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Court issued the White Book on IP protection. Amendments Patent Law and Trademark are expected to be promulgated soon.

Litigation in relation to Intellectual Property increased much in 2012 comparing to the year 2011. The civil cases IP cases launched in the whole China are more than 80.000 (and more than half are related to copyright). Among those only around 1.400 count as one the party a foreign company. It clearly proves that IP is an issue not just in relation to foreign matters but especially on pure national level.

Decision of detention upon a criminal prosecution in relation to IPRs violation are more than doubled comparing to 2011 (+136%). The detained persons are around 15.000. This data proves that attentions of authorities on the counterfeits is high and determination to curb the counterfeits is strong.

Enjoy reading our CHINA GOSSIP and if any clarification is needed do not hesitate to contact us.

Dear Readers,

Spring is blossoming in the north hemisphere and so do the IP regulations in China. New Copyright regulations have been passed. Supreme People’s

NEWS

WIPO Chinese Office to open in Beijing

The World Intellectual Property Organization (WIPO) will open its Chinese Office in Beijing, to serve as platform to strengthen relationship between China and WIPO and to offer several services as arbitration and mediation. It will represent the 5th office of this kind worldwide after Brazil, Japan, the United States and Singapore. (Source: www.chinadaily.com.cn)

Apple Inc. sued in Shanghai for “Siri” patent violation

On 27th March, the Shanghai No.1 Intermediate People’s Court has held the evidence exchange hearing in the patent case between Apple Inc. and Shanghai Zhi Zhen Internet Technology Co., Ltd.

According to the claim from Shanghai Zhi Zhen, “Siri”, the system for iPhones and iPads, infringes its patent rights which are used on the ‘Xiao i’, a chat robot system developed since 2003.

‘Xiao i’ core technology is based on man-machine interaction and the system has been used in government hotlines, telecommunications, banking and e-commerce service sections among the others fields of application,

Shanghai Zhi Zhen is seeking for confirmation of patent infringement and injunction to stop Apple Inc. from producing and selling products which use Siri system in China. Apple has applied to China’s SIPO for the invalidation of ‘Xiao i’ patent and on the other hand claims that Siri doesn’t infringe Zhi Zhen’s patent because it doesn’t have a game server, a technical feature of ‘Xiao i’.

Apple asked the Court to suspend the case pending a ruling at the SIPO to invalidate the Chinese firm’s patent. The request has been rejected, though the Court granted one month more to find evidences.

(Source: www.shanghaidaily.com)

1st July 2013: the end for the free online music downloading

As referred by Gao Xiaosong, Chinese music producer, and by Wang Changtian, president of Enlight Media, free online music downloading will end in China on 1st July 2013 to be replaced by a system where legal copies will be distributed.

The authorities, record companies and online providers are working on details



but it seems that an agreement has been reached according to which record companies have reduced the price to allow a wider diffusion of the online music in respect of copyright protection.

400 million internet users listen and download online music in China and, according to China Audio & Video Association statistics, China’s 2012 music copyright market valued at more than 40 billion RMB (\$6.4 billion). However, actual copyright revenue only amounted to 800 million RMB.

However, many netizens are questioning the truth of the news, given that similar rumors circulated last year.

(Source: Xinhua)

New Essential Drugs list issued by Ministry of Health

On 19th March, PRC Ministry of Health issued a list of essential medicine made by 317 kinds of chemical medicines and biological products and 203 Chinese patent medicines, 213 new entries added compared with the 2009 version of the same document.

Essential medicines are those drugs which have to be always available to the public, at affordable prices and proper dosage. The dosage has increased too compared to 2009 to ensure appropriate supply, particularly for children’s essential medicines and their vaccines which include 200 of the 520 new essential medicines.

Consequently, the Ministry asked clinics and hospitals to report drug shortages to ensure enough supply and promote the prescription of these essential drugs raising the reimbursements’ rate.

(Source: Xinhua)

McDonald’s and McConkey are not similar trademarks

In March 2013, Beijing no.1 Intermediate People’s Court approved the registration of the trademark “麦肯基 MCKonkey” filed by Guangzhou McConkey Food Company. McDonald’s corporation claim was then rejected by the Court, upholding the previous decision made by TRAB claiming that the opposed mark doesn’t constitute similarity with trademarks 麦当劳 and McDonald’s, owned by McDonald’s Corporation.

In 2003, the Guangzhou-based company applied for registration of trademark 麦肯基 MCKonKEY to the China Trademark Office (CTMO) in class 43 therefore to be used in restaurants, fast food restaurants, etc. During the publication period, in 2007, McDonald’s Corporation opposed the trademark registration appealing to the principle of similarity. The CTMO rejected the opposition and

McDonald's Corporation appealed to the TRAB in 2010 highlighting that trademark McDonald's can be recognized as well-known brand in China and abroad and that McConkey registered the trademark not only copying their registered trademark but also in the same class. According to the principle of good faith, the trademark McConkey should then have been rejected.

TRAB considered that McDonald's Corporation evidences were not sufficient to prove that the trademarks McDonald's and 麦当劳 are well-known trademarks before the filing of trademark 麦肯基 MCKONKEY. It also considered different the two trademarks in design, pronunciation, overall appearance and consumers cannot mislead the two trademarks.

McDonald's Corporation then brought the McConkey Food Company and TRAB to the court questioning again that the trademark was copying their registered trademarks and that the qualification of the representative of the Guangzhou based company were questionable in the catering business. The court upheld TRAB's decision appealing to Art. 28 of the Trademark Law, it confirmed that the key for the case is the similarity or not of the two trademarks.

(Source: China IP News)

SIPO pushes for high quality invention patents

Tian Lipu, commissioner of the State Intellectual Property Office, in an interview with China News Service, clearly stated that Chinese officials should find better ways to make profit from the national patent inventory.

According to his opinion, China has a large number of patents (in 2012 it contributed 30% of world's total patents) but this doesn't mean that these are high quality ones. High quality patents are recognized by awards but in China the number of awards received is much less than the number of applications.

Among the big number of patents, very few are commercialized while this is the most valuable way to make patents profitable. More attention from local governments and patent offices should be put on support for enforcement and commercialization focusing more on invention patents than design and utility models.

In the Five-Year Plan of 2011, when for the first statistical indicators for patent have been included, the government planned to reach a patent

ownership quota of 3.3 patents per 10,000 Chinese by 2015.

This standard in Tian's opinion, is much lower than other developed countries where the invention patents ownership reaches 30 patents per 10,000 citizens.

(Source: China Daily)



China among the top five countries for European patent filings in 2012

In 2012, the European Patent Office totally received 258,000 patent filings, 5.2% more than 2011. Among these, Chinese companies put China among the top five countries with 7.3% quota of patent filings at a growth rate of 11.1% compared to 2011.

Among the top 10 companies, the Chinese telecom equipment producer ZTE Corp has been listed, confirming the high rate of digital communication patent filings which reached the 42% of all the patent applications from China.

(Source: China Daily)

New Intellectual Property plan released for 2013

As in 2012, recently an action plan of intellectual property has been drafted by an interdepartmental agency made by 28 Chinese government organizations. The plan is intended to give guidelines and tasks including intellectual property creation, management and promotion. The action plan includes 84 measures with much defined targets, in particular the review and assessment of the Outline of the National Intellectual Property Strategy and the strategies for the key industries of strategic importance. The tasks will be accomplished by a strong cooperation among the involved government departments.

Both for trademarks and patents the attention will be put on quality rather than quantity to guarantee a wide innovation strategy.

(Source: China Daily)

IPR Judicial Protection to be increased

On 10th March, the Supreme People's Court (SPC) and the Supreme People's Procuratorate (SPP), confirmed in their work reports that China will increase the IPR judicial protection. In the last five years many steps have been taken in this direction by the local courts too though the

Among the big number of patents, very few are profitable

improvement of judicial transparency, the protection of patents and famous trademarks, as well as through the involvement in many campaigns against IPR infringement. Since 2008, the SPP prosecuted more than 50,000 suspects of IPR infringement and counterfeiting, in 2013 the focus will be the environmental resources combined with the IP judicial protection to promote the development of ecological civilization construction, self-innovation and culture industry. With reference to the local courts, the growth rate of cases is impressive with IP civil cases in 2011 more than doubled compared with 2008.

(Source: www.cipnews.com.cn)

State Council modifies the Copyright Law

In March 2013, the State Council announced the decision of reviewing the Copyright Law Implementation Regulations, Regulations for the Protection of Information Network Transmission Rights, Protection of Computer Software Regulations. The reviews will enforce the sanctions, at administrative level, for those who will infringe the copyright uploading and diffusing third parties' material online without the proper permissions. The infringers who will obtain illegal profit, can be fined up to 3 to 5 times' fine as much as the illegal profit. The infringers who will not make any illegal profit or whose profit will be less than 50,000 RMB (\$8,000) can be fined from 100,000 (\$16,000) to 250,000 RMB (\$40,000).

Specifically, the revised Copyright Law Implementation Regulations, the amount of the fine to infringers shall be evaluated case by case. Illegal profits up to 50,000 RMB will be fined from 1 to 5 times as the illegal profit. Infringing acts with no profit or with a profit less than 50,000 RMB, will be fined 250,000 RMB.

The revised Regulations for the Protection of Information Network Transmission Rights claims the same fines' levels as the Copyright Law.

Differently, the Protection of Computer Software Regulations establishes that infringements will be punished with injunction in relation to the production and distribution of infringing copies, confiscation of illegal profit and seizure of infringing copies and equipment used for making infringing copies, as well as fine.

(Source: *China IP News*)

The 2012 White Paper on IP Judicial Protection has been issued

The 2012 White Paper on IP Judicial Protection has been issued by the Supreme People's Court on April 22nd 2013.

The report highlights the progress accomplished last year in IP protection from legal, judicial and enforcement perspective.

Some of the key points in the report:

- Substantial increase in the courts adjudications for IP-related civil litigation (+46% in first instance; +25% in second instance). IP owners seem to prefer litigation on grounds of copyright, trademark, patent and technology violations claims; on the other hand unfair competition litigations have slightly decreased (-1.23%).
- Criminal litigation and adjudication has also dramatically increased (+130%) mainly against manufacturers and distributors of IP infringing products or services, leading to condemnation of more than 15,000 culprits.
- Implementation of the National Intellectual Property Strategy. Pilot projects for establishment of intellectual property divisions supervising civil, administrative and criminal cases have been launched in 133 courts throughout China.
- Consistency in application of law. Several guidelines have been issued last year by the Supreme People's Court in order to improve uniformity of law interpretation. Moreover, courts seem to improve in their use of fact-finding mechanisms when dealing with technology-related litigation (forensic examination, expert assistance, etc..).

To read the full report in English please click [here](#) or visit <http://www.court.gov.cn>

QBPC released the Yearly Best Practice and the Five Model Cases

The Quality Brand Protection Committee (QBPC) has recently voted for the Yearly Best Practice and the Five Model Case of 2012. The QBPC, supported by the former Ministry of Foreign Trade and Economic Cooperation, and registered under the China Association of Enterprises with Foreign Investment (CAEFI) aims to strengthen Chinese IPR laws and regulations, strengthen IPR creation, application, protection and management, improve the IPR protection system, enhance the public's awareness of IPR protection, establish a long-standing and effective IPR protection system and support the improvement of the innovation environment.

One of HFG case has been chosen in the Best 10

Criminal Cases. Following are the results of the “Criminal Case” section:

1. Microsoft
2. JNJ
3. UL
4. Unilever and Beiersdorf
5. Amway
6. Nokia
7. Astra – Zeneca, Bayer, GSK, Novartis, Pfizer, Roche, Servier
8. SKF
9. BP and Shell
10. Bosch, NGK, and TOYOTA; 10. HP

One of HFG case has been chosen in the Best 10 Criminal Cases.

World Intellectual Property Day: China Customs Release the Top Ten IPR Protection Cases

On 26th April 2013, the World Intellectual Property Day, the China Customs released the Top 10 of the IPR Protection cases. The list, with motivations, is as follows:

1. Hangzhou Customs seize counterfeit “GOLDEN” adhesive tapes: in this case both administrative and criminal enforcement joined together in the IPR field to protect a domestic well-known brand.
2. Xiamen Customs seize infringing clothing worth more than 4 mln RMB: Xiamen Customs seized infringing products in more occasions.. The infringing parties attempted to evade the customs’ monitoring by claiming for non-record brands or using trademark that are not well-known.
3. Ningbo Customs seize infringing “Shalina” cream: in this case, the infringing party exported infringing goods by registering different companies.
4. Tianjin Customs seize infringing “Zhenjiang vinegar”: the first case for Tianjin Customs to seize products infringing the geographical indication.
5. Shanghai Customs seize counterfeit “Jamila” seasoning: this case has reached the highest value and the largest amount of infringing products ever seized since Shanghai Customs launched the “Shield of National Gate” campaign.
6. Shenzhen Customs seize imported counterfeit “Ai Li Da” Medicine: the most important cases after Shenzhen Customs strengthened legal sanctions for the imp/exp of goods to the USA. It is also the largest case regarding the import of infringing medicine to China via post channel.
7. Qingdao Customs seize counterfeit “VIAGRA”, “CIALIS” medicine though post channel: first time for Qingdao Customs to seize counterfeit products through mail check and transfer to PSB for criminal sanctions.

8. Guangzhou Customs seize mobile phone accessories counterfeiting “NOKIA” and other brands: successful coordination between the Customs and PSB.

9. Gongbei Customs seize exporting counterfeit “ZELZAL” Motor Car: first time for Gongbei Customs to seize counterfeit motor car accessories since it started the “The Shield of National Gate” campaign.

10. Wuhan Customs seize counterfeit “AMG” Wheel Hubs: the seizure has protected the consumers’ safety

SPECIAL SECTIONS

PRACTICAL TIPS: Invention and utility model

In China you can file patent for invention and for utility model at the same time for the same invention in the name of one applicant. Utility will be registered in around 6 months and then be enforceable very soon. In order to avoid double patenting, utility model with same claims shall be withdrawn when the invention patent reach registration.

IP SCHOOL:

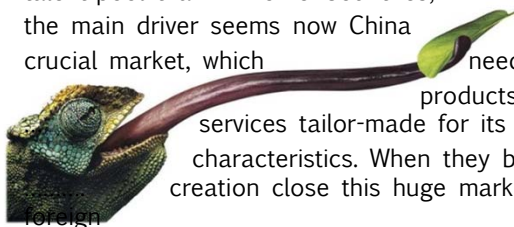
The Civil Litigation involving patent disputes

Civil Litigation involving patent disputes shall be heard by competent intermediate courts designated by the Supreme Court. The administrative litigation involving patent disputes shall be heard only by Beijing No. 1 Intermediate Court. During the course of civil litigation, the defendant could initiate an invalidation proceeding with SIPO to challenge the patent validity. If dissatisfied with the official decision, either party may initiate an administrative litigation against SIPO. For invention patent lawsuit, the civil court may not suspend the trial before the admin. proceeding result, while for utility model and design patents, it normally suspends until result of the administrative proceeding.

FROM “MADE IN CHINA” TO “CREATED IN CHINA”: RISKS TO AVOID FOR FOREIGN COMPANIES

R&D activities from both MNCs and SMEs are moving more and more into China.

The main reason for this is no more the cheaper talent-pool than in home Countries; the main driver seems now China being a crucial market, which needs products and services tailor-made for its unique characteristics. When they bring creation close this huge market,



companies obviously enter the scope of PRC laws and regulations about inventions and know-how, but often ignore the consequences.

What foreign companies want is securing full ownership of their R&D knowledge.

To get there and avoid unwanted risks, companies shall be extremely careful in drafting their contracts with R&D personnel, as well as taking due precautions in their internal policies.

Failing this, PRC law will apply by default, which means that in many cases IP rights (basically, the right to apply for invention patents) can belong to inventors rather than investors.



A key-element in this regard is the nature of inventor-company relationship.

Employment agreement

Inventors are often hired with employment contract.

In this case, PRC laws (Patent Law and Implementing Regulations) grant to the employer the ownership of the invention, as long as this is “employment invention”, i.e.:

A. Has been accomplished (i) during execution of his own duty, (2) in execution of any task, other than his own duty, which was entrusted to him by the entity to which he belongs; (3) within one year after the retirement, transfer from the entity to which he originally belongs or the labor and personnel relationship being terminated, where the invention-creation relates to his own duty or the other task entrusted to him by the entity to which he previously belonged; or

B. Has been accomplished by using the material and technical conditions of an employer. Beside these cases, the invention is considered “non-employment creation” and as such it belongs mandatorily to the employee, any limitations to this right not being allowed.

Very important, even when he has no ownership rights over the invention, PRC law provides that the inventor shall receive both an award from his employer in case a patent is granted to the employment-invention, and a periodic remuneration for the exploitation of such patent.

Such amounts shall be – according to the law – “reasonable”; the law provides minimum thresholds, which apply in case there is no agreement between the parties (3000 RMB as minimum award and yearly 2% on profits generated from patent).

Needless to say, such minimum thresholds are rarely accepted by the inventors and the matter frequently ends up in litigation.

Independent work

Other times inventions are developed in an independent-work framework, mainly technology consulting, technology service or commissioned technology development schemes.

It is a pretty common scheme as it allows companies to enjoy (i) tax/contribution optimization, and (ii) easier contract termination (while, on the other hand, termination of employment contracts is restricted and extremely expensive and costly).

Generally speaking, in these situations the right to patent the invention belongs to:

- The technology developer, if the development has been commissioned (the commissioner has a right to exploit the invention free of charge);
- The consultant/service supplier, if he has directly developed the technology (even by using the client’s resources/materials);
- The client, if he is the one who developed the technology – even by exploiting the work of the consultant/service supplier.

Moreover, if the commissioned technology has not been patented, in the absence of agreement by the parties the developer can exploit and transfer to third parties the unpatented know-how.

These provisions can be overturned by the parties’ agreement.

Moreover, they are rather vague: for instance, it could not be crystal-clear under which circumstances it shall be deemed that an invention is developed by the consultant or by the client. Much of this is up to the court’s interpretation.

For this reason, it is very important that the invention ownership shall be regulated in detail within the technology contracts.

What to do

The main risks companies may want to avoid are:

Employment invention to be qualified as non-employment invention

To avoid this risk, the employment contract and the job description shall be carefully drafted. Moreover, it is important to guarantee traceability of all resources/materials used by the employee during the inventions process, as well as of any guidelines/instructions from the employer.

Employee files a law suit for remuneration/award of “employment invention”

Lack of agreement on employee remuneration/award – in case the employment invention is then patented and exploited by the employer – is a typical ground for litigation, which can lead to high damages to be refunded to the same can be said for very general agreements, which do not conceive a sense of “reasonableness”.

Remuneration/award for the employee shall be carefully detailed and balanced between the parties (e.g., linking the growth of the remuneration to the degree of exploitation of the invention).

Previous employer claims employee invention

As we have seen, the employer has the right to patent the invention of the employee until one year after the termination of the employment, if such invention is connected to the duties previously attended by the employee.

In order to assess and prevent such a risk, it is critical to proceed to due diligence on the past career of the inventor to be hired.

HFG NEWS



Fabio Giacobello wins the “Client Choice Award – Trademark: China”

HFG Law Firm & IP Practice is proud to inform you that our partner Fabio Giacobello has been awarded with the “Client Choice Award 2013 – Trademark: China”.

The Client Choice Awards, established in 2005, aim to recognize those law firms and partners around the world that stand apart for the excellent client care they provide and the quality of their service. The criteria for the awards focus on an ability to add real value to clients' business above and beyond the other players in the market. Uniquely, law firms and partners can only be nominated for these awards by corporate counsel.

The awarding ceremony has been held on 27th February, 2013 in London.

Following, are the quotes from our clients:

“Fabio Giacobello provides excellent value for money.”

“Flexible and available to any request from client.”

“Great direct communication with client”.

“Mr. Giacobello is practical and effective in the means suggested in each matter.”

Shirley Chang and Ottavia Curcuraci attended the “ALB China Law Awards” awarding ceremony

On 28th March 2013, in Beijing, Partner Shirley Chang and International Relations Executive Ottavia Curcuraci of HFG attended the awarding ceremony and gala dinner of the “Asian Legal Business China Law Awards” where HFG Law Firm & IP Practice had been shortlisted for the category “IP Law Firm of the Year”.

HFG at MICAM Shanghai Exhibition

HFG has attended the MICAM Shanghai Exhibition as recommended law firm suggested by ANCI (Italian National Footwear Association). The MICAM is an international trade fair reserved to world market leaders in the footwear and leather goods segment, held for the first time in Shanghai on 9th-11th April, 2013 at the Shanghai Exhibition Center. HFG partner, Fabio Giacobello, has been speaker for a specific seminar organized by ICE , Italian Trade Commission, to inform the Italian companies attending the event about the IP status in China.

Fabio Giacobello nominated Arbitrator at SHIAC

During the opening ceremony of Shanghai International Economic and Trade Arbitration Commission (SHIAC) held on 11th April, the Commission has released the names of the new panel of arbitrators effective as from 1st May 2013. HFG is proud to inform you that Partner Fabio Giacobello has been appointed Arbitrator in the field of Intellectual Property, Technology Transfer, Contracts, (Licensing, Franchising, Distribution, etc.), Corporate and Commercial Law.

HFG case chosen as one of the typical 50

HFG is glad to inform you that one of our cases has been chosen by the Supreme People's Court as one of the 50 typical IPR cases in 2012. The case was a civil lawsuit about trademark infringement and unfair competition where the Société Jas Hennessy & Co. sued Zheng Weiping; Chang Li Xuan Ni Shi Winery Co., Ltd.; Shanghai Hua Jin Trading Co., Ltd.; Qinhuangdao Margaux Chateau Co., Ltd . The decision of the Hefei City Intermediate People's Court Anhui Province was

against the infringers as per following details:

- Shanghai Hua Jin Trading Co., Ltd. has been imposed to stop the infringement against the trademarks “Hennessy”, “Axe Device” and “轩尼诗”; to stop using the website domain name “hensy.cn”; to pay RMB 120,000 as compensation to the damages to Hennessy; to publish a statement on Legal Daily in order to eliminate the effect provoked by the infringement to Hennessy
- Chang Li Xuan Ni Shi Winery Co., Ltd. has been imposed to stop using the word “Xuan Ni Shi” in its company name

The full list of the cases chosen by the Supreme People’s Court (in Chinese language only) can be found [here](#)

HFG and ECUPL sign scholarship agreement

On 26th April 2013, HFG and East China University of Political Science and Law (ECUPL) signed a cooperation agreement under which HFG will provide scholarships every year for the 8 most excellent students at the Intellectual Property Institute of the ECUPL. In the words of Professor Huang Wushuang, we hope that this agreement is the first step of a growing cooperation between HFG and ECUPL.

HFG delegation will attend IBA, IACC, INTA in Dallas

We’d like to inform you that HFG delegation will attend the three conferences to be held in Dallas in the first week of May. Details are as follows: Mr. Zhang Xu will attend the IACC Annual Spring Conference, May 1-3, at the Marriot City Center; Mr. Eric Su will attend the IBA World Life Science Conference, May 1-3, at The Adolphus Hotel; Mr. Eric Su, Ms. Tiger Zhao and Mr. Zhang Xu will attend the INTA’s Annual Meeting, May 4-8, at the Dallas Convention Center.

HFG Staff will attend 2nd Pharma Legal Affairs and 5th China IP Counsel Conference

Foreign Counsel Mr. Nicola Aporti and Patent Attorney Ms. Helen Wang will attend the 2nd Pharma Legal Affairs Conference to be held in Shanghai from 21st to 23rd May 2013.

Trademark Attorney Ms. Lanny Lee and Intl. Relations Executive Ms. Ottavia Curcuraci will attend the 5th China IP Counsel Conference to be held in Shanghai on 21st-22nd May.

HFG PUBLICATIONS

[Waging war on the well established misuse of dummy corporations](#) – by Zhang Xu & Nikita Xue

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