

IP in China: The Value for U.S. Companies, Protection and Enforcement, and How to Win the Battle

Kilpatrick Townsend's [Charles Gray](#) and [Sindy Ding-Voorhees](#) recently participated in a high-profile panel with Whirlpool Corporation's Pervin Taleyarkhan (Legal Counsel Patents) and Oxford Industries' Mary Margaret Heaton (Assistant General Counsel) at the [Association of Corporate Counsel](#) (ACC) Virtual Annual Meeting. The panel discussed "IP in China: The Value for U.S. Companies, Protection and Enforcement, and How to Win the Battle." This session provided a common-sense approach to IP in China, and provided an in-depth look at the tools available to assist U.S. companies to "win" the IP battle in China.

Key patent-related takeaways from this presentation include:

1

The relative value of IP litigation and enforcement in China is increasing.

2

China will soon become a top venue for IP litigation in the world.

3

Remember to protect your IP from misappropriation by being proactive with your China IP filing strategy.

4

Whenever possible, leverage the power of relatively inexpensive utility model patents in China.

Key trademark-related takeaways from this presentation include:

1

China is strictly first to file, so if you do not file for protection for your brands, someone else will.

2

China is not like the U.S. – the ability to effectively steal or block a brand is endemic. All brand owners have to take many steps that are either unnecessary or even unheard of in the U.S. to protect their own brands and maintain their rights in them.

3

Prevention is much better than a cure. This involves:

- A defensive filing program to shut out registration options for third parties in all relevant and ancillary classes and for primary brands in all classes.
- A recovery program to complete subclass coverage for older registrations to preclude others registering your marks for very similar goods or services.
- Securing copyright in all respects for the brands, and full coverage and enforcement of online rights including domain names, social media handles, and app names and logos.
- Lack of prior trademark rights is no longer fatal in oppositions and other grounds are becoming recognized. The China National Intellectual Property Administration (CNIPA) now plays a much more active role in guarding against bad faith applications.
- Bringing non-use cancellation or invalidation actions strategically against infringing marks that have been registered by third parties.

4

Look for and take advantage of local resources in China, especially for their local knowledge and language skills, which would save your communication costs and achieve your goals more effectively.

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