

Managing the

Problem of Piracy

应对侵权问题

Managing protection of intellectual property is one of the perennial challenges for Swiss businesses in China.

The Bridge looks at what can be done in order to achieve the best results.

by **Mark Andrews**

做好知识产权保护工作是瑞士在华企业面对的一项长期存在的挑战。《桥》在本文中介绍了企业应该做好哪些防范和应对工作。

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Over the years there have been a number of high profile cases that have brought out in the open the threat that foreign companies face in protecting their IP in China. In the automotive sector, Land Rover and Porsche, for example, have claimed to have been victims, but chose not to pursue any action. This decision may well be because of the patchy record of Chinese courts' rulings on these matters in the past. An earlier attempt by Fiat in 2008 to stop production of the Great Wall Peri (which it claimed was a copy of the Fiat Panda), resulted with the action being dismissed in China, while an Italian court ruled in Fiat's favour and banned sales of the car in Europe.

There are signs that things may be turning for the better. In August 2017, New Balance, an American sportswear retailer, won a US\$1.5 million award - the highest award ever granted to a foreign business in China - for trademark

去年来发生的多起高知名度案件将外资企业在华面对的知识产权保护威胁暴露无遗。举例来讲，在汽车行业，路虎和保时捷都曾宣称是受害者，但最终却选择不采取任何行动。企业做出这种决定的原因很可能是中国法院过去在这些问题的裁决上记录不佳。早在2008年，菲亚特曾试图通过法律手段要求长城精灵（据称该款汽车是菲亚特熊猫的翻版）停止生产，结果是案件在中国被撤诉，而意大利法院则判决菲亚特胜诉，并严禁长城在欧洲销售这款车。

不过，有迹象显示事态正朝着好的方向发展。2017年8月，美国运动服饰零售商 New Balance 在与三家国内运动鞋厂商的商标侵权案中胜诉，并获得

infringements by three domestic shoe producers. This followed on the heels of a 2015 ruling for a lawsuit in which the company lost to a man who had registered the Chinese name of New Balance.

China's IP regulations

So where does China and Chinese legislation actually stand on these issues? "Prior to China entering the WTO, China's chief negotiator claimed that China's system for the protection of intellectual property rights reached the level of best international practice," says Paul Thaler, Managing Partner of Wenfei Attorneys-at-Law. "But in practice, the three key areas of intellectual property: patent law, copyright, and trademark law have all required two major modifications in the intervening period. In contrast, Swiss law has barely needed any modification in that time. However, China has now reached the stage where it has a relatively complete structure of intellectual property laws and regulations."

"The establishment of the Chinese IP legal framework was initiated in the 1980s, the IP legal framework was further enriched by a great number of administrative regulations, measures, policies and Supreme Court circulars," says Fiona Gao, an Associate with VISCHER, one of Switzerland's leading law firms. "Since 2007 when President Hu Jintao announced that developing and protecting IP was part of the national development strategy, things really started to change with the recognition of the importance and value of brands and patents, especially since the end of 2014," says Gao. "Since then, Beijing, Shanghai and Guangzhou have established specialized IP courts to judge on IP-related cases. This really was the beginning of a new era. It is also very important to bear in mind China's economic situation and its industry structure when discussing IP protection. After the 2008 financial crisis, companies that had before only exported had to reconsider overseas markets and look at sales within China. Many were OEM manufacturers that had yet to establish their own R&D team and to develop products with their own brands. As a consequence, we have seen a great increase in patent and trademark applications from Chinese companies in the past ten years."

IP and the shift to an innovation economy

The Chinese government has also focused its policy on developing the local consumer market, and promoting more innovation and R&D. This, coupled with the steady rise of Chinese brands, has made comprehensive, enforced IP protection of increasing importance to Chinese businesses. "China with its rapid economic development is undergoing fundamental changes. From simply copying - or adapting - to combining or integrating technologies and now through to innovation," says Charles Merkle, President, CBC, a Swiss consulting firm in China.

A good example of this changing perspective is the recent claim from Chinese parties that foreign companies are stealing its high speed railway technology IP. This is of some importance to China as it has invested considerably in the development of this technology, and promoting its sale overseas is a key objective of its US\$ trillion Belt & Road Initiative. Ironically, the Chinese claim comes just a few years after Japanese and European companies made a similar claim: that China had stolen their technology to



Fiona Gao
VISCHER

150 万美元的赔偿，这是外资企业在中国获得的最高额的赔偿。而就在此前的2015年，公司在与注册 New Balance 中文名的一位自然人的案件中败诉。

中国的知识产权法规

那么中国和中国法律在这些问题上的立场是什么呢？“在中国加入 WTO 之前，中国的主谈判官曾表示中国的知识产权保护体系已经达到了最佳的国际实践水平，”文斐律师事务所 (Wenfei Attorneys-at-Law) 执行合伙人 Paul Thaler 说，“但是在实践中，知识产权的三个主要方面：专利法、版权和商标法都需在干预期内做出两大重要修订。相反的，当时的瑞士法律几乎不需要做任何的调整。不过，目前中国已经发展到了拥有较为完善的知识产权法律法规结构的阶段。”

“中国的知识产权法律框架的建立是从 20 世纪 80 年代开始的，之后在发布了多个行政规范、办法、政策和最高法院通告后知识产权法律框架得到了进一步的充实，”瑞士知名律师事务所 VISCHER 的律师 Fiona Gao 表示，“自 2007 年时任国家主席胡锦涛宣布发展和保护知识产权是国家发展战略的一部分以来，事态开始改观，品牌和专利的价值及重要性得到了认可，尤其是在 2014 年年底之后。”Gao 还说：“自此，北京、上海和广州相继设立了专门的知识产权法庭来裁判知识产权相关案件。这标志着全新纪元的开始。另外，我们在探讨知识产权保护问题时还应考虑到中国的经济形势及产业结构等因素。自 2008 年金融危机以来，那些出口型企业不得不重新审视海外市场并开始在国内市场寻找机会。这些企业多数都是尚未成立自有研发团队并开发自有品牌产品的代工企业。这也是我们在过去十年里看到中国企业对专利和商标的申请大幅增加的原因。”

知识产权和向创新型经济的转型

与此同时，中国政府也将政策重点放在了发展本土消费市场 and 促进创新和研发上。伴随着中国品牌的稳步成长，这使得全方面的、行之有效的知识产权保护成为中国企业迫切需要的规范。“快速发展下的中国正经历着翻天覆地的变化，它经历了从简单的复制或调整到结合或整合技术再到现在的自主创新的过程，”瑞士在华咨询公司 CBC 总裁 Charles Merkle 表示。

一个很好的例子就是中国方面近期指责有外资企业盗用中国的高速铁路技术知识产权。这项技术对于中国来说是十分重要的，因为中国在其研发上投入了巨额资金，另外，在海外销售推广这一技术也是中国上万亿美金的“一带一路”倡议的重要目标之一。耐人寻味的是，中国的指责是在



Paul Thaler
Wenfei

develop its high speed trains, and had been exporting it in contravention of the original sales agreements.

This new pivot to protection of local brands is also broadly reflected in the numbers. Last year China had 2.36 million patent applications compared with just 14,000 when China started registering patents in 1985, according to data provided by Wenfei. China was also last year the fifth largest applicant for trademarks in the Madrid system with 3,014 applications by domestic companies, while foreign companies had 21,238 applications for international registration in China.

The figures, however, should be interpreted with some caution. Chinese patent law allows two types, and many of the patents being filed by Chinese companies are utility model (UM) rather than invention patents. These are cheaper, much quicker to do (one year, rather than five), last ten years rather than 20, and, significantly, have a lower threshold of 'novelty' requirement than invention patents. Still, they do show that the concept and value of IP protection is being grasped and acted upon in the local business environment.

The challenge of e-commerce

For much of the past 15 years, China has earned worldwide notoriety for its pirated consumer products, ranging from DVDs of international films and TV series, to a wide range of luxury-brand clothing and watches offered at a fraction of the price (and generally, the quality) of the original. With the explosive growth of online shopping in China over the past five years, a new dimension was added to this problem. In recent years, e-commerce giants such as Alibaba have received regular criticism for the amount of fakes being sold on their platforms. To counteract these accusations (and with a mindful eye on its international expansion) Alibaba claims to have made big efforts to address the problem, including now having a team of more than 2,000 people investigating counterfeit products on its websites. According to the company, this resulted last year in 469 cases being punished by the government and 33 criminal verdicts. "The good thing about online sales channels is accountability," says Wenfei's Thaler. "Often sellers need to provide substantial documentation and some form of deposit in case of disputes. In the past, small factories would produce counterfeit products and distribute them through various opaque channels until they ended up in the shops. Online sales channels - as the most important channel of the future - will improve transparency and accountability."

Taking action on piracy

For international companies, the general advice is that they need accept that - as in many other areas of commercial law in China - a lot of successful protection will depend on self policing and initiating action. "It's up to the companies to keep a watch, and then act swiftly to deter the bad actors early and thoroughly" says Gianna Abegg, Swiss attorney-at-law, at Eiger law firm in Shanghai. "If companies do this, their take down actions can work fairly effectively." To tackle bricks and mortar stores selling pirated goods, VISCHER's Gao believes that from an economic perspective, the spiralling real estate prices in cities like Shanghai and Beijing will make it increasingly difficult for such low margin shops to survive. One such example was Shanghai's notorious Han City, popularly nicknamed Taobao City, on central Nanjing Xi Lu, which was full of little stores selling pirated items. New management increased rents and as a result pushed out these tenants. At the production end, original brands, working in collaboration with local



Gianna Abegg
Eiger

日本和欧洲企业做出类似的指责之后做出的：他们认为中国抄袭了他们的技术来发展高铁，对这项技术的出口违反了最初的销售协议。

这种对本土品牌保护的新转变也在数据中有所体现。据文斐律师事务所提供的数据显示，去年中国的专利申请数达236万个，而在1985年中国开始注册专利时只有14,000个。去年，中国是在马德里系统中申请商标的第五大国家，共有3,014家本土企业申请，而外资企业在中国申请的国际注册数达21,238个。

不过，我们应该十分谨慎的解读这些数据。中国的专利法允许两种形式，而中国企业注册的多数专利属于实用新型专利而非发明型专利。这种专利更为廉价，只需较短的时间即可完成（1年，而不是5年），可持续10年，而不是20年，相比发明型专利对于“创新”的门槛要求更低。即便如此，它们仍显示了人们抓住了知识产权保护的理念和价值并在本土商业环境中加以实践。

电子商务的挑战

在过去15年里，中国消费品造假的问题世界闻名，从国际影片和电视系列片DVD盗版到以极为低廉的价格（低品质）盗版更广泛的奢侈品服装和手表品牌等。随着过去五年里网络购物在中国爆发式的增长，这个问题出现了新的情况。近年来，像阿里巴巴这样的电子商务大鳄时常会收到关于在其平台上销售的产品涉嫌盗版的控诉。为了对抗这些控诉（和为国际扩张铺路），阿里巴巴宣布将花大力气解决这一问题，包括成立拥有2,000多人的团队专门调查网站上的盗版产品。据该公司称，这一行动的结果是：去年共有469起案件受到政府处罚和33起刑事判决。“在线销售渠道的一大好处是其责任制，”文斐律师事务所的Thaler表示：“为了避免纠纷，卖家往往需要提供大量的文件和一定数额的保证金。过去，许多小工厂会生产造假产品并通过多个不透明的渠道分销，直至这些产品进入商店。在线销售渠道作为未来最重要的销售渠道有助于提高透明度和责任制。”

采取行动打击盗版

对于国际企业，我们总的建议是它们需要接受——正如中国商业法的多个其他领域一样——许多成功的保护都来自于自有政策和自发行动这个事实。“企业应关注并快速行动以在早期彻底的阻止不遵守规则的行为，”上海律师事务所Eiger的瑞士律师Gianna Abegg表示，“如果企业这样做的话，它们的行动往往可以收到很好的效果。”为了解决实体店销售盗版商品的问题，VISCHER律所的Gao律师认为从经济角度来看，上海和北京等城市急剧上涨的房价也使得这种低成本商店难以为继。其中一个例子就是位居南京西路中段被称为淘宝城的上海汉城购物中心，这里曾经遍布着销售伪造商品的小商店。随着新的管理者提高房租，这些租客不得不离开汉城购物中心。而在生产端，原版品牌还与本土公安机关、企业及其法律代表合作，成功的搜查并关闭了造假工厂并对涉案者进行了处罚。

police, companies and their legal representatives are having some success in raiding and closing counterfeiting factories, and punishing those involved.

Swiss and Swissness

Switzerland first passed a 'Swissness' law in 1971 and a new so called "Swissness Bill" entered into force at the beginning of this year. Thereafter, the requirements for products to be considered as Swiss have been tightened up. "The essence of this Swissness Bill is Swiss designation. It defines objective criteria for various products and services, and the 'Swissness' shall only be declared and labelled when the objective criteria are met," says Gao. This means that some companies now have to reconsider their supply chains to ensure that they meet the Swissness requirements for the products' components. "For some Chinese suppliers, such as those that manufacture watch parts, if they want to continue the relationship with Swiss manufacturers they now must consider setting up their factories in Switzerland, which is costly," says Gao. As a consequence, some Chinese companies continue to claim that their products are Swiss when they are not, and enforcement can be a problem. "The Swissness Bill is a Swiss national law. Although in principle it has an extraterritorial aim, it is difficult to enforce abroad," says Gao. "Enforcement is dependent on appropriate bilateral agreements and there are no such agreements between Switzerland and China." However, Chinese law firms have had some success in opposing trademark applications using the Swiss cross on products which do not meet the Swissness law.

How companies can protect IP

While many companies may bemoan what they consider inadequate protection in China, without registering their trademarks or patents then really there is no recourse against infringement. "If you have a registered patent or trademark, a judge has the possibility to issue an injunction ordering a company to stop when a lawsuit is filed and before a judgement is issued," says Nicolas Musy, co-founder of Swiss Center China. And what in Switzerland are seen as company secrets may not automatically be seen as such in China. Musy advises that companies must take extra care and mark documents as confidential and make sure sensitive information is only made available to employees who really need it. "In practice, this means that all proprietary information is marked as such and you should do everything possible to make sure you can trace how, and by whom, the information has been transferred."

It is also important to keep the problem in perspective. Although big IP infringement cases may grab the headlines, research shows that many international companies have learnt increasingly to live with the problem. A 2017 CEIBS survey shows that the issue of IP theft is actually near the bottom of concerns for many foreign companies operating in China. And as the Chinese economy matures it is likely to become less of a threat. "The early days are over when China benefited more from not protecting IP," says Eiger's Abegg. "The scales are now slowly but surely tipping the other way, as Chinese companies develop their own IP." ○



Nicolas Musy
Swiss Center China

瑞士和 Swissness

瑞士于1971年首次通过了“Swissness”法案,今年初,全新的“Swissness Bill”也开始付诸实施。自此,对于能被称为是瑞士品质的产品要求更加严格。“Swissness Bill的精髓就是瑞士名称。它界定了多种产品和服务的客观标准,并认为只有满足客观标准要求的产品才能获得‘Swissness’标识,” Gao 律师表示。这意味着许多企业必须重新审查自己的供应链,以保证满足 Swissness 对产品零部件的要求。“对于那些生产手表零部件的中国供应商来说,如果他们希

望继续保持与瑞士厂商间的合作,他们就必须考虑在瑞士设立工厂,而这一成本将是十分昂贵的,” Gao 律师说。因此,一些中国企业不断表示自己的产品是瑞士品质,这使得法案的执行成了一个较大的问题。

“Swissness Bill 是瑞士的国家法律,尽管从原则上来讲具有治外法权的目的,但在海外的执行是十分困难的,” Gao 律师继续说道,“执行需依赖于相应的双边协定,然而瑞中之间并无此类协定。”不过,中国律师事务所在反对不满足 Swissness 法规定条件的产品上使用瑞士十字标识的商标申请中曾多次胜诉。

企业应如何保护知识产权

许多企业苦于在华的知识产权保护不充分,没有注册商标或专利就意味着在面临侵权时无法追索。“如果已经注册了专利或商标,法官就有可能发布禁止令,在立案且尚未判决时便命令企业停止运营,”中国瑞士中心联合创办人 Nicolas Musy 表示。另外,在瑞士被视为是公司机密的信息可能在中国并非如此。Musy 建议企业应格外谨慎的对机密文件进行标注,并保证仅对必须的员工开放敏感信息。“在实践中,这表示对所有的专有资料进行标注,并采取所有可能的行动保证可追溯到是谁如何转移了资料。”

同样重要的是以正确的态度看待这一问题。虽然大型知识产权侵权案件可以在头条中曝光,但有研究显示,许多国际企业已经学会了适应这个问题。2017年的 CEIBS 调查显示,知识产权侵权的问题事实上已经成为在华运营的外资企业的所有顾虑中排名最靠后的一个。随着中国经济的成熟,这个问题的威胁将逐渐消减。“早期中国从无知识产权保护中获益的日子已经结束了,” Eiger 律师事务所的 Abegg 表示,“随着中国企业发展自己的知识产权,事态正逐渐朝着好的方向发展。” ○

Sources quoted in the article

文章中引用的出处

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