IP Protection in China for the Laser Industry

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https://intellectual-property-helpdesk.ec.europa.eu/
Mr. Matias Zubimendi is the IP Business Advisor at China IP SME Helpdesk, where he advises European SMEs on intellectual property rights matters. Mr. Zubimendi holds a Master’s degree in Chinese Civil and Commercial Law from Peking University as well as a Master’s degree in Intellectual Property Law from Austral University in cooperation with the World Intellectual Property Organisation. Mr. Zubimendi has a strong background in both business development and intellectual property rights protection, having previously worked as a China Business and Legal Consultant at Terragene, where he focused on business development and as a Director of Legal Affairs at Conquer Europe. Previously, he has also worked as a Patent and Trademark Attorney at Phoebus Abogados and Mazzeo & Canet, where he represented SMEs as well as Fortune 500 companies.

Mr. Zubimendi has given lectures at various conferences including the Ibero-American Conference on Chinese Studies and published several articles including *The legal protection of intangibles in the video games industry*. As a Professor Assistant, he has also given lectures on Commercial Law and Procedural law, while focusing on Copyright and AI in his research. Mr. Zubimendi is a native Spanish speaker fluent in English.
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Introduction to IPR

01

Intellectual property rights

1.1 What can I do with my IPRs?
- Monopoly
- Protect investments
- Conduct a business
  - Manufacture
  - Sell
  - Export
  - Import
- Licenses

1.2 Main principles
- Registration
  - First-to-file
- Territoriality
IPRs relevant for the laser industry

What types of IP should I pay attention to?

2.1 Invention patent / Utility models
- Products
- Process

2.2 Trade secrets
- Future products
- Business plans

2.3 Design patents
- Products
- GUI

2.4 Copyright

2.5 Trade marks

TIP – Prepare your strategy to be efficient: Combine the registrations methods.
Invention patent / utility model protection
- How to protect your inventions

### 3.1 Registration!
- CNIPA
- PCT

### 3.2 What can I register?
- Products
- Process
- Software?

### 3.3 Patent vs. utility model
- Parallel registration

### 3.4 Requirements
- Novelty
- Non-obviousness
- Industrial application
Invention patent / utility model protection
- New patent law

3.5 Patent extension
- CNIPA delay
- Market access

3.7 Damages
- Statutory
- Punitive

3.6 Open license system
- How to apply?
- Can I reverse my decision to use open license system?

Are there going to be new updates soon? Yes, implementing rules are coming soon.
Case study

Patents vs trade secrets?

Factors analyzed
- Reverse engineering (impossible to dismantle parts)
- Costs of registration
- Costs of enforcement
- Protection during registration vs technology life-cycle

Lessons learnt
- If reverse engineering is not possible, it is safe to protect your product with trade secrets
- Patent litigation is very expensive and takes several years
- Fixed protection term can eliminate patents as an effective way of IP protection if technology has long life-cycle
### Design patent
- The style of your products

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<th>4.1</th>
<th>What do design patents protect?</th>
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<td>Aesthetic aspects of a product</td>
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<th>4.2</th>
<th>Partial vs. overall aspect</th>
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<td>New patent law</td>
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<th>4.3</th>
<th>Graphic User Interface</th>
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<th>4.4</th>
<th>How can I register my design?</th>
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Copyright
- Software

5.1 Registration?
- Automatic protection – Berne Convention
  - Register anyway

5.2 What should I register?
- Software
- Databases
- Manuals
- Photos

5.3 Is it really useful?
- Internet Courts unique jurisdictions

5.4 Legalisation issues – Blockchain to the rescue
- Use of blockchain as evidence
Trade mark
- What’s your Chinese name?

Register now!
- First-to-file system
- When should I register?
- What should I register?

How can I register my trade mark?
- CNIPA
- Madrid System

Trade mark translation
- Phonetical
- Conceptual
- Mixture

Trade mark vs. copyright
- Combine protection methods
Technology transfer
- Be careful when sharing

7.1 When exactly is there a technology transfer?
- License
- Ownership
- Service providing

7.2 What laws should I check?
- Foreign Investment Law (2020)
- Regulation on the Administration of the Import and Export of Technologies (TIER) – 2019
- Catalogue for Prohibited and Restricted Technology Imports / Exports
- Negative Lists for Foreign Investments

7.3 Types of technologies
- Freely importable
- Restricted
- Prohibited

What happens if I export to China a technology that is prohibited for foreigners?
Technology transfer
- Be careful when sharing

Confidentially
- NDAs
- NNNs

License – Important clauses
- Territory
- Duration
- Content
- Royalties
- Control

Future technologies (developed during a license period)
- Ownership clauses
- Information protocols
- Trade secret protective measures
Due diligence

- How can I study a potential partner?

**8.1 What’s your name?**
- Made-up name of the Chinese company
- Legal name of the Chinese company

**8.2 Where can I get information?**
- National Enterprise Credit Information Publicity System (NECIPS)
- Chambers of Commerce
- Embassies
- China IP SME Helpdesk

**8.3 What information can I get from the NECIPS?**
- Legal representative
- Capital
- Business type / scope
- Sanctions
- Shareholders

**8.4 How to analyse that information?**
Red flags
Enforcement
- How to react efficiently?

9.1 I spotted an infringement, what should I do?
- Look for a lawyer
- Collect evidence
- Decide your jurisdiction

9.2 What are the possible jurisdictions?
- E-commerce platforms
- Regular commercial courts
- Internet courts
- Criminal courts

9.3 What should I analyse when choosing the jurisdiction?
- What do I want to achieve? Solve the problem or be compensated?
- How much money do I want to spend?
- How many infringers do I have?
- How much do I know about the infringer?
- How much evidence do I have?

9.4 I was contacted by a law firm already, should I go with them?
The price of not having a good lawyer
Takeaway messages

- Register your IP in advance
- Protect your unregistered inventions with trade secrets
- Combine the different IPRs to protect your business

- Study your partners
- Study the laws and bureaucracy of your sector
- Contact the public institutions to better understand the market

- Contact the China IP SME Helpdesk  question@china-iprhelpdesk.eu
HELPLINE
free, fast & confidential
3 days working

question@china-iprhelpdesk.eu

Your feedback is very valuable info for us.
We appreciate if you could share your comments with us.