

IP STARS

from Managing IP

THE GUIDE TO THE WORLD'S LEADING IP LAW FIRMS AND PRACTITIONERS

TRADEMARK

The background of the lower half of the cover is an abstract, textured design. It features broad, expressive brushstrokes in various shades of purple, from deep indigo to light lavender, set against a white background. The strokes are layered and overlapping, creating a sense of movement and depth.

2023

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INTRODUCTION

Welcome to the 2023 edition of IP STARS, the leading specialist guide to IP law firms and practitioners worldwide. Managing IP published its first legal directory in 1994 and rebranded it in 2013 as IP STARS. The research for IP STARS covers a variety of IP practice areas and more than 70 jurisdictions, making it the most comprehensive and respected IP guide in the legal profession.

No more paper

A big development this year is that Managing IP has stopped printing its magazine and the IP STARS handbooks. We now produce a digital IP STARS handbook (in PDF). All our rankings and related content are now published on our website, [ipstars.com](https://www.ipstars.com). One of the reasons for this decision is to fulfil the ESG commitment to reduce our impact on the environment and encourage sustainable practices in the industries we serve.

In this edition

We have only featured the trademark rankings for some jurisdictions in this PDF edition. All the trademark rankings for the 2023 edition are available on our website. There were several ranking changes this year, including firms that were ranked for the first time. All our 2023 practitioner rankings and selected firm reviews will be published on our website.

Ukraine and Russia

The research for Ukraine and Russia is still suspended due to the market uncertainty created by the war. We will, however, continue to monitor IP developments in both markets. Our last firm rankings for Ukraine, the 2021 edition, are available on our website. Our thoughts and prayers are with the Ukrainian people and the IP community.

Learn more

Please visit our website to see what we have already published and what to expect next. The research for the 2024 edition of IP STARS will start in September 2023. You can get the latest IP developments and firm news by signing up to receive our monthly newsletter, following us on Twitter (@IP_STARS), and joining Managing IP's LinkedIn group page.

IP STARS is an exclusive rankings publication; we do not rank all firms and individuals offering IP services. Participation in our research does not guarantee a ranking. Please read our methodology to learn more about our research and rankings.

As the legal and business environment for IP evolves or becomes uncertain, we hope that IP STARS can guide those looking for experienced IP advisers in different parts of the world.

Congratulations to all the firms ranked this year.

Kingsley Egbuonu
Editor



INCORPORATING IP ASIA

IP STARS is published annually by:
Managing IP, Legal Media Group

Delinian Limited
4-8 Bouverie Street
London, EC4Y 8AX
T: +44 20 7779 8888
F: +44 20 7779 8500
E: research@managingip.com
W: www.ipstars.com

MANAGING IP RESEARCH

Global research editor

Kingsley Egbuonu

US editor

Chris Adams

Research analysts

Chris Adams, Kingsley Egbuonu,
Srikanth Kumar, Stanley Li,
Jose Martinez, Liam McDaid,
Juliana Monteiro, Sharda Somenarain,
Charlie Wong, and Ye Zhang

MANAGING IP INSIGHT

Editor-in-chief

Ed Conlon

Deputy editor

Max Walters

Commercial projects editors

Phil Myers

Tom Baker

Senior Asia reporter

Sukanya Sarkar

Reporters

Rory O'Neill

Rani Mehta

MANAGING IP SUBSCRIPTIONS

Head of subscriptions

Jack Avent

T: +44 20 7779 8379

E: jack.avent@delinian.com

Customer services

T: +44 20 7779 8610

BUSINESS DEVELOPMENT**Commercial director/publisher**

Nicholas Heath
T: +44 20 7779 8692
E: nheath@managingip.com

Americas manager

George Reeves
T: +1 212 224 3938
E: george.reeves@euromoneyny.com

Asia manager

Matthew Siu
T: +852 2842 6937
E: matthew.siu@euromoneyasia.com

EMEA manager

Prin Shasiharan
T: +44 20 7779 8004
E: prin.shasiharan@euromoneyplc.com

Events sales manager

Latina Angelova
E: latina.angelova@delinian.com

Marketing executive

Elly Heath
E: elly.heath@delinian.com

PRODUCTION**Head of production**

Luca Ercolani

Web production editor

Josh Pasanisi

DIVISIONAL DIRECTORS**Managing director, LMG**

Thomas St Denis

CEO, NextGen

Isaac Showman

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RESEARCH METHODOLOGY

The research for IP STARS is conducted rigorously and impartially by our team of research analysts in London, New York, and Hong Kong. Each year, we request information from thousands of firms, IP practitioners and their clients through interviews, emails, and online surveys.

Before compiling the rankings, our analysts also conducted their own independent research, including an analysis of publicly available information (such as court or IP office data) and existing data we have about firms. The aspects assessed for the firm rankings include expertise, workload, market reputation and record, outcomes achieved for clients, and unique strengths in each practice area. These are considered when deciding which firms to include in the rankings and which tier and practice area they should be in.

Firms are ranked alphabetically in tiers, or as highly recommended or recommended. The total number of firms listed varies from jurisdiction to jurisdiction. For most jurisdictions, the rankings are split into prosecution and disputes work. However, in certain jurisdictions, we evaluated and ranked firms for their general trademark practice.

The prosecution ranking takes account of pre- and post-registration work, including office proceedings and portfolio management advice. The disputes ranking covers trademark-related disputes (in and outside the courts) and anti-counterfeiting work. Where appropriate, some firms have been ranked for both practice areas, and in a few European jurisdictions, we have a separate table for law firms that do trademark filing and prosecution work.

These rankings are based on information available at the time the research was completed (February 2023). Except for firm name changes, any subsequent developments or information that could influence our rankings will be considered during the research for the 2024 edition of IP STARS, which starts in September 2023.

For the avoidance of doubt, the ranking tables do not suggest or indicate that the expertise or services of the listed firms are limited to the practice area in question, and Managing IP does not recommend or endorse any firm for IP work. No firm can pay to be included or to influence the results.

The rankings are not influenced by any commercial relationship, including advertising, with Managing IP or IP STARS. There is no fee to pay to participate in our research. The rankings are subject to change each year. Please visit our website to read more about our methodology and practice areas. Get in touch via email (research@managingip.com) if you have any feedback or questions.



ARGENTINA

TRADEMARK

TIER 1

G Breuer
Marval O'Farrell & Mairal

TIER 2

Berton Moreno IP Law
Ferrer Reyes Tellechea & Bouché
Ojam Bullrich Flanzbaum
Palacio & Asociados

TIER 3

Baker McKenzie
Mitrani Caballero & Ruiz Moreno
Abogados
Noetinger & Armando
Richelet & Richelet

OTHER NOTABLE FIRMS

Allende & Brea
Berken IP
ClarkeModet
Estudio Chaloupka
Hausheer Belgrano & Fernandez
Litvin Marzorati Legales
Moeller IP
Sena & Berton Moreno

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AUSTRALIA

TRADEMARK

LAW FIRMS

TIER 1

Allens
Ashurst
Gilbert + Tobin
Herbert Smith Freehills
King & Wood Mallesons

TIER 2

Baker McKenzie
Clayton Utz
Corrs Chambers Westgarth
MinterEllison

TIER 3

Addisons
Banki Haddock Fiora
Bird & Bird
DLA Piper
Norton Rose Fulbright

OTHER NOTABLE FIRMS

Gadens
K&L Gates
Macpherson Kelley
McCullough Robertson
Sparke Helmore

TRADEMARK

PATENT & TRADE MARK ATTORNEY FIRMS

TIER 1

Davies Collison Cave
Griffith Hack
Phillips Ormonde Fitzpatrick
Spruson & Ferguson

TIER 2

FB Rice
Wrays

TIER 3

Halfords IP
Madderns

OTHER NOTABLE FIRMS

IP Gateway
Michael Buck IP

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AUSTRIA

TRADEMARK DISPUTES

TIER 1

Gassauer-Fleissner
Geistwert
Schoenherr
Schwarz Schönherr

TIER 2

CMS
Wiltschek Plasser

TIER 3

Dorda
Taylor Wessing

OTHER NOTABLE FIRMS

ABP Anwälte Burger & Partner
Baker McKenzie
Binder Grösswang
Brauneis Klauser Prändl
Freshfields Bruckhaus Deringer
KWR Karasek Wietrzyk
Salomonowitz Attorneys at Law
Hide tiers

TRADEMARK PROSECUTION

TIER 1

Puchberger & Partner
Schoenherr
SONN

TIER 2

Gassauer-Fleissner
Geistwert

TIER 3

ABP Anwälte Burger & Partner
Baker McKenzie
Dorda
Taylor Wessing
Other Notable Firms
Brauneis Klauser Prändl

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BELGIUM

TRADEMARK DISPUTES

TIER 1

Fencer
NautaDutilh
Simont Braun
Van Innis & Delarue

TIER 2

ALTIUS
Bird & Bird
Crowell & Moring
Hoyng Rokh Monegier
Stibbe
Wiggin

TIER 3

Allen & Overy
CMS
Fieldfisher
Petillion

OTHER NOTABLE FIRMS

& De Bandt
DLA Piper
Eubelius
Inteo
Janson
Linklaters
Lydian

TRADEMARK PROSECUTION

TIER 1

AWA
Gevers

TIER 2

De Clercq & Partners
Kirkpatrick
Novagraaf

TIER 3

Brantsandpatents
Bureau M F J Bockstael
Calysta

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BENELUX

TRADEMARK PROSECUTION

PATENT & TRADEMARK
ATTORNEY FIRMS

TIER 1

Chiever

Gevers

NLO Shieldmark

Novagraaf

TIER 2

Kirkpatrick

Knijff Trade Mark Attorneys

TIER 3

Arnold & Siedsma

AWA

De Clercq & Partners

Marks & Clerk

VO

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BRAZIL

TRADEMARK DISPUTES

TIER 1

Daniel Law
Dannemann Siemsen
Gusmão & Labrunie
Kasznar Leonardos
Montaury Pimenta Machado & Vieira de Mello

TIER 2

Barbosa Müssnich Aragão (BMA)
Bhering Advogados
David do Nascimento Advogados Associados
Licks Attorneys
Pinheiro Neto Advogados

TIER 3

Di Blasi Parente & Associados
Guerra IP
Luiz Leonardos & Advogados
Madrone Fialho Advogados
Trench Rossi Watanabe
Veirano Advogados

OTHER NOTABLE FIRMS

Ariboni Fabbri & Schmidt
Mansur Murad Advogados
Murta Goyanes Advogados
Soerensen Garcia Advogados Associados

TRADEMARK PROSECUTION

TIER 1

Daniel Law
Dannemann Siemsen
Gusmão & Labrunie
Kasznar Leonardos

TIER 2

Barbosa Müssnich Aragão (BMA)
Bhering Advogados
Di Blasi Parente & Associados
Montaury Pimenta Machado & Vieira de Mello

TIER 3

David do Nascimento Advogados Associados
Demarest Advogados
Guerra IP
Luiz Leonardos & Advogados

OTHER NOTABLE FIRMS

Ariboni Fabbri & Schmidt
Barreto Veiga Advogados (BVA)
Felsberg Advogados
Licks Attorneys
Madrone Fialho Advogados
Mansur Murad Advogados
Trench Rossi Watanabe
Vaz e Dias Advogados & Associados

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BULGARIA

TRADEMARK

TIER 1

Boyanov & Co
Dimitrov Petrov & Co
Djingov Gouginski Kyutchukov &
Velichkov (DGKV)
Pavlov & Co

TIER 2

Bojinov & Bojinov
Kambourov & Partners

TIER 3

ARSIS Consulting
Gugushev & Partners Law
Interius
Manev & Partners
Petošević

OTHER NOTABLE FIRMS

Dr Emil Benatov & Partners
IP Consulting

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CANADA

TRADEMARK DISPUTES

TIER 1

Gowling WLG
Smart & Biggar

TIER 2

Bereskin & Parr
Borden Ladner Gervais
Norton Rose Fulbright
Osler Hoskin & Harcourt

TIER 3

Bennett Jones
Blake Cassels & Graydon
Cassels Brock & Blackwell
DLA Piper
Lipkus Law
Marks & Clerk
McMillan
Robic
Torys

OTHER NOTABLE FIRMS

Aird & Berlis
CPST Intellectual Property
Deeth Williams Wall
Fasken
McCarthy Tétrault
Stikeman Elliott

TRADEMARK PROSECUTION

TIER 1

Bereskin & Parr
Borden Ladner Gervais
Gowling WLG
Smart & Biggar

TIER 2

Bennett Jones
Norton Rose Fulbright
Osler Hoskin & Harcourt
Robic

TIER 3

Baker McKenzie
Cassels Brock & Blackwell
CPST Intellectual Property
Deeth Williams Wall
Fasken
Marks & Clerk
McCarthy Tétrault
McMillan
Ridout & Maybee
Torys

OTHER NOTABLE FIRMS

Aird & Berlis
DLA Piper
Lavery

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CHILE

TRADEMARK

TIER 1

Albagli Zaliasnik

Alessandri

Carey

Sargent & Krahn

Silva

TIER 2

Claro & Cia

Porzio Rios Garcia Abogados

Villaseca Abogados

TIER 3

Beuchat Barros & Pfenniger

ClarkeModet

Covarrubias

Magliona Abogados

OTHER NOTABLE FIRMS

CMS Carey & Allende

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CHINA

DOMESTIC FIRMS

TRADEMARK DISPUTES

TIER 1

King & Wood Mallesons
Wanhuida Intellectual Property

TIER 2

CCPIT Patent and Trademark Law Office
Chang Tsi & Partners
Fangda Partners
JunHe
Kangxin Partners
LexField Law Offices
Lifang & Partners
Unitalen Attorneys at Law
Zhong Lun Law Firm

TIER 3

Beijing East IP
China Patent Agent (HK)
FenXun Partners
Han Kun Law Offices
IntellecPro
Liu Shen & Associates
Lusheng Law Firm
Watson & Band

OTHER NOTABLE FIRMS

An Tian Zhang & Partners
AnJie Broad Law Firm
Beijing Sanyou Intellectual Property Agency
DeHeng Law Offices
Gen Law Firm
Hylands Law Firm
Lawjay Partners
Lung Tin Intellectual Property Agent
Shanghai Patent & Trademark Law Office
Tahota Law Firm
Zhongzi Law Office
ZY Partner

TRADEMARK PROSECUTION

TIER 1

CCPIT Patent and Trademark Law Office
China Patent Agent (HK)
King & Wood Mallesons
Wanhuida Intellectual Property

TIER 2

Chang Tsi & Partners
Kangxin Partners
NTD Intellectual Property Attorneys
Unitalen Attorneys at Law

TIER 3

An Tian Zhang & Partners
Beijing Sanyou Intellectual Property Agency
China Sinda Intellectual Property
IntellecPro
LexField Law Offices
Liu Shen & Associates

OTHER NOTABLE FIRMS

Advance China IP Law Office
AFD China Intellectual Property Law Office
Beijing East IP
Beijing Janlea Trademark Agency
JunHe
Lung Tin Intellectual Property Agent
Shanghai Patent & Trademark Law Office
Zhongzi Law Office

FOREIGN FIRMS

TRADEMARK

TIER 1

Baker McKenzie
Hogan Lovells
Rouse

TIER 2

AWA
Bird & Bird
Deacons
DLA Piper
SIPS
Wilkinson & Grist

TIER 3

Gowling WLG
Jones Day
Mayer Brown
Perkins Coie
Simmons & Simmons
Spruson & Ferguson
Vivien Chan & Co

OTHER NOTABLE FIRMS

Norton Rose Fulbright

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**Spring Chang**

Founding Partner

Chang Tsi & Partners

6-8th Floor Tower A, Hundred Island
Park, Bei Zhan Bei Jie Street, Xicheng
District, Beijing 100044, P.R. China

Tel: +86 10 8836 9999

Fax: +86 10 8836 9996

springchang@changtsi.com

www.changtsi.com

Named the World's Leading Intellectual Property Lawyer by Chambers & Partners, Spring Chang has advised and represented numerous world's leading companies in a wide array of business sectors such as electronics, consumer, pharmaceutical, food and beverage, apparel, and jewelry.

Thanks to her creative approach and high efficiency in over three decades of practice, Spring has earned an international reputation and many publications appreciate her "great judgment" and "wealth of experience in serving well-known multinationals".

Spring has been widely recognized as one of the most influential IP lawyers in China by leading legal media as she always provides clients with tailored legal solutions in a rapidly changing Chinese market. She has been also invited by renowned legal associations and institutions worldwide to share her extensive knowhows in trademark and design patent law.

**Vivien Chan**

Vivien Chan & Co.

32/F, Harbour Centre,
25 Harbour Road, Hong Kong

Tel: +852 2522 9183

Fax: +852 2845 9160

vivchan@vcclawservices.com

www.vcclawservices.com

Vivien Chan is the founding and senior partner of Vivien Chan & Co, a Greater China law firm with offices in Hong Kong (1985) and Beijing (1993). Ms Chan was awarded the Lifetime Achievement Award in 2017 by the American Chamber of Commerce in Hong Kong and has recently recognized as Chambers and Partners 2023 Eminent Practitioners of Intellectual Property. Vivien was awarded the Bronze Bauhinia Star in 2008 and Silver Bauhinia Star in 2014 by the HKSAR Government for her outstanding contributions to Hong Kong.

Vivien started her own law firm in 1985 and has over 40 years of experience in M&A, China direct investment, corporate services, employment, technology transfers and information technology, intellectual property and related tax issues. As a firm, Vivien Chan & Co has won numerous awards and accolades, and is consistently named as one of the leading intellectual property firms in Greater China and Asia.

Vivien is a Justice of the Peace and a past president of the Inter-Pacific Bar Association. She is a Notary Public, a Notarial Attesting Officer in PRC, and an arbitrator at CIETAC, Shanghai International Arbitration Center and the Shenzhen Arbitration Commission. She founded the Hong Kong Committee for UNICEF United Nations Children's Fund and is the former chair of the Hong Kong Adventure Corps (HKAC) and the HKSAR Estate Agents Authority. She is a member of governing Council of the University of Hong Kong.

Vivien received her law degree from King's College, University of London, and is admitted as a solicitor in England and Wales, Hong Kong, Australia and Singapore. Vivien is fluent in English, Mandarin, French and Cantonese.

**Anna Mae Koo**

Vivien Chan & Co.
32/F, Harbour Centre,
25 Harbour Road, Hong Kong
Tel: +852 2522 9183
Fax: +852 2845 9160
annamae.koo@vcclawservices.com
www.vcclawservices.com

Anna Mae Koo is a partner of Vivien Chan & Co, where she practises non-contentious, contentious and transactional IP law. She regularly advises on all areas of intellectual property, including licensing, franchising and other transactional intellectual property, due diligence and strategic acquisitions, prosecution, technical assistance and technology transfer agreements, trade practices and unfair competition law in China and Hong Kong.

Ms Koo is involved in many renowned international associations, including as vice chair of the Professional Development Committee of the International Trademark Association and the Litigation Committee of the International Bar Association. She is consistently named a Rising Star Lawyer in intellectual property by various publications.

Ms Koo is active among tech entrepreneur spheres. She was a Techstar mentor in London, serves on the Innovation and Technology Venture Fund for the Hong Kong government, an adviser for CapitaLand (Singapore)'s C31V corporate venture fund, and is on the Entrepreneurship Committee Advisory Group for Cyberport Hong Kong.

Ms Koo was a Prince Philip Scholar at the University of Cambridge and read law at Peterhouse, Cambridge. She has also obtained a master's in real estate from the University of Hong Kong. She is fluent in English, Mandarin and Cantonese.

**Bai Gang**

Founding Partner

Wanhuida Intellectual Property
Yiyuan Office Building, Friendship Hotel,
No. 1 Zhongguancun Street South,
Haidian District, Beijing, China 100873
Tel: (86-10) 6892-1000
Fax: (86-10) 6894-8030
baigang@wanhuida.com
www.wanhuida.com

Bai Gang is the Founding Partner and Management Committee Chair at Wanhuida Intellectual Property.

Mr. Bai is a prominent figure in China's intellectual property field. He is a veteran intellectual property counsel who has been representing the clients' prosecuting, enforcement and litigating interests in China since 1990s. He has been leading the firm's practice groups in obtaining landmark decisions, delivering astute, reliable and effective legal solutions for clients' high-profile cases, contributing to the nation's IP legislative progress and helping to mold the industry standards.

Mr. Bai has been playing an advisory role in the legislative progress of Chinese IP laws and regulations. He was invited to advise on the third amendment to the "Trademark Law", the amendment to the "Regulations for the Implementation of the Trademark Law", the revision of the "Regulations on Customs Protection of Intellectual Property Rights", the drafting of the "Provisions of the Supreme People's Court on Several Issues Concerning the Hearing of Administrative Cases Involving the Granting and Affirmation of Trademark Rights", among others.

Mr. Bai authors/co-authors a dozen of articles and treatise. Some of his recent publications includes: *"The Court of Yuyao (Zhejiang Province) adjudicates a civil claim incidental to a criminal trademark infringement case"*, *"Matters to be addressed in the future revision of China's trade mark law"*, *"China's 2018 National Intellectual Property Action Plan"*, *"Regulations Clarify Role of New Agencies Following China's IP Institutional Reform"* and *"The Outlook for IP and Brand Owners in the Context of China's Institutional Reform"*.

He currently serves on INTA's Board of Directors for the 2020-2022 term. Since 2014, Mr. Bai has been included nine years in a row in Managing IP's List of IP STARS in China. He has been rated as Leading Lawyer/Individual by *"Legal 500"* (2010-2022), *"Chambers & Partners"* (2011-2021) as well as *"Asialaw Profiles"* (2016-2022). He is inducted into the Legal 500 Asia Pacific Hall of Fame in 2021 and 2022. In 2022, he is also listed as an *"Eminent Practitioner"* by *"Chambers & Partners"* in the category of *"Intellectual Property: Non-litigation (PRC Firms)"*.





Ren Haiyan
Partner

Wanhuida Intellectual Property
Yiyuan Office Building, Friendship Hotel,
No.1 Zhongguancun Street South,
Haidian District, Beijing, China 100873
Tel: (86-10) 6892-1000
Fax: (86-10) 6894-8030
renhaiyan@wanhuida.com
www.wanhuida.com

Ren Haiyan is a Partner at Wanhuida Intellectual Property and a member of the firm's Management Committee. She is the most experienced trademark attorney of the firm, starting practising as a trademark attorney in 1994 and progressively extending her practice to design patent counseling and strategic planning for integrated IP rights protection.

In her 28 years of practice, Ms. Ren has handled high-profile cases relating to trademark and design patent filing, registration, litigation and dispute resolution. She has advised numerous Fortune 500 companies on trademark profile auditing, strategic planning for trademark and design protection, domain name disputes, unfair competition, customs border protection and criminal enforcement.

Ms. Ren was elected to the China Trademark Office Subcommittee of the INTA Trademark Office Practices Committee for her significant experience in the field. She is also a sought-after speaker at IP-related seminars and conferences throughout China and has given speeches at various global annual conferences organised by INTA, IACC and others.

Ms. Ren authors or co-authors a dozen articles. Some of her most recent articles includes "Several Issues We Should Know in the Battle against Bad-Faith Trademarks in China", "Becoming more strategic in fighting bad faith filing in China" and "Bad faith trademark filing".

As one of the firm's main representatives, Ms. Ren has been nominated as a leading individual practitioner in the field of intellectual property in China. She was included in *Managing IP's* 2021 and 2020 edition of Top 250 Women in IP for her exceptional performance for her clients and firms. She was named as an "Outstanding Individual" by the *World Trademark Review* in 2011, 2012, 2017, 2018 and 2019 and 2022. She has been an "IP STAR" in China rated by *Managing IP* since 2017. Since 2019, Haiyan has been listed as a recommended IP Lawyer by The Asia Pacific Legal 500.



Huang Hui
Partner

Wanhuida Intellectual Property
Yiyuan Office Building, Friendship Hotel,
No.1 Zhongguancun Street South,
Haidian District, Beijing, China 100873
Tel: (86-10) 6892-1000
Fax: (86-10) 6894-8030
huanghui@wanhuida.com
www.wanhuida.com

Dr. Huang is a Partner at Wanhuida Intellectual Property and a Member of the firm's Management Committee. He holds a J.D. on Trademark Law from the China Academy of Social Sciences and another from the University of Strasbourg in France.

Dr. Huang is a multi-faceted intellectual property counsel with stellar academic credentials on China's trademark legislation and practice and a veteran lawyer who represents clients in all levels of Chinese courts up to the Supreme People's Court in a wide variety of intellectual property litigations, some of which have become landmark cases.

Since joining private practice in 2002, Dr. Huang has been prosecuting and litigating trademarks, fighting for the clients in their most intricate matters before the nation's IP administrative agencies and judiciary, protecting and defending client's interests and helping advancing China's legal fronts.

Dr. Huang is a prolific writer. He authors or co-authors a dozen publications, including "Trademark & Unfair Competition Cases in China", Trademark Chapter of the "Study on Global Intellectual Property Developments 2019", "L'IMPACT DE L'USAGE SUR L'ÉTENDUE DE LA PROTECTION DES MARQUES: ÉTUDE DE DROIT COMPARÉ CHINE – UNION EUROPÉENNE" (2010-2018), "Zheng Chengsi IP Anthology – Trademark & Unfair Competition", "Trademark Law" and the "Trademark Laws of Twelve Nations". He translates the Legislative Part of the "Intellectual Property Code of France".

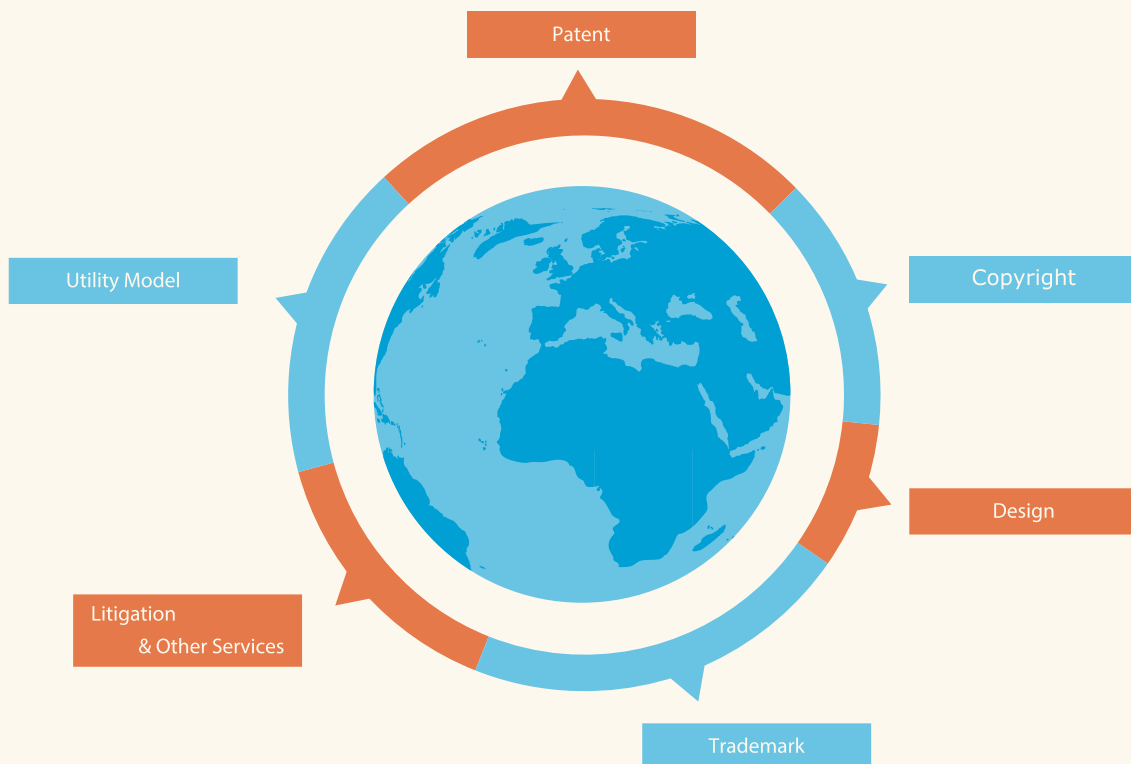
On account of his expertise in the Trademark Law, Dr. Huang has been vigorously involved in the initial drafting and subsequent amendments to China's major trademark-related laws, regulations, judicial interpretations, as well as regulatory documents.

Dr. Huang has been rated as an Outstanding Individual by *World Trademark Review* 12 years in a row and has been included in *Managing IP's* List of IP STARS in China since 2015. In 2020, he is identified as one of the WTR Global Leaders (Private Practice) in mainland China.



AFD China Intellectual Property Law Office

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AFD China Intellectual Property is a top-tier privately-owned IP firm in China. We have over 250 people working in our Beijing Office. Two third of them are IP practitioners including patent attorneys, trademark attorneys, and attorneys-at-law. We also have a client-supporting team including several U.S. patent agents located in Washington, U.S.A.

We provide services to clients worldwide in all areas of intellectual property law, including patents, trademarks, copyrights, unfair competition, trade secrets, domain names, licensing, and other legal areas dealing with technology and IP.

Contact Us:

Head Office: Golden Towers, Tower B,
21st Fl., 38 Xueqing Road, Beijing
100083, China

Tel: +86 10 8273 0790
Fax: +86 10 8273 0820
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Beijing Office

6-8th Floor Tower A, Hundred Island Park, Bei Zhan Bei Jie Street, Xicheng District, Beijing 100044, P.R. China

Tel. (+86) 10 8836 9999
Fax. (+86) 10 8836 9996
E-Mail. info@changtsi.com



Shanghai Office

2508 A, Office Section 3, Jinmao Tower, 88 Century Avenue, Pudong New Area, Shanghai 200121, P.R. China

Tel. (+86) 21 6168 2668
Fax. (+86) 21 6106 2098
E-Mail. info@changtsi.com



Guangzhou Office

2305 Tower B Center Plaza, No. 161 Linhexi Rd, Tianhe District, Guangzhou 510620, P.R. China

Tel. (+86) 20 2881 6699
Fax. (+86) 20 2881 6669
E-Mail. info@changtsi.com



Shenzhen Office

38E China Energy Storage Building, No.3099, Keyuan South Road, Nanshan District, Shenzhen 518057, P.R. China

Tel. (+86) 755 8660 3009
Fax. (+86) 755 8660 3005
E-Mail. info@changtsi.com



Hong Kong Office

Level 19, Two International Finance Centre, 8 Finance Street, Central, Hong Kong, P.R. China

Tel. (+852) 3101 7277
Fax. 852 3101 7288
E-Mail. info@changtsi.com



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CPA Tower, No. 46 Huayanbeili,
Chaoyang District, Beijing 100029, China

Tel : (86 10) 8220 2288

Fax : (86 10) 6621 1564 (Patent)

(86 10) 6621 1590 (Trademark)

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Fax: (1 212) 809 8118

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12/F, Block One, China Phoenix Building,
2008 Shennan Road, Futian District,
Shenzhen 518026, China

Tel: (86 755) 8275 5788

Fax: (86 755) 8368 8269

Tokyo

Rm 811, Burex Kyobashi Building,
2-7-14 Kyobashi, Chuo-Ku,
Tokyo 104-0031, Japan

Tel : (81 3) 6263 2418

Fax : (81 3) 6263 2417

Shanghai

23/F, Crystal Century Mansion,
567 Weihai Road, Jing'an District,
Shanghai 200041, China

Tel : (86 21) 5203 1399

Fax : (86 21) 6288 3922

Munich

Frauenstr. 32,
80469 Munich,
Germany

Tel: (49 89) 228 9328

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A vintage-style map of Southeast Asia and the Pacific Ocean serves as the background. A silver and black compass is positioned in the upper right quadrant, pointing towards the top right. The map shows various countries including China, Myanmar, Thailand, Cambodia, Laos, Vietnam, Philippines, Malaysia, Singapore, Indonesia, and Papua New Guinea. Major cities like Bangkok, Manila, Jakarta, and Singapore are labeled. The text is overlaid on a semi-transparent white rounded rectangle in the center.

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Add(Beijing): 7th Floor, Scitech Place No.22
Jianguomenwai Avenue Beijing 100004, China
Tel: +86 10 5920 8888
Fax: +86 10 5920 8588
E-Mail: mail@unitalen.com
Website: www.unitalen.com

地址: 中国北京建国门外大街22号赛特广场7层
(邮编: 100004)
电话: +86 10 5920 8888
传真: +86 10 5920 8588
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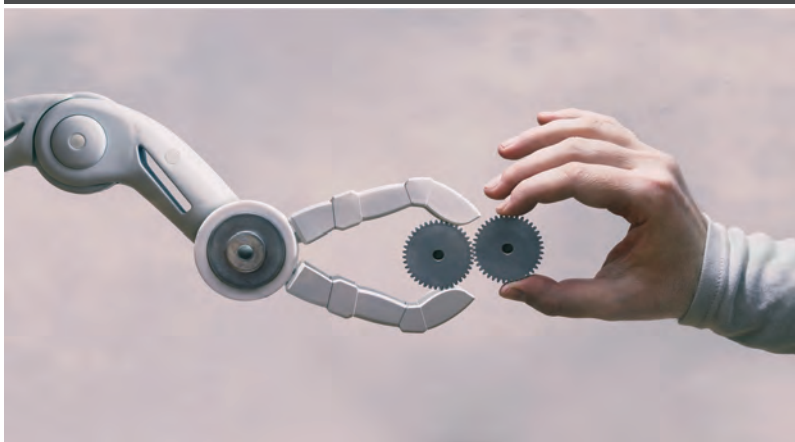
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Before they become
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all phenomena are seeds.

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25 Harbour Road, Hong Kong

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F : (852) 2845 9205

E : vivchan@vcclawservices.com

Beijing Office

Suite 508, Beijing Tower
10 East Changan Street, Beijing 100006, China

T : (8610) 6522 7072

F : (8610) 6522 6967

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**Vivien Chan**

Vivien Chan & Co.
32/F, Harbour Centre,
25 Harbour Road, Hong Kong
Tel: +852 2522 9183
Fax: +852 2845 9160
vivchan@vcclawservices.com
www.vcclawservices.com

Vivien Chan is the founding and senior partner of Vivien Chan & Co, a Greater China law firm with offices in Hong Kong (1985) and Beijing (1993). Ms Chan was awarded the Lifetime Achievement Award in 2017 by the American Chamber of Commerce in Hong Kong and has recently recognized as Chambers and Partners 2023 Eminent Practitioners of Intellectual Property. Vivien was awarded the Bronze Bauhinia Star in 2008 and Silver Bauhinia Star in 2014 by the HKSAR Government for her outstanding contributions to Hong Kong.

Vivien started her own law firm in 1985 and has over 40 years of experience in M&A, China direct investment, corporate services, employment, technology transfers and information technology, intellectual property and related tax issues. As a firm, Vivien Chan & Co has won numerous awards and accolades, and is consistently named as one of the leading intellectual property firms in Greater China and Asia.

Vivien is a Justice of the Peace and a past president of the Inter-Pacific Bar Association. She is a Notary Public, a Notarial Attesting Officer in PRC, and an arbitrator at CIETAC, Shanghai International Arbitration Center and the Shenzhen Arbitration Commission. She founded the Hong Kong Committee for UNICEF United Nations Children's Fund and is the former chair of the Hong Kong Adventure Corps (HKAC) and the HKSAR Estate Agents Authority. She is a member of governing Council of the University of Hong Kong.

Vivien received her law degree from King's College, University of London, and is admitted as a solicitor in England and Wales, Hong Kong, Australia and Singapore. Vivien is fluent in English, Mandarin, French and Cantonese.

**Anna Mae Koo**

Vivien Chan & Co.
32/F, Harbour Centre,
25 Harbour Road, Hong Kong
Tel: +852 2522 9183
Fax: +852 2845 9160
annamae.koo@vcclawservices.com
www.vcclawservices.com

Anna Mae Koo is a partner of Vivien Chan & Co, where she practises non-contentious, contentious and transactional IP law. She regularly advises on all areas of intellectual property, including licensing, franchising and other transactional intellectual property, due diligence and strategic acquisitions, prosecution, technical assistance and technology transfer agreements, trade practices and unfair competition law in China and Hong Kong.

Ms Koo is involved in many renowned international associations, including as vice chair of the Professional Development Committee of the International Trademark Association and the Litigation Committee of the International Bar Association. She is consistently named a Rising Star Lawyer in intellectual property by various publications.

Ms Koo is active among tech entrepreneur spheres. She was a Techstar mentor in London, serves on the Innovation and Technology Venture Fund for the Hong Kong government, an adviser for CapitaLand (Singapore)'s C31V corporate venture fund, and is on the Entrepreneurship Committee Advisory Group for Cyberport Hong Kong.

Ms Koo was a Prince Philip Scholar at the University of Cambridge and read law at Peterhouse, Cambridge. She has also obtained a master's in real estate from the University of Hong Kong. She is fluent in English, Mandarin and Cantonese.

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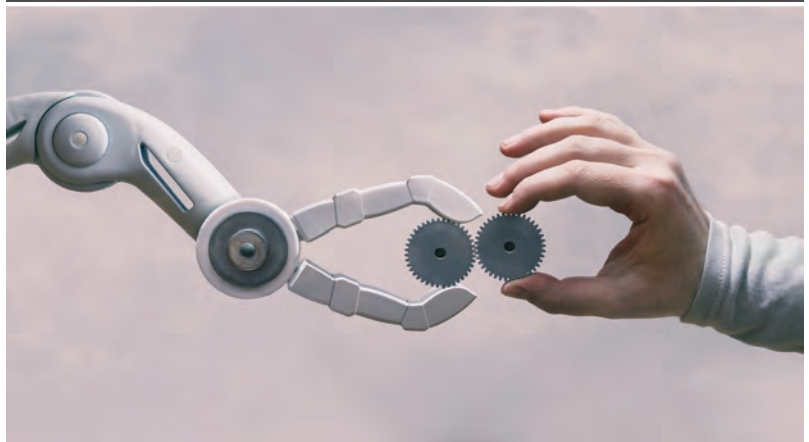
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Hong Kong Office

32/F, Harbour Centre
25 Harbour Road, Hong Kong

T : (852) 2522 9183

F : (852) 2845 9205

E : vivchan@vcclawservices.com

Beijing Office

Suite 508, Beijing Tower
10 East Changan Street, Beijing 100006, China

T : (8610) 6522 7072

F : (8610) 6522 6967

E : beijing@vcclawservices.com

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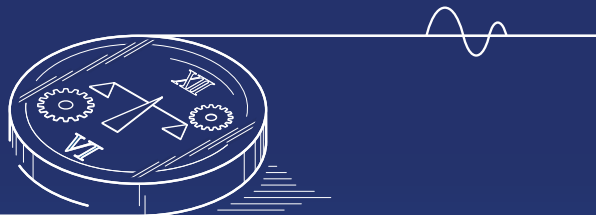
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Malaysia: Trademarks roundup 2022

Azlina Khalid of **Henry Goh** summarises the trademark developments since the Malaysian Trademarks Act 2019 came into force.

The second anniversary of the Malaysian Trademarks Act 2019, on December 27 2021, came and went without much fanfare. By the time the new year of 2022 had announced itself, the general perception was that the relevant stakeholders and the national regulatory agency, MyIPO, had grown accustomed to the new legislation that repealed the archaic 1976 act.

After many months of battling the COVID pandemic, the fourth year of the 2019 act's enforcement impacted the Malaysian trademark landscape in more ways than one. This article will discuss those developments.

Growth in trade marks

The final number of trademark filings for 2021 in Malaysia was 50,500, of which almost 60% were accounted for by foreign applicants. This was a change to the balance that existed before the pandemic, when the number of local applicants was almost equal to the number of foreign applicants.

At the time of writing, the statistics available through MyIPO had only been updated to the end of August 2022, with a total of 31,540 applications having been filed. Again, the number of foreign applicants was significantly higher, at 19,899 (an increase of 3% on 2021), than the number of local applicants, which stood at 11,641.

Assuming a constant amount of 3,942 marks being filed monthly, an extrapolation of the available numbers suggests that about 47,310 trademark applications were filed in 2022. If this were indeed the case,

then there would have been a 6% drop in the number of trademark filings handled by MyIPO from 2021.

One reason may be that local businesses in Malaysia are still reeling from the economic impact of the pandemic and have put their intellectual property strategies on hold to concentrate on riding out their business challenges.

Out of the total trademark applications that were filed in 2022, the exact number of applications of Madrid System origins cannot be ascertained. MyIPO remains reticent to share its international application statistics, which would provide a clearer picture of the country's filing trends.

As for trademarks that were accepted for registration in the same year, it is heartening to note that proportionally more marks were accepted and registered by MyIPO. As a comparison, 34,304 trademark applications were registered in 2021. Up to the end of August 2022, 24,043 marks had been registered. Extrapolating once again based on the available numbers, it can be suggested that the number of trademarks which were allowed registration by the end of the year could have reached 36,000, which would be almost a 5% increase in registered marks.

The administration of trademarks

2022 as a whole may best be remembered by how often, and for how long, the majority of the Malaysian workforce had to work from home or on a hybrid basis. This was primarily due to the highly contagious

Omicron variant of COVID that was pervasive that year.

MyIPO continued to serve practitioners and the public by making available its IP Online filing system and accepting manual filing in its day-to-day transactions. Perhaps the most keenly felt challenge in the Malaysian intellectual property space in 2022 was the shortage of MyIPO officers, particularly in the trademarks section.

While the Search and Examination Unit seemed to cope well with its scope of work, churning out numerous notifications of provisional refusal, perhaps the same cannot be said for the appeals and hearing units.

As a quick recap, under the new act there was a significant change to the examination procedure, whereby the applicant no longer has the luxury of, at first, filing written representations to the Registrar arguing against the raised objections and then having the option to request a hearing if the submissions are rejected.

Since the perceived 'second bite at the cherry' has been nipped in the bud, and applicants are now given an ultimatum of filing written representations or requesting a hearing, more and more of them have chosen the latter option, which is to file for a hearing so that their local agent or representative is able to argue their case fully.

However, this has created a bottleneck at the Hearing Unit, which Henry Goh understands to be severely understaffed. This means that while a majority of applicants are opting for a hearing to prosecute their application fully, there has been an accumulation of cases that concern

the setting of hearing dates. At the time of writing, it is understood that the Registry is unable to cope with the deluge of hearing requests and is now only fixing hearing dates for trademark disputes with hearing requests that were filed in 2020 or early 2021. Due to the staff shortage, even with hearings being fixed and heard, decisions may be issued late, as the same officers are dealing with the files.

This snowball effect of late hearing dates being scheduled in addition to late decisions being rendered does not bode well for applicants, some of which may lose interest in their applications simply because of the protracted length of time it takes for their marks to be accepted.

It is hoped that MyIPO will make serious inroads in addressing this issue so that it will not lose the confidence of local and foreign applicant stakeholders.

The trademark legislation

In so far as trademarks are concerned, there were no significant changes in legislation in 2022. However, the Malaysian government passed the new Geographical Indications Act (the GI Act 2022), which replaced the Geographical Indications Act 2000 on March 18 2022.

A geographical indication (GI) is distinct from a trademark, as a GI is essentially a protected mark for a collective group of producers or a responsible authority from an area or region that manufactures or produces a specific product. The most obvious example would be champagne from the Champagne region in France. Malaysia, with its rich and abundant natural resources, is home to a plethora of goods produced in certain regions and some have been registered as GIs. The ones that are commonly known would be Bario Rice and Sarawak peppers.

Due to the promulgation of the GI Act 2022 and to give effect to the same, the Trademarks Act 2019 was amended through the Trademarks (Amendment of First and Second Schedule) Order 2022 (the Order) and the Trademarks (Amendment Regulations) 2022 (the Regulations).

The key amendments under the Order and Regulations include:

- Prohibition of registration of a collective mark containing a GI if it includes an indication term that is identical to any goods or services in Malaysia, or where the GI is not protected or has lost its protection from its country of origin, or where the goods do not originate from there, so as to mislead the public as to the source of the collective mark;
- Prohibition of registration of a collective mark which has been applied for or has been registered under the GI Act 2022 for identical or similar goods and where the goods do not originate from the indicated GI;
- Prohibition of registration of a collective mark in respect of a wine or spirit where the collective mark is used in relation to wines or spirits not originating from the place indicated by the initial GI and even excludes GIs accompanied by terms of expression such as 'kind', 'type', and 'style';
- The invalidation of a registered collective mark with a GI is allowed where the mark was wrongly registered, or the mark has fallen into disuse or lost protection in its country of origin, or where the GI has become a common name for goods in Malaysia;
- An applicant for a new collective mark/certification trademark that has a GI from any country except Malaysia must furnish MyIPO with evidence that the mark has been granted a GI in its country of origin; and
- For opposition proceedings involving collective or certification marks with GIs, the notice of opposition must contain a statement that the opposition is based on the registration of a GI registered under the GI Act 2022, with a representation and full particulars of the registered GI included in the grounds of opposition.

As can be seen, these amendments to the Order and Regulations were necessary to give full effect to the new GI Act 2022



Azlina Khalid

Senior legal counsel

Henry Goh

T: +60 3 9771 8688

E: malaysia@henrygoh.com

With more than 25 years of IP work experience and 18 of them spent at Henry Goh, Azlina, who is the firm's senior legal counsel (in-house) and head of prosecution, is the go-to person for registration, prosecution and advisory in relation to trademark matters.

Her wealth of knowledge extends beyond the above, and she is also skilful in patent, industrial design and copyright legal issues. Helming a team made up of a legal counsel, trademark agents, and legal and trademark executives for day-to-day work, she also provides guidance to clients in relation to matters such as pre-litigation advice, advisory on trademark enforcement, consultation on franchise and licensing agreements, domain name registration and IP due diligence.

She is one of the firm's main speakers and presenters at company-organised seminars for clients and the public. On the international front, Azlina has received various invitations to speak, with papers presented in India, Thailand, and Japan.

while maintaining the sanctity of collective and certification trademarks falling within the purview of the Trademarks Act 2019.

Trademark litigation

Once the majority of workers came back to working in the office, so did the judiciary and court officers. However, the trend of

hearing cases online via Zoom or even a hybrid mode of online and physical hearings still seems to be the norm. Regarding the number of cases, it can be surmised that there has been a slowdown of intellectual property cases being filed in the past year.

One of the most recent cases decided in 2022 was *Oatly AB v Pahang Pharmacy Sdn Bhd* [2022] MLJU 3042. This case was interesting as it dealt with the revocation of a trademark under the new Section 46 of the Trademarks Act 2019.

The facts of the case were as follows:

- The defendant had three trademarks for the word 'OATLEY' that had been registered since 2013 under the old act in classes 5, 16 and 29 respectively;
- The plaintiff, a Swedish company, is a manufacturer of oat-based dairy products and substitutes, and sells its goods under the brand name OATLY;
- The plaintiff was successful in registering its OATLY trademark in 2016 and 2020 for classes 29, 30 and 32;
- To expand its business in Malaysia, the plaintiff then filed a further seven applications in multiple classes but the applications were issued with provisional refusals stemming from the defendant's prior registration; and
- The plaintiff then conducted an investigation and a market survey to determine if the defendant's registered trademarks were indeed being used in the market, and subsequently filed an originating summons to expunge the registrations from the Malaysian Trademarks Register for non-use under Section 46(1) of the Trademarks Act 2019.

At the hearing of the plaintiff's application to expunge, counsel for the plaintiff informed the court that his client was relying on limb (b) of the aforementioned section, which states: "The Registration of a trademark may be revoked by the Court on an application by an aggrieved person on any grounds as follows: where the use of the goods or services under paragraph (a) has been suspended for an uninterrupted period of three years, and there are no proper reasons for non-use."

The plaintiff took the position that there was a three-year period of non-use, where use had been suspended from 2019–22 after the defendant had shown that they were using the registered trademarks between 2013–16. Therefore, the calculation as to when the non-use period of three years came into question.

Based on the facts of the case and evidence produced during the hearing, the judge determined the case as follows:

- The plaintiff had successfully established a prima facie case of non-use by the defendant during the market survey that had been undertaken. There was evidence to show that the defendant had not been using its registered trademarks after registration; i.e., after 2016;
- The burden of proof once the plaintiff had established non-use then shifts to the defendant to show that it was still using its registered trademarks, or, if there had been no use, there were proper reasons for the same; and
- Evidence adduced had shown that the defendant had not used its registered trademark since 2016 and had relied on the pandemic as a proper reason for non-use in addition to submitting its business plan to use its registered

marks on its registered goods between November 2021 and September 2022.

However, the above was rejected by the court as the defendant was not able to proffer any reasons for its non-use of its registered trademarks between 2016 and the onset of the pandemic.

As a result, the judge ordered the expungement of the defendant's trademarks in classes 5 and 29 only, while leaving the remaining registration intact.

The takeaway of the case suggests that if a registered proprietor does not actively use its trademark that has been registered, then the possibility of losing it is very real. Additionally, the timeframe for calculating the three-year period of non-use, while usually taken from the date of registration (or the date of notification of registration), may change once the plaintiff is able to show non-use, and the burden of showing use then shifts to the defendant proprietor to prove that there had been use of the registered mark up to the application to revoke; failing which, it must clearly indicate good and proper reasons for the non-use.

Conclusion

2022 can be seen as a fairly challenging year in the Malaysian trademark landscape, but one ought to remain optimistic that things will improve in the next 10 months or so. Local businesses seem to be slowly getting back on their feet and there is continued interest among foreigners in protecting their trademarks in this small but significant market within the region. MyIPO should endeavour to improve itself in all its operational aspects so as to sustain such interest, which, in turn, will be good for the Malaysian economy.


Azlina Aisyah Khalid

Henry Goh & Co Sdn. Bhd.
VO2-10-06 Lingkaran SV
Sunway Velocity, Jalan Peel
55100 Kuala Lumpur, Malaysia
Tel: 03-9771 8688
Fax: 03-9771 8788
azlina@henrygoh.com
www.henrygoh.com

With more than twenty-seven years of IP work experience and nineteen of them spent at Henry Goh, Azlina who is the Firm's Senior Legal Counsel (In House) and Head of Prosecution, is the go-to person for registration, prosecution and advisory in relation to trademark matters.

Helming a close-knit team of professionals with legal and trademark expertise for day-to-day work, Azlina also provides good guidance to clients in relation to matters such as pre-litigation advice, advisory on trademark enforcement, consultation on franchise and licensing agreements, domain name registration and IP due diligence. Azlina has excellent rapport with the Malaysian IP Office whilst carrying out her duties as a Registered Patent, Trademark, Industrial Design and Geographical Indication Agent.

She was called to the Malaysian Bar in 1996 after passing her CLP examinations subsequent to obtaining her Law degree from the University of Kent at Canterbury, United Kingdom. She spent her formative years as a practicing lawyer at one of Malaysia's leading law firms which has a sizeable IP department. It was serendipity when she chanced upon an advertisement taken out by the Firm's founder, Mr. Henry Goh in 2004 and the rest they say, is history.

Her professional memberships include the Malaysian Intellectual Property Association (MIPA), the Malaysian Intellectual Property Alumni Association (MIPAA) and the Asian Patent Attorneys Association (APAA). Azlina is a twice alumnus of the Japan's Association of Overseas Technical Scholarship (AOTS) having participated in the JPO/IPR Training Course in 1998 and 2008. She has also attended the IP Valuation and IP Business Basics courses organized by the IP Academy of Singapore.

For her skills set, she has received validation from peers and clients alike with the following accolades throughout the years:

- a) AsiaLaw's Leading Lawyers (2012-2018)
- b) WTR 1000 Malaysia's Recommended Individuals (2012-2023)
- c) IP Stars (2014-2022)
- d) WIPR Leader (2016-2023)
- e) Who's Who in Legal Southeast Asia (2021-2023).

Azlina is responsible for the Firm's in house publication in her capacity as its Editor in Chief. She is one of the Firm's main speakers and presenters when there are company organized seminars for clients and the public. On an international front, Azlina has received various invitations to speak with papers presented in India, Thailand, and Japan. She regularly represents the Firm in overseas networking opportunities, business trips and conferences.



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**Min Son**

President and founder

Hanol IP & Law
6FL 135 Beobwon-ro Songpa-gu
Seoul, South Korea
PO Box: 05836
Tel: +8229421100
hanol@hanollawip.com
www.hanollawip.com

Industry sectors:

Life sciences and Chemistry, Pharmaceuticals, Healthcare & Medical Devices, Engineering and Software, Trademark

Min Son founded Hanol Intellectual Property & Law in 2001, and she continues to serve as its head. With a commitment to excellence, Hanol IP & Law has become a leading full-spectrum intellectual property law firm in Korea, offering comprehensive patent and related IP services with a strong reputation in prosecution, litigation, consulting, licensing, and commercialization, etc. Dr. Son has her Ph.D. in biochemistry and has handled numerous high-profile cases in the life sciences, chemistry, engineering, and trademarks. She has expertise in managing extensive patent portfolios for major conglomerates, as well as in cultivating patents and know-how and developing IP-based products for small and medium enterprises.

Year Joined Firm: 2001

Education/Alumni:

- Ph.D. in Biochemistry at University of Wisconsin-Madison
- Santa Clara University School of Law, Intellectual Property LL.M
- BS in Biochemistry at Yonsei University

Languages Spoken: Korean, English

Network Memberships:

INTA, AIPLA, AIPPI, APAA, FICPI, KPAA

Experience:

- Patent examiner (KIPO)
- Patent attorney (Kim & Chang) Performed patent litigation & prosecution representing many global companies
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- Presidential Advisory Council for Science and Technology with IP
- Ministry of Science, ICT and Future Planning; National Biotechnology Policy Council



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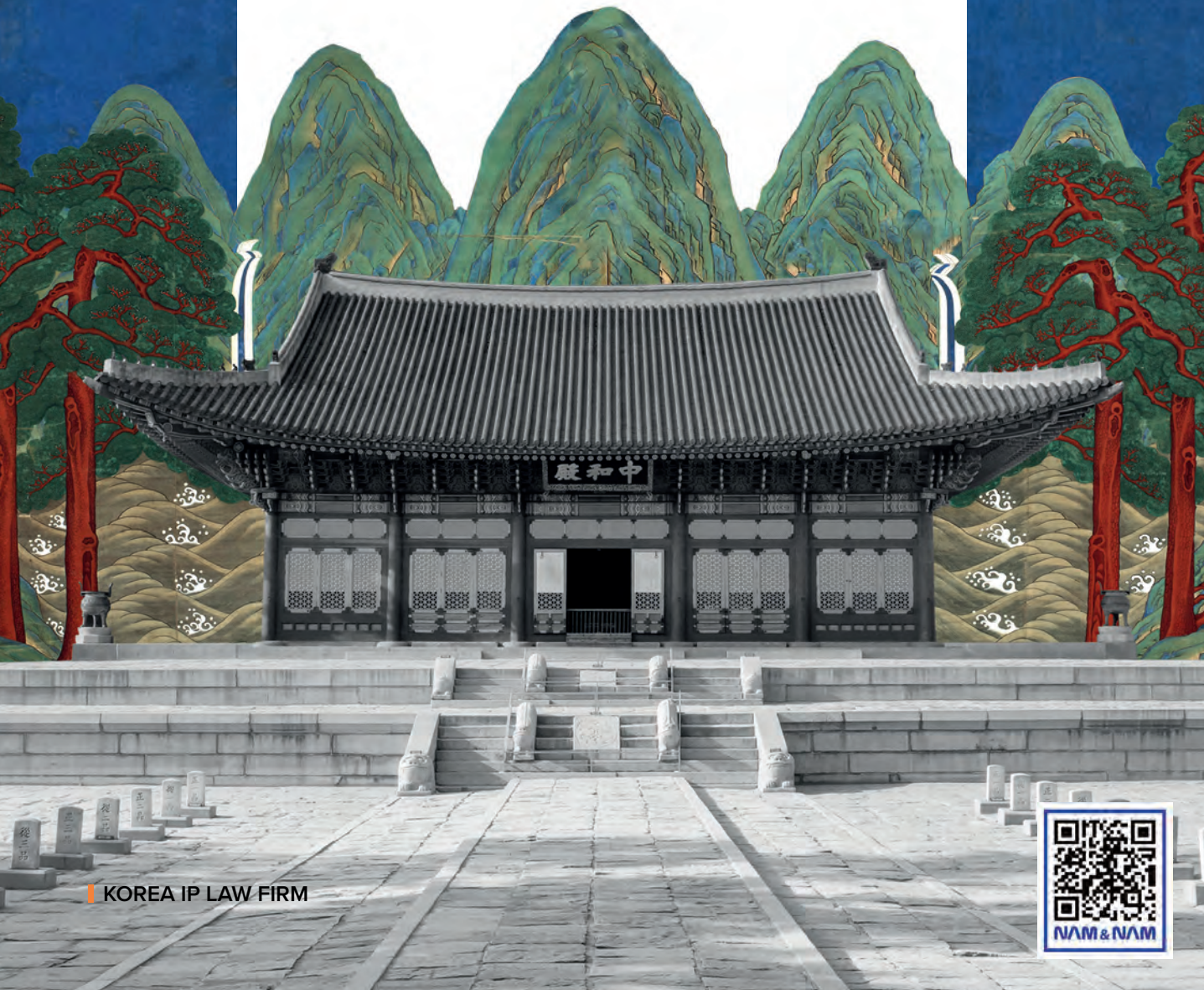
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Contact:

Mr. Pham Vu Khanh Toan
Director
hanoi@pham.com.vn

Hanoi Head Office

8, Tran Hung Dao St., Hoan Kiem Dist., Hanoi
Tel: (84-24) 38244852; Fax: (84-24) 38244853
Email: hanoi@pham.com.vn

Ho Chi Minh city Office

72/6A Tran Quoc Toan St., Vo Thi Sau Ward.,
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Firm Profile

Founded in 1991, Pham & Associates is the oldest and one of the most prominent IP Law firms in Vietnam. The firm offers a full spectrum of intellectual property services in prosecution and litigation for domestic and overseas clients. Since 2001, it has also been engaged in rendering legal services regarding business laws in Vietnam.

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Our lawyers have vast experience in protecting and enforcing IP rights, providing legal support in negotiations and IP dispute resolution.

The firm's working languages is Vietnamese, English, German, Chinese, French and Russian.

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- Copyright, Domain Names
- Plant Variety Protection
- IP Litigation & Licensing
- IP Assets Management & Evaluation

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- Commerce
- Real Estate & Construction
- Tax, Finance & Banking
- Shipping
- Insurance
- Employment & Dispute Resolution

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- **Winner of the Vietnam Patent Firm of the Year Award** and short-listed as one of 5 firms for the Vietnam Trademark Firm of the Year Award (consecutively from 2009-2022) by *Asia IP*;
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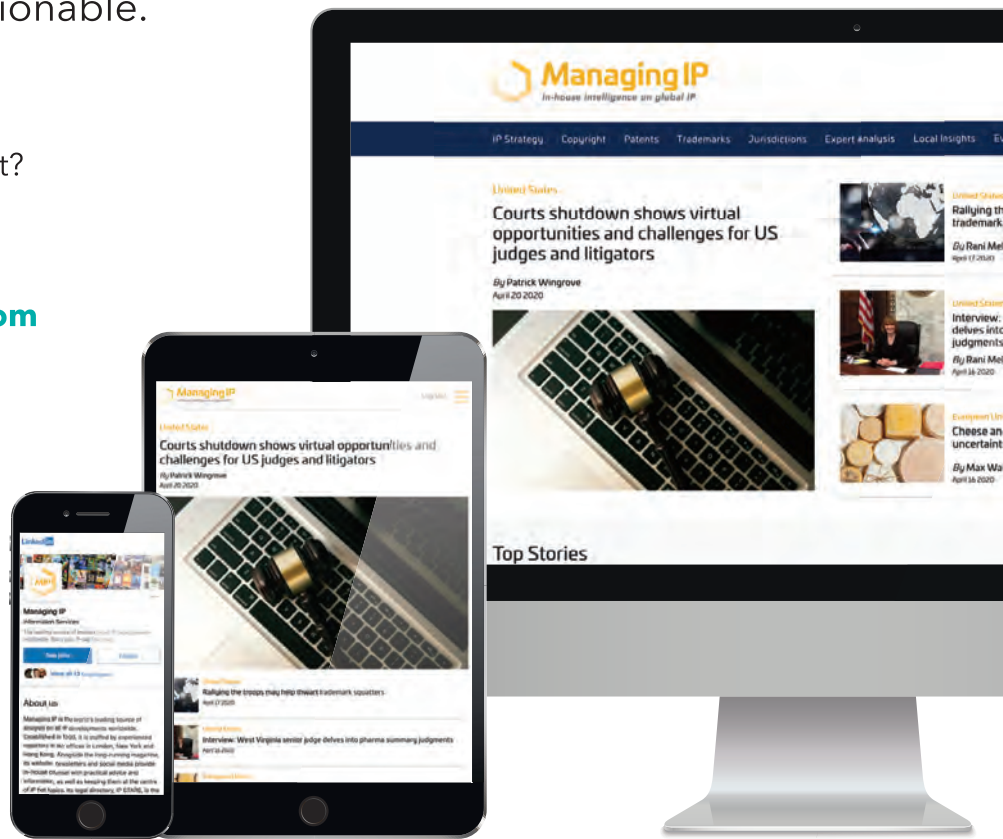


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