

Handling Changes and challenges faced by businesses today

应对企业界当前面临的变化与挑战

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ABOUT HFG 关于恒方



China Offices
中国办事处

- Shanghai
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HFG Professionals
恒方专业人士

- 60 professionals with legal/scientific background
- Multi-national team
- Depth of experience (average 15 years)
- Languages spoken: EN, CH, FR, IT, JP, ES, RU

- 60名法律/理工背景专业人士
- 多国团队
- 经验丰富 (平均15年)
- 多语种: 英语、汉语、法语、日语、西班牙语、俄语



Client Base
客户群体

- Multinational companies
- Small/medium enterprises
- Law firms
- IP agents/firms

- 跨国公司
- 中小企业
- 律师事务所
- 知识产权代理人/事务所

Agenda 主要内容

1. Setting the stage: counterfeits at EU borders 背景：欧盟边境假冒商品猖獗
2. Changes of the E-commerce law and their effect on businesses 《电商法》的变化及其对企业的影响
3. Challenges for foreign businesses in China 在华外资企业面临的挑战
4. Enforcement in in the e-commerce environment 电商背景下的执法情况
5. Legislative and judicial changes making enforcement better 如何利用立法、司法的变化提高执法水平

EU Customs intelligence 2018: Counterfeits caught at EU borders

2018年欧盟海关情报：欧盟边境查获的假冒商品

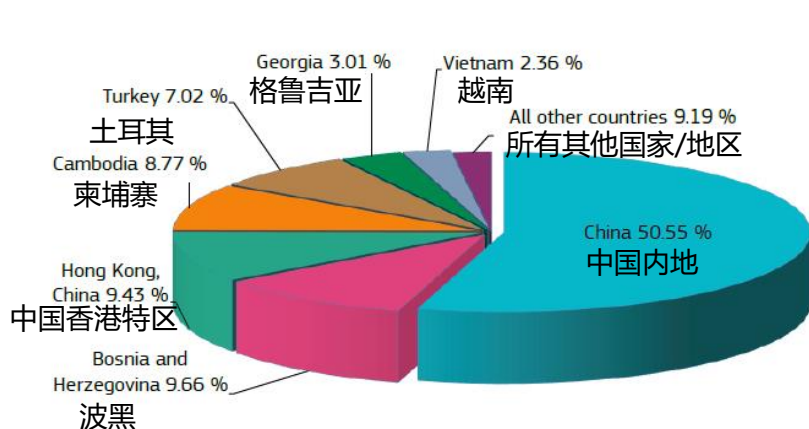


图11. 来源国家/地区分布 (物品总量)

Chart 11. Country of provenance by articles

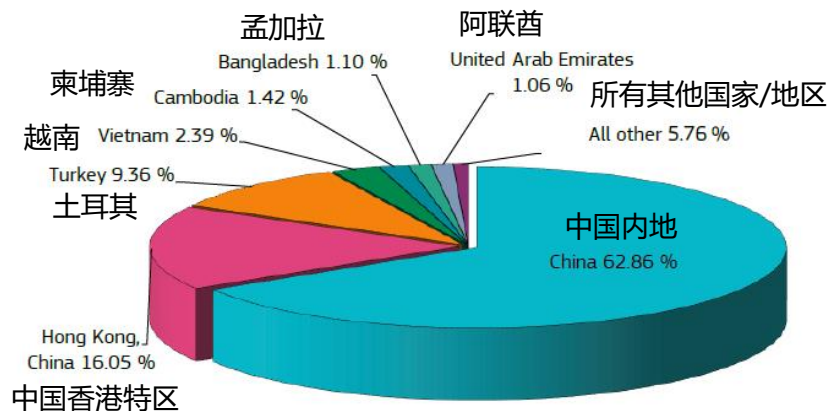
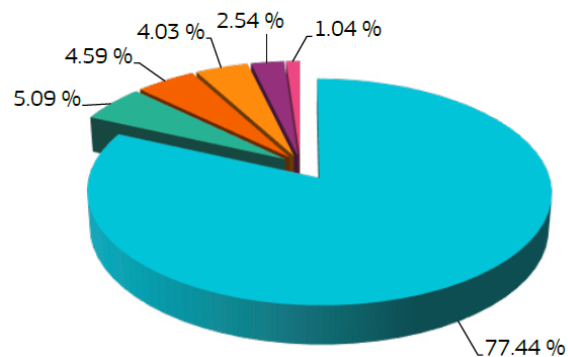


图12. 来源国家/地区分布 (物品价值)

Chart 12. Country of provenance by value

案例百分比排名前五的来源国家/地区
Top five countries of provenance in % cases



中国内地 China
 中国香港特区 Hong Kong, China
 新加坡 Singapore
 未知 Unknown
 土耳其 Turkey
 美国 USA

查获总计	2017	2018
Detention totals		
案件数	57 433	69 354
程序数	74 706	89 873
物品量	31 410 703	26 720 827
欧盟境内零售价值 (欧元)	582 456 067	738 125 867

Annex 6. TOP THREE COUNTRIES OF PROVENANCE BY NUMBER OF ARTICLES

附件6. 物品量排名前三的来源国家/地区

中国内地		物品件数	占总数%
1. China		Articles	% of total
玩具	Toys	2 920 346	28 %
其他护肤用品 (剃须刀、洗发水、除味剂、牙刷等)	Other body care items (razor blades, shampoo, deodorant, toothbrushes, etc.)	1 019 164	10 %
食物	Foodstuffs	706 690	7 %
药品	Medicines	672 558	6 %
其他商品	Other goods	611 757	6 %
衣物 (成衣)	Clothing (ready-to-wear)	516 331	5 %
遮阳镜和其他眼镜	Sunglasses and other eyeglasses	515 662	5 %
香烟	Cigarettes	508 400	5 %
手机零配件	Parts and technical accessories for mobile phones	437 816	4 %
运动鞋	Sports shoes	411 208	4 %
总计 Total		10 486 958	
中国香港特区		物品件数	占总数%
3. Hong Kong, China		Articles	% of total
标签、标贴	Labels, tags, stickers	639 873	33 %
手机零配件	Parts and technical accessories for mobile phones	480 848	25 %
玩具	Toys	253 206	13 %
衣物 (成衣)	Clothing (ready-to-wear)	116 116	6 %
包装材料	Packaging materials	115 482	6 %
游戏 (包括电子游戏控制器)	Games (including electronic game consoles)	69 722	4 %
其他护肤用品 (剃须刀、洗发水、除味剂、牙刷等)	Other body care items (razor blades, shampoo, deodorant, toothbrushes, etc.)	44 831	2 %
衣物配饰 (腰带、领带、披肩、帽子、手套等)	Clothing accessories (belts, ties, shawls, caps, gloves, etc.)	26 940	1 %
汽车, 包括零配件	Vehicles, including accessories and parts	25 442	1 %
其他商品	Other goods	22 076	1 %
总计 Total		1 956 823	

E-commerce law in practice 实践中的电商法

On 1st January 2019, the Chinese E-commerce Law came into effect
《中国电子商务法》于2019年1月1日生效

Article 9 E-commerce law 《电商法》第九条

Definition of e-commerce platform 电商平台的定义

Social media platforms argue they are not e-commerce platform as they are a telecommunication service

社交媒体平台辩称其为电信服务商，并非电商平台

Compromise privacy of users that establish one on one communication?
损害一对一通信用户的隐私？

However, more and more counterfeits on social media platforms
然而，社交媒体平台上的假冒商品越来越多

Businesses need for law to decide upon status of social media companies
企业需要能够进一步厘清社交媒体平台责任主体的法条

E-commerce law in practice 实践中的电商法

Article 42 : notice and take down procedure with e-commerce platforms in case of infringement on platforms.

第四十二条：平台侵权事件发生后，电商平台的侵权通知及商品删除程序。

Article 43 reduces this liability as “an operator on the platform, upon receiving the transmitted notice, may submit a declaration of non-infringement to the e-commerce platform operator”,

第四十三条减轻了这种责任，因为“平台内经营者接到转送的通知后，可以向电子商务平台经营者提交不存在侵权行为的声明”。

and 而且

“the e-commerce platform operator, shall transmit the declaration to the IP right holder and direct it to complain to competent authorities or take its case to the people’s court within 15 days, as otherwise the case will be terminated”.

“电子商务平台经营者接到声明后，应当将该声明转送发出通知的知识产权权利人，并告知其可以向有关主管部门投诉或者向人民法院起诉。电子商务平台经营者在转送声明到达知识产权权利人后十五日内，未收到权利人已经投诉或者起诉通知的，应当及时终止所采取的措施。”

In practice 15-day limit not a hard line, which is good for businesses.

实践中，15天限制并非强制规定，这对企业有利。

Business cannot afford going to administrative or court for every single case.

企业不可能将每个案件都提交行政部门或法院。

E-commerce law in practice 实践中的电商法

Chinese E-commerce platforms not sharing information of infringer and allow individuals and companies to set up many shops on their platforms.

中国电商平台不共享侵权人信息，且允许个人和企业平台上开设多家网店。

Most platforms have no filtering software to prevent this from happening.

多数平台没有预防此种情形的过滤软件。

One counterfeiter could have many shops, making it cumbersome for right holders to take down these shops, as notice and takedown mechanisms work mostly per individual case. 造假者可开设多家网店，增加了权利人删除侵权网店的难度，因为通知和删除机制通常仅作用于单个网店。

Takes too long to deal with a single infringement case. A shop can re-open again if it has sold IP infringing products.

处理单独侵权案例耗时过长。已售出侵权产品的网店还可以再次开张。

Many e-commerce platforms have reportedly not wished to disclose information regarding the infringer. Thus, enforcement actions of right holders are delayed.

许多电商平台表示不愿意披露侵权人信息，权利人的执法行动因而遭到延误。

Need for tool for businesses to gather information from e-commerce platforms

企业需要能够从电商平台收集信息的工具

E-commerce law in practice 实践中的电商法

E-commerce platforms often require the Chinese IP certificates in order to enforce IPR on their platforms

电商平台经常要求提供中国知识产权证明文件才能在其平台上开展执法行动

Require a Chinese certificate of IP right in advance. This delays procedure of enforcement, 要求事先提供中国知识产权证明文件，导致执法程序延迟。

Copyright, according to the Berne Convention, exists the moment a work is made, and China has created a copyright registration system in order to prove the right of copyright. The problem is not with this registration system, but with the need for e-commerce platforms to see this copyright certificate.

依据《伯尔尼公约》，作品一旦完成，著作权便存在。中国有著作权登记制度，用于著作权的证明。问题不在于登记制度本身，而在于电商平台对著作权证书的查看需要。

Many e-commerce platforms in China do not accept copyright infringement cases or trademark cases if there is no Chinese copyright registration certificate or Chinese trademark certificate.

如果没有中国著作权登记证书或中国商标证书，许多电商平台就不受理著作权或商标侵权案件。

Challenges for foreign companies in China

在华外资企业面临的挑战

To WIN: 要胜诉

Need registration of trademark, patent, copyright or unregistered right AUCL
根据《反不正当竞争法》，需要登记商标、专利、著作权或未注册的权利

Biggest misunderstandings registration 最大的误解 “登记”

- Foreign trademark and protection for China 外国商标与对中国的保护
- Classes and subclasses 类别与子类
- Chinese language trademark 中文商标
- design rights and Chinese patent law 外观设计权与中国专利法
- Prior rights for getting back tm (copyright etc.) 取回商标 (著作权等) 需在先权利

Enforcement 执法

- Obtaining evidence 获取证据
- Notarisation of evidence - needed in China 证据公证 ——在中国需要
- Notarised and legalised PoA - needed for action 经公证的合法授权委托书——执法行动需要

E-commerce 电子商务

- ✓ 82% of postal packages containing fake goods entering EU are from China (2018 EU Customs intelligence).
- ✓ 进入欧盟的含假冒商品的邮政包裹中，82%来自中国（2018年欧盟海关情报）。
- ✓ Check CN ecommerce platforms
- ✓ 检查中国电商平台
- ✓ Sellers often use images from company website, trademark or the photographs and text from product catalogue
- ✓ 卖家经常使用来自公司网站的图片、商标、或来自产品目录的照片和文字

Notice-and-
take-down
通知及删除

Trademark
and copyright
商标及著作权

Investigate
first full
Overview
摸清来龙去脉

Sample
Purchase
样品购买

Notarise first
if plan is
to shut down
production 如果申请
叫停侵权商品的生产
，首先要做好公证

Strategy against counterfeiters 打假策略

Market Monitoring
监控市场



Circumstances Mastering
掌握情况



Responding
进行反击



Effects Confirming
确认效果

- Investigation in Exhibition or counterfeits sold online 调查网络销售的展品或假冒品
- Monitoring Physical Shops 监控实体店
- Monitoring similar & illegal products 监控类似或违法产品

- Online investigation 网络调查
- Investigating AIC & domiciliary registration info 调查工商和住所登记信息
- On-site investigation 现场调查
- **Notarisation 公证**

- Warning with C&D letters, negotiations 发出制止函警告; 进行协商
- Administrative & Criminal strike, strike by e-commerce platform 行政及刑事打击; 电商平台打击
- Civil litigation 民事诉讼

- Education by attorney; Ex post reeducation (effects confirming) 律师教育; 事后再教育 (确认效果)
- Follow up on enforcement of punishment 跟进处罚执行情况
- Double check of webpage modification & elimination (in certain period) 核实网页修改及删除情况 (一段时间后)
- Ensuring enforcement of judgments 确保判决执行

Enforcement 执法



STEP I 第1步

Notarised evidence in China by Chinese notary

经中国公证机构公证的证据



STEP II 第2步

Ecommerce complaint 电商投诉

Administrative enforcement 行政执法

Civil enforcement 民事执法

Criminal prosecution 刑事起诉

Customs protection 海关保护

Negotiations 协商

Current case online counterfeits in practice

真实网络造假案例

Trademark infringement 商标侵权

Infringing facts: 侵权事实:

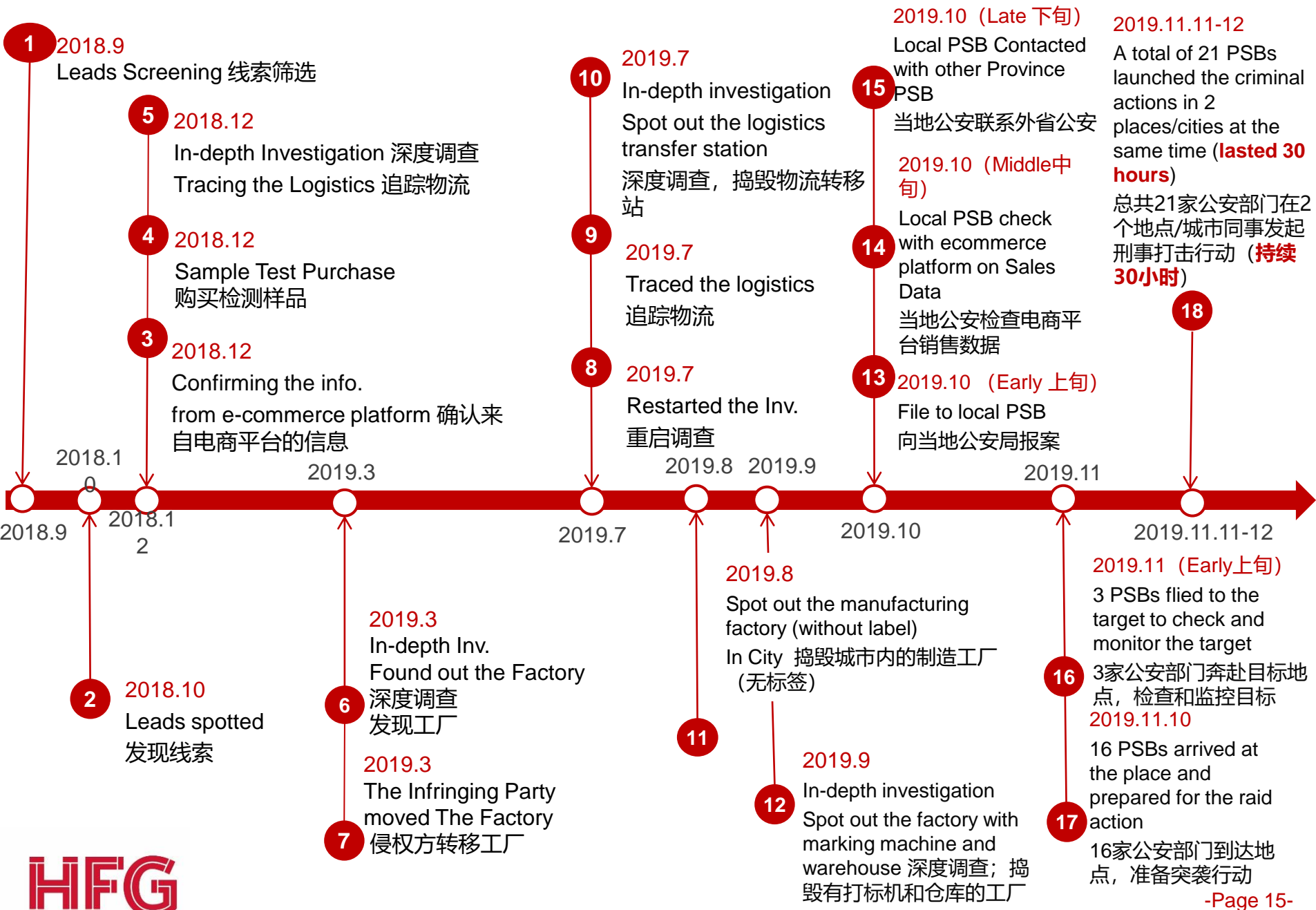
- The infringers manufacturer and **sold counterfeit products** client through **online shops** in China.
- 侵权人制造并通过中国境内**网店出售假冒产品**。
- The **online sales** amount was confirmed to be **RMB 6 million** in the investigation by PSB in the case.
- 经公安局调查，网上销售额达**600万元**。

INVESTIGATION is key 调查是关键

Measures of right protection: 维权措施:

- Criminal Raid action 刑事突袭行动
- Criminal Lawsuit & Negotiation for Compensation 提起刑事诉讼，进行赔偿协商
 - 1 million RMB through negotiations + 3 million fine 赔偿100万元+罚款300万元
- Civil Lawsuit 民事诉讼
 - for further compensation from other targets 获取其他投诉对象的赔偿

Overview & Time Line of the Case 案例概况及时间线



Amendments to Trademark Law 《电商法》修订

Issued on 23 April 2019 and effective from 1 November 2019
2019年4月23日颁布，2019年11月1日生效

1. Curbing bad faith trademarks by allowing rejections for bad faith at the trademark application stage.
允许在商标申请阶段驳回恶意申请，从而遏制恶意商标注册行为。

2. Increasing damages for infringement (5 ml RMB statutory damages / up to 5 times revenues in case admin punishment).
提高侵权赔偿额（法定赔偿500万元/行政处罚可高达5倍非法所得）。

Regulations on the Registration of Trademarks were published (effective 1 December 2019) clarifies the elements indicating bad faith and trademark hoarding under the new article 4 of the TML.

《规范商标申请注册行为若干规定》（2019年12月1日生效）依据新《商标法》第4条，对商标恶意注册与囤积行为的指示要素做了澄清。

《商标法》列出的恶意行为

第4条	恶意+不以使用为目的
第7条	善意
第13.1条	他人未在中国注册的驰名商标
第13.2条	他人已经在中国注册的驰名商标
第15.1条	代理人或代表
第19.4条	商标代理机构
第32.1条	侵害他人在先权利
	著作权
	个人名称
	公司名称
	影片名称
第32.2条	不正当手段+已经使用并有一定影响
第44条	欺骗或其他不正当手段

Bad Faith In Trademark Law			
	2019	2014	2001
ART. 4	Malicious + not for the purpose of use	X	X
ART. 7	Good faith	V	X
ART. 13.1	Unregistered Well-known trademark	V	V
ART. 13.2	Registered Well-known trademark	V	V
ART. 15.1	Agent or Representative	V	V
ART. 15.2	Any relationship + use in China	V	X
ART. 19.4	Trademark agency	V	X
ART. 32.1	Infringement of other prior rights	V	V
	_ Copyright	V	V
	_ Personal Name	V	V
	_ Company Name	V	V
	_ Title of Movie	V	V
ART. 32.2	Improper means + prior use with influence	V	V
ART. 44	Fraud or other improper means	V	V

Amendments to Patent Law 《专利法》修订

Interesting changes for e-commerce: design patents 电商相关变化：外观设计专利

1. Partial designs
protection 部分外观设计
保护

2. 15 year protection of
design patents 外观设计
专利15年保护

Promulgated on 17 October 2020 and effective from 1 June 2021.
2020年10月17日颁布，2021年6月1日起生效。

Fabbri 法布芮

Decision July 29 2020 Shanghai Yangpu District People's Court has recognized Fabbri's packaging
上海杨浦区人民法院2020年7月29日做出判决，认可法布芮包装

Blue-and-white "faentino" decoration
蓝白“费恩蒂诺”装潢

Enjoying high reputation ex art. 6.1 of Anti-Unfair Competition Law ("AUCL").
具备高度影响（依据《反不正当竞争法》第6.1条的定义）。



Fabbri 法布芮

3 step reasoning: 3步论证:

Is Fabbri's product packaging enjoying certain influence in the Chinese market? 法布芮的产品包装是否在中国市场具备一定影响?

Due to Fabbri's long-term and extensive product promotion as well as a large number of marketing and selling activities, Fabbri packaging enjoy certain influence. 经长期广泛的产品推广、销售活动, 法布芮的包装具备一定影响。

Is Yipai product packaging similar to Fabbri's product packing? 伊派产品包装是否与法布芮产品包装相似?

Based on overall visual effects, Yipai product packaging is similar to Fabbri's product packaging. 伊派的产品包装与法布芮的产品包装整体视觉效果相似。

Would there be confusion among the relevant public? 是否会造成相关公众的混淆?

Relevant public might confusingly believe that there are connections between the defendants and Fabbri due to the similarity of both parties' product packaging.

被告与法布芮产品包装的相似性, 可导致相关公众错误地认为双方存在关联。



Fabrizi 法布芮

Difficulty to obtain the recognition by the Court that the packaging is largely known to consumers.
难以让法院认可该包装已基本为消费者所知。

Under the previous legislation (in force until **2017**) was required that the object of protection was **“famous”**.
依据以往立法（**2017**年以前有效），保护对象必须 **“知名”**。

Under the **current AUCL** the word **“famous”** has been substituted with the sentence **“enjoy certain (high) reputation”**.
依据**现行《反不正当竞争法》**，“知名”一词替换为 **“具备一定（高度）影响”**。

To prove such high reputation, it is necessary to provide the court with a large amount of evidence of use.
要证明此种高度影响，有必要向法院提供大量使用证据。

Plaintiff has to contribute with a **massive work of evidence collection** starting from the time in which the company entered the market and with **special focus on the last 3-5 years**.

原告必须**开展海量证据搜集工作**，证据时间跨度要从公司进入市场开始，**特别关注最近3-5年**。



CASES 案例

Land Rover vs Land Wind 路虎诉陆风



March 13, 2019, Beijing Chaoyang District Court ordered Land Wind Corporation to cease the production, sales and marketing of its X7 model cars and compensate 1.5 million yuan for damages and reasonable expenses of Jaguar Land Rover Corporation in the unfair competition case. 2019年3月13日，在路虎诉陆风的不正当竞争案件中，北京朝阳区人民法院命令陆风停止生产、销售和推广X7车型，并向捷豹路虎赔偿150万元。

“The relevant public can link the shape and structure used by the “Evoque” model car to Jaguar Land Rover’s specific model car products due to the long-term publicity and use, with function to identify the source of goods”. “经过路虎的长期宣传和使用，相关公众能够将“揽胜极光”车型所使用的形状构造装潢与路虎特定型号汽车商品联系起来，从而起到识别商品来源的作用”。

The appearance of “Evoque” model car possess the requirement of “decoration with certain influence” provided on Art 6.1 of Anti-unfair Competition Law of the People’s Republic of China. “揽胜极光”车型外观属于《中华人民共和国反不正当竞争法》第6.1条规定的“具有一定影响的装潢”。

The shape and decoration of Jiangling’s “Land Wind X7” car and the “Evoque” car are similar in term of overall visual effect including suspended roof, push-down roof, raised feature lines, engine cover, vehicle outline. “陆风X7”车型与“揽胜极光”车型在整体视觉效果上相似，包括下压式车顶、悬浮式车顶、上扬的特征线条、蚌壳式发动机盖、整车轮廓造型。

Thanks for your time!
谢谢!



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