1. THE FACTS: Business in the Separate Customs Territory of Taiwan, Penghu, Kinmen and Matsu for EU SMEs
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IP Factsheet: Taiwan

CHINA IPR SME HELPDESK
1. THE FACTS: Business in the Separate Customs Territory of Taiwan, Penghu, Kinmen and Matsu for EU Companies

SIZE of Market:
- EU exports to Taiwan: EUR 21.5 billion
- EU imports from Taiwan: EUR 30.4 billion
- Total trade in goods: EUR 51.9 billion

- Taiwan is the EU’s seventh largest trading partner in Asia.
- The EU is Taiwan’s fourth largest trading partner.
- In 2017, EU investments in Taiwan amounted to €21.2 billion

Key INDUSTRY SECTORS:
- EU exports to Taiwan mainly consist of semi-finished products, machinery and transport equipment.
- Taiwan’s key export items to the EU include office telecommunications equipment, transport equipment and chemicals.

1 Source for the Facts: DG Trade
IP TIPS and WATCH-OUTS in Taiwan

- All the applications and documents shall be filed and submitted in Taiwan in Chinese language with traditional characters. Therefore foreign applicants need to provide an accurate translation of all their works.

- Taiwan has an Intellectual Property Court responsible for all intellectual property-related civil, criminal and administrative cases.

Intellectual Property Rights for SMEs: Why is this RELEVANT to you?

Intellectual Property (IP), as intangible assets, are a key factor in the competitiveness of your business in the global economy. IP is a primary method for securing a return on investment in innovation and is particularly relevant to Small and Medium-sized Enterprises (SMEs) as they internationalise their business to areas such as Taiwan. Although SMEs often have limited time and resources, it is important to be aware of how IP can be valuable to your business. Not only a way to help you protect your innovations from competitors, IP assets can also be an important source of cash-flow for SMEs through licensing deals or selling IP, as well as a significant pull-factor when attracting investors.

SMEs are businesses which have fewer than 250 employees and turnover of less than EUR 50 million or balance sheet total of less than EUR 43 million. SMEs represent 99% of all enterprises in the EU, and account for about 70% of jobs. Their flexibility and growth potential is seen as a major motor of future innovation and job creation, which is pivotal for the prosperity and economic competitiveness of Europe as a whole.
Intellectual Property Rights (IPR) infringement is one of the most common concerns for businesses when dealing with countries across Asia, and its impact on your company could be substantial. It can lead to loss of business, revenue, reputation and competitive advantage, which affects SMEs both abroad and in their core domestic markets, and the inadequate protection of inventions and creations can jeopardise prospects for maintaining a competitive advantage.

How does Taiwan's IP legal framework compare to INTERNATIONAL STANDARDS?
Taiwan is not a member of the World Intellectual Property Organisation (WIPO) and most WIPO-administered agreements. This also means that it is not party to most multilateral treaties. Taiwan has however acceded to: i) the Agreement Establishing the World Trade Organisation (WTO) (1 January, 1995); ii) the Agreement on Trade-Related Aspects of Intellectual Property Rights ("TRIPS Agreement") (1 January, 1995); and iii) Intellectual Property Experts Group (IPEG) under the Asia-Pacific Economic Cooperation (APEC).
Taiwan also has bilateral intellectual property related agreements and memorandums of understanding with a number of countries, including Austria, Australia, Chile, China, Costa Rica, the Czech Republic, El Salvador, the EU, France, Germany, Guatemala, Japan, Italy, Liechtenstein, the Netherlands, Nicaragua, Paraguay, the Philippines, Spain, Switzerland, the United Kingdom, and the United States.

A. Copyrights
WHAT are Copyrights?
Copyright means the moral and economic rights that a creator has to a literary, scientific, artistic, or other intellectual work. Works protected by copyright include: i) oral and literary works; ii) musical works; iii) dramatic and choreographic works; iv) artistic works; v) photographic works; vi) pictorial and graphical works; vii) audiovisual works; viii) sound recordings; ix) architectural works; and x) computer programs.

Copyrights in Taiwan: What you need to know
Protection for copyright under Taiwan's Copyright Act only extends to the expression of the work in question, and not to the work's underlying ideas, procedures, production processes, systems, methods of operation, concepts, principles or discoveries. As in other countries, copyrights refer to a bundle of rights including economic and moral rights. The economic rights, and the ability to monetise a work can be sold or licensed by the author. On the other hand moral rights, including the rights to publication, the right of attribution (crediting the author) and the right to the integrity of the work, cannot be assigned or waived. In practice this is important when an employee or sub-contractor creates a work on behalf of your company. You may ask an employee to sign an agreement to deem the company the author of a work rather than the employee as an individual or an agreement which states the employee agrees to not enforce their moral rights to the works against the company. You may ask a sub-contractor to assign the economic rights to your company but they will retain the moral rights.

Economic rights can be transferred to others. When these rights are transferred, the scope of the transfer covers what is stipulated by the parties. Any rights that are not clearly covered by the stipulations are presumed not having been transferred to others. It is thus recommended that any transfer of economic rights should be made explicitly in writing to avoid later disputes.

How LONG does legal protection last?
Economic rights last for the life of the author plus 50 years after the author’s death with some exceptions:
1. where a work is first publicly released between the 40th and 50th years after the author's death, the economic rights last for a term of 10 years beginning from the time of the first public release;
2. economic rights in a joint work last for 50 years after the death of the last surviving author;
Copyrights TIPS and WATCH-OUTS in Taiwan

Online P2P piracy via bittorrent still remains a significant problem for companies in the music and movie industries, with available data indicating that despite the accessibility of movies-on-demand and Netflix within the Taiwan market, many consumers continue to engage in the uploading and downloading common to such websites. Although the Taiwan government is in the midst of evaluating amendments to the Copyright Act, the current version of the law centers online enforcement on a “three strikes” principle that is triggered by the sorts of infringement that are not commonly done anymore, such as posting a pirated copyrighted work in a set, designated place online for people to directly download.

HOW do I register
Taiwan no longer maintains a copyright registration system. Copyright is automatically granted on any work which falls under the scope of the Copyright Act.

3. economic rights in a work written under a pseudonym or an anonymous work last for 50 years from the time of public release; provided, it can be proven that the author has been deceased for over 50 years;

4. economic rights in works authored by a legally registered entity (rather than an individual) endure for 50 years after the public release of the work; if the work is not published for 50 years after creation the opportunity for it to be protected under copyright will be lost;

5. economic rights for photographic works, audiovisual works, sound recordings, and performances endure for 50 years after the public release of the work.

B. Patents

WHAT are Patents?
A patent in Taiwan is an intellectual property right granted by the Taiwan Intellectual Property Office (TIPO) to encourage, protect and utilise the creations of invention, utility model and design in order to promote industrial development. It grants an inventor the right, “to exclude others from making, using, offering for sale, or selling the invention throughout Taiwan” for a limited time period.

There are three types of patents in Taiwan: Invention, Utility Model, and Design. Invention Patents are granted to the creation of technical ideas. A Utility Model patent protects creations considered to have a lower degree of inventiveness than is required for invention patents such as innovations relating to shape or structure. A Design Patent is an article created, wholly or in part, for visual appeal through the use of shape, pattern, colour, or any combination thereof. This includes computer-generated icons and graphical user interfaces.

Animals, plants, and essential biological processes for the production of animals or plants, except for processes for producing microorganisms, are NOT patentable in Taiwan. Diagnostic, therapeutic and surgical methods for the treatment of humans or animals are also NOT Patentable in Taiwan.
Patents in Taiwan: What you need to know
The application process from start to finish takes approximately 24 for Invention Patents, and 3 to 8 months for Utility Models and Design Patents to be granted in Taiwan. Accelerated Examination Programs (AEP) and Patent Prosecution Highway (PPH) programs can speed up the process of examination.

In order to accelerate the patent examination process, a Utility Model patent will not go through the same rigorous substantive examination as an Invention Patent. Therefore, a Utility Model patent will generally be granted more quickly.

Taiwan uses the ‘first-to-file principle’: in a case where two or more patent applications are filed for the same invention, the earliest eligible application will be granted. However, this does not apply if the ‘priority date’ of a later application is before the filing date of the earlier one. A priority date allows for an applicant to file a subsequent application in Taiwan for an invention already filed for in another country; protection will be effective as of the date of filing the first application in the other country, provided that country is party to the Paris Convention for the Protection of Industrial Property and TRIPS. The applicant must file a subsequent patent or Utility Model application in Taiwan within 12 months of the first patent application filing date in the other country or within 6 months for a Design Patent application. Although Taiwan itself is not party to the Paris Convention, priority date claims from members of the Paris Convention are recognised in Taiwan.

Please note that Taiwan is not party to the Patent Cooperation Treaty (PCT) which supports patent applications in multiple countries. Therefore all patent applications must be made directly to the TIPO and must be translated in traditional Chinese characters.

SMEs that fulfill one of the 4 conditions below could request for Accelerated Examination Program (AEP), which speeds up patent grant procedure. The 4 conditions are as follows:

1. The corresponding application has been approved by a foreign patent authority under substantive examination.
2. The EPO, JPO or USPTO has issued an office action (OA) during substantive examination but has yet to approve the application's foreign counterpart.
3. The invention application is essential to commercial exploitation.
4. Inventions related to green technologies.

How LONG does legal protection last?
The three different patent types have different protection periods. Invention Patents are valid for 20 years from the date of filing, subject to the payment of annual maintenance fees. Utility Model patents are valid for only 10 years from the date of filing. Design Patents last 15 years from the date of filing. HOW do I register? Patent application forms are available from the TIPO website: https://www.tipo.gov.tw/branch.asp?ctNode=7487&CtUnit=3633&BaseDSD=7&mp=1 (only available in Chinese).

It is recommended to use the services of an experienced patent attorney who can give you the best advice on making a successful application.

After the TIPO receives the application and gives the first approval (documents are correct, meets basic registration requirements), the application will be passed to the formal examination process, which takes up to 15 months for Invention Patents and usually less time for Design Patents. Utility Models are not subject to such substantive examination and will usually be granted if the application documents are correctly filed.

Following the granting of a patent, an applicant needs to pay the first annual fee within three months to complete registration and receive certification.

Registration can be filed with:
Taiwan Intellectual Property Office
185 Hsinhai Rd., Sec. 2, 3F; Taipei 10637, Taiwan, R.O.C
(+886) 2-2738-0007
www.tipo.gov.tw/en

WHO can register?
The inventor, utility model creator, designer, or a legally appointed representative has the right to apply.

Which LANGUAGES can I use?
Applications for registration must be in Traditional Chinese. English language information may be included in the application, but that information must appear in Traditional Chinese as well.
Patent WATCH-OUTS in Taiwan

- Taiwan uses a first to file system for patent applications.
- Patent violations do not fall under criminal prosecution which means all infringement cases should be solved through civil procedures. The patent owner has to make an infringement claim within two years after he/she becomes aware of the infringement. Patent owners should have a monitoring system in place and pursue patent infringements. Patent owners need to be especially diligent to preserve evidence for civil litigation.
- Under a new border protection provision in the Patent Act, IP holders can request Customs to detain suspected imported goods. Written application and placement of a bond are necessary (see Section 4).

Annuity Fees

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How much does it COST?
The filing fee for an Invention Patent in Taiwan is EUR 108 and substantive examination fee is EUR 216 and upwards. The basic filing fee for a Utility Model or Design Patent in Taiwan is EUR 93.

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It is recommended to use the services of an experienced patent attorney who can give you the best advice on how to make a successful application.

C. Trade Marks

WHAT are trade marks?
A trade mark refers to any sign with distinctiveness and may consist of words, devices, symbols, colours, three-dimensional shapes, motions, holograms, sounds, or any combination thereof. The term ‘distinctiveness’ means relevant consumers should be able to recognise a sign as an indication of the source of goods or services, and distinguish the goods or services of one business from those of another.

The Trademark Act (2016) provides for a number of circumstances under which a mark cannot be registered. These include, but are not limited to, identical or similar to national or military flags, emblems, insignia, and seals of Taiwan or a foreign country; identical to the portrait or name of Dr. Sun Yat-Sen (first president of the Republic of China in 1912) or of the head of state of Taiwan; or are contrary to public policy or good morals.

Under Taiwan’s Fair Trade Act no enterprise shall use in the same or similar manner the name, trade mark, or trade appearances of another business or service, commonly known to enterprises or consumers.

Trade marks in Taiwan: What you need to know
Trade marks in Taiwan are protected under the Trademark Act. A degree of protection is provided as soon as an application is made (against other parties trying to register the same trade mark) but full legal protection is only provided once the trade mark has been granted. For the best protection you should allow enough time to register your trade mark before entering the market. Trade marks can be invalidated if they are not used within three years of registration. You should ensure that your trade mark is used in the Taiwan market through sales or marketing within three years of registration. On the other hand ‘non-use invalidation’ can be useful if you wish to
Trade Mark TIPS AND WATCH-OUTS IN TAIWAN

• Taiwan follows the Nice Convention of trade mark classes but in practice TIPO often require applicants to be more specific on the type of goods. For example the Nice Convention includes class 18 for ‘leather and imitations of leather’. However TIPO may require a more specific description, e.g. leather bags, purses and belts. A trade mark attorney or agent in Taiwan will be familiar with the requirements and be able to advise you accordingly.

• While Taiwan is not a member of the Paris Convention, it still allows for international extension of a trade mark application to Taiwan from Paris convention countries through a simple application. SMEs wishing to apply for a Taiwan trade mark internationally should be aware that the application must be made within six months of the original filing and state this priority filing date. Additionally, SMEs must be aware this is only a mechanism for extending the application and does not guarantee the trade mark will be granted.

How LONG does legal protection last?
Protection granted to a mark under Taiwan’s Trademark Act is for up to a 10-year period and may be renewed for subsequent 10-year periods indefinitely. Complete protection starts from the date of issuing the trade mark certificate.

WHO can register?
Any individual or entity may register a trade mark. A foreigner who has no domicile or place of business in Taiwan must designate a trademark agent who has a domicile in Taiwan for handling trademark matters. In any case, legal advice or handling the application through an attorney or trade mark agent is recommended.

Which LANGUAGES can I use?
Applications for registration must be in Traditional Chinese. English language information may be included in the application, but that information must appear in Traditional Chinese as well.

How much does it COST?
The basic filing fees (official application fee and the certificate registration fee) for trade mark registration in Taiwan are approximately EUR 165 (TWD 5,550). The official schedule of trade mark fees can be found in English and Chinese at https://www.tipo.gov.tw/en/cp-643-862306-026ee-2.html
D. Trade Secrets

WHAT are Trade Secrets?
The term ‘trade secret’ as used in the Taiwan Trade Secrets Act means any method, technique, process, formula, program, design, or other information that may be used in the course of production, sales, or operations. As examples, a unique recipe for a fizzy drink or client mailing lists could be considered trade secrets. Trade secrets enjoy a degree of statutory protection in Taiwan under the Trade Secrets Act, as well as general protection under the Civil and Criminal Codes.

Trade Secrets in Taiwan: What you need to know
A trade secret must also meet the following requirements for protection under the Trade Secrets Act: i) it is not publically known, even to persons generally involved in that field of information; ii) it has actual or potential economic value due to its secretive nature; and iii) its owner has taken reasonable measures to maintain its secrecy.

Trade secrets of foreign individuals or companies are protected as long as the foreign national’s country provides reciprocal protection of trade secrets to Taiwanese individuals/companies. The latest amendment to Trade Secret Act increases protection of foreigner’s trade secrets as now an unrecognized foreign juridical person may file a complaint, initiate a private prosecution, or institute a civil suit when their trade secrets are misappropriated.

How LONG does legal protection last?
Trade secrets can be protected indefinitely so long as they do not become publicly known and can meet the three requirements stated above. The Coca-Cola formula is an example of a trade secret: the exact recipe is unknown publicly or by most within the company apart from a select few employees and protection therefore continues for as long as this secrecy is maintained.

Trade Mark TIPS AND WATCH-OUTS IN TAIWAN
1. Following the new Trade Secrets Act amended in 2019, anyone who acquires a trade secret by theft, fraud, coercion, bribery, unauthorised reproduction, breach of an obligation to maintain secrecy, inducement of others to breach an obligation to maintain secrecy, or any other similar means, can be subject to criminal liabilities.

2. Any person who uses trade secrets acquired by an illegal method in foreign jurisdictions (including mainland China, Hong Kong, or Macao) will be sentenced to a prison term of between 1 to 10 years, and in addition, a fine of between TWD 3 million (EUR 92,000) to TWD 50 million (EUR 1,500,000) may be imposed.

3. Any representative of a company including agents, employees or any other staff who acquires a trade secret by illegal means will also be subject to punishment.

4. A person subject to a confidentiality order shall not use the investigation information for purposes other than the investigation, or disclose such information to any person not subject to a confidentiality order.

4. Using CUSTOMS to block counterfeits

WHAT are Customs?
Customs is an authority or agency responsible for collecting and safeguarding customs duties and controlling the flow of goods in and out of a country and the scope of their powers differs from country to country. The Customs Administration of Taiwan is authorised to prevent counterfeit goods from being imported (copyright, patents, trade marks) into Taiwan or exported from Taiwan (in case of trade marks and copyright only). Once the trade mark or copyright owner has registered their IP with the Customs Administration, Customs will detain suspicious goods to give the IP owner the opportunity to take enforcement actions. If found to be infringing, the goods will be destroyed.

Customs in Taiwan: What you need to know
Customs enforcement protection is a great way to prevent
foreign pirated and counterfeit goods from being imported into Taiwan or exported from Taiwan. However, Customs will only detain the suspicious goods for a period of two to three days. During this time the IP owner will need to go to the Customs to verify the suspicious goods. After receiving the notification from the Customs, the copyright or trade mark holder must identify on-site the items in question within 4 hours for export by air freight and within 1 business day for import/export by sea freight and import by air freight. The owner will also need to provide photos of the original goods to Customs to assist them to identify the counterfeit goods. The right holder must then submit evidence of infringement within 3 business days. When failing to provide such evidence in time, right holders can apply once in writing with a legitimate reason for an extension of additional 3 business days prior to the deadline.

**WHAT can be registered?**
The following items can be registered with the Customs Administration:

- Trade marks registered in Taiwan;
- Copyright created in Taiwan;
- Trade marks registered in another country and in the process of being registered in Taiwan;
- Trade marks registered and copyright materials created registered in another country and which are able to be proven as famous in Taiwan.

**How LONG does legal protection last?**
There is no formal registration procedure, for copyright but when a rights holder has a case, they can submit documentation showing their ownership of the copyright to Customs. The protection period is one year from the date that Customs accepts the case and the copyright can be extended by one year each time before the expiry date.

In case of trade marks, a Customs registration (‘advice protection’) will remain in force until the due date for renewal of the registered trade mark. The registration with Customs is renewable after the registered mark is renewed.

**HOW do I register?**

**WHO can register?**
The trade mark or copyright owner, licensee or agent of the licensee.

**Which LANGUAGES can I use?**
Applications must be in Traditional Chinese. English language information may be included in the application, but that information must appear in Traditional Chinese as well.

**How much does it COST?**
There are no fees for registration with Customs.

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**5. Enforcing your IP**

EU SMEs should monitor the market, including e-commerce websites and product-relevant retail chains, to detect infringement of their rights. If infringement is detected it is recommended that you consult with a legal firm to determine the most effective course of action. In the case of your IP assets being infringed in Taiwan, there are several main avenues of enforcement which you can consider which are outlined below: administrative actions, civil litigation, criminal prosecution, and customs seizures (customs are described separately in Part 4 above). In many cases however, private mediation via legal professionals is effective and efficient and should be considered as a viable option.
Administrative actions
The Intellectual Property Court has jurisdiction over administrative complaints for IP violations. An individual or company should set out a complaint in writing to the Court. Before going to court, IP holders can request administrative actions by agencies handling specific industries. Administrative authorities have the power to impose fines and imprisonment. If the infringing party fails to cease, or repeats the infringement they might be subject to imprisonment for up to three years and/or a fine of up to TWD 100 million (EUR 2,900,000).

The appeal procedure at the TIPO in the case of rejection of a trade mark or patent application is also of an administrative nature. The procedure can take various forms, e.g. complaints to the administrative authorities, supplementary briefs within a procedure at TIPO, appeal briefs at the Taiwanese Ministry of Economic Affairs and complaints to the Intellectual Property Court.

Civil Litigation
Civil litigation may be initiated for infringement under the Patent, Copyright, Trademark, Fair Trade and Trade Secrets Acts. These should be filed at local Courts or the Intellectual Property Court. Remedies include court orders to cease activity, damages compensation, seizure of goods or capital, and destruction of goods. However, the decision about where to file a civil law suit will depend on the IP holder’s strategy and should be discussed and decided with local attorney support.

Criminal Prosecution
Criminal prosecution may be brought under the Copyright, Trademark, and Trade Secrets Acts. Prosecution may be private or public. However, infringements against all types of patents have now been decriminalised. The IP holder would need to file a criminal complaint with the police prosecution office first. After completion of the investigation the prosecution office can transfer the matter to the Criminal Court that has jurisdiction over the case.

An IP holder may also submit a supplemental civil complaint in order to receive compensation once a criminal matter has been transferred from the Prosecutors Office to the Criminal Court. The complaint will usually be transferred to a civil court for a decision following the conclusion of the criminal matter. The facts as determined by the court in the criminal matter will also be used to decide on a supplemental civil complaint. No court fee is payable for a supplemental civil complaint and the IP holder does not need to provide evidence during the civil proceeding. Thus a supplemental civil complaint can be a more cost effective way to receive compensation.

Enforcement WATCH-OUTS in Taiwan
- Filing of supplementary civil actions in a criminal procedure can be a very useful way to cut down costs and to get civil damages from the counterparty.
- Preservation of evidence relating to the original and infringing articles is of utmost importance for IP enforcement. The judicial system in Taiwan does not include the process of investigating and discovering evidence once a court case has formally started as, for example, in the UK.

6. RELATED LINKS and Additional Information

China IPR SME Helpdesk – www.china-iprhelpdesk.eu


Taiwanese Trademark Search Database – https://twtmsearch.tipo.gov.tw/OS0/OS0101.jsp?l6=en_US&isReadBulletinzh_TW=true

Taiwan Intellectual Property Court – https://ipc.judicial.gov.tw/ipr_english/

Taiwan Customs - https://etaipei.customs.gov.tw/


The China IPR SME Helpdesk provides free, confidential, business-focused advice relating to China IPR to European Small and Medium Enterprises (SMEs).

**HELPLINE** Submit further questions to the Helpdesk via phone, email (question@china-iprhelpdesk.eu) or in person and receive free and confidential first-line advice within three working days from a China IP expert.

**TRAINING** The Helpdesk arranges training on China IPR protection and enforcement across Europe and China, tailored to the needs of SMEs.

**MATERIALS** Helpdesk business-focused guides and training materials on China IPR issues are all downloadable from the online portal.

**ONLINE SERVICES** Our multi-lingual online portal (www.china-iprhelpdesk.eu) provides easy access to Helpdesk guides, case studies, E-learning modules, event information and webinars.

Prepared by:

The language offer will depend on the specific service and experts’ availability.

If you have any queries on how to protect your Intellectual Property in China contact our Helpdesk service:

If you want more information on additional free services offered by the Helpdesk contact the coordination team:

Follow us on Social Media and stay tuned on new releases of factsheets and other IP content:

@china-iprhelpdesk