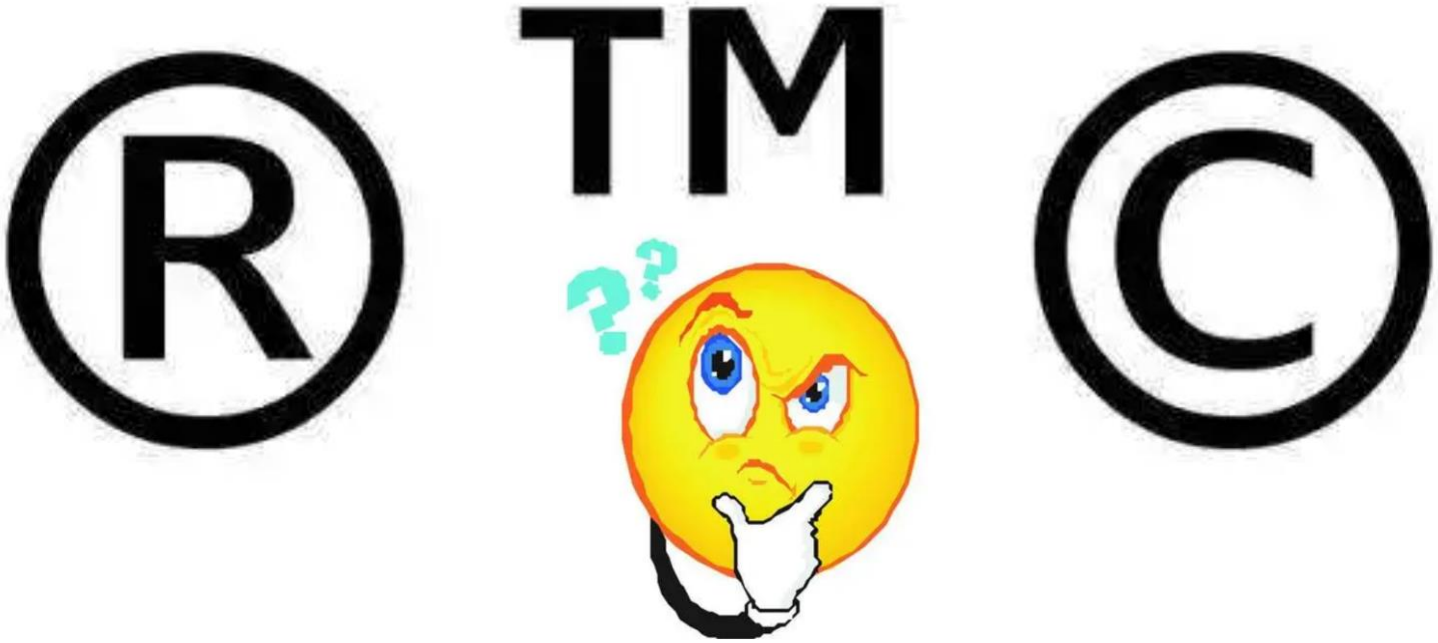
What shall I consider when Entering China Market??

Patent



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What shall I consider when Entering China Market??

- **Trademark Registration**
- **Patent, including invention, utility model, design**
- **Copyright registration**
- **IP registration with online platforms in China**
- **Customs Registration**
- **NDA, distribution agreement regulating IP especially**

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Trademark Registration

- Why?
- Who?
- How?
- When?

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Trademark Registration WHY??

Necessary requirement to open an online store, or entry into physical shopping malls in China

◆Prevent your mark is stolen by someone else. China online filing is quite convenient, daily filing over 10000 apps.

Gain your business partner's or suppliers trust

◆Prevent unauthorized goods enter your worldwide market

legal base for Customs Registration & online taking down & Anti-counterfeit enforcement

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Trademark Registration

Who?

- Companies/individuals who will do or already do business in China;
- Company/individuals who will or already attend Chinese events, such as Canton Fair, Beijing Fair and etc;
- Companies who is using OEM factories in mainland in China;
- Companies whose websites can be accessed from mainland China, Hong Kong, Taiwan and Macau;
- Companies who attend events or exhibitions in your own country or other countries with some visitors from China
- My Chinese business partner?

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How to choose?

- Main brand on core products & products related to the core ones, for example, bags(Class 18) & clothes(class 25); Medical-cosmetics (Class5) and non-medical cosmetics(Class 3); nutrition (class 5) & sports equipment(Class 28)&sports drinks and snacks(Class 30 and 32)
- Apply for a corresponding Chinese trademark to your brand on core products & products related to the core ones(CASTEL case)
- Avoid forbidden words, vague words, descriptive words, ingredients, better choose creative words(natural, fresh, green and etc.);

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When?

ASAP, at least not wait until you decided to run business in China or show your brands to your potential Chinese business partners or distributors, that will be too late

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What if my mark is registered by others already, what can I do?

Legal action+applying for your own mark at the same time

All this needs professional assistance from trademark attorneys

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Patent & Copyright

- **Patent: invention, utility models, designs (including special shape, Colour combination, patterns and etc.)**

- **Copyright (art works, sculptures, special designed packages, patterns, drawings, devices, logos and etc.)**

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Customs Registration

- Your must have a prior registration for IP right, including patent, trademark, copyright;
- It can seize the goods bearing the mark registered with China customs in and out of China in any port;
- The seizure will be conducted automatically by Customs

Procedure

Registration your IP → Customs Notify the unauthorized shipment to you

↓

you request for seizure with payment of bond → goods destroyed, bonds refund

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NDA, distribution agreement regulating IP especially

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	Trademark	Copyright	Invention & utility model	design
Grant Duration	4-6 months	60 working days	Invention: 3- 5 years Utility model:6-12 months Design: 8-12 months	
Protection duration	10 years from registration	Individual: whole life+50 years after right owner death; Corporate: 50 years after the first publication	Invention: 20 years from application date Utility model: 10 years from application date Design: 15 years from application date	
Legal base for infringement?	✓	✓	✓	✓
Legal base for enforcement?	✓	Based on local authority	✓	✓
Ok for customs registration	✓	✓	✓	✓
Removable?	Yes, opposition/invalidation/cancellation	Not easy, need Courts judgment	Yes, can be invalid based on lack of novelty, creation or utility	

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- Trademark(English and Chinese) is priority, attached to goods, can be renewed every 10 years, solid evidence for enforcement, but it cannot cover all products, so might need apply in different classes if your business in wide variety.
- Registration in China does not cover Hong Kong, Macao and Taiwan regions of China, needs separate filings.
- If, the trademark cannot be registrable, and if it is a logo, special shape of the products(longchamp), filing for copyright registration, which do not need to be limited to goods, but in some local authorities, copyright is not reliable as it has no substantial examination. Berne Convention, but hardly to prove.
- If the package or pattern of your products are quite unique, apply for design application
- Routine watch/monitor for your IP rights in China, including online platforms

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