



ZHANG Yan

Partner



Areas of Practice

ZHANG Yan is fully engaged in IP litigation and administrative enforcement. He advises clients on IP portfolio management and integrated protection strategies, and enforces IP protection strategies in a manner that maximises the gains of his clients. Managing IP has previously described him as having “made an excellent first impression by gaining an understanding of our business very quickly and working tirelessly on our cases.”

Mr Zhang has rich experience in fighting against IP infringement in China, as well as defending against infringement actions in the fields of patent, trademark, unfair competition, business secrets and copyright. He enforces IP against infringers through administrative and criminal procedures by working with local administrations and courts. IAM has previously called him “*talented at defending and initiating infringement proceedings.*”

Mr Zhang also advises clients on various licensing agreements, as well as corporate issues relating to IP. He provides advice on crisis management, public relations, and legal compliance solutions. IAM has previously stated that “*Yan Zhang is one of a handful of domestic experts with in-depth knowledge of how to structure licensing deals and transactional agreements.*”

He has represented clients in multiple milestone and pioneer cases in the field of IP, including 3D trademarks, parallel import, well-known trademarks, such cases were listed by different legal media, administrations, and Chinese courts, including Supreme Court.

Representative Cases

- **Chivas v Yantai Aowei:** This was the first judgment of a Chinese court to confirm 3D trademark infringement. 3D trademark enforcement is difficult in China. Yantai Aowei imitated the unique bottle shape of the Chivas Regal 12-year-old whisky, which is a 3D trademark of Chivas. In the first instance, Hangzhou Intermediate People’s Court ordered Yantai Aowei to cease infringement and to pay damages. Yantai Aowei appealed but their appeal was rejected.
- **3D Trademark Infringement and well-known commodity:** Represented Pernod Ricard, a European liquor company, in a number of trademark infringement actions relating to 3D



trademarks for Chivas Brothers, Royal Salute, Ballantine, Absolut, and Martell, all of which are well-known commodities. The Absolut case was the first to obtain a judgment for 3D bottle shapes that infringed upon a 2D trademark.

- **Well-known trademark recognition:** Represented, Michelin, a European tire company for recognition of the first and by far the only Chinese super well-known trademark before the court.
- **Parallel Import and Grey Market products:** Advised and represented different clients on parallel import issues, and acting against importers and distributors through administrative raids and civil litigation. By far, these cases are the few cases where IPR owners can succeed against PI/GM importers and distributors in China.
- **Malicious trademark cancellation and prior right conflicts:** Represented Futabasha, a Japanese publishing house, against infringers who registered a cartoon image as trademarks, and acting to have the trademarks cancelled based on malicious registration, prior trademark rights and copyright.
- **Stopping malicious trademark registration and use based on trademark infringement and unfair competition:** Represented Bernard Controls, a European valve company, in litigations against infringers using the same company name and selling products through infringing promotions and web sites. The litigations resulted in court orders for the infringers to change their company name, transfer the trademarks, transfer the domain names, and pay substantial damages.
- **Defending against malicious trademark registration and accusations based on trademark infringement and unfair competition:** Represented Opple Lighting, China's biggest lighting company, against a malicious trademark assignee, that sued for trademark infringement before the client made an IPO. A favourable judgment was granted that required the other side to cease infringement, and narrowed the scope of the trademark registered under the name of the malicious assignee through a series of trademark prosecution related litigations.
- **Criminal proceedings:** Representing a group of foreign spirit companies against counterfeiters, and lobbying the PSB and People's Procuratorates to initiate criminal prosecutions, with a maximum sentence of 5 years. One of those cases was listed as a top 10 IP case by the Supreme People's Court. Additionally, he has represented a foreign spirits company to pursue criminal action against counterfeiters. He has also represented different companies against on-line counterfeiters during criminal raids.



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Projects

- He has provided comprehensive IP portfolio management services for Danone, a European food company, on the establishment of a comprehensive IP portfolio containing patents and trademarks.
- He has provided risk solutions and crisis management for clients by cooperation with investigation teams and authorities to coordinate raids.

Professional Affiliations

- Member, INTA Geographical Indications Committee
- Member, INTA Non-Traditional Trademark Committee
- Member, INTA Enforcement Committee
- Member, AIPPI
- Member, MARQUES
- Expert, China National Center for Abroad IP Dispute Disposition and Guidance
- Member of Sports Legal Study of China Law Society
- Deputy Chief of Committee of Litigation of Beijing Trademark Association
- Member, Committee of Competition and Anti-trust of Beijing Lawyer Association

Awards

- Recommended Individual, Transactions, IAM 1000
- Listed, Who's Who Legal: Trademarks
- Recommended Individual, Licensing, IAM 1000
- Deal of the Year, China Business Law Journal
- Recommended Individual, IAM Licensing 250

Publications

- Co-author of "US Company Law Commentary"
- Co-author of "Nature of Patent Invalidation Request under Chinese Law System"



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- Author, China Section, Getting the Deal Through: Licensing, 2013
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- Mr Zhang has published many other articles on trademarks, patent and unfair competition, published on different media, including China Intellectual Property, Shanghai Intellectual Property, Lexology, and other periodicals

Education

- LLM, International Law, University of International Business and Economics (2002)
- BA, English, Nankai University (1999)

Qualifications

- China Licensed Lawyer

Working Languages

- Mandarin Chinese
- English