



## Edward Yao

### Partner

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## OVERVIEW

Edward Yao is a partner and his practice includes various intellectual property-related matters as well as dispute resolution, litigation and arbitration.

He focuses his practice on IP prosecution, protection, and enforcement, anti-counterfeiting, litigation, arbitration, dispute resolution, IP transactions and licensing programs in China. He specializes in developing and implementing comprehensive and effective IP and litigation strategies for multinational corporations.

He has represented some of the world's most famous brands (including the Top 10 brands) in a broad range of industries, including but not limited to technology, online gaming, financial services, wine, education, clothing and luxury goods, pharmaceutical, hospitality, food, and restaurant services. He handled a number of high-profile cases in China, including obtaining the title of a well-known trademark.

He has been ranked in *The Legal 500 Asia Pacific* and *World Trademark Review 1000*. One source describes him: "At K&L Gates, IP all-rounder Edward Yao is a polished IP disputes expert and effective contract negotiator. He has earned the trust of some of the world's most well-known names in a wide range of industry sectors."

## PROFESSIONAL BACKGROUND

Prior to joining the firm, Edward was an experienced litigator and head of the trademark group at a Chinese law firm based in Beijing. In addition, he was a litigator and trademark attorney at two Chinese law firms.

## ACHIEVEMENTS

- Individually ranked by the *World Trademark Review 1000* for Enforcement and Litigation in China and SARs: China: Foreign, 2023
- Listed in the World's Leading Trademark Professionals by *World Trademark Review 1000*, 2023-2024
- Recognized by *The Legal 500 Asia Pacific* as a Rising Star for Intellectual Property: Foreign Firms in China, 2022-2024

## SPEAKING ENGAGEMENTS

- IP applications and litigations, Sinopec Group, August 2019
- 337 Proceeding in US, Beijing Zhongguancun Forum for Middle and Small-sized Enterprises, November 2017
- Market Supervision Bureau of Chaoyang District, Beijing, September 2017
- Patent litigation and 337 proceedings in US, CRRC Corporation Limited, May 2017
- Trademark enforcement and recognition of well-known trademark under new Trademark Law in China

## EDUCATION

- LL.M., China University of Political Science and Law
- B.A., Renmin University of China

## ADMISSIONS

- Bar of People's Rep. of China
- China National Intellectual Property Administration (Chinese Patent Bar)

## LANGUAGES

- Chinese (Mandarin)
- English

## THOUGHT LEADERSHIP *POWERED BY HUB*

- 11 July 2023, Rules on Suspension of CNIPA Trademark Proceedings
- 11 August 2021, Guide: How to Enforce Intellectual Property Rights in China
- 13 April 2021, Amendments to China's Copyright Law
- 1 February 2020, Fashion Law – February 2020 Edition
- February 2016, 98 Million Reasons to Think About how you use Your Brand in China – The Risks of not Obtaining Proper IP Protection for Your Business in China

## OTHER PUBLICATIONS

- "How to Enforce Intellectual Property Rights in China," *Intellectual Property & Technology Law Journal*, 34 (3), March 2022

- Border Patrol, *Ragtrader*, June 2019
- “Risks prevention of trademark license in China,” *Asian Legal Business*, December 2014
- “Anti-dilution strategy of brand for famous brand owner,” *China Business Law Journal*, July 2014

## NEWS & EVENTS

- 14 February 2024, *World Trademark Review 1000* Recognizes K&L Gates, Lawyers as IP and Trademark Leaders in 2024 Edition
- 17 January 2024, The Legal 500 Recognises K&L Gates in 2024 Asia Pacific Edition
- 2 January 2024, K&L Gates Names Nearly 30 Partners, Government Affairs Advisors Across Firm
- 9 February 2023, K&L Gates, Lawyers Named as IP and Trademark Leaders in 2023 *World Trademark Review 1000* Rankings
- 16 January 2023, The Legal 500 Recognizes K&L Gates in 2023 Asia Pacific Edition
- 13 January 2022, Legal 500 Recognizes K&L Gates in 2022 Asia Pacific Guide
- 23 February 2021, K&L Gates Enhances Global Trademark Capabilities with Launch of K&L Gates IP Agency

## AREAS OF FOCUS

- IP Procurement and Portfolio Management
- Commercial Disputes
- Data Protection, Privacy, and Security
- IP Litigation

## REPRESENTATIVE EXPERIENCE

### IP Procurement and Portfolio Management

- Represented an international top petroleum company to succeed in recognizing its mark as well-known trademark in opposition proceedings
- Represented an international top IT company to succeed in recognizing its mark as well-known trademark in opposition, appeal of opposition proceedings, and court appeal proceedings
- Represented an international gaming company to prosecute and enforce IP rights in China
- Represented an international top IT company to succeed in opposing the famous trademarks of its competitor
- Represented a famous medical company to succeed in opposing the trademark imitation by its distributor and obtaining the trademark registrations in China

- Represented a famous beauty apparatus company to succeed in opposing the trademark imitation by its competitor and obtaining the trademark registrations in China
- Represented a famous cellphone accessories brand owner in China, and succeeded in fighting against the trademark imitation

## **IP Litigation**

- Represented an international hotel brand owner to fight against the infringements in China, and succeeded in canceling the trade name of one infringer based on trademark infringements and unfair competition in litigation proceedings
- Represented an international cup brand owner to fight against the infringements in China, and succeed in raid actions, administrative litigations, and civil litigations
- Represented a Canadian seafood brand owner to fight against the infringements in China, and succeed in administrative litigations and civil litigations
- Represented a famous food brand owner to fight against the infringements in China, and succeed in civil litigations based on the trademark infringements and unfair competitions
- Advised a famous cellphone accessories brand owners in China, and succeed in fighting against the trademark infringements
- Advised a famous apparatus rental brand owner to succeed in civil litigation based on trademark and trade name infringements
- Advised a famous medicine services brand owner to succeed in civil litigation based on trademark, trade name infringements, and unfair competitions
- Advised a famous US brand owner on domain name dispute
- Advised a famous German company against patent infringements in China
- Advised a famous US car accessory company against patent infringements in China
- Advised a famous US software company against copyright infringement in China
- Advised a famous US skin care company against trademark infringement, copyright infringement, and unfair competition in China
- Advised a famous US semiconductor company against trademark infringement, copyright infringement, and unfair competition in China

## **Complex Commercial Litigation and Disputes**

- Advised an international top IT company to conduct the investigation on the theft crime of employee and focus on criminal litigation
- Advised on arbitration for breach of product purchase contract
- Advised a famous US data company to conduct the investigation and strategy against IP theft in China

- Advised a famous traveling magazine on strategy against breach of contract
- Advised an international clothing company to solve the dispute on the payment of royalty in China

### **Technology Transactions and Sourcing**

- Represented a famous Chinese company to negotiate for technology and patent license
- Advised an international famous clothing company to license its trademarks to Chinese companies
- Advised a famous US university for IP license in China
- Advised a famous education company for IP license in China
- Advised a famous online gaming company for IP license in China
- Advised a famous pharmaceutical company for IP license in China

### **Data Protection, Privacy, and Security**

- Advised a famous aggregation platform on IP protection, information protection, Internet security, and cloud services
- Advised a famous restaurant holding company on data compliance in China
- Advised a famous Australia bank for data compliance in China
- Advised a famous railway company for data compliance and strategy against data breaches in China
- Advised a famous data company for data compliance in China