

Monthly Newsletter

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Holiday Notice

Our office and IP Administration in the regions below will be closed for International Workers' Day as follows:

Mainland China: May 1 - May 5, 2024

Taiwan: May 1, 2024 (exceptionally, TIPO will not be closed)

Hong Kong: May 1, 2024

Macao: May 1, 2024

All deadlines falling on a holiday will be automatically extended (except Taiwan). Should you have any urgent cases, please let us have your instructions ahead of the holidays.



Chang Tsi & Partners Ranks Band 1 on LEGALBAND's 2024 Client Guide

The well-known legal media LEGALBAND has released the "2024 A Client's Guide: Top Ranked Law Firms" and the "2024 A Client's Guide: Top Ranked Lawyers".

Chang Tsi & Partners has secured the top spot on both lists, being recognized as the Band 1 law firm in "Intellectual Property Litigation/Non-litigation" and its managing partners, Simon Tsi and founding partner, Spring Chang, respectively ranked in Band 1 for "Intellectual Property: Litigation" and "Intellectual Property: Non-litigation".



To issue the most reliable ranking publication to the market, the research team of LEGALBAND spent months conducting interviews with clients, independent research, and studies of submissions. Being recognized on the list is a great honor for Chang Tai & Partners.

Established in 2002, Chang Tsi & Partners is a "National Outstanding Law Firm (nominated by Ministry of Justice of China)". The firm has deep expertise in trademark, patent, copyrights, and other traditional areas of intellectual property. In addition, Chang Tsi & Partners has been focusing on highly specialized IP areas, such as design patent, customs protection, IP Commercial and corporate law.

Chang Tsi & Partners has always adhered to the philosophy of "being the best law firm in China, providing clients with the best legal services, and maximizing clients' legitimate rights and interests". This award is a high recognition of Chang Tsi & Partners' professional capabilities, and we will continue to leverage its strengths to provide first-class legal services to clients, helping them protect and realize the value of their intellectual property through rich industry experience and profound professional knowledge.



Hong Kong Team Achievement: 100% Success Rate in HK Contentious Cases Last Year

We are so happy about our team's amazing accomplishment that we can barely contain our joy and cannot wait to share such great news – we achieved 100% success rate in contentious cases (Opposition and Cancellation cases) we represented last year!

Taking this opportunity, we would like to briefly introduce the opposition proceedings in Hong Kong. Let's unveil the mystery and see how to best enforce your trademark rights in such important opposition stage in Hong Kong.

Firstly, an opposition to a trademark application can be filed within 3 months as of the date of publication of the trademark. "Any" person may issue a notice of opposition to the registrar regarding the registration of the trademark. Oppositions can be based on absolute and relative grounds.

Secondly, after the opposition being filed, the opposed party is entitled to file a counter-statement within 3 months after receipt of the copy of notice of opposition. It's special practice in Hong Kong that in the event that the opposed party does not file a counter-statement within the prescribed period, its application will be automatically withdrawn. Due to the relatively expensive legal costs in opposition proceedings in Hong Kong, an individual or a micro business seldom responds to a notice of opposition. Therefore, in some situations, even if the success chances may not be highly promising, the opposition may still be worth a try depending on the importance of the mark and the background of the opposed party.

If the opposed party does file a counter-statement, the opposition will then move into the complicated evidential exchange and hearing stages. There is also a similar special practice in the evidential exchange stage that it's the opponent that should file the evidence in the form of Statutory Declaration or Affidavit in the first round of evidential exchange. If the opponent does not file the evidence in the first round, it will be deemed as abandoning its opposition.

All in all, due to the complexities and lots of special practices involved in the HK opposition proceedings, attorneys with rich experience could do a lot in helping their clients enhancing the success chances of opposition in Hong Kong - the process is like a strategic game.

Chang Tsi's Hong Kong Team boasts rich experience in contentious trademark matters in Hong Kong. Should any assistance be required in this jurisdiction, please always feel free to contact Lihan, the leader of HK team, and our HongKongTeam at HKteam@changtsi.com. The Team will be your valuable legal partner and provide you with best legal service as always!



Chang Tsi & Partners Successfully Represents Wuxi's First Intellectual Property Civil Case Attached to Criminal Case

Michael Fu



The counterfeit "Oreo" trademark case represented by Chang Tsi and Partners has been selected as one of the top ten typical cases of intellectual property judicial protection by the Wuxi Municipal Court in 2023. It has received high praise and recognition from the court, marking another milestone in Chang Tsi's trademark legal services.

Case Summary:

The plaintiff, Intercontinental Great Brands LLC, is a subsidiary of Mondelēz International. Known globally for its diverse portfolio of food and beverage products that includes biscuits, chocolate, gum, candy, and powdered beverages, Mondelēz International owns several brands each generating revenue in the billions of dollars.

Amongst these, "OREO" stands out as highly recognized. However, amidst growing Chinese consumer demand, counterfeit "OREO" biscuits began surfacing in the market, ultimately prompting the plaintiff to undertake extensive protective measures in China.

Between September 2022 and February 2023, the defendants Xu, Lin, and Hong produced counterfeit "OREO" biscuits in a factory near University Road in Jinping District, Shantou City, Guangdong Province. Aware of "OREO" being a legally registered trademark and lacking any authorization from the plaintiff, Xu orchestrated financing and marketing, Lin managed production and procurement of equipment and packaging, while Hong initially packaged and eventually assisted in production. The counterfeits were then sold via online stores on major e-commerce platforms by Fang in Wuxi and Jiang in Huai'an, Jiangsu. Following customer complaints and subsequent notification by Fang and Jiang, the Wuxi Public Security Bureau's Hui Shan Branch launched a criminal investigation on March 25, 2023.

Upon transfer to the Hui Shan District People's Procuratorate for review and prosecution, Chang Tsi & Partners acted expediently, appointing attorneys Michael Fu and Yang Luo to examine the case records and develop a comprehensive protection strategy. This proactive approach enabled the initiation of Wuxi's first Civil Case Attached to Criminal Case, merging claims for compensation and a public apology in "China Food Safety Daily" to mitigate the infringement's negative impact. On January 3, 2024, a hearing took place in the Hui Shan District People's Court of Wuxi City, with a judgment rendered on January 18.

Judgment Results:

1. Defendant Xu: Guilty of counterfeiting a registered trademark, sentenced to three and a half years in prison, and fined 90,000 RMB.
2. Defendant Hong: Guilty of the same, sentenced to three years and three months in prison, and fined 30,000 RMB.
3. Defendant Lin: Guilty as well, sentenced to a three-year suspended prison term, and fined 50,000 RMB.

4. The defendants are ordered to forfeit their illegal earnings - 60,000 RMB for Xu, 21,000 RMB for Lin, and 26,000 RMB for Hong - to the state treasury.

5. The seized counterfeit OREO biscuits and an iPhone 13 used in the criminal activities were disposed of by authorities.

6. Defendants Xu, Hong, and Lin must jointly compensate Intercontinental Great Brands LLC with a total of 225,700 RMB; Xu and Hong are further liable for an additional 54,300 RMB.

7. Defendants must publish a public apology in the "China Food Safety Daily". Non-appeal of the first-instance judgment has made it final and conclusive.

Against the backdrop of comprehensive strengthening of intellectual property rights, Chang Tsi & Partners successfully drove Intercontinental Great Brands LLC's Civil Case Attached to Criminal Case, ultimately achieving full protection of the involved intellectual property in both criminal and civil aspects within the same case.

Chang Tsi & Partners has maintained a leading position in the field of intellectual property litigation and dispute resolution, contributing a wealth of groundbreaking and innovative classic cases that drive the development of the intellectual property industry. For instance, in recent years, the case of invalidation of design patents represented by Michael Wu **has been recognized as one of the top ten annual patent invalidation cases by the National Intellectual Property Administration**. Chang Tsi & Partners will continue to strengthen its services in the field of intellectual property, align with development directions, strive for innovation, enhance core competitiveness, provide more professional services to clients, and contribute to the development of the intellectual property industry.

The Case Represented by Chang Tsi & Partners Received High Praise from the Changzhou Intermediate People's Court and the Ningguo Procuratorate.

Ason Zhang

This case is a coordinated action involving both criminal crackdown and civil compensation claims against counterfeit automotive spare parts. In recent years, various counterfeit products related to this brand of automotive parts have been flooding the market. However, due to the diverse types of products, wide-ranging areas of involvement, and various types of infringement, it has been challenging to identify the source of the counterfeit products for effective enforcement actions, despite actions taken against some entities.

At the end of 2022, Chang Tsi & Partners, entrusted by the client, first conducted a review of the main prior rights related to the brand's automotive parts, including trademark rights, design patents, and utility model patents. Subsequently, an analysis of the main shipping areas of automotive parts in the market was conducted, identifying two important provinces, Jiangsu and Anhui. Then, focusing on the most active entities in these two provinces, particularly those with significant sales volume and production capacity, several key entities were selected for online and on-site investigations.

Following this, the civil compensation litigation process was promptly initiated. Initially, the client harbored doubts, believing that the likelihood of pursuing compensation from infringers in China was slim. However, Chang Tsi & Partners obtained compensation totaling several million RMB two months ahead of expectations, and the progress of another civil case proceeded smoothly, resulting in nearly a million RMB in compensation.

With increased confidence, Chang Tsi & Partners assisted the client in comprehensive intellectual property strategic planning, expanding services such as design patent applications, trademark Class P business, online complaints, and customs training. Chang Tsi & Partners will continue to conduct activities such as exhibitions and market surveys, and will collaborate internationally in rights protection actions using customs data to establish a closed-loop system.

The Changzhou Intermediate People's Court has prioritized cracking down on and harshly punishing major infringement cases involving well-known trademarks and trade secrets, considering this case as a **"typical case concerning the interests of the masses and attracting high social attention"**. The Ningguo Procuratorate reported on this case, praising the **"inter-regional cooperation, breaking down major compliance challenges for businesses"**, and highly appreciating the **"heartwarming action to help businesses overcome difficulties"**, describing it as **"a collaborative effort of prosecution across 160 kilometers, as well as a heartwarming initiative to assist businesses in distress"**.



Ason Zhang

Partner
Attorney at Law

Mr. Ason Zhang provides consultation services on a wide range of intellectual property issues in China, in contentious and non-contentious matters. He specializes in developing intellectual property strategy and enforcement programs for many multinational corporations.