



European
Commission

SOUTH-EAST ASIA IPR SME HELPDESK

IP considerations for the Automotive Industry in South-East Asia



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1. Overview: Automotive Industry in South-East Asia

The automotive industry in South-East Asia has exhibited robust growth over the last few years. According to the latest statistics from the ASEAN Automotive Federation, combined motor vehicle sales in 7 major ASEAN countries (Indonesia, Malaysia, the Philippines, Singapore, Thailand, Vietnam and Brunei) reached 3.16 million in 2016¹, almost double the sales figure in 2006 which was 1.78 million units². The motorcycle sector also thrives in ASEAN, with almost 10 million motorcycles and scooters sold in 2016³. More importantly, not only is ASEAN a vast automotive market, it is also a global automotive production hub, manufacturing on average 4 million motor vehicles and 9 million motorcycles a year for the past 5 years⁴.

With a combined population of almost 630 million, an aggregate GDP of over US\$2.4 trillion in 2015⁵, and an average annual GDP growth of around 6% over the past decade, growth in the automotive industry in the ASEAN region is to be expected. In addition to the extensive market size that ASEAN presents, consumers in this region are also increasingly affluent, which results in a rising demand for car ownership as a symbol of success⁶. In a recent report by Research and Markets, it is predicted that the automobile industry in South-east Asia will maintain fast growth from 2017 to 2021 due to the increasing demand for automobiles in this region, as well as the relatively low labour cost in producing vehicles and related accessories⁷.

¹ASEAN Automotive Federation 2016 Statistics http://www.asean-autofed.com/files/AAF_Statistics_2016.pdf. ²ASEAN Automotive Federation 2007 Statistics http://www.asean-autofed.com/files/AAF_Statistics_2007.pdf. ³ASEAN Automotive Federation 2016 Statistics http://www.asean-autofed.com/files/AAF_Statistics_2016.pdf. ⁴ASEAN Automotive Federation Statistics from 2012 to 2016 <http://www.asean-autofed.com/statistics.html>. ⁵ASEAN Economic Community Chartbook 2016 <http://www.aseanstats.org/wp-content/uploads/2016/11/AEC-Chartbook-2016-1.pdf>. ⁶Riding Southeast Asia's Automotive Highway https://www.pwc.com/kr/ko/industries/automotive/201511_riding-southeast-asia-automotive-highway_en.pdf. ⁷Automobile Industry Forecast to 2021 <http://www.researchandmarkets.com/research/cpwn72/automobile>.

As per above, the South-East Asia region offers vast opportunities for EU manufacturers and distributors of vehicles and vehicle components. Given the constant innovation that is at the forefront of the automotive industry, the importance of intellectual property (“IP”), as well as the protection and enforcement thereof, is undeniable. As such, when exploring the possibility of investing or expanding into the ASEAN market, EU SMEs should be aware of the IP risks that they will face when operating in this region, in particular with respect to the new technologies and the ability to protect these technologies from local competitors.



2. Frequent issues concerning Trade Marks

i) Trade mark registration and branding strategies

Branding is important to the success of EU SMEs venturing into the South-East Asia automotive market. A good branding strategy may help EU SMEs leverage the reputation that they have built up in other markets, allowing them to compete with local suppliers. As such, the first and foremost consideration for EU SMEs wishing to enter the region is to ensure that their trade marks are registered in the respective local markets.

The trade mark regimes in the South-East Asia region generally adopt the “first-to-file” system, which grants exclusive trade mark rights in a particular country to the party that first applies to register the mark in that country once the registration is completed. It shall be noted that there is no centralised or common system for trade mark registration at ASEAN level, therefore registrations shall be made in each of the countries where EU SMEs are operating or intend to do business. As such, EU SMEs must remember to register their trade marks in the respective local markets, in order to avoid the problem of “trade mark squatting” where third parties register the trade marks first in order to profit from such registrations. In addition, EU SMEs should consider registering their trade mark in local languages as well, as registration of a trade mark in original Roman characters does not automatically grant protection against the use or registration of the same or a similar trade mark written in local scripts used in particular South-East Asian countries, such as Tamil, Thai, Burmese, Lao or Khmer. Registering trade marks in local languages may also help

EU SMEs avoid the situation whereby local consumers adopt a local version of their trade mark (for example, by way of translation or transliteration), which may not have the right connotations or image that EU SMEs wish to convey.

A preliminary search on trade mark availability in the countries of interest is always recommended before proceeding with trade mark registrations in the said countries.

Apart from registering their trade marks, EU SMEs should also adopt a consistent branding strategy in order to leverage the reputation and goodwill that has been built up in other markets, or to establish a brand with robust reputation and goodwill in the local markets. Given the rapidly changing automotive landscape, with the rise of electric and autonomous driving, increased environmental awareness, and a growing demand for more digitally-focused experiences, there is a call for automotive businesses to adjust their branding strategy accordingly to remain competitive⁸. An effective branding strategy that focuses on the desired qualities that EU SMEs wish to deliver will therefore help consumers differentiate their products and services from those of their competitors and generally help EU SMEs to succeed in penetrating new markets.

As an additional practical tip on the importance of branding strategies, during the initial lifespan of a new product, patent registration is usually important in preventing unauthorised reproduction of the product. However, once the term of protection of the patent expires, trade marks will play a crucial role in allowing EU SMEs to benefit from the reputation and goodwill built during the term of the patent protection. This can serve as a main driver of revenue for EU SMEs in the long run.

ii) Trade mark infringement & counterfeit of automotive components

Another pertinent issue involving trade marks in the automotive industry concerns counterfeit automotive components, such as parts and accessories used in the manufacture, repair and modification of motor vehicles. Parts distributors, whether ensure that their trade marks are registered in the respective local markets. wholesalers or retailers, may sell counterfeit products at real-product prices, increasing their own profit margins.

Trade marks play a crucial role in allowing EU SMEs to benefit from the reputation and goodwill built during the term of the patent protection



⁸ Automotive branding: Shift up a gear or risk stalling <http://www.siegelgale.com/automotive-branding-shift-up-a-gear-or-risk-stalling/>.

Not only does the circulation of counterfeit components result in economic loss for the automotive companies, the usage of counterfeit parts may also affect both the performance and the safety of the motor vehicles, thus endangering the reputation and goodwill that the companies have built up in the region. In the Philippines, for example, fake motorcycles and parts were becoming so rampant in the local marketplace that legitimate manufacturers, such as Honda, have taken notice of the issue and warn riders of the threats that such fake motorcycles and parts pose to their own safety as well as the overall public safety⁹.

As such, EU SMEs whose parts are being copied should consider commencing administrative, criminal or civil proceedings in the respective local jurisdictions in order to enforce their IP rights as soon as they become aware of the issue. Collaborating with the local enforcement authorities and commencing appropriate proceedings that are available under the laws of the local jurisdictions may enable EU SMEs to put a stop to counterfeits, either through seizure and disposal of the counterfeit goods, or through injunction orders mandating the offenders to cease selling and producing the counterfeits.

In addition, EU SMEs should take practical measures such as employing the appropriate technology to fight counterfeits, and/or consulting with their local agents, distributors and suppliers to find out about the local IP context, as well as to identify potential risks and how to counter them. It is also important to be active in educating consumers about products' distinctive qualities, as well as dangers of counterfeit products, through conducting campaigns, both online and off-line, to raise public awareness of EU SMEs' IP rights.

For more information about Trade Marks in South-East Asia, please refer to our Guide on Protecting Your Trade Marks in South-East Asia at http://www.southeastasia-iphelpdesk.eu/sites/default/files/publications/EN_TM.pdf.

3. Frequent issues concerning Patents

i) Protection through standard patents and simple patents

With constant innovation and the introduction of new technologies, patent protection remains one of the most important forms of intellectual property for many automotive companies. Patent owners acquire the exclusive rights for a limited period of time (usually 20 years) to prevent others from making, using, commercialising or importing the patented inventions during the term of the patent.

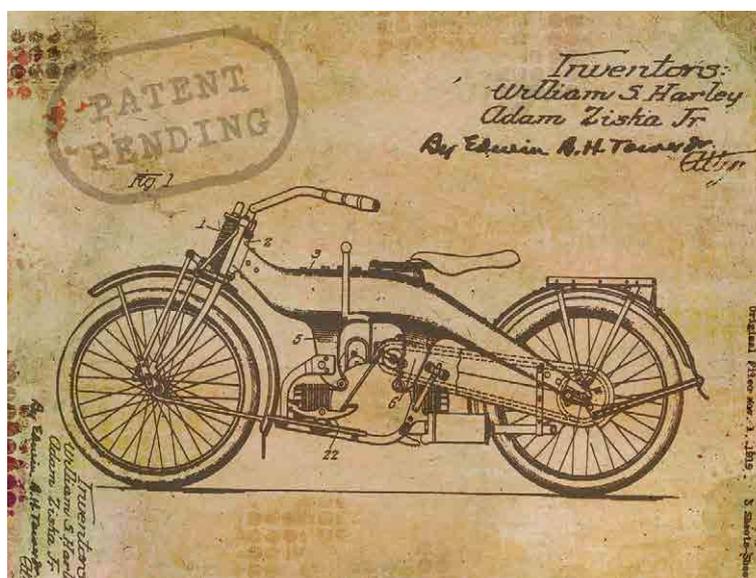
Generally, for an invention to be patentable, the invention must meet the following three requirements: (1) novelty, (2) inventive step, and (3) industrial applicability. In addition to standard innovation patents, some South-East Asian countries also allow for a "lesser" form of patent protection for which no or a lesser degree of innovation is required to qualify for protection. For example, Petty Patent in Laos (for a period of 10 years, which may be extended once for an

additional 2 years period) and Utility Innovation in Malaysia (for a period of 10 years, which may be extended for another 2 consecutive 5-year terms) require a lesser degree of innovation. On the other hand, Utility Model in Cambodia and the Philippines (both for a period of 7 years), Simple Patent in Indonesia (for a period of 10 years), and Utility Solution Patent in Vietnam (for a period of 10 years) require no inventive step at all. To fully understand the scope of such IP registrations, EU SMEs should consult with local IP experts able to advise them on how to achieve their goals and better address their need for patent protection.

Such "simple patents" are generally easier and faster to obtain than standard patents. However, they protect the inventions for a shorter period of time than standard patents. In addition, as such simple patents do not require substantial examination, they are less effective when enforced and may be exposed to a higher risk of invalidation. As such, EU SMEs should only consider simple patents for products with a shorter life span and/or with a lesser degree of innovation in order to maximise achievable protection.

On the other hand, the application process for standard patents in South-East Asian countries may be lengthy and require substantial resources to support the patent applications through to grant. This may sometimes deter EU SMEs from seeking patent protection for their inventions. As such, where applicable, EU SMEs should avail themselves of the ASEAN Patent Examination Cooperation (ASPEC) Programme as well as any other Patent Prosecution Highway Programmes between the national patent offices. Such programmes allow the sharing of search and examination results between the participating patent offices, thereby allowing applicants in participating countries to obtain the corresponding patents faster and more efficiently.

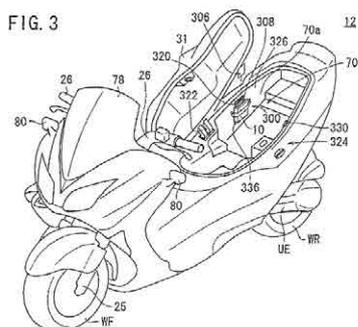
EU SMEs may also consider applying for both simple patent and standard patent simultaneously for the same invention. Once the standard patent has been granted, EU SMEs may abandon the simple patent. This strategy allows EU SMEs to take advantage of the faster approval of the simple patent, which would provide EU SMEs a first level of protection until the standard patent is granted.



⁹ Honda warns public against fake motorcycles and parts <http://www.topgear.com.ph/news/industry-news/honda-warns-public-against-fake-motorcycles-and-parts>.

ii) Patent infringement

Specific to the automotive industry, there are numerous technological innovations and industrial processes that are protected by patents and are therefore on public records. For example, a simple search on the public patent database maintained by the Intellectual Property Office of Singapore reveals a number of patents registered in the name of Honda Motor Co., Ltd., such as the “Motorcycle Communication Device and Mounting Structure thereof” as illustrated by the following figure:-



Hence, these inventions are at a higher risk of being copied or otherwise infringed. For example, infringement may occur through the reverse engineering of a specific technical equipment, or through production of “overruns” of automotive components, or the sharing of certain production details or specifications to potential counterfeiters by contractors who are hired to produce original automotive components for vehicle manufacturers. As such, where resources permit, EU SMEs should consider making minor amendments to their inventions regularly in order to stay ahead of the counterfeiters. In addition, EU SMEs are strongly advised to complement patent protection with appropriate contractual arrangements to ensure that their contractors and suppliers protect the confidentiality of specifications and production details.

iii) Risks of infringing existing patents owned by Patent Assertion Entities (“patent trolls”)

Patent Assertion Entities (or sometimes “patent trolls”) are companies that acquire patents from third parties and seek to generate revenue by licensing them at inflated prices, or asserting them against alleged infringers. Such entities pose grave threats to companies, especially EU SMEs who may not have the resources to pursue the matter in court and may therefore be forced to settle on terms unfavourable to them.

Given the convergence of the automotive industry and software that leads to cars integrating high-tech innovations such as Wi-Fi, cellular and audio technology, voice technology, user interface, and security measures, automakers are becoming more and more vulnerable to the threats posed by “patent trolls” that acquire patents on such high-tech innovations. EU SMEs should forge a strong bond with their suppliers and join forces with each other in order to effectively combat “patent trolls”.

For more information about Patents in South-East Asia, please refer to our Guide on Protecting Your Patents in South-East Asia at http://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/EN_patent.pdf.

4. Frequent issues concerning Industrial Designs

Generally, an industrial design refers to the ornamental or aesthetic features of a product. It may consist of three dimensional features, such as the shape of the product, or two dimensional features, such as patterns, lines or colour¹⁰.

Industrial design protection is crucial to preserve the value of a product based on its aesthetic design. In the automotive industry, protecting industrial designs is of utmost importance as it prevents competitors from copying the design of vehicles and simply re-branding it. Industrial design protection should be sought not only for the general look of the vehicles, but also the vehicles’ spare parts such as tyres, rims, steering wheels or bumpers with a distinctive appearance. For example, exhibited below is the perspective view of a steering wheel design registered in Singapore (Registration No. 30201703579U) by Toyota Jidosha Kabushiki Kaisha, taken from the public design database maintained by the Intellectual Property Office of Singapore:



Industrial design regimes in South-East Asian countries generally follow the “first-to-file” system, which grants protection in a particular country to the first person to file the industrial design application in that country once the design is registered. Accordingly, EU SMEs should strive to apply for protection of industrial designs early, before others do so first and benefit from the original creator’s efforts. Before applying for the industrial design, EU SMEs should also conduct prior searches on designs in the countries of interest to ensure that the designs they wish to protect have not been registered in the relevant countries already.

In South-East Asia, such prior searches are made easier with ASEAN DesignView, an integrated searchable online database of industrial design registrations and published industrial design applications filed in participating ASEAN countries, including Brunei Darussalam, Cambodia, Lao PDR, Malaysia, the Philippines, Singapore, Thailand and Vietnam. EU SMEs should utilize this platform prior to expanding into South-East Asian countries, although it is nevertheless recommend that EU SMEs engage the services of local law firms or IP agents to conduct a more thorough search on the official local industrial design databases.

For more information on ASEAN DesignView, please refer to our How to Guide on ASEAN DesignView at http://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/How_to_Designview.pdf.

¹⁰ Industrial Designs <http://www.wipo.int/designs/en/>.

5. Frequent issues concerning Trade Secrets

As previously mentioned, although patents are effective in protecting innovations, they are made available to the public through publication by the patent offices. Accordingly, while patent registration offers EU SMEs legal protection in South-East Asian countries, it also increases the risk of copying by their competitors. As such, EU SMEs may consider protecting their technologies by avoiding disclosure to third parties, thus maintaining their “trade secrets”.

i) Trade secret protection through physical security measures

As far as possible, EU SMEs should limit physical access to their technologies. Important documents describing the technologies should be kept in a safe place, with adequate security measures being put in place, and with few parties being given access to such documents. For example, the documents containing the trade secrets may be kept in a safe which is to be locked at all times (either physical lock or digital lock), with few people being given the keys to the lock. In addition, closed-circuit television (CCTV) cameras may also be installed in the room in which the safe is kept, to monitor unauthorised access to the safe.

Those parties that are given access to the technologies in view of their specific position in the company, should in turn be bound by obligations of confidentiality with high penalties in case of breach to serve as deterrence against disclosure.

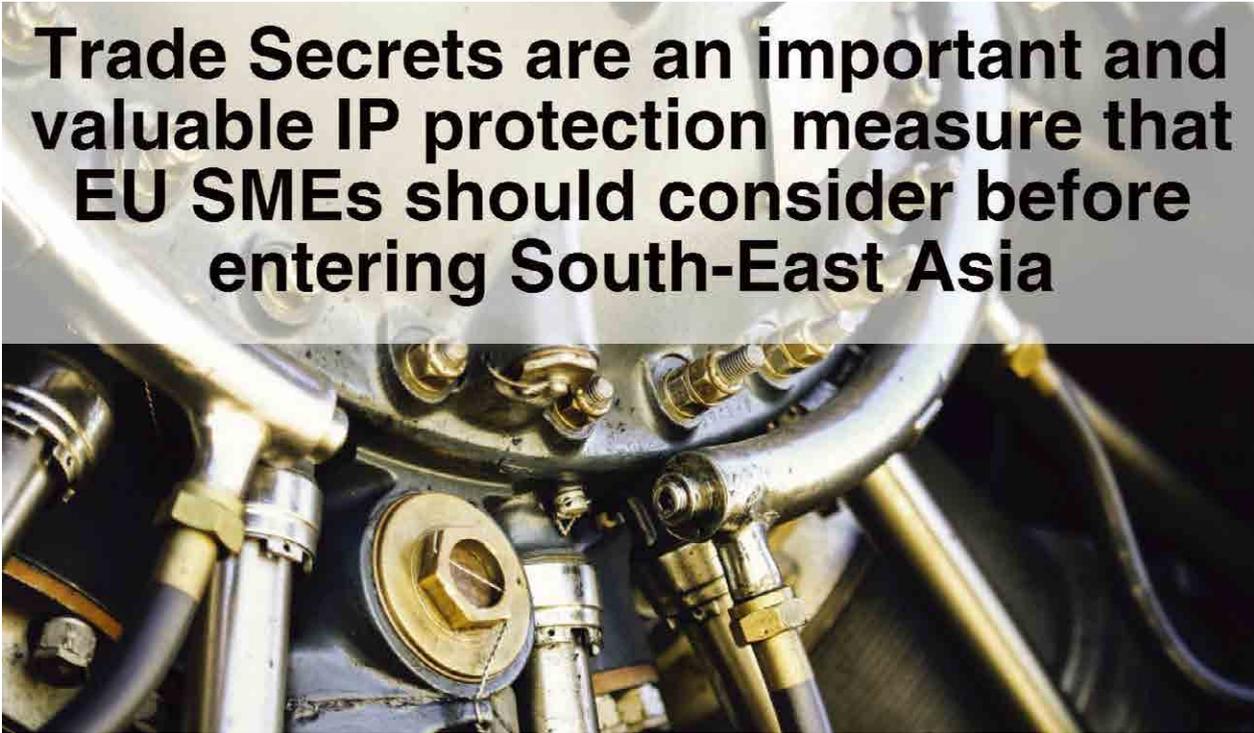
ii) Trade secret protection through contractual arrangements

EU SMEs should also protect their trade secrets via contractual means. Specifically, EU SMEs should have their employees, consultants, vendors, suppliers and other individuals related to the company sign Non-Disclosure Agreements or add confidentiality clauses to their contracts with these parties. Well-drafted confidentiality clauses, which comprehensively define “confidential information” and clearly provide for the confidentiality obligations, as well as the penalties that will result if such obligations are breached, may help EU SMEs create an additional layer of legal protection to their trade secrets.

Although the protection of trade secrets is of a less formal nature as compared to that of trade marks or patents, it is still an important and valuable IP protection measure that EU SMEs should carefully consider before entering the South-East Asian markets. Relevant clauses in Employment Contracts as well as Non-Disclosure Agreements signed with partners would be the most effective ways to maintain secrecy of such information.

For more information about Trade Secrets in South-East Asia, please refer to our Guide on Protecting Your Trade Secrets in South-East Asia at <http://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/Trade-Secrets-English.pdf>.

For specific information on the various IP rights in each of the ten countries of South-East Asia, please refer to our IP Country Factsheets available at <http://www.southeastasia-iprhelpdesk.eu/en/country-factsheets>.



Trade Secrets are an important and valuable IP protection measure that EU SMEs should consider before entering South-East Asia

6. SME Case Studies

Case study 1

Background

Textra Automotive (“Textra”) is a medium-sized European company known for producing high-tech sensors for cars. After an extensive market study, Textra has decided to enter the ASEAN market. It identifies Siam Manufacturing Group (“Siam”) as a promising partner in Thailand and enters into an agreement with the latter to manufacture and distribute sensors to vehicle manufacturers in Thailand. If the products prove profitable in Thailand, Textra will expand its business to the other major automotive manufacturing countries in the region.

Following three successive profitable quarters, Textra decides to pursue sales of the products in Indonesia, Malaysia, Vietnam and the Philippines. It applies to register its name as a trade mark in Thailand, with a plan to register the same mark in the other four countries, claiming priority from the Thailand application. However, Textra discovers that the trade mark has already been registered by Mais Manufacturing Ltd. (“Mais”).

Actions taken

Upon further investigation, Textra is appalled to learn that Mais has manufactured inferior sensors and sold the same for a reduced price under Textra’s trade mark. It turns out that Siam has been selling faulty Textra sensors that it manufactures to Mais, despite the contract between

Textra and Siam specifying that all faulty sensors are to be destroyed. The problems are compounded when Textra receives a Letter of Demand from Mais alleging trade mark infringement.

Textra is advised by its local lawyer that the “Textra” trade mark is legitimately registered in Thailand by Mais, and therefore it cannot claim the trade mark from Mais.

Outcome

Faced with the threat of lawsuits for trade mark infringement by Mais, Textra is forced to negotiate with Mais to purchase the “Textra” trade mark from the latter at a substantial price.

Lessons Learned

- EU SMEs should conduct due diligence on their local partners before working with them.
- EU SMEs should register their trade marks in the South-East Asian countries of interest before or as soon as they enter the respective countries.
- EU SMEs should actively monitor the market for infringement products and set aside a budget for commencing actions against the infringers. Infringing it. Sale of sub-standard counterfeit medical devices poses a risk to the health of the consumer and can adversely damage the reputation of the company.

Case study 2

Background

Mobix Auto (“Mobix”) is a European company specialised in manufacturing parts and accessories for automotive manufacturers. Having achieved considerable market share in its home market and some other European countries, Mobix plans to introduce its products to the South-East Asian market, after learning of the growing demand for vehicles and vehicle components in this region.

Before entering the region, Mobix attends an automotive trade show organised in Singapore to survey the potential markets in the region, and to establish contacts with potential local partners. At the trade show, Mobix comes into contact with Metro Singapore (“Metro”), a distributor of parts and accessories in Singapore and the region.

Actions taken

After learning of Mobix’s intention to enter the South-East Asian market, Metro expresses its interest in becoming Mobix’s local partner and promised to “take care” of the necessary in order for Mobix to seamlessly enter the Singapore market, before expanding into the region. Delighted, Mobix leaves some brochures of the products (with images of the product designs) that it intends to introduce to the respective local markets, and the two companies fix their next meeting in the near future to formally discuss the terms of their joint venture.

Outcome

Six months later, having obtained the necessary approval from the Board of Directors, Mobix is ready to enter into formal negotiations with Metro to set up the joint venture. However, Metro declines Mobix’s invitation to engage in formal negotiations, stating that it has entered into a joint venture with another reputable European parts manufacturer, given that Mobix had taken too long to come back with its proposal.

Disheartened by the news, Mobix nevertheless starts to look for another local partner. At the same time, Mobix’s Managing Director decides to register the designs of the parts and accessories that Mobix intends to bring to the Singapore market, having attended a talk on Intellectual Property Protection recently. As it turns out, very similar, if not identical, designs of said parts and accessories have been validly registered in Singapore in the name of Metro. Mobix is now faced with the threat of design infringement if it brings its products into Singapore.

Lessons Learned

- EU SMEs should apply for protection of industrial designs early, before others do so first and benefit from their creative efforts.
- When engaging in initial negotiations with potential local partners, EU SMEs should be vigilant and consider entering into non-disclosure agreements with such local partners, pending formalisation of the relationship between the parties subsequently.



7. Take Away Messages

- EU SMEs should consider using a combination of IPs to protect their technologies and products, including trade marks, patents, industrial designs and trade secrets. If possible, EU SMEs should apply for trade mark, design and patent protection even before entering the local markets. When cost is a major concern, EU SMEs should prioritise and register the more important IP rights first for the relevant countries, before applying to register the rest of the IP rights.
- EU SMEs should also actively monitor their IP rights and bring any infringing acts to the attention of the competent authorities (e.g. polices and customs in the respective local jurisdictions), for the latter to undertake the necessary actions (if the same are provided for under the local laws) to protect the interests of EU SMEs in cases of IP right infringement.
- In relation to automotive counterfeits specifically, EU SMEs should take practical measures such as employing the appropriate technology to fight counterfeits, and/or consulting with their local agents, distributors and suppliers to find out about the local conditions as well as to identify potential risks and how to counter them. EU SMEs should also be active in educating consumers about the distinctive qualities of their products, as well as the dangers of counterfeit products. This may be done through conducting campaigns, both online and off-line, to raise public awareness of EU SMEs' IP rights.
- Adopting a consistent and unique branding strategy may be extremely valuable, especially in the automotive industry, in order to differentiate EU SMEs from their competitors and establish reputation and goodwill in the market. This may serve the long term interest of EU SMEs, especially after patent protection for their inventions has lapsed.
- EU SMEs should remain vigilant in ensuring that their trade secrets are protected. This may increase their chances of making a successful claim for trade secret, as often one of the key conditions for the constitution of a trade secret are measures used to protect the confidentiality of the information.

8. Glossary of Terms

- **ASEAN** – The Association of South-East Asian Nations is a regional organisation comprising ten South-East Asian states which promotes intergovernmental cooperation and facilitates economic integration amongst its members. Since its formation on 8 August 1967 by Indonesia, Malaysia, the Philippines, Singapore, and Thailand, the organisation's membership has expanded to include Brunei, Cambodia, Laos, Myanmar, and Vietnam. Its principal aims include accelerating economic growth, social progress, and sociocultural evolution among its members, alongside the protection of regional stability and the provision of a mechanism for member countries to resolve differences peacefully.
- **Design** – External appearance/compositions of lines or colours or any three-dimensional forms which give a special appearance to a product.
- **Patent** – An exclusive right granted for a product or a process that provides a new way of doing something or offers a new technical solution to a problem.
- **Patent Assertion Entities** – This term generally refer to entities that obtain patents from third parties and seek to generate revenue by licensing them for inflated prices or asserting them against alleged infringers.
- **Trade mark** – A trade mark or service mark is a distinctive sign which identifies certain products or services as those produced or provided by a specific source/origin allowing the public to distinguish them from goods or services of others.
- **Trade secret** – Any confidential business information which provides an enterprise a competitive edge may be considered a trade secret.
- **Utility Models (Simple Patents)** – The conditions for the registration of utility models are usually less stringent, the procedure for registration is faster and acquisition and maintenance fees are generally lower than those applicable to standard patents.

9. Related links and additional information

- Visit our Guide on Protecting Your Trade Marks in South-East Asia - http://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/EN_TM.pdf
- Visit our Guide on Protecting Your Patents in South-East Asia - http://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/EN_patent.pdf
- Visit our Guide on Protecting Your Trade Secrets in South-East Asia - <http://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/Trade-Secrets-English.pdf>
- Visit the country factsheets of South-East Asia countries – <http://www.southeastasia-iprhelpdesk.eu/en/country-factsheets>
- Visit other publications at South-East Asia IPR SME Helpdesk website – www.ipr-hub.eu
- Visit the Helpdesk blog <http://www.yourIPinsider.eu> for related articles on IP in South-East Asia and China

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