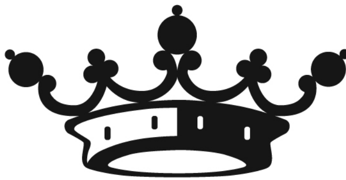
INSIDE THE MINDS

International IP Issues and Strategies

Leading Lawyers on Managing Intellectual Property Protection and Enforcement Efforts across Multiple Jurisdictions



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Strategies for IP Protection in China

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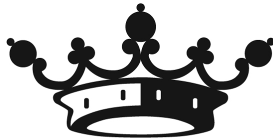

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My daily practice largely consists of advising clients on developing and executing an intellectual property (IP) strategy that supports their business goals and adds value to their company. In counseling my clients, I rely on my past professional experience, which was split between in-house and law firm practice, and included patent prosecution and patent litigation. The majority of my clients are based in Silicon Valley, Israel, and the Far East, but their markets are diverse and span the globe. Consequently, part of my counseling relates to strategies for operating within foreign jurisdictions (outside of the United States). Since practically all of my clients consider China a coveted current or future market, and since I serve many China-based clients, IP protection in China has become an integral part of my daily practice. The following chapter highlights some of the contemporary issues I encounter in my work relating to IP protection in China.

The Changing Landscape of IP Protection in China

The 2008 Olympic Games gave the Chinese a chance to show the world that they have achieved sophistication on par with any other developed country. In addition to the Olympic records that were broken by Chinese athletes, China managed to set new standards for engineering, construction, organization, and manpower management. The Chinese government achieved another feat that escaped the view of cameras, but which could have been noted by those who frequented China in the years leading up to the Olympics—those who visited the "Silk Market," the "Pearl Market," and similar shopping spots where one could always reliably obtain counterfeits of any Western brand. The astute shopper could have noticed the absence of any counterfeit of the Olympics logo (the stylized "jing" character) and any Olympics mascots. The IP of these popular marks belongs to the Chinese government, which successfully enforced its IP rights, as it derived revenue from sales of any Olympics merchandise. Clearly, when it comes to the Chinese government's own revenue, the authorities do indeed know how to enforce IP rights.

A review of Western media might easily lead one to believe Westerners have no chance of protecting their IP in China. Indeed, most companies in the United States believe that, given the chance, Chinese companies would copy their technologies and the U.S. patent holders will have no recourse. A

new perspective, however, is emerging among the Chinese, who believe foreigners have an advantage in enforcing their IP rights in Chinese courts.

Key Jurisdictional Considerations

China and the International Community

Any investigation of legal issues should start with the written law of the jurisdiction in question. The first question is, therefore, does China have sufficient IP laws? It should be clear that, due to the history of China, Chinese IP laws are nascent, relative to those of other developed nations. Despite their newness, however, Chinese IP laws are on par with those of similar countries, and they actually bear a resemblance to those of some European countries such as Germany. In addition, China's IP laws have undergone repeated revisions approximately every eight years, to make improvements and render the legislation suitable for the economic superpower China is becoming.

To illustrate with comparative history, U.S. patent laws, based on the U.S. Constitution, trace back to the first Patent Act of 1790, which lasted a mere three years before being replaced by the Patent Act of 1793, drafted almost entirely by Thomas Jefferson alone. The U.S. patent laws have undergone many amendments over the years, with notable, major revisions coming in 1836 and 1952. Another major legislation affecting IP law in the United States was the creation of the Court of Appeals for the Federal Circuit (the patent appeals court) in 1984. As of this writing, proposed legislation is pending approval that promises to yet again amend U.S. patent laws.

While the Chinese nation has a long and fascinating history, its IP rights laws were only recently formulated in 1979, closely followed by China's membership in the World Intellectual Property Organization one year later. Rather than "reinventing the wheel," the Chinese have drawn on the experience of other developed countries and drafted their IP rights laws to conform to the Berne Convention for the Protection of Literary and Artistic Works and the Agreement on Trade-Related Aspects of Intellectual Property Rights, thereby enacting laws adhering to international standards. While criticism of the Chinese IP rights laws abound, the Chinese have amended their laws twice (1992 and 2000) to comply with international

standards, and they are currently considering further amendments. In reviewing the rich history of U.S. patent laws, however, one cannot escape the conclusion that, just as technologies evolve, IP rights laws must also remain dynamic and evolve in step to harmonize with our constantly changing times. Seeking the "perfect" IP rights laws that anticipate and provide the proper answer to any circumstance is, thus, a fallacy, and one should rather understand the prevailing framework and operate within the given law of the jurisdiction in question.

Understanding China as a Multifaceted Entity

Once the question of the laws themselves has been satisfied, one must ask whether China's IP rights laws can be enforced. In investigating enforcement, one must understand that China is a large country divided into many provinces, various local municipalities, and municipal governmental organizations. Consequently, and at least for the foreseeable future, enforcement questions cannot be answered in general for all of China, but must instead be specific to a given jurisdiction. As for the developed costal regions (e.g., Beijing, Shanghai, Guagzhou), the courts are sophisticated and can adequately handle enforcement actions. Unfortunately, jurisdictions that are further inland are not as developed at this time—but they are making some headway.

The difference in sophistication between various jurisdictions must be taken into account in business dealings, IP filings, and enforcement issues. In business dealings with a company from a developed region, for example, IP rights issues are often discussed on a similar level to that used among companies from the Western world. The business culture of China, where confrontation is avoided but negotiations are constant, must also be understood. Cultural influence on business dealings is more prevalent in businesses from undeveloped areas, where the signing of an agreement is often taken as the start of negotiations, and raising an IP rights issue would probably be met with bafflement.

Due to the lack of sophistication of undeveloped areas, it is imperative that one hires a law firm based in Beijing or Shanghai to handle IP rights filings and other matters in China. To properly file a patent application in China, for example, the Chinese agent must be well versed not only in English, but

also in the technical terms relating to the work involved. The Chinese agent must be able to comprehend the technology involved in order to properly translate any documents. The agent must have a firm grasp of Chinese patent laws in order to adequately respond to the rejections and objections of the State Intellectual Property Office and provide the best patent for the client. The above qualifications are rarely found anywhere other than in the coastal developed cities of China, particularly in Beijing and Shanghai.

When enforcing IP rights in the coastal regions, the attorney may prepare a case in a similar manner as he or she might in the United States or Europe. One may expect the sophistication of judges in Beijing, Shanghai, and similar cities to conform to their position. Beijing, Shanghai, and Tianjin have established IP courts within the Intermediate People's Court, and Beijing, Shanghai, Guangdong, Fujian, and Hainan have separate IP courts at the Higher People's Court level. The Supreme People's Court, in addition, has established a separate IP division. By establishing these courts, the Chinese government provided adequate vehicles for enforcing IP rights in China, especially in developed regions. However, one must pay close attention to tutorials and other aids to assist the judge in understanding the issues involved. Practitioners should be prepared to dedicate time and effort to arrive at simplified explanation of the technology and legal issues involved. To that end, it would be advisable to hire a local technology expert (e.g., a university professor). In undeveloped jurisdictions, it may also help to hire a local firm connected politically and socially to the community.

Vehicles for IP Protection in China

Due to the peculiarities of the Chinese market and China's current position as a manufacturing powerhouse, the Western company must devise a specific IP strategy for China, and not merely implement the same strategy it might employ in Europe or the United States. One should endeavor to utilize a "whole portfolio" approach, where several vehicles of IP protection are employed to satisfy different protection requirements. Like other developed nations, China has IP rights laws relating to patents, trademarks, copyrights, and trade secrets. In addition to utility patents and design patents, however, China also has "patents for utility models," which are not available in the United States. One must understand the pros and

cons of each of these vehicles, and one must make use of each as necessary for the particular situation.

As China is currently the "manufacturing center" of the world, an enforceable patent of the proper scope may be akin to a "world patent," as there are many products that, effectively, cannot currently be manufactured anywhere but in China. Consequently, if one is able to enforce a patent in China to control the manufacturing of the product in China, one may consider that patent a worldwide enforcement vehicle.

Patents for Inventions

All patent applications are handled by the State Intellectual Property Office in Beijing. Patents for inventions (i.e., utility patents) in China are handled similarly to those in Western countries. In general, they are examined for compliance with a sufficiency of disclosure, novelty, and inventiveness—requirements known to all patent practitioners. China is a member of the Paris Convention and the Patent Cooperation Treaty. Therefore, those filing first outside of China may use the Patent Cooperation Treaty vehicle to enter China at a later time. Note, however, that Taiwan is not a member of the Patent Cooperation Treaty, and patent applications must be filed directly in Taiwan to obtain patent protection there.

A Chinese patent application from abroad, whether filed directly in China or through a national stage entry via the Patent Cooperation Treaty, must be filed by a Chinese patent agency authorized by the State Intellectual Property Office. A Chinese-language version must be supplied. In this regard, it should be noted that mainland China uses simplified Chinese characters while Taiwan uses traditional characters, so the translation for one jurisdiction cannot be used for the other.

Unlike the United States, which is a first-to-invent jurisdiction, China is a first-to-file jurisdiction. Similarly, unlike the United States, where patent applications enter an examination queue upon filing, an applicant for a Chinese patent must file a request for examination within three years of filing. Otherwise, the application is not examined and is considered abandoned.

While business methods may be problematic to patent, software may be patented in China if it is claimed properly. For a business method to be eligible for a patent, it must include a technical innovation. The novelty cannot reside in the method of doing business, but must rather take the form of some technical improvement. Software claims can be submitted for a method, for an apparatus (e.g., a microprocessor performing a series of steps), or for a storage media. While cheaper than jurisdictions such as Japan and Europe, patents in China are still relatively more expensive than other available forms of IP rights protection and therefore should be utilized cautiously.

Patents for Utility Models

While utility models are available in Japan, Korea, Germany, and other countries, they are not available in the United States. Consequently, many American companies fail to utilize this vehicle for IP rights protection. Used wisely, however, the utility model can be an indispensable part of a well-positioned IP portfolio.

Utility models are meant to cover minor improvements, and are sometimes referred to as "petty patents." Under current law, applications for utility models are not examined on the merit until such a time as the patentee seeks to enforce their patent rights against an infringer. The protection term is ten years from filing date. Due to the nature of these devices, the utility models particularly lend themselves for the protection of items such as consumables, replacement parts, and minor improvements. A utility model may be efficiently used when, for example, one employs a "razor blade" business model, where much of the revenue is derived from the recurrent sales of consumables rather than from that of the original product utilizing the consumables.

Patents for utility models are much cheaper than patents for invention, since no prosecution on the merit is involved. In addition, since they are examined only for formalities, utility models are granted relatively quickly. The application itself is similar to a patent for invention application, but since it is limited to a relatively minor technological advancement, it may be much shorter and therefore cheaper to prepare.

For companies seeking to outsource the manufacturing of consumables or replacement parts to China, filing a utility model is often considered necessary due to a trap created by the Chinese legal system (similar to that of other countries, such as Taiwan and Korea). To illustrate the operation of the trap, consider the following example.

A foreign company sends drawings of machine consumable parts meant to be manufactured by a Chinese company. Unbeknownst to the foreign company, the Chinese company files the drawings in an application for a utility model and receives a patent, as there is no examination on the merit. A manufacturer in China purchases the machine from the foreign company, and when the manufacturer needs consumable parts, it tries to purchase them directly from the Chinese company, rather than from the foreign company. This action, of course, upsets the foreign company, which informs the Chinese company that they do not have the right to sell the consumables directly. To that, the Chinese company responds, "Of course we can. We have a patent."[1] Further, if the business relationship worsens and the foreign company sells consumable parts to the manufacturer, the Chinese company may sue the foreign company for patent infringement.

In China, courts cannot rule on the validity of the patent, but rather only on infringement. Since the patent includes the drawings sent by the foreign company, it is a given that the court would find infringement. The only recourse is for the foreign company to request that the State Intellectual Property Office to review the validity of the patent. Until the office rules on the validity of the patent, however, the Chinese company may prevent the foreign company from importing the consumable part into China. The foreign company might have avoided the trap, therefore, by filing an application for a utility model *before* sending the drawings to the Chinese company.

Design Patents

Design patents can prove to be a very important protection vehicle in China, much more so than in, for instance, the United States. Design patents are cheap, easy to obtain, and relatively difficult to invalidate. Like

[1] While a patent does not bestow on its holder the right to practice the invention, this fact escapes most company executives, who erroneously hold the belief that if they have a patent it means they have the right to manufacture the patented invention.

utility model applications, design patents are not examined on the merit until such a time as the patentee seeks to enforce them—and like utility models, design patents harbor a trap for the unwary. One well-known business that ran afoul of that trap is the Nissan Motor Company.

The Great Wall Motor Company manufactures and sells the Sing pickup truck in China. The Sing pickup truck resembles—to say the least—Nissan's Frontier pickup truck, which is sold by Nissan in the United States.[2] When Nissan attempted to enforce its IP rights to the Frontier design versus the competing Sing imitation, the Great Wall Motor Company answered with a design patent lawsuit, preventing Nissan from importing the Frontier into China. (Unbeknownst to Nissan, the Great Wall Motor Company filed several design patent applications on the Frontier design.) Nissan then attempted to invalidate the patent, as Nissan sold its Frontier in the United States years before Great Wall ever filed its patent application. Under Chinese IP rights laws, though, sales outside China cannot be used as prior art to invalidate a design patent. In response, Nissan attempted to use its Frontier sales catalogs as published prior art. However, to invalidate Great Wall's design patent, Nissan had to show published images of all sides of the patented design. Alas, Nissan did not have images of the back of the truck in its catalog. Consequently, Nissan found itself unable to invalidate Great Wall's design patents, which were almost an exact copy of Nissan's own design.

Trademarks

China is a signatory to the Madrid Agreement for the International Registration of Trademarks, and it joined the Madrid Protocol, which requires reciprocal trademark registration for member countries. The State Administration for Industry and Commerce administers the trademark office.

The Starbucks trademark litigation has shown that Chinese courts are just as adept in handling trademark law as any U.S. or European court. While most people think of the Chinese as tea drinkers, Starbucks' entry into China was a resounding success—and one perhaps beyond Starbucks' expectations, as

[2] To see images of all of the products and trademarks discussed in this chapter, please visit the U.S.-Asia Technology Management Center of Stanford University, or download this Adobe pdf file: asia.stanford.edu/events/fall06/slides/061019-bach.pdf.

the company failed to register its Chinese mark. An enterprising Chinese company then registered its company name as that mark. The competing Chinese company then started selling coffee and even decided to style its logo in a design quite similar to Starbucks', replacing only the mermaid drawing in the middle with a picture of a cup of coffee instead.

Starbucks sued the Chinese company for trademark violation. The facts of the case presented the Chinese judge with a perfect opportunity to dismiss Starbucks' case and admonish the foreign company for failing to properly register their mark. Instead, the judge properly applied IP law and ruled that Starbucks is a well-known mark all over the world and that the Chinese company should be prevented from taking unfair advantage of Starbucks' brand.

As a comparative side note, Starbucks has lost a somewhat similar dispute in South Korea, where a Korean company operated a coffee shop chain under the mark Starpreya. Starpreya also stylized a logo similar to the Starbucks logo, but replaced the mermaid drawing with a drawing akin to a Greek female profile. Of course, those who travel to Asia know the Starbucks stylized logo has been "high-jacked" and transformed by many coffee companies.

Another interesting trademark case is *Honda Motors v. Chongqing Lifan Industries*. Established in 1992, Lifan is one of the largest motorcycle manufacturers in China, and its Hongda motorcycles are almost as ubiquitous as bicycles in China. The Hongda brand is well known in China and is more recognizable by Chinese than Honda. In spite of its huge success selling its Hongda motorcycles in China and Vietnam, Lifan had decided to apply a Honda logo on the fuel tank, in addition to the Hongda logo embossed on the side of its motorcycles. That was more than Honda could tolerate, and it sued for injunction and $3 million in damages. Apparently, this was also more than the judge could tolerate, and while siding with Honda, he awarded Honda less than $200,000 in damages.

Copyrights

Copyrights are administered by the State Administration for Press and Publication under the National Copyright Administration. While a more

difficult vehicle to enforce (mainly due to the ease and proliferation of counterfeit software, DVDs, CDs, etc.), those willing to invest the necessary effort in copyrights can be successful—though the measure of success may not always be satisfying. An example of the operation of copyright protections in China is found in the Chinese Web site www.116.com.cn, which enabled its users to download and view Vin Diesel's "The Pacifier" movie without first obtaining a license from the Walt Disney Company. The Walt Disney Company sued the Web site for copyright violation and won the suit, obtaining an injunction against the Web site to prevent any further dissemination of the movie. The court, however, awarded a total of only $11,140 in monetary damages, which surely did not even approach Disney's legal expenses in bringing the case to court. From the business perspective, it may even be the case that the publicity gained by the Web site for their violation far outweighs the negligible payment of $11,140, and one may therefore interpret the results of this case as an incentive for future violators: feel free to violate, because the publicity gained is worth the cost.

Trade Secrets

It has been reported that the average Chinese employee aged twenty-five to thirty-five is now likely to stay at a company for only one to two years. Such mobility is not seen even in Silicon Valley. This, together with Chinese employees' general lack of understanding of IP rights, makes loss of IP due to trade secrets violation of high concern. Of course, trade secret violation is not limited to departing employees, but may even be orchestrated by a company's management.

A case in point is *General Motors v. Chery Automobile Company*. GM has licensed the Matiz compact car design from Korea's Daewoo, to build a car for the Chinese market in a joint venture with Shanghai Automotive Industry Corp. and Wuling Motor Corp., to be named Chevy Spark. However, before GM was able to introduce its Chevy Spark in China, Chery has launched its QQ model, which highly resembles the Spark. Chery is a state-owned enterprise, and all of GM's efforts to mediate the case were futile, resulting in GM suing Chery for trade secret violations.

As it turned out, Chery also had applied for design patents on its QQ design, providing the authorities an avenue to admonish GM for failing to apply for

patent protection on its Spark design. GM therefore sued under trade secret violation, rather than for design patent infringement. However, under Chinese law, as is under other countries' trade secret laws, in order to prove a violation the plaintiff must present evidence of misappropriation. In the United States, such evidence is gathered during discovery, but Chinese law has no discovery provisions. That forced GM to pursue an inference of misappropriation, as the two cars were practically twins in exterior and interior appearance. Alas, the court was not convinced, which led GM to settle the case under undisclosed, but presumable unfavorable terms.

In view of current job mobility and the Chinese legal system, it is imperative to take all measures to protect trade secrets. This includes disclosure on a strictly need-to-know basis, proper locks on all confidential file cabinets, security of all premises, and limitations on access to sensitive areas. All design and engineering activity should be properly documented and safely stored, to serve as evidence if and when needed. Additionally, proper use should be made of the other IP rights vehicles discussed above, rather than merely relying on trade secrets.

Enforcement

The subject of enforcement of IP rights in China is intricate and deserves its own chapter. It should be clear that a foreign entity should not attempt to enforce IP rights in China without first hiring a Chinese lawyer.

Unlike the United States, where rights are enforced in the judicial system, enforcement of IP rights in China may be done in the courts or by administrative proceedings. The administrative track, whereby an IP rights holder files a compliant at the local administrative office, is the most prevalent. The administrative track is effective in seizing the infringing goods or obtaining information about the goods. However, while the administrative office may fine the infringer, it may not award damages. An important issue to note is that a particular local agency may have subject matter and jurisdiction limitations on its authority. Therefore, the extent of the infringement should be well investigated prior to selecting the agency to which the complaint would be submitted. Also, the political power play among the various local agencies should be taken into account.

In addition to the agencies listed below, if an IP rights holder suspects that a certain shipment in or out of China contains infringing products, the IP rights holder may file a complaint with the General Administration of Customs. However, prior to such an application, the IP rights holder must record its IP rights with the General Administration of Customs.

For patent infringement cases, the State Intellectual Property Office has established local offices throughout China that are responsible for receiving and investigating infringement allegations. For drug-related complaints, one may also consider approaching the State Drug Administration, which is in charge of investigating drug counterfeits. The trademark office under SAIC has the authority to investigate and enforce trademark violations. The trademark office has the authority to issue a cease-and-desist order, order the destruction of the infringing products, and impose fines. When the infringing products are of inferior quality, the mark holder may also complain to the Administration for Quality Supervision, Inspection, and Quarantine. Also, a complaint under the Law to Counter Unfair Competition may be launched with the Fair Trade Bureau. For copyright violations, the copyright holder may file a complaint with the National Copyright Administration or the Ministry of Culture for small-scale infringements. However, for a large-scale counterfeits operation, the copyrights holder may complain to the Public Security Bureau, which may institute criminal proceedings.

In addition to the above administrative agencies, an IP rights holder may also file a complaint with the courts. Legal proceedings in China are substantially cheaper than those in the United States, but navigating the Chinese court system requires the hiring of a local law firm. For example, one peculiarity of the Chinese legal system is that the court's "acceptance" of the complaint is somewhat of a milestone, and is regularly reported in press releases by plaintiffs.

Conclusion

The Chinese government is in the midst of great efforts to instill an innovation culture in China's industry to elevate China from being the manufacturer of the world, to the innovator of the world. Of course, as Chinese companies transform from manufacturing to innovation, they will feel the need for IP rights protection, and will pressure the Chinese authorities to increase

enforcement. Such actions will benefit foreign companies that take the proper steps in advance (i.e., those that now register patents, trademarks, and copyrights). Conversely, those companies that fail to register their IP, perhaps due to their mistrust of the Chinese legal system, may very likely find themselves on the defense side of an IP rights lawsuit, without the ability to counter with any registered IP rights of their own.

Joseph Bach is a partner in the technology and intellectual property practice group of Nixon Peabody. Based in Silicon Valley, he advises his clients on all aspects of intellectual property law, including patent prosecution and litigation. He effectively assists his clients in managing and protecting their intellectual property portfolios through the use of methodologies and protocols designed to align the IP strategy to the business goals and business model. He has experience in litigating intellectual property cases before a wide variety of tribunals, including federal courts and the International Trade Commission. He advises technology companies based in the United States, the Pacific Rim, and Israel. He also has significant experience with, and is regularly invited to lecture on, intellectual property issues specific to China.

Formerly the senior director of intellectual property with Applied Materials, the world's largest supplier of equipment to the global semiconductor industry, Mr. Bach was responsible for all aspects of Applied Materials' intellectual property internationally, including managing and implementing intellectual property strategies, supervising patent prosecution work, evaluating intellectual property of acquisition targets, negotiating various intellectual property agreements, performing product clearances, and defending patent oppositions.

Dedication: *This chapter is dedicated to the late Deng Jun, deputy director of the executive office of the State Intellectual Property Office and director-general of the Intellectual Property Development and Research Center of the People's Republic of China, for the fascinating discussions of IP rights issues over the best Chinese food in Beijing and Bo'ao.*

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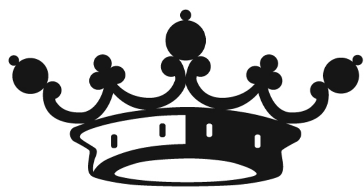

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