

## Tracy Li

Partner | Intellectual Property | Hong Kong

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### Tracy is a Partner in the China IP Practice

Tracy is qualified as a solicitor in Hong Kong and holds a LLB, a PCLL and a BSS (Government and Laws) from the University of Hong Kong.

Tracy's practice covers IP protection and enforcement. She advises on strategic issues in China relating to commercial exploitation of IP rights, e-commerce, portfolio management, brand protection, and copyright protection. Many of her clients are multinational and regional businesses in a variety of industries, including luxury goods, fashion, consumer goods, hospitality, gaming, and e-commerce platforms etc.

Tracy has successfully obtained well-known trade mark recognition and has established personal name rights for international clients in non-contentious proceedings. She regularly advises on parallel imports and Original Equipment Manufacturing (OEM) issues, in particular, she successfully defended a Malaysian clothing company's PRC trade mark registration based on OEM use in non-use cancellation proceedings before the Beijing Higher People's Court, which set a precedent for future cases.

On the commercial side, Tracy has represented many clients in negotiating agreements involving cooperation, co-existence, licensing and assignments of IP assets, as well as advising on IP audits and due diligence for mergers and acquisitions. She is also experienced in advising on entertainment matters including movie clearance and music clearance in China.

Tracy advises extensively on e-commerce issues in China including assisting e-commerce platforms with compliance issues and strengthen platform protection for genuine brand owners.

Tracy represented the Law Society of Hong Kong as a delegate at the Union of Internationale des Avocats (UIA) Annual Congress in Valencia, Spain in 2015. She was one of the organising committees for the Cross Straits Four Regions Young Lawyers Forum organised by the HKLS in 2016 and 2017.

### Highlights

- Advising a global chain of health food shops on civil litigation in China and arbitration proceedings at CIETAC against its franchisee, representing the client in settlement negotiations and terminating the preliminary injunction against client.
- Successfully obtained well-known trademark recognition in trademark opposition proceedings for a Swiss watch designer and manufacturer; advising the same on data localisation, consumer protection, anti-monopoly matters etc.
- Successful recognition of personal name right for a Belgian designer in trademark proceedings in China through diplomatic efforts.
- Assisted a Malaysian apparel company in defending its PRC trademark registration based on use of trademarks on Original Equipment Manufacturing (OEM); a landmark case issued by the PRC Beijing Higher Court.
- Advising a listed global hotel group on IP commercialization projects such as expansion of the hotel's F&B products to various e-commerce platforms, collaborations with other brands, including drafting and reviewing various legal instruments and agreements.
- Advising leading PRC e-commerce platforms on compliance matters on parallel imports and combating counterfeits.
- Conducting diligence exercise on sale and acquisition of IP rights for a sportswear brand and a video game company.
- Advising on errors and omission insurance for animations and movies.
- Managing trade mark portfolios and prosecuting trade marks in China for major Hong Kong and multi-national clients including a Swiss watch brand, a listed global hotel group, US-based hotel and casino, European advertising company, US venture capital etc.



### Principal Areas

- Intellectual Property
  - China IP Services
  - Copyright
  - Enforcement and Litigation
  - Internet and Online Business
  - IP Commercial Advisory
  - Trade Marks

### Sectors

- Consumer Goods and Retail
- Hospitality and Leisure
- Technology, Media and Telecom
  - Media and Entertainment

### Languages

- English
- Cantonese
- Mandarin

### Jurisdictions

- Solicitor, Hong Kong, 2010

- Acting for various foreign companies in negotiations for buying-back of trademarks and/or domain names in China, including but not limited to a US-based leading online payment company, a US-based home appliance company, foreign fashion designers, Swiss skincare brands.
- Advising on raid action for an Icelandic company involving IP rights infringement, unfair competition acts and false advertising acts.

## More about Tracy Li

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### Accolades

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- **Legal 500**
  - Recommended Lawyer, IP, China (Foreign Firm) (2023)
- **Managing IP**
  - Rising Star, Hong Kong (2020–2022)
- **Euromoney Legal Media Group's Expert Guide**
  - Rising Star, Trade Marks, Hong Kong (2017, 2019– 2020)

### Appointments/Memberships

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- Member, The Law Society of Hong Kong
- Member, International Trademark Association
- Organising Committee, Cross Straits Four Regions Young Lawyers Forum organised by The Law Society of Hong Kong (2016 – 2017)

### Education

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- PCLL, The University of Hong Kong (2008)
- LLB, The University of Hong Kong (2007)
- BSS (Government and Laws), The University of Hong Kong (2006)

### Publications

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- “China closes loophole on trademark infringement for OEM, *Asia IP Magazine* (Oct 2020)
- “OMG! Has China’s Supreme Court reversed its position on OEM trademark infringement? The implications of HONDAKIT case”, *Deacons IP Client Alert*, (Jul 2020)
- “Beijing Court Confirms OEM Constitutes use in Non-use Cancellation Proceedings – Useful Tips for Trade mark Owners”, *Expert Guides* (Jul 2017)
- “OEM after PRETUL – Beijing IP Court finds that OEM constitutes use in non-use cancellation proceedings”, *Expert Guides* (Aug 2016)