

Monthly Newsletter

Issued by Chang Tsi & Partners | www.changtsi.com | Jul 2023



Celebrating 20 Glorious Years: Chang Tsi & Partners' 20th Anniversary Gala

On July 16, 2023, Chang Tsi & Partners' 20th anniversary celebration event took place in the grand banquet hall of the China World Hotel, Beijing. The event was attended by all partners, colleagues from various offices across Beijing, Shanghai, Guangzhou, Shenzhen, Guangxi, distinguished alumni, and some family members, with a total of over 350 attendees coming together to commemorate this milestone.

The celebration commenced with a 50-meter red carpet corridor, showcasing the remarkable journey of Chang Tsi & Partners over the past 20 years, from its humble beginnings to its transformation and soaring success.



Adorned in elegant evening attire, our employees walked the red carpet, exuding the essence of Chang Tsi & Partners' elite spirit.

Managing Partner, Simon Tsi, delivered an inspiring keynote speech on behalf of the firm's executive committee. He recounted Chang Tsi & Partners' tenacious growth story, shared valuable insights on how the firm stands out in a competitive landscape, and set forth a resolute vision for the future, guiding the path towards the next strategic objectives.



In honor of the 20th anniversary, Chang Tsi & Partners presented the most extensive and prestigious awards ever held, recognizing the exceptional contributions of each Chang Tsi member and setting new benchmarks to inspire dreams and uphold the core values.





During the banquet, the talented Chang Tsi members presented a mesmerizing audiovisual feast, from the heartwarming rendition of "Chang Tsi in My Eyes" to the performances from the major branches in Beijing, Shanghai, Guangzhou, and Shenzhen, showcasing the vibrant spirits and diverse talents of our young lawyers and industry leaders, earning thunderous applause



Throughout the evening, we shared joyous moments, creating a joyful and harmonious ambiance.

As we look back on the journey, Chang Tsi & Partners' steadfast steps have formed a beautiful tapestry, embracing change and embracing an international vision, weaving a story of a new era and a new China. In the future, Chang Tsi & Partners will embrace the ever-changing times, standing at the forefront of the tide. We will continue to adhere to our values, dedicate to intellectual property as our core business, and forge Chang Tsi & Partners into a premium legal service brand, ascending our shared cause to even greater heights!

The Pilot Project of Priority Examination for Invention Patent Applications by Macau Applicants in Mainland China Comes into Effect on July 1st, 2023.

In order to implement the central government's decision on fostering the construction of Guangdong-Hong Kong-Macau Greater Bay Area, and support Macau residents in effective protection of their IP rights in Mainland China, the China National Intellectual Property Administration (CNIPA) will, in the form of a pilot project, facilitate the arrangements for priority examination of invention patent applications submitted by Macau applicants in Mainland China.

Upon this project, the permanent residents in Macau, companies established under Macau Commercial Code, and other legal entities or organizations in Macau can submit the application materials through the Patent Office of CNIPA in Guangzhou or Shenzhen, the applications that meet the relevant conditions can be given priority examination in Mainland China.

The applications applicable to this pilot project must be the invention patent application filed by Macau applicants, and must be in the substantive examination stage in Mainland China. In addition, the technical fields of these applications shall belong to those fields specified in Measures for the Administration of Patent Priority Examination (Order of the CNIPA [No.76]), and the classification number should fall within the scope of Reference Table for Strategic Emerging Industry Classification and International Patent Classification (2021) (Trial).

Macau applicants can submit application materials to the Patent Office of the CNIPA in Guangzhou or Shenzhen in person or by post, but shall not submit applications to two offices repeatedly for the same patent. For specific application procedures, please refer to the Guidelines for Macau SAR Applicants to Apply for Priority Examination of Invention Patents in mainland China.



Advancing Intellectual Property: Ron Tsi's Participation in 64th Meetings of the Assemblies of the Member States of WIPO

WIPO (World Intellectual Property Organization) is a specialized agency of the United Nations dedicated to promoting and protecting intellectual property (IP) across the globe. The organization serves as a forum for member states to discuss and establish international IP policies, treaties, and cooperation.

The Sixty-Fourth Series of Meetings of the Assemblies of the Member States of WIPO was a significant event held at the WIPO headquarters in Geneva, Switzerland. During this series of meetings, representatives from member states came together to address critical issues related to IP, exchange ideas, and make decisions that impact the global IP landscape. The meeting served as a platform for discussing WIPO's initiatives and achievements and shaping the future direction of international IP regulation and enforcement.

Mr Ron Tsi, attorney at law at Chang Tsi & Partners, actively participated in the Sixty-Fourth Series of Meetings. Ron has been dedicated to client relationship management and coordinating outbound IP cases since 2015. His profound legal background in China and extensive experience in assisting global IPR clients, including leading companies in high-tech, food, and pharmaceutical fields, have made him an expert in IP matters not only in China but also in the US and EU. As a regular attendee of prestigious IP conferences such as INTA, MARQUES, and AIPLA, Ron is committed to staying up-to-date with the latest developments in the IP industry.



Ron Tsi's participation in the Sixty-Fourth Series of Meetings at WIPO further highlights his dedication to the field of intellectual property and his commitment to collaborating with global stakeholders to shape effective IP strategies and policies. His involvement in such prestigious gatherings underscores the recognition of his expertise and the significance of his contributions to the international IP community.

Chang Tsi & Partners demonstrates unwavering dedication to the thriving IP law industry through our commitment to providing top-tier legal services in the IP domain. By actively sending representatives to participate in prestigious international IP conferences, Chang Tsi & Partners continues to showcase its expertise, dedication, and forward-thinking approach in shaping effective IP strategies for clients worldwide.



Interpretation of the Standards for Suspension in Trademark Review

Emma Ma

Recently, the Trademark Office of China National Intellectual Property Administration (hereafter referred to as the CNIPA) issued an interpretation of the Standards for Suspension in Trademark Review, which distinctly specifying seven circumstances of warranting suspension and three circumstances where the suspension may be considered depending on specific case details.

Among the seven circumstances of warranting suspension, five are universally applicable to refusal reviews, non-registration reviews, and invalidation cases, namely:

(1) the disputed trademark or cited trademark is in the process of a name change or assignment, and following the changes or assignment, the said trademark no longer presents a conflict of rights.

(2) the cited trademark has expired and is in the process of renewal or a grace period for renewal.

(3) the cited trademark is in process of deregistration or withdrawal application.

(4) the cited trademark has been cancelled, declared invalid or subject to no renewal upon expiration, and the date of revocation, invalidation, or deregistration is less than one year when the case is heard; it should be noted that if the reason for refusal does not involve Article 50 of Chinese Trademark Law, there is no need for suspension; according to the Trademark Review and Adjudication Guidelines (hereafter referred to as Guidelines), if the cited trademark is cancelled due to cessation of use for three consecutive years, the Guidelines shall prevail.

(5) the case involving the cited trademark has been concluded and is awaiting the conclusion to be effective, or the enforcement of an effective judgment is pending for retrial.

One particular scenario is specifically applicable to non-registration reviews and invalidation cases, consistent with the provisions of Article 35, Paragraph 4 and Article 45, Paragraph 3 of Chinese Trademark Law. This is:

(6) the prior rights involved must be based on the outcome of another case that is under hearing of the People's Court or being processed by the administrative authority. Another scenario is specifically applicable to refusal review cases:

(7) the right status of the cited trademark must be based on the result of another case that is under hearing of the People's Court or being processed by the administrative authority, and the applicant explicitly requests a suspension.

To maximize the benefit to right holders, no distinction shall be made between the times and subjects of application for cited trademark. However, the applicants should clearly state the specific details of cases, such as the registration number of cited trademark, the ongoing procedures, and its relationship with this case, and the warrant of suspension must meet the principle of necessity.

In addition, there are three scenarios where the proceedings may be suspended depending on the specific details of cases:

(8) in the case of refusal review, the cited trademark has been subjected to a request for invalidation, and the registrant of cited trademark has been determined in other cases to constitute a bad-faith registration as stipulated in Article 4, Paragraph 4 of Article 19, and Paragraph 1 of Article 44 of Chinese Trademark Law, the proceedings can be suspended in such cases. The difference between this scenario and the aforementioned scenario (7) is that the suspension request by the applicant is not a prerequisite, the examiner can independently decide whether to suspend the case based on the specific situation, so as to effectively reduce the troubles of duplicate applications and exhaustion of legal procedures caused by the bad-faith trademark registration.

(9) if it is necessary to wait for the prior ruling or judgement of a case with the same or related situation, the proceedings can be suspended as per the needs of individual case. This scenario does not necessarily involve a cited trademark, and a suspension request by the applicant is not required. However, for coordination of administrative authorization and confirmation, as well as administrative and judicial procedures, unifying the review and trial standards, avoiding procedural loopholes caused by conflicting conclusions, and reducing the burden on parties, the examiners can independently decide whether to suspend the case according to its specific situation.

(10) in other scenarios that cannot be exhausted, the principle of necessity and favoring legitimate right holder is upheld, the examiner can independently decide whether to suspend the case based on the specifics situation with a reference to the above scenarios.



Emma Ma

Counsel | Attorney at Law
Trademark Agent

Emma Ma joined Chang Tsi & Partners in 2009. Currently, Emma serves as the head of prosecution at the firm's headquarters in Beijing.

Spring Chang Recognized as 2023 WIPR Leader

Chang Tsi & Partners' Founding Partner, Spring Chang, has been recognized in the esteemed WIPR Leaders 2023 Directory.

This significant achievement showcases Spring Chang's unwavering commitment to delivering exceptional IP legal services.

WIPR Leaders serves as a comprehensive guide to the world's foremost IP practitioners, featuring a distinguished list of over 2,500 lawyers specializing in patent, trademark, and copyright practices. The rigorous selection process involved a thorough nomination period, followed by meticulous vetting by the WIPR research team. The team assessed nominees based on their extensive experience, industry expertise, notable cases, and contributions to the field through activities such as writing and teaching.

Spring Chang's inclusion in the directory is a testament to her stellar reputation as a leading intellectual property lawyer. WIPR comments, 'Named the World's Leading Intellectual Property Lawyer by Chambers & Partners, founding partner Spring Chang is a razor-sharp IP attorney who has advised and represented hundreds of major electronics, consumer, pharmaceutical, apparel and jewelry companies in the Chinese market, as well as Chinese companies overseas.'

We are immensely proud of Spring Chang's well-deserved recognition in the WIPR Leaders 2023 Directory. Her dedication, expertise, and unwavering commitment to excellence continue to position our firm as a trusted leader in the field of intellectual property.

Chang Tsi & Partners is a renowned intellectual property law firm committed to providing comprehensive legal solutions to clients worldwide. With a team of highly skilled professionals, we offer top-tier legal services in patent, trademark, copyright, and other IP-related matters. Our unwavering dedication to client success and our extensive industry knowledge set us apart as trusted advisors in the ever-evolving landscape of intellectual property.

