

Connie Zhuang

Partner Attorney

Practices: IP Agency, Intellectual Property, Dispute Resolution, Competition and Antitrust

Industries: Real Estate, Service Industry, Automobile, Manufacturing and Industries,
Consumer Goods and Retail, Healthcare and Medicine, Telecommunications,
Media, Entertainment and High Technology

Working language: Chinese, English



Introduction

Connie Zhuang is an all-round international trademark attorney, and her practice fields including the full-range international trademark affairs (foreign to domestic, foreign to foreign, and foreign to domestic): various trademark applications (including Madrid International Trademark Registration, EU and OAPI trademark registration), oppositions, review and adjudication cases, and subsequent administrative lawsuits for determination on trademark rights & ownership; civil lawsuits for trademark infringement & unfair competition; anti-counterfeiting through administrative authorities; customs protection; overall strategies for Chinese and international IP protection; due diligence on trademarks; legal affairs related to copyrights, trade names, unique names and packaging of goods/services, domain names, trade secrets, anti-unfair competition, and other related civil rights/contracts arising from trademark business; handling of right conflicts between different types of IPRs; etc.

Connie Zhuang is specialized in dealing with contentious and non-contentious trademark affairs for and on behalf of foreign clients in the Chinese mainland, and she has worked in this field for more than 25 years. Connie Zhuang, in cooperation with foreign attorneys in major countries and regions around the world, also works for domestic clients in handling trademark affairs in such jurisdictions.

Remarkable achievements

- The administrative lawsuit of invalidation against the Trademark No.11585461 for “世纪博世” (“Century Bosch in Chinese”) in Class 4: Represented Robert Bosch GmbH (the Plaintiff), overruled the Administrative Decision, won finally in the First-instance Trial, and got the Plaintiff’s trademark “博世” (Bosch in Chinese) recognized to be well-known. Besides, producing sufficient evidences, having represented Bosch Group in several hundreds of

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oppositions and invalidation cases and won the majority, among dozens of which CTMO & CNIPA already prior recognized Bosch series trademarks to be well-known repeatedly for many times, soundly in support of Bosch's success in this lawsuit.

- The appeal administrative lawsuit of invalidation against the Trademark No.1602550 for “安踏及图” (“Anta in Chinese & Device”) in Class 9: Represented Anta (China) Co., Ltd. (the Appellant, and the Plaintiff in the First-instance Trial), overruled the Administrative Decision and the First-instance Judgment, won in the Second-instance Trial, got the Appellant's trademark “安踏” (Anta in Chinese) recognized to be well-known, and got the aforesaid bad faith trademark, which was registered for nearly 20 years and used extensively in long term, eventually invalidated. The case was reported by China Intellectual Property News subsequently.
- The civil lawsuit (Perfetti Van Mellen S.P.A. of Italy & Perfetti Van Melle Confectionery (China) Co., Ltd. vs Shenyang Aerbeisi Beverages Co., Ltd.) of infringement upon the plaintiffs' prior well-known trademarks registered on non-identical and dissimilar goods: Represented the two Plaintiffs, won finally in the First-instance Trial, and got the trademarks “阿尔卑斯” (“Alpenliebe” in Chinese) and “Alpenliebe” recognized to be well-known.
- The civil lawsuit (Perfetti Van Mellen S.P.A. of Italy vs Shandong Huatang Foodstuffs Co., Ltd.) of infringement upon registered trademarks and unfair competition: Represented the Plaintiff, and won in the First-instance Trial, with the decided amount of compensation being RMB1,000,000.00 (pending the Second-instance Trial).
- The administrative lawsuit of application for invalidation against the Trademark No. 37142713 for “艾美拉” (“Emmy La in Chinese”) in Class 41: Represented the Emmy Awards for TV programs of the USA, won finally, and got the trademark invalidated by China National Intellectual Property Administration (CNIPA).
- The administrative lawsuits of review on oppositions against the Trademark No.3843993 for “马自达MAZDA” in Class 9 and the Trademark No.4206799 for “MAZDA” in Class 9: Represented the Plaintiff Mazda Motor Corporation, overruled the Administrative Decisions, won finally in the First-instance Trial, and got the Plaintiff's Trademarks “马自达” (MAZDA in Chinese) and “MAZDA” recognized to be well-known.
- The administrative lawsuit of review on opposition against the Trademark No.1741524 for “ERNEST BOREL & Device” in Class 25: Representing the Plaintiff Ernest Borel [Far East] Company Limited of Hong Kong, overruling the Administrative Decision, winning finally in the First-instance Trial, and getting the Plaintiff's Trademark “ERNEST BOREL & Device” recognized to be well-known.
- The administrative lawsuit of invalidation against the Trademark No.12109319 for “九号思慕昔” (“No. 9 Smoothie in Chinese”) in Class 43: Represented Smoothie Foods & Beverages Co., Ltd. of Taiwan, won in the First & Second Instance Trials, in which it was unanimously determined that the aforesaid bad faith trademark was registered by the real infringers in collusion with the controller's relative and it was determined in the Second-instance Judgment with binding force that the single Chinese character in artistic design in the right owner's trademark is protected by the Copyright

Law of China, and won earlier in the related administrative complaint against the real infringers for infringing upon Smoothie's registered trademarks.

- The civil case of negotiation & conciliation regarding a Lithuanian trademark holder's claim of trademark infringement in tens of overseas jurisdictions against a state-owned enterprise: in association with a German attorney, made defense against the Lithuanian enterprise's claim of trademark infringement involving mainly EU and Thailand and the relevant copyright infringement, successfully promoting both parties to, through negotiation and under fair and reasonable conditions, reach a trademark co-existence agreement in global range, which offers solid protection for the smooth operation of more than 90 visa application centers located in 46 countries and regions.
- The administrative lawsuit of dispute regarding the CTMO's approval on assignment of the Trademark No.1110463 for “美毗达” (“Minidiab” [Glipizide]): Represented the Third Party (the trademark assignee) to produce evidences and make defense, gave sound support to the legitimacy of the Defendant i.e. China Trademark Office (CTMO) in giving approval on assignment of the trademark, claimed the expiry of the time limitation of action, successfully forced the Plaintiff (the trademark assignor) to withdraw the Lawsuit in the First-instance Trial, and got the approval on assignment of trademark finally maintained.
- The civil lawsuit (Consitex SA of Switzerland vs Chendu Outlet Business Operation Management Co., Ltd.) of infringement upon 10 registered trademarks for “Ermenegildo Zegna” and “Zegna”: Represented the Plaintiff, and finally won in the First-instance Trial, so as to effectively prevent the Defendant from being engaged in the unfair competition acts of, by utilizing the parallel import, scrambling & disturbing the market with low price.
- Two civil lawsuits (Perfetti Van Mellen S.P.A. of Italy vs Suzhou Tongxinbei Foodstuffs Co., Ltd. and Yiwu Difeng Foodstuffs Co., Ltd.) of infringement upon 7 registered trademarks for “Big Babol”: Represented the Plaintiff, finally won both in the First-instance Trial, and in Tongxinbei Lawsuit, and got the preliminary injunction (Preservation of Acts) issued by Suzhou Intermediate Court issued for the first time in its history, so as to effectively prevent the two Defendants from producing and/or importing counterfeit Big Babol branded bubble gums at low prices to African & Middle East countries.
- The civil lawsuit (Perfetti Van Melle Confectionery (China) Co., Ltd. vs a domestic company manufacturing and merchandising Wales twin lollipops that infringe upon the packaging and decoration peculiar to Alpenliebe Dual Lollipops with fame) of unfair competition,, and the civil lawsuit (Perfetti Van Mellen S.P.A. of Italy vs a foodstuff company in Fujian Province manufacturing and merchandising lollipops that infringe upon the packaging and decoration peculiar to “Alpenliebe Rich Milk Lollipops” with fame) of unfair competition: Made accurate legal analysis and strategies for litigation and completing all preparation works for the Plaintiffs, won in both lawsuits, and got the compensation of RMB500,000 in “Alpenliebe Rich Milk Lollipops” Case through compulsory enforcement.
- The civil lawsuit (the asset management subsidiary of a famous domestic insurance company vs an asset management company located in Beijing with identical trade name registered in bad faith) of infringement upon registered

trademarks and unfair competition of unilaterally using the owner's famous trade name: Represented the Plaintiff to bring the lawsuit, and wound up the case in the First-instance Trial by forcing the Defendant to admit infringement and fully accept the terms and conditions set forth by the Plaintiff (modifying its trade name within the specified time limit, and making compensation of RMB1,000,000, etc.).

- The administrative lawsuit of review on opposition against the Trademark No.4905161 for "Device" in Class 25 (both parties applied for review, thus two lawsuits were involved): Represented the Plaintiff Anta (China) Co., Ltd., claiming that the former Trademark Review & Adjudication Board (TRAB, the Defendant) did not grant it the reasonable opportunity of defense, which was material violation of procedure, and got support from the First & Second Instance Courts, with the Administrative Decisions canceled, the Defendant ordered to remake decisions, and the aforesaid trademark eventually not approved for registration.
- Represented Mothercare UK Limited (maternal & infant products), Tod's S.P.A of Italy (fashion products), and Ulrich Behringer of Germany (acoustic products) based on copyright infringement, and successfully invalidated or disapproved the others' later filed/registered bad faith trademarks in administrative lawsuits of review on opposition/trademark dispute.
- Represented the American fashion designer and director Mr. Thomas Carlyle Ford, and the American fashion designer Mr. Jeremy Scott based on infringement upon prior personal name right, and successfully invalidated or disapproved the others' later filed/registered bad faith trademarks in administrative lawsuits of review on opposition or trademark opposition.
- The administrative lawsuit of review on refusal of the Trademark No.11672722 for "毕马威" ("KPMG in Chinese") in Class 35: Represented the Plaintiff, properly resolved the right conflict with the others' trademarks with prior right by making the effective strategies of expedited assignment and partial invalidation, and got the plaintiff's major service mark registered on its main services eventually by claiming the changed circumstances in litigation.
- Represented the Plaintiffs Shiseido Co., Ltd., Star Micronics Co., Ltd. & NGK Spark Plug Co., Ltd. of Japan, and New Zealand Wool Services International Limited, and won finally in the administrative lawsuits of review on opposition/trademark dispute/review on refusal by claiming that the litigated trademarks were without owner because of the revocation of its registrant's business license, or the Plaintiff had no proper qualification of proceeding with the lawsuit, or the special name for the type of the goods was permitted to be registered as trademark, or the Adverse Party was wrong in understanding and application of the law.
- The six administrative lawsuits of review on oppositions against the Trademark No. 4640170 for "KURT GEIGER" and the Trademark No. 4623056 for "KURT GIUGRE": Represented the Third Party, by claiming the evidence produced by the Plaintiff, a department store based in London, UK, was critically insufficient, won all in the First-instance Trial, and maintained the favorable decisions in the Second-instance Trial, so as to create better opportunities for the Third Party to get higher amount of charge for assignment through negotiation subsequently.
- Represented Emerson Electric of the USA, SOFY Sanitary Napkins of Japan,

Lotus Cashmere Garments of China, Emanuel Ungaro Clothing of Italy, and Anta Sports Shoes & Sports Clothing, and got the Adverse Parties' trademarks disapproved for registration/invalidated in a number of administrative lawsuits of review on opposition/trademark dispute by claiming the similarity of trademarks in the sense of the Trademark Law with the fame and reputation of the real owners' trademark into consideration, and the similarity of goods in different subgroups of the classifications of similar goods & services, in pursuance to the principle of "First-to-File".

- Made the overall strategies for IP protection domestically and/or internationally for a number of Chinese enterprises, such as a well-known sports products company group, a famous luxury real estate developer, a heavy truck producer in Inner Mongolia, a reputable department store located in Beijing, a leading TV station in China, and a famous bank.
- Conducted due diligence on trademark rights for a domestically well-known luxury real estate developer, a worldwide fortune 500 Enterprise from Korea, the Chinese subsidiaries of a USA pharmaceutical company, a Singapore-based company, an Italy-based company and a Japan-based company with respect to two sports clothing brands assigned to a well-known Chinese sports products manufacturer respectively.
- Lodged administrative complaints of trademark infringement and/or unfair competition on behalf of the right owners of the following brands: Alpenliebe, Big Babol, Chupa Chups, and Fruit-tella (confectioneries) (Italy); Mei & Mei, and Smoothie (restaurant) (Taiwan); D & G (clothing, sunglasses, spectacles, and perfumes) (Italy); Ermenegildo Zegna, and Zegna (men's clothing) (Italy); BALLY (clothing, bags, and leatherware) (Switzerland); Horwath (business consultancy) (USA); Phillips (lamps, and electric appliances) (Netherlands).
- Represented Mondo Sports Floors of Italy, and successfully invalidated the same bad faith trademark later filed & registered on the same products by a domestic competitor. Accompanied an Italian attorney to meet the examiners of the former TRAB for oral statements, and got the case once published to be the typical case of the former TRAB.
- Represented MARIE DALGAR, a domestic cosmetic brand, and successfully invalidating a number of bad faith series trademarks of "MACK ANCY" (with different elements embodied, but the design and visual effects being confusingly similar) which was imitated from the right owner's trademarks, later filed and registered in bad faith by four illegal companies/individual in collusion with each other, so as to effectively crack down the aforesaid infringers from manufacturing and merchandising the counterfeiting lipsticks and cosmetic powder with the same/confusingly similar outward design or packaging as that of the genuine identical products.
- Represented a famous domestic sports products manufacturer to make defense against the lawsuits of trademark ownership, or/and trademark infringement, which were proceeded with by its USA competitor in the USA and Canada; to apply for trademark invalidation, cancellation or opposition, make Defense, and file the applications for trademark registration in the USA, Canada, Japan, France, Germany, UK, EU, Australia and the Chinese mainland, involving its international competitors based in the USA, Australia, Italy, and UK; to make defense against the trademark infringement lawsuit filed by an individual trademark pirate in Russia; to raise

oppositions against bad faith trademark applications in India and Italy; and to handle trademark renewal in more than 70 countries or regions.

- Represented a number of domestic companies to deal with Madrid international trademark registration and renewal, as well as EU & OAPI trademark applications.

Academic writings

Publishing articles for making legal analysis on related issues in self-handled typical cases irregularly.

Work experience

Since March 1997, Connie has been working in famous foreign-involved trademark agencies and law firms successively, handling contentious and non-contentious trademark affairs for more than 25 years. She joined Globe-Law since June 2017 as a partner, and has been working there till now.

Education

July 1994 Bachelor of Laws and Master of International Law, Law School of Renmin University of China

Honors & Awards

- China's Top-50 intellectual property lawyers
- Foreign-related lawyer of Beijing Lawyers Association
- First batch of lawyers in the legal service talent pool for the Belt and Road Initiative of Beijing Chaoyang District Lawyers Association
- Top-10 Trademark Lawyers of the Year in the service industry at the Great Power Intellectual Property Forum 2019