

China Law & Practice

Special Focus



Intellectual Property

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Managing one of the world's largest patent portfolios



Shen Jianfeng, Director of ZTE's IP Department, spoke to David Tring about strategy, counterfeiting and how to effectively manage IP at R&D centres

What is the general structure of ZTE's legal department?

At ZTE, great importance has been placed on intellectual property rights (IPR) strategy. According to ZTE's business demand, there are sections with different functions which make up the legal department. IPR managers in various sections are separately responsible for strategic planning, performance evaluation, risk management, licensing and operation, patent prosecution, intellectual property commercial competition, as well as litigation and negotiations.

Each position has a clearly defined duty and generally each IPR manager is independently responsible for the work covered by their own scope. However, for significant matters or tasks that require cooperation, I choose to organise a virtual team with a leader to coordinate and manage human resources in order to complete these particular tasks. Thus, with a combination of centralised management and decentralised

cooperation, an efficient and advanced IPR management system can be formed.

How do you tackle counterfeiting?

In recent years, counterfeiting has become rampant and has a very bad affect on ZTE's product market. In recent years, we have found many cases of counterfeiting. These cases involved products like batteries, cell phones, data cards and others. Our cooperation with the Administration for Industry and Commerce and public security departments has meant ZTE's IPR department has helped the company avoid enormous economic loss.

What recent changes to IP legislation have affected your work?

We attach great attention to the changes in IP legislation. Once I am aware of such changes, I will promptly organise a discussion within the department to assess the impact of these

changes. Not long ago, SIPO made publicly available a draft of the proposed *Service Invention Regulations* (国家知识产权局职务发明条例). The service invention system is a basic system for adjusting the ownership of the rights and profit distribution, which will also bring certain challenges to many enterprises in terms of compliance with reward and remuneration issues in China. I organised a special group to carry out general research on this draft and submitted our own comments to SIPO.

What are some of the IP issues involved with research and development?

In China, a research and development project involves many IP issues. For example, early in the project, if the project team did not perform a novelty search carefully, they might risk infringing the patent rights of other businesses. If some companies used pirated software during a research and development project, they might face the risk of infringing copyright. Finally, when a product is shipped, if the research team used someone else's trademark, they might risk infringing trademark rights.

ZTE fully respects the intellectual property of others, we are committed to accelerating innovation through collaboration and support for intellectual property rights. Over the years, the IPR department has been strengthening the IP protection awareness of the staff. To protect our own intellectual property rights, ZTE has set up an efficient and sophisticated IPR management system. We put intellectual property protection into the whole process of research and development execution. In the process, IPR managers should go into the R&D centre to collaborate closely with the

research fellows on each project. Measures, such as designing-around and patent monitoring are in place to prevent potential risks.

What is a typical workday like for you?

Currently, I am responsible for developing and revising the intellectual property rights strategy, risk management, intellectual property operation, intellectual property assets reserve and intellectual property litigation management. Every weekday, I focus on these responsibilities.

What are some IP trends you are witnessing?

First, the patent wars between high-technology companies are increasing. I am acutely conscious of the increasing pressure of IP litigation, not only because the communications industry is technology intensive, but because Chinese communications enterprises are expanding rapidly all over the world. In the past ten years, ZTE has experienced explosive growth in patent applications. ZTE is now one of the leading patent holders among vendors in the telecommunications industry internationally, having filed applications for 48,000 patents globally. Our rapidly growing patent portfolio will help reduce the risks of IP litigation. The tremendous growth in ZTE's patent applications has been important in dealing with foreign tycoons and patent trolls. We have cast off our passive attitude.

Second, innovation of IP business models is particularly active. Intellectual property assets are among the most valuable assets at a company and it is increasingly important to leverage them for competitive advantage. IP business models are mature and systematic in developed countries. In the past two years, new patent operation centres have sprung up all over China. ZTE is actively participating in IP operations, which will in turn reduce R&D costs for innovators and increase the profits of our company. So far, we have tried many methods of patent management. We have adopted for example, patent auction, patent licensing, patent shares, internal licensing and patent pools building.

How do you manage IP protection around the world?

The IPR department has a very professional team. Expertise of law, communication technology and business are combined in the team. Every IPR manager has legal talent and is specialised in multiple academic fields. I have established a regular meeting system within the IPR department. Section members meet once a month to discuss and suggest solutions to work problems. At our regular meeting, everyone can express themselves freely. Together we can pool resources and find the best answers to the many IPR problems.

As I have said before, an efficient and perfect IPR management system has been formed in

ZTE. We put intellectual property protection into the whole process of research and development execution, market sales, logistics and purchasing. We have successfully implemented IP risks prevention and controlling in a comprehensive way and for this reason we can effectively prevent IP risks. I am also looking into the project operation of our IP protection. A project management system has been applied to IPR litigation and negotiations. Because of this system, most of the IPR litigation and negotiations problems have been solved in an appropriate manner.

What qualities do you look for when working with external counsel?

First, we usually hire different law firms according to different situations in different countries, and for grave and complex cases we will be very careful to designate a key law firm. Furthermore, we are looking for external counsel with the following qualities:

- Rich experience in dealing with IPR cases and especially good at handling cases in the communications field;
- Outstanding case management capacity and the ability to solve any unexpected issues;
- Excellent communication skills with experience in Chinese, European and US cultures;
- Experience in cost reduction and expense control. Reasonable prices for customers qualified to provide quality service.

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Sophisticated counterfeiters and stronger enforcement

Chinese and foreign companies need to employ anti-counterfeiting strategies as actions against companies with registered intellectual property can be difficult

Contrary to what many people believe, the open manufacture and sale of counterfeit products is becoming uncommon in China. However, the losses caused to both foreign and Chinese companies from sophisticated counterfeiting operations and infringement increases every year. Strategic development of intellectual property rights and active enforcement will reduce the risks from these counterfeiters, infringers and growing competitors.

Every year, many Chinese companies maliciously register intellectual property and take advantage of the reputation of other companies to frequently sell sub-quality products. Increased investment in prosecution and enforcement provides long term benefits in protecting the reputation of brands and supports current operations and future expansion in the growing Chinese market. If a suspected counterfeiter or infringer is found and not investigated and challenged, there is a very real risk that its business could grow larger and larger, making it increasingly difficult to challenge its use in the future.

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Spring Chang, Chang Tsi & Partners

Chinese government agencies and courts have recently become more active in enforcing intellectual property rights, especially in eastern China. When companies file complaints and do enforcement work, government agencies are also more likely to pay attention to their trademarks. In recent months, our firm has regularly been contacted by local Administration of Industry and Commerce (AIC) officials and the Public Security Bureau requesting verification that seized goods were counterfeit after they had conducted raids. Previously, raid actions prior to the filing of formal complaints were less common.

Unfortunately, but understandably, the government is also enforcing and recognising rights secured by savvy counterfeiters. Chinese companies and individuals have applied for and registered millions of trademarks, patents and domain names. Many of the intellectual property rights secured are similar to, or identical with, those developed by known companies, their competitors or even their business partners. The former counterfeiters then become the legal rights owners and cancelling their marks and invalidating their patents is often challenging. Anti-counterfeiting actions against these companies with registered trademarks and other intellectual

property becomes more difficult, although we are also increasingly seeing favourable judgments in these challenging cases as well.

In this article, we describe how to outmanoeuvre these sophisticated Chinese counterfeiters. We begin by providing an overview of the active enforcement occurring and prosecution issues in China. Then, we discuss the need for intellectual property audits and an aggressive prosecution strategy for trademarks, copyrights, design, utility model and invention patents, and domain names. Finally, we describe how to effectively perform anti-counterfeiting work through cease and desist letters, administrative raid actions and penalty decisions, civil litigation and criminal prosecution, and customs protection.

We have handled a number of matters where our clients have had their goods detained at China Customs because someone else registered their intellectual property in China and recorded it at customs. And, Chinese companies have also registered companies and secured trademarks in foreign jurisdictions in order to claim

that their shipments containing counterfeit products are original equipment manufacturing (OEM). Stopping these sophisticated counterfeiters is possible, but careful planning and initial investments are often required.

Enforcement and prosecution

Administrative and judicial enforcement of intellectual property has increased in recent years. In 2012, AIC officials inspected 394,500 markets and investigated and prosecuted 120,400 infringement and counterfeiting cases, with an estimated value of over Rmb2 billion (\$326 million). Of these administrative enforcement actions, 59,085 cases were trademark infringement and counterfeiting cases and 14,033 of those cases included foreign rights owners. Also, in 2012, there were 12,974 first-instance criminal cases concluded and criminal judgments became effective against 15,338 people - an increase of 94% from 2011.

However, the number of registered trademarks and patents makes prosecution and enforcement work more challenging. In 2012, 1.6 million trademark applications were filed in China, an annual increase of over 15%. For 11 years now, China has had the largest number of applications in the world. The number of oppositions is also large and increasing, and 73,000 trademark opposition cases were decided last year, an increase of nearly 30% from 2011. By the end of 2012, 4486 trademarks had been recognised as well-known through administrative proceedings including oppositions.

In 2012, the State Intellectual Property Office (SIPO) received a total of over two million patent applications, including 650,000 invention patent applications, 740,000 Utility Model applications and 657,000 design patent applications. Domain names are also

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often registered by so-called cyber squatters and may be used to sell counterfeit goods. By the end of 2012, China had 7.5 million .CN domain names, an increase of over 112 percent from 2011. In addition, the number of 中国 Chinese domain names reached 280,000. Registering key domain names for defensive purposes is significantly more cost-effective than reclaiming a domain name through the Asian Domain Name Dispute Resolution Centre or civil litigation.

Hermès and trademark markets

The Chinese government is serious about enforcing intellectual property. However, counterfeiters are often able to register or purchase or licence trademarks or patents that are identical or similar to those of other known companies. The success and troubles of Hermès in China illustrate the potential for meaningful enforcement, but also the attention that needs to be spent on trademark oppositions and cancellations.

In a widely publicised decision in August 2012, Heyuan Intermediate People's Court in Guangdong Province sentenced Xiao Zhenjiang to life in prison. According to a statement on the Court website, Xiao was found with Rmb100 million yuan worth of fake Hermès products. Three of his accomplices were also sentenced to seven to 10 years in prison and were handed fines of Rmb500,000 to 800,000.

Although in April 2013, the sentence for Xiao was reduced to six years the case still has had a strong deterrent effect. Trademark violations under the *PRC Criminal Law* (中华人民共和国刑法) provide for criminal sentences up to seven years, but Heyuan Court had issued a life sentence for the manufacture and sale of

substandard products. Xiao and his gang were well organised, but they did not have a registered trademark. However, they could easily have bought one.

Currently, one of China's many online marketplaces to purchase trademarks, Famous Trademark Assignment Net (名牌商标转让网), features the trademark H FRG EMMAS. Although there are several different English letters in this registered trademark than the real trademark, the website prominently features the mark together with a variation of the distinctive Hermès carriage along with a variation of the common Chinese name for Hermès. Unfortunately, for the French Hermès, they were not successful in registering their Chinese version mark in China.

The price for H FRG EMMAS is negotiable, but similar imitation marks have sold for hundreds of thousands of dollars. Hermès should probably file a cancellation in dispute against this mark, but even with the clear bad faith such an action will be more challenging than opposing the mark initially – which was not done. Opposing and preventing the registration of similar marks is a key component of anti-counterfeiting.

Even third-party registrations of a foreign company's house mark – and the Chinese versions – are still common. For these types of marks, requests for millions of renminbi for registrant of a company's own trademark are not unusual. Nearly everyone in China knows that Proview Electronics managed to obtain \$60 million from Apple for the iPad trademark that Apple thought it had already purchased. Although not a counterfeiter, Proview Electronics's iPad trademark and the surrounding media coverage increased awareness of the value of selling trademarks.

IP audits and prosecution

The key to successful anti-counterfeiting work is registering intellectual property in China. Companies need to make sure that their existing intellectual property rights in China are sufficient to support their business, especially potential expansion in China. Thus, it is important to conduct extensive audit work regularly.

Audit work forms the foundation of a company's intelligence on whether their rights have been sufficiently protected and whether there are similar or identical marks against which actions need to be taken. The audit work will also help companies to determine how to strategically proceed with necessary action, both now and in the future.

Key issues for trademark prosecution include Chinese version marks and the sub-class principle. Many companies are still unaware of the threat posed by the Chinese equivalents of their trademarks and unfortunately there are often many characters with similar pronunciation and appearance. These Chinese equivalent marks are better recognised and more familiar to consumers in the Chinese market. Therefore, it is strongly recommended to figure out and register Chinese equivalent marks as soon as possible. Also, in China each international trademark class is further classified into many Chinese local subclasses and the registration of a trademark in one subclass cannot prevent others from registering similar trademarks in other subclasses.

It is also important to consider the potential for design patents, as well as potentially utility model and invention patents. Domain name registrations are also another area that needs to be carefully considered.

Anti-counterfeiting strategy and customs

Once intellectual property rights are secured it is highly recommended that they be recorded at customs and market surveys be undertaken to determine the extent of any potential infringement. Once market surveys are completed, investigations should be done to determine the key sources and key evidence may be notarised. Then complaints can be filed and administrative or police raids conducted. Following a raid, penalty decisions will be issued and civil or potentially criminal liability may be pursued. These successful cases against the key infringers will provide a strong deterrent in the market.

Based on our experience, usually we can prevent the significant majority of infringing acts by means of investigation, notarised purchase, administrative or police action and follow-up checks. Moreover these actions would also continue to produce a deterrent effect in the key markets.

China customs is also effective at stopping the export of counterfeit and infringing goods. Because some courts believe that OEM should be defined as unauthorised use of a trademark in China, the court may find use of an unregistered trademark in your OEM in China infringes upon the trademark right of the Chinese registrant of the trademark (copycat). Chinese companies have also registered companies and secured trademarks in foreign jurisdictions in order to claim that their shipments containing counterfeit products are OEM.

Chinese counterfeiters understand and know how to navigate

China's intellectual property law – and the serious risks of counterfeiting. We have used the term counterfeiters expansively to refer to any company or individual that takes an advantage based on the reputation of another company through copying or imitating its intellectual property. This expansive definition of counterfeiters represents the reality on the ground. In many cases, we have found companies in China manufacturing some products using their own mark, or a registered or unregistered variation of another company's marks and then secretly producing entirely counterfeit products as well.

Previously, much of our work dealt with helping clients register and enforce their trademarks against Chinese companies that were copying and selling our client's products using our client's trademarks. Now, we are seeing more and more of these same companies applying for similar trademarks and copying our client's products while applying and protecting themselves with design, utility model and invention patents of their own. These companies then often use shell companies or related companies to register domains and use online sales via third-party websites to sell goods across China and around the world. Effectively stopping these increasingly sophisticated counterfeiters requires strategic development of intellectual property rights and active enforcement.

*Spring Chang and Steven Andrews
Chang Tsi & Partners, Beijing*

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IP issues with R&D centres

In 2000 China had 100 foreign R&D centres. That number now stands at 1600 and is set to increase. Foreign companies need to understand the IP challenges in operating a R&D centre

As Chinese customers call for higher supply of products and services, multinational companies and SMEs need to develop tailor-made solutions to cater for this ever-growing market. From pharmaceutical to automotive, from textile to machinery, product creation moves closer to its new end-users. This also reflects in more R&D centres being set-up in China, either as a wholly foreign-owned enterprise or as a joint-venture with a PRC shareholder. R&D activities of foreign companies enter the radar of PRC laws. IP-related issues shall therefore be considered now from a PRC law perspective.

Invention ownership

From a legal perspective, this is probably the main issue for foreign investors. In practice, R&D activities are normally carried out by researchers hired through an employment agreement. The *PRC Patent Law* (中华人民共和国专利法) and the *Implementing Rules for the PRC Patent Law* (中华人民共和国专利法实施细则) grant to the employer the ownership of the invention as long as this is a service-invention, which is defined as the invention having been accomplished:

- 1) during execution of the employee's duty; or
- 2) in execution of any task, other than employee's duty, entrusted to employee by the employer; or
- 3) within one year after the retirement or transfer of the employee from the original employer, where the invention-creation relates to the employee's duty or the other task entrusted to the employee by the previous employer; or
- 4) mainly by using the material and technical conditions of the employer (including the employer's money, equipment, spare parts, raw materials or technical materials not disclosed to the public). In this case, however, the service-invention belongs to the employer only in the absence of a different agreement by the parties.

Beyond these cases, the invention is considered as a non-service invention, which always belongs to the inventor. Qualifying an invention as service rather than non-service is critical; even if the law seems to set a clear difference, in practice, the border may be rather blurry and uncertain.

PRC courts use a substantial approach to assess the existence of an employment relationship. Employees temporarily transferred from other entities are considered as normal employees for service-invention purposes. Legal relationship, employment subordination as well as payroll are used to assess the existence of an employment relationship. For example, a former employee immediately re-hired

as an independent consultant after his retirement was deemed an employee and his invention – developed after the re-hire – was considered a service-invention on the grounds that there had been neither substantial interruption of the employment nor any change in the way the employee performed its work. This was held in the *Sinopec Shanghai v Gao Xi* before the Shanghai People's Court in 2008.

Particularly dangerous is the invention by newly-hired employees during the first year of employment, which belongs to the previous employer if linked to the tasks carried out with the previous employer. In *Connings v Shanghai Hongliu* in 2012, Shanghai High Court held that the invention developed by four newly-hired employees could actually be linked to their tasks under the previous employer – as shown by the corresponding job description – who was therefore granted the patent application right. Courts can also question inventions accomplished after such one-year period, if they are too similar to inventions within this period.

As for inventions developed by using the employer's resources, courts distinguish whether the employee had mere access to such resources – which shall not configure per se service-invention – or rather had actual intention of using those to develop a new invention. Another decisive element is the actual role played by

Qualifying an invention as service rather than non-service is critical; even if the law seems to set a clear difference, in practice, the border may be rather blurry and uncertain

Nicola Aporti, HFG, Shanghai

such resources in the creation process. For example, if their use is not a decisive element in the invention development or creation process, the court can deem it as a non-service invention.

Other times, inventions are developed in an independent-work framework, which can be qualified – pursuant to the *PRC Contract Law* (中华人民共和国合同法) – as technology consulting, technology service or commissioned cooperative technology development.

These scenarios are not uncommon, as they allow companies to save on tax and social contribution and terminate contracts much more easily than employment contracts. Generally speaking, in such cases, the right to apply for a patent belongs to:

- the technology developer, if the development has been commissioned (the commissioner has a right to exploit the invention free of charge);

- the consultant or service supplier, who has directly developed the technology (even if by using the client's resources and materials);
- the client, if he is the one who developed the technology – even by exploiting the work of the consultant or service supplier.

Moreover, if the commissioned technology has not been patented, in the absence of an agreement by the parties, the developer can exploit and transfer to third parties the unpatented know-how. However, these provisions can be – and normally are – overturned by the parties' agreement.

Pre-emption

Even if the employer owns IP rights over service-inventions, the employee-inventor enjoys pre-emption right over the transfer of such service-invention (Article 326.1 of the Contract Law). It is not uncommon that IP rights generated through R&D in China are assigned to an overseas parent company or related companies for no or little consideration. This may possibly be challenged by the tax authorities for anti-avoidance; moreover, companies need to secure waivers from their employees of any such pre-emption right.

Inventor remuneration

According to Articles 77 and 78 of the Patent Law Implementing Regulations, the inventor-employee has the right to receive remuneration from the employer when the latter is granted a patent for that service-invention and exploits such patent.

The amount of remuneration shall be agreed between the parties, either in the employment contract or in the internal regulations of the employer. However, if no such agreement exists, the law provides minimum thresholds:

- a one-lump sum of Rmb3000 (\$500) as award for each patent granted and at least Rmb1000 for each utility model or design patent granted;
- yearly amount of 2% on profits from patent or utility model exploitation, or yearly amount of 0.2% on profits from design patent exploitation;
- no less than 10% of the royalty perceived for patent licensing to third parties.

Despite no specific provision, some decisions seem to imply that invention remuneration can be already included in the salary. It is advisable however, to avoid requalification, a reasonable salary structure aligned with the profits derived from the patent and the legal thresholds.

Employers shall be aware that disputes over the amount of such remuneration are anything but rare. Some of the most challenged issues are:

- **Patent exploitation by the employer:** technical comparisons between the service-invention and the patent granted or the product sold by the employer is a key element to assess whether the employer has actually exploited the invention. Courts often rely on an independent expert's opinion. Circumstantial evidence can also be used and in *Pan Xiping v Shenzhen Jinshanjiang*, before the Guangdong High Court, the Court

Nicola Aporti

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Nicola supports international companies in establishing and running their operations in China. He has substantive experience in the corporate (set-up, M&A, restructuring, administrative problem solving), food & drug regulatory, labor and contractual (distribution, franchising, manufacturing) areas. Most of his clients come from the automotive, food, pharmaceutical and cosmetic industries.

With a project-management approach, Nicola helps clients by implementing complex projects throughout various regulatory issues involved (tax, custom, financial, product registration and safety, environmental) and providing turn-key solutions. At HFG, Nicola is responsible for international business development and he often cooperates with education institutions and industry associations by giving lectures or seminars about the Chinese legal system.

Since 2010, Nicola has been a lecturer at the Shanghai Normal University for international students on PRC corporate topics. Nicola completed his international law studies between Italy, France and Australia and holds a degree in Law from the University of Ferrara.

In 2005, he was admitted to the Italian bar. Nicola speaks, reads and writes Mandarin Chinese and is fluent in English, French and Italian.

considered that the employer had exploited the service-invention based on the fact that the product packaging showed the patent number and that the product's name was very similar to the patent name;

- **How much the invention has contributed to the profits:** sometimes, service-invention accounts only for a portion of the profits. In *Weng Like v Shanghai Pudong 'EV' Fuel Injection*, the Shanghai High Court deemed that the technology exploited (transfer) by the employer actually made minor use of the patented service-invention and therefore calculated the remuneration accordingly;
- **Amount of the remuneration:** courts have a substantial approach and can proactively investigate to assess the real profits from the inventions. In *Pan Xiping v Shenzhen Jinshanjiang*, an employee sued his employer claiming remuneration for the invention, which the employer had successfully patented and then licensed to a related company. The Court ruled in favour of the employee and quantified the remuneration. In doing so, it assumed that royalties in an intra-group licence agreement are not a fair benchmark. Therefore, the court was free to assess – based on its own discretion – a higher value of the patent and on such value it calculated the remuneration for the employee.

In some cases, inventors shall also be remunerated with reference to unpatented inventions. Under the Contract Law (Article 326.1), when an employer transfers or uses technology developed by an employee, a percentage of these proceeds shall be given as a reward to the inventor. However, this provision does not specify the minimum percentage of the proceeds.

Even if regulation still focuses on individual inventors, inventions today always – or almost – come from team-work. PRC courts

seem aware of this and in various cases have granted remuneration to several inventors involved in the same creation process.

Changes to service inventions

PRC legislation regarding inventions is comprised of several pieces of legislation, sometimes overlapping and with an unclear relationship between them. Besides the general framework of the Patent Law and its Implementing Regulations, the Contract Law also has relevant provisions, as well as other specific or local regulations.

The State Intellectual Property Office (SIPO) is in the process of enacting new *Service Invention Regulations* (国家知识产权局职务发明条例). At the time of writing, the Regulations are still

awards for patent grant shall be at least 200% of the inventor salary; exploitation of new patents shall be at least 5% of the operating profits. Patent licence remuneration shall be at least 20% of the licence fee.

Best practices

Foreign companies setting up R&D activities in China shall focus on internal policies aimed at:

- strengthening confidentiality protocols (with both legal and physical means);
- avoiding employee's invention from becoming a non-service invention. The employment contract and the job description shall be carefully drafted. Traceability and records of all resources and materials used by the employee, as well as guidelines and instructions from the employer, are also important;
- implement reasonable remuneration policies.

In particular, these shall enhance teamwork, avoiding individual competition which leads to lack of cooperation between team members – in the end, this is a lose-lose scenario;

- conduct technical and legal due diligence on newly-hired employee so as to avoid losing their invention to the former employer.

*Nicola Aporti
HFG, Shanghai*

PRC legislation regarding inventions is comprised of several pieces of legislation, sometimes overlapping and with an unclear relationship between them

in the drafting phase. Based on the current draft, we expect, when approved, substantial changes. For example, the current draft:

- expressly states the employee's obligation to report any invention, both service and non-service related to the employer;
- provides for a disposal procedure whereby the employer can choose whether to apply for a patent, keep the invention a secret or disclose it to the public domain;
- changes remuneration amounts and criteria. For example,



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