SQUIRE PATTON BOGGS

Paolo Beconcini



Consultant

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Languages spoken
English | German | Italian | Mandarin | Spanish

About Paolo

Since 2012, Dr. Paolo Beconcini has headed the firm's China Intellectual Property team spanning several offices, including Beijing, Shanghai, Hong Kong and Los Angeles. Paolo consults with companies seeking protection for their IP rights in China and legal action against infringers, advising on issues of law and enforcement, conducting evidence gathering and piloting their cases through the Chinese legal system.

A sought-after authority on IP protection and litigation in China, Paolo manages the trademark, copyright and design portfolios of European and US clients, conceives and implements IP litigation strategies, regularly appears in Chinese courts and attends IPR administrative and police raids on counterfeiters. His record of success in patent and trademark infringement lawsuits includes landmark cases designated "case of the year" by several IP journals. He leads business intelligence teams that pursue evidence of counterfeiting operations, particularly concerning automotive, fashion and consumer goods.

Paolo is frequently invited to speak at conferences devoted to the growing field of Chinese IP, and has been actively involved in field projects, including trademark and patent enforcement training programs for Chinese civil servants. Paolo is regularly interviewed on China IP matters by media around the world such as *The Wall Street Journal*, CNN, BBC, *The Times,* Bloomberg, *La Tribune* and *Il Sole24 Ore*, to name a few.

In China, where intellectual property disputes routinely involve multiple cultures, Paolo's fluency in five languages, including Mandarin, helps him navigate international borders and creates confidence in his clients. Paolo represents US and European clients in confronting the myriad cross-cultural challenges – legal, commercial and political – that threaten patent and trademark assets.

Experience

Patent, Trade Secret and Design Infringement

- Representing a French company specializing in manufacturing complex production machinery for aviation components in a trade secret infringement case in China.

- Representing a world leading Italian company in mechanical components for furniture in patent infringement and patent invalidation lawsuits in China.
- Advised a US corporation regarding trade secret theft by a former employee based in China.
- Representing a leading German tool manufacturer and distributor in a cross-border patent infringement matter originating in China and expanding to several European countries.
- Representing Henkel Group in three design infringement lawsuits against Chinese counterfeiters of the client's iconic design for the "Bref" toilet freshener.
- Representing a US company manufacturing mobile phone accessories in a patent infringement lawsuit filed by a US competitor in China, concerning devices for holding mobile phone cases.
- Representing a US brand selling outdoor furniture in a cross-border US-China litigation against another US competitor and its Chinese suppliers. The case revolves around the infringement of the design rights of his client on outdoor furniture. It involves several parties and two major lawsuits in China and the US. The matter is still pending.
- Representing a US car maker in the investigation and enforcement of an infringement of a design patent over the outer design of a commercial vehicle by a Chinese competitor.
- *Neoplan v. Zonda* – When the client's award-winning luxury bus design was copied by Chinese competitors, Paolo's team gathered evidence against the infringers, successfully defended five patent invalidation proceedings and managed the high-profile media aspects of the case, resulting in an award of €2.5 million in damages. This remains the largest award to date for a design patent infringement action in China. The case was named 2009's "case of the year" in several international IP journals.

Trademark Infringement/Counterfeiting and Copyright

- Representing Harris Tweed Authority in its anticounterfeiting investigations and enforcement in China.
- Representing Major League Baseball (MLB) in its anticounterfeiting enforcement activities in China; led nearly 200 successful administrative and criminal raid actions in 2023.
- Representing MF-Brands (Lacoste) in anticounterfeiting investigations and enforcement in the US.
- Representing Diesel SpA in several trademark enforcement matters in China and Hong Kong.
- Coordinating and conducting all investigation and IP enforcement in China for a German cosmetic brand; this includes dozens of civil lawsuits following from police raids. Handling approximately 100 investigation and enforcement matters annually.
- Represented Valentino SpA in several trademark infringement lawsuits in China, including a significant lawsuit that was favorably settled in our client's favor.
- Representing fashion brand Roberto Cavalli in trademark infringement investigation and enforcement.
- Representing a well-known English shoe brand in all trademark enforcement matters in China.
- Representing a French shoe brand in a dispute with a Chinese troll, including trademark invalidations proceedings, administrative enforcement by raids against the Chinese infringer's factory and a lawsuit filed against the same counterfeiter.
- Coordinated, for three years, all the trademark enforcement actions for the Henkel Group in China. In 2018, we conducted 16 raids and more than 20 investigations of trademark infringement activities by Chinese counterfeiters.
- Representing a German chemical company in a trademark enforcement action in South China against a former distributor. The dispute focuses on the former distributor's illegally appropriating of the client's trademarks and business secrets. Action is still pending.

- Successfully coordinated and conducted an extensive criminal enforcement operation in Eastern China which resulted in raids on several factories by the Chinese police. The operation resulted in the arrest of a dozen individuals and the seizure of almost 100,000 pieces of fake cosmetic products on behalf of our client.
- Successfully raided more than 18 factories and warehouses in China manufacturing and storing more than 10,000 fake auto parts of a famous car part maker from Europe during 2017. Two of these cases are heading to a criminal trial and civil litigation for damage recovery will follow, given the seriousness of the infringements.
- Successfully raided more than 17,000 fake shoes of an Italian shoe brand in the course of 2017. Three of the relevant raids have been concluded with the criminal trial and conviction of the infringers. One of these cases has then been litigated before a civil court in South China and the client has been awarded more than €30,000 in damages.
- Winning a landmark copyright lawsuit in Shenzhen to protect the outer shape of a bag on behalf of an Italian fashion brand. The lawsuit validated the copyrightability of the three-dimensional embodiment of copyrighted drawings of a bag.

Trademark Filing and Prosecution

- Manage the trademark portfolio in China for several European fashion brands, including Clark's, Tod's, Furla, Benetton, Roger Vivier, etc.
- Manage the China trademark portfolio of Henkel Group and several other EU and US brands.
- Obtained important decisions recognizing the well-known status of several clients' trademarks in China.

Credentials

Education

- University of Florence, LL.M.
- University of Florence, B.A.
- University of Southern California, LL.M.

Memberships & Affiliations

- Adjunct professor at USC Gould School of Law since 2024
- Member of INTA Anticounterfeiting Committee, 2024-2026
- Guest lecturer, Cornell Law School, University of Southern California, New York University and Pepperdine University
- China expert consultant, National Cyber-Forensics and Training Alliance (NCFTA)
- Global Chamber Los Angeles – Advisory Board
- Member of the INTA Design Subcommittee 2022-2024, Anticounterfeiting Committee 2024
- Lecturer, master class, IP Business Management School, University of Strasbourg

Recognitions

- Named as an Ambassador, Centre for International Intellectual Property Studies (CEIPI) IP Business Academy, 2024
- Ranked since 2018, *WTR 1000*: China and SARs: China: Foreign
- Named as a Leader by *World Intellectual Property Review* (*WIPR*) 2022, 2023 and 2024
- Recognized in *World Intellectual Property Review (WIPR)* China Trademarks 2023, 2024
- Anti-counterfeiting consultant to Interpol Illicit Trafficking and Anti-Counterfeiting Division
- Consultant to Italian Custom Police on China IP-related matters
- Consultant to the Danish Patent and Trademark Office on China IP-related matters
- Consultant to the EU China IPR SME Desk

Expertise

Services

- Intellectual Property & Technology

Industries

- Advertising, Media & Brands

Publications & Speaking Engagements

Speaking Engagements

- Speaker, "The Future of Luxury: is Made in Italy Ready?" Pepperdine University, November 2022.
- Speaker, "IP Challenges for Foreign Battery Makers in China – Latest Industrial and Legal Trends," PlugVolt webinar, May 2022.
- Speaker, "The Global Plague of Counterfeiting," IPWatchdog webinar, February 2022.
- Speaker, "A Good Time for Made in Italy: Opportunities and Challenges," hosted by Squire Patton Boggs and the Italian Institute for Foreign Commerce, May 2021.
- Speaker, webinar, "China-US Economic Relations and the Protection of Trade Secrets," Squire Patton Boggs and the Atlantic Council, November 2020.
- Speaker, "Trademark Infringement and Enforcement in China," Stafford Seminars, January 2020.
- Speaker, "Let's Do China" 2019 Road Show presentation on protecting IP assets in China, Manchester and Leeds, June 26-27, 2019.
- Speaker, "Multi-National Design Enforcement: The Road to Remedies," 2018 Designs Conference: The Power of Design Program, London, England, February 26-27, 2018.
- Speaker, "IPR Protection in China," Association of Corporate Counsel APAC, September 12, 2017.
- Speaker, "IPR Protection in China," Association of Corporate Counsel of Orange County, California, August 19, 2017.
- Speaker, "IPR Protection in China," Association of Corporate Counsel of Los Angeles, August 17, 2017.

Publications

- Author, "Recycled Packaging and Trademark Infringement," *IP Litigator*, Wolters Kluwer, November/December 2022.

- Author, "Alternative Strategies to the Enforcement Against Parallel Import of Cosmetics by Unauthorized Sellers," *The Licensing Journal*, Wolters Kluwer, October 2022.
- Author, "China: Design Patents and the Metaverse," *The Licensing Journal*, Wolters Kluwer, September 2022.
- Co-author, "Design Rights: Functionality and Scope of Protection," Second Edition, Wolters Kluwer, September 2022.
- Author, "The State of Trade Secret Protection in China in Light of the U.S.-China Trade Wars: Trade Secret Protection in China Before and After the U.S.-China Trade Agreement of January 15," *UIC John Marshall Law School Review of Intellectual Property Law*, February 26, 2021.
- Author, "The China IP Blog Series: Latest on Functional Features and Junk Design Patents in China," *UIC John Marshall Law School Review of Intellectual Property Law*, February 19, 2021.
- Author, "The China IP Blog Series: Chinese OEM Trademark Infringement Liability in Light of the Global Covid-19," *UIC John Marshall Law School Review of Intellectual Property Law*, February 5, 2021.
- Author, "Latest trends in the OEM trademark infringement liability saga in China, especially in light of Covid-19," *UIC John Marshall Law School Review of Intellectual Property Law*, February 3, 2021.
- Author, "The China IP Blog Series: The Latest Amendments to the Chinese Patent Law," *UIC John Marshall Law School Review of Intellectual Property Law*, January 29, 2021.
- Author, "China's Recent Trade Investment Agreement with the EU and the Impact of its Provisions on Forced Technology Transfer," *UIC John Marshall Law School Review of Intellectual Property Law*, January 27, 2021.
- Author, "Changes in Trademark and Trade Secret Laws Address Concerns of Western Countries," *IP Litigator*, July/August 2019.
- Author, "China Trademark Office Attempts to Curb Bad Faith Filings," *IPWatchdog*, March 7, 2019.
- Author, "New Requirements for Foreign Companies filing Trademark Appeals in China," *IPWatchdog*, January 2019.
- Co-author, "Design Rights: Functionality and Scope of Protection," Wolters Kluwer, September 2017.
- Author, "Rules of Engagement: Trademark Strategies, Protection and Enforcement in China," *Kluwer Law International*, November 2016.
- Co-author, "Design Rights: Functionality and Scope of Protection," Wolters Kluwer for the AIPPI Series, September 2016.
- Co-author, "Trade Secret Protection in China: Lack of Regulation or Know-How Mismanagement?" *IP Licensing Journal*, Wolters Kluwer, Vol.36, no.3, March 2016.
- Co-author, "Potential Threats Behind a Joint Patent Application in China – Caveats for Foreign High-Tech Companies Dealing with Chinese Research Institutes," *Legal Studio – Lexis Nexis*, March 9, 2016.
- Author, "Trademarks anti-counterfeiting in China: Corrupted Enforcement Officials and the Role of Foreign Brands," *IP Frontline*, January 27, 2016.

About our firm

One of the world's strongest integrated law firms, providing insight at the point where law, business and government meet. We deliver commercially focused business solutions by combining our legal, lobbying and political capabilities and invaluable connections on the ground to a diverse mix of clients, from long-established leading corporations to emerging businesses, startup visionaries and sovereign nations. More than 1,500 lawyers in over 40 offices across four continents provide unrivaled access to expertise.