



**FERRANTE**  
INTELLECTUAL PROPERTY

**INTELLECTUAL PROPERTY RIGHTS  
PROTECTION WEBINAR**

October 2021

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- 1. Introduction**
  - 2. What is Intellectual Property: forms of intellectual property**
  - 3. How to protect intellectual property**
    - 3.1 in China**
    - 3.2 in Vietnam**
    - 3.3 in Singapore**
  - 4. Enforcement of IP, brand protection tips and advices**
    - 4.1 in China**
    - 4.2 in Vietnam**
    - 4.3 in Singapore**
  - 5. Cases Examples**

# FERRANTE INTELLECTUAL PROPERTY

- A full practice intellectual property firm with particular expertise in working across Greater China and Southeast Asia
- Offers comprehensive legal services on all aspects of IPRs
- Key areas
  - ✓ Prosecution of trademarks, patents, and copyrights
  - ✓ Civil, criminal, and administrative lawsuits
  - ✓ Anti-counterfeiting & monitoring programs
  - ✓ Investigations and raid actions
  - ✓ PRC customs recordation of IPRs, customs seizures, training customs officials, online enforcement actions, Commercial Arbitration



# FERRANTE INTELLECTUAL PROPERTY



- Michele Ferrante is founding and Managing Partner of FERRANTE INTELLECTUAL PROPERTY.
- Michele is a lawyer admitted to the Milan Bar. He practiced in Italy, corporate and intellectual property law. He also has multijurisdictional legal practice experience in the UK and France.
- Since 1999, the main focus of Michele's practice is advising high-profile foreign companies in the protection of their IP rights and the design of tailor made anti-counterfeit strategies in China. Michele's main clients include companies from automotive, luxury fashion, healthcare and beverage industry.
- Michele is an active speaker, lecturer, moderator and panelist at IP conferences relating to IP law in China; he is a prolific author on a broad range of topics related to IP. He speaks Italian, English, French and Spanish.



# WHAT IS INTELLECTUAL PROPERTY

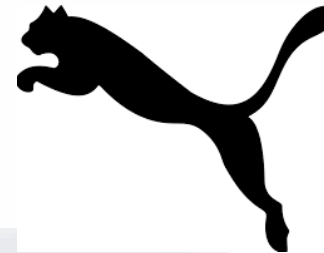
- Property of your mind or proprietary knowledge
  - Productive new idea you create
  - Helps to protect your business
  - Valuable asset for your business
  - Set your business apart from competitors
  - Can provide an important revenue income
  - IP as a property can be sold, bought, licensed, pass under a will, assigned
  - Pull-factor when attracting investors
  - Infringement of intellectual property diminishes your brand, attempts on the free-riding reputation of your brand
- Trademarks
  - Copyrights
  - Patents
  - Trade Secrets
  - Geographic Indication
  - Domain name and etc.



# WHAT IS INTELLECTUAL PROPERTY

## Trademarks

- Trademark is a unique identification of your brand, used exclusively for your goods and services
- Symbol, logo, word, sound, color, design, etc.
- Word mark
- Device
- Combination
- 3D
- Sound, etc.

The FedEx logo, featuring the word "FedEx" in a bold, sans-serif font. The "Fed" is purple and the "Ex" is orange.

# WHAT IS INTELLECTUAL PROPERTY

## Copyrights

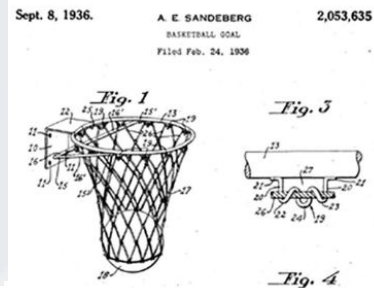
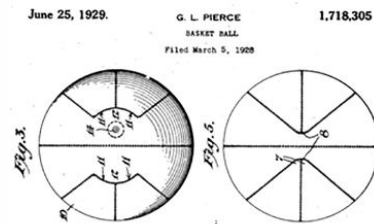
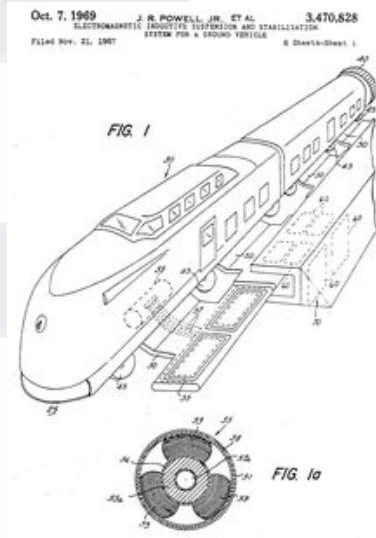
- Protects a form of expression, written work, books, design, artwork, paintings, musical compositions, plays, movies, radio/tv programs, performances, and other artistic works
- Although copyright is an automatic right, it is advisable to register your valuable copyrights



# WHAT IS INTELLECTUAL PROPERTY

## Patents

- Innovations such as objects, process of manufacture, new technologies and methods can be protected with patents
- Functional & Technical inventions

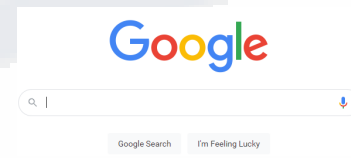




# WHAT IS INTELLECTUAL PROPERTY

## Trade Secrets

- Commercially valuable asset because it is secret
- Known only to a limited group of persons
- Importance of manufacturing process, methods and techniques, product specifications, etc.
- Sharing these extremely valuable secrets would bring damages to the company





# HOW TO PROTECT INTELLECTUAL PROPERTY China

## IP rights available in China

- Trademark (word, device, combination mark, 3D trademark, sounds)
- Copyright
- Patent
- Design Patent
- Trade Secrets
- Geographic Indication
- Domain name and etc.



# HOW TO PROTECT INTELLECTUAL PROPERTY

## China - Trademarks

- **Registration** 6-9 months
- **Term** 10 years
- **First to file principle** - first in time first in right
- Perform a search for prior acquired trademark rights, Trademark monitoring of possible infringement filing
- Protection starts from the **registration date in China**
- For enforcing an international trade mark extended to China, **the confirmation certificate is required**
- The trade mark can be **cancelled** if it is not used for 3 years from the registration date in China
- In China, trade marks shall be **used exactly in the way they have been registered**
- **Chinese character version** of the trade mark shall be registered

APPLICATION

EXAMINATION

PUBLICATION-  
OPPOSITION

REGISTRATION



# HOW TO PROTECT INTELLECTUAL PROPERTY

## China

COPYRIGHT	INVENTION PATENT	DESIGN PATENT	TRADE SECRETS
<ul style="list-style-type: none"><li>• Protection creation date</li><li>• Advisable to record the copyright in China</li><li>• Term 50 years</li></ul>	<ul style="list-style-type: none"><li>• Protects <b>new</b> developed technology</li><li>• Protection application date</li><li>• Term 20 years</li></ul>	<ul style="list-style-type: none"><li>• Ornamental appearance of the product</li><li>• Annual renewal</li><li>• Term 15 years</li></ul>	<ul style="list-style-type: none"><li>• Technical or operational information unknown to the public</li><li>• Produce economic value</li><li>• Protection as long as is not published</li></ul>





# HOW TO PROTECT INTELLECTUAL PROPERTY Vietnam

## IP rights available in Vietnam

- Trademarks
- Copyright
- Patents
- Designs
- Trade secrets
- Geographical Indications
- Plant varieties



# HOW TO PROTECT INTELLECTUAL PROPERTY

## Vietnam - Trademarks

- Trademark system protects symbols, colours and other visual devices used to identify a business' products or services, including three-dimensional objects
- **First-to-file** rule is applied
- Claiming priority is possible
- **Registration** 12-15 months
- **Term** 10 years
- Protection starts from the **filing application date**
- The trade mark can be **cancelled** if it is not used for 5 years from the registration date

APPLICATION

PUBLICATION  
OF  
APPLICATION

SUBSTANTIVE  
EXAMINATION

GRANTING  
REGISTRATION



# HOW TO PROTECT INTELLECTUAL PROPERTY Vietnam

COPYRIGHT	INVENTION PATENT	DESIGN PATENT	TRADE SECRETS
<ul style="list-style-type: none"><li>• Advisable to record the copyright in Vietnam</li><li>• Term 50 years</li></ul>	<ul style="list-style-type: none"><li>• Protection from filing date</li><li>• First to file principle</li><li>• Term 20 years</li></ul>	<ul style="list-style-type: none"><li>• Must be new, creative and have an industrial application</li><li>• Term 5 years</li><li>• Renewable for two consecutive periods of five years</li></ul>	<ul style="list-style-type: none"><li>• Protected upon creation without any registration, provided that reasonable measures have been taken to keep the information secret</li></ul>





# HOW TO PROTECT INTELLECTUAL PROPERTY

## Singapore

IP rights available in Singapore

- Trademarks
- Copyrights
- Patents
- Designs
- Geographical Indications
- Trade Secrets
- Plant Varieties





# HOW TO PROTECT INTELLECTUAL PROPERTY

## Singapore - Trademarks

- **First-to-file** rule is applied
- Claiming priority is possible
- **Registration** 7-9 months
- **Term** 10 years
- Protection starts from the **filing application date**
- The trade mark can be **cancelled** if it is not used for 5 years from the registration date

APPLICATION

EXAMINATION

PUBLICATION

GRANTING  
REGISTRATION



# HOW TO PROTECT INTELLECTUAL PROPERTY

## Singapore

COPYRIGHT	INVENTION PATENT	DESIGN PATENT	TRADE SECRETS
<ul style="list-style-type: none"><li>• No system for the registration of copyright</li></ul>	<ul style="list-style-type: none"><li>• Protection from filing date</li><li>• First to file principle</li><li>• Term 20 years</li><li>• Annual renewal fees starting from the end of the 4<sup>th</sup> year</li></ul>	<ul style="list-style-type: none"><li>• Must be novel</li><li>• Protection from registration date</li><li>• Term 5 years</li><li>• Renewable for two consecutive periods of five years</li></ul>	<ul style="list-style-type: none"><li>• Protected for an unlimited period of time as long as they do not become common knowledge or become generally available to the public</li></ul>





# ENFORCEMENT OF IP, BRAND PROTECTION TIPS & ADVICES

## China

Actions against identified infringements through different enforcement routes

Internet

Admin

Civil

Criminal

Customs

Take professional advice from local IP experts

Be proactive

Have China-specific contracts

Check whether there have been previous registrations of your marks or other IP

Assess the risks of the market, due diligence on organizations and individuals you work with

Register your IP rights

Cooperate with enforcement agencies



# ENFORCEMENT OF IP, BRAND PROTECTION TIPS & ADVICES

## Vietnam

Actions against identified infringements through different enforcement routes

Admin

Civil

Criminal

Customs

Take professional advice from local IP experts

Check whether there have been previous registrations of your marks or other IP

Assess the risks of the market, due diligence on organizations and individuals you work with

Register your IP rights, including customs

Proper attention to your IP by management and employees

Good relationships with organizations that can help you

Consider high-level administrative authorities for important largescale cases

Consider mediation before defensive action





# ENFORCEMENT OF IP, BRAND PROTECTION TIPS & ADVICES

## Singapore

Actions against identified infringements through different enforcement routes



Civil



Criminal



Customs

There is no official IP recordal system for Singapore Customs

Written notice to customs about the suspected importation of IPR-infringing goods must be submitted

Proactive monitoring is important

No compensation through criminal proceedings, may commence civil litigation to claim monetary compensation

Demand letters should be carefully drafted as The Patent Act, The Copyright Act, Trade Marks Act and GI Act contain provisions against groundless threats of infringement



# BURBERRY CASE

Burberry Limited



Xinboli Trading (Shanghai) Co., Ltd.

Pictures taken in January 2021



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# BURBERRY CASE

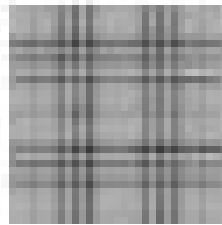
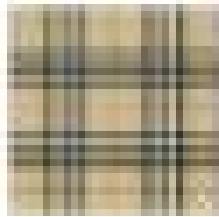
**Burberry Limited**

Trademark: BURBERRY



**BURBERRY**

patterns registered as trademarks

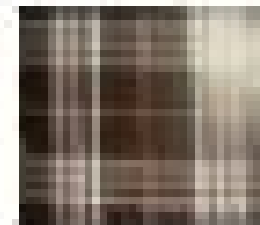
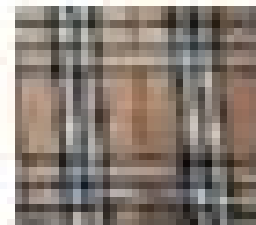


**Xinboli Trading (Shanghai) Co., Ltd.**

Trademark: BANEBERRY



widely used patterns



- Use of “BANEBERRY” in parallel with logo and patterns similar to Burberry’s & similar sales channels (mall, outlet) resulted in actual confusion and consumer complaints
- Additionally, Baneberry’s increase of sales online lowered Burberry’s market share, weakened the distinctiveness and recognizability of its trademarks





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**Thank you!**

Michele FERRANTE

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