Protecting Intellectual Property in Retail sector in South-East Asia

Waiting for the Organiser...

The webinar will begin shortly
Protecting Intellectual Property in Retail sector in South-East Asia

South-East Asia IPR SME Helpdesk

6 September 2019
Welcome to the Webinar

Moderator:

Doan Ngoc Phuong Trang
Project Assistant
South-East Asia IPR SME Helpdesk
Webinar Interaction Tools

- Hide control panel here
- Turn on full screen here
- Raise your hand here
- Send the IP expert a question here

Webinar 24 hour technical support number:
http://support.gotomeeting.com ‘Contact Us’ section

question@southeastasia-iprhelpdesk.eu
www.ipr-hub.eu

Agenda

(Brussels time zone)

• 10:00 – 10:10: Introduction to the Helpdesk and its services
  Nora Bihari, Project Manager

• 10:10 – 10:40: Intellectual property protection in retail sector in ASEAN
  Tran Manh Hung, BMVN International LLC,
  SEA IPR SME Helpdesk External Helpdesk
  ❑ An overview of ASEAN Economic Community (AEC)
  ❑ Trademark Prosecution in ASEAN
  ❑ Trademark Enforcement in ASEAN

• 10:40 - 10:55: Q&A
  Nora Bihari and Tran Manh Hung

• 10:55 - 11:00: Closing
  Nora Bihari, Project Manager
Core Services – What we offer

Enquiry Helpline

Webinars and E-learning modules

Website & Blog
Newsletter, E-Bulletin

Training Workshops

Guides and factsheets

Protecting Intellectual Property in Retail sector in South-East Asia

Tran Manh Hung
SEA IPR SME Helpdesk, External Expert
6 September 2019
Speaker’s bio

Name: Mr. Tran Manh Hung
Firm: BMVN International LLC –
      A member firm of Baker & McKenzie International
Location: Hanoi, Vietnam
Email: tmh@bmvn.com.vn

• Mr. Tran Manh Hung is the Director and Managing Partner of BMVN International LLC, a licensed law firm and IP agent, and is a member of Baker McKenzie.
• Mr. Tran has successfully represented some of the world’s largest multinational companies in both contentious and non-contentious aspects of IP law, including patents, designs, trademarks, copyright, unfair competition, anti-counterfeiting, anti-piracy, domain names, commercial IP involving franchising and licensing arrangements, trade secrets, and technology. Mr. Tran has also been called upon by the Vietnamese Government to review and help revise the country's IP Law and the Criminal Code's IP provisions.
• Mr. Tran was voted Vietnam Lawyer of the Year in the National poll of Vietnamese lawyers organized jointly by the Vietnam Lawyers’ Federation, the Ministry of Justice and Vietnam Law Magazine in 2009, has been ranked as the Strongly Recommended IP Lawyer by Global3000, and has received high recognition from Asialaw, and Managing IP Asia.
AN OVERVIEW OF ASEAN ECONOMIC COMMUNITY (AEC)
Poll question 1:

Have you registered your Trademark(s) in any South-East Asia countries?

A. Yes
B. No
Background

ASEAN Charter

ASEAN Political-Security Community

ASEAN Economic Community

ASEAN Socio-Cultural Community
4 Pillars of ASEAN Economic Community (AEC)

Increase Competitiveness
- Competitive policies
- Consumer protection
- IP rights
- Infrastructure Development
- Taxation and E-Commerce

Creation of a Single Market and Production Base
- Free flow of goods
- Free flow of services
- Free flow of investment
- Free flow of skilled labor
- Freer flow of capital

Promote Equitable Economic Development
- SME development
- Initiative for ASEAN Integration

Integrating ASEAN into Global Economy
- Coherent approach to external economic relations
- Enhanced participation in global supply network

SOUTH-EAST ASIA
IPR SME HELPDESK

ASEAN Intellectual Property Rights Action Plan

Singapore
- Has advanced registration and enforcement infrastructure
- Acceded and complied with all AEC treaty requirements
- Creation of IP Hub
- Offers tax incentives for IP Holding Co
- Less counterfeiting issues

Malaysia, Thailand, Brunei, Indonesia, Philippines, Vietnam
- Generally complied with TRIPs
- Enforcement options are available and relatively mature court system
- Need to comply with further obligations under AEC, e.g. accession to Madrid Protocol for Malaysia

Laos, Cambodia
- Relatively new IP regime and basic legal infrastructure in terms of protection and enforcement capacity

Myanmar
- Myanmar has passed new trademark, industrial design and patent law
- Current system will be replaced by a registration system once new laws are in place
- Enforcement through police action may be possible

SOUTH-EAST ASIA
IPR SME HELPDESK

ASEAN Treaties

ASEAN - China

ASEAN - Japan

ASEAN - Korea

ASEAN - India

ASEAN - Australia - New Zealand
TRADEMARK PROSECUTION IN THE ASEAN
Poll question 2:

What is your most concern regarding IPR when planning to do business in South-East Asia countries?

A. Counterfeiting products
B. Registration Time
C. Registration Cost
## TRADEMARK PROSECUTION IN THE ASEAN

### Overview – Subject-matters of IP rights

<table>
<thead>
<tr>
<th></th>
<th>Indonesia</th>
<th>Malaysia</th>
<th>Philippines</th>
<th>Singapore</th>
<th>Thailand</th>
<th>Vietnam</th>
<th>Myanmar</th>
<th>Laos</th>
<th>Cambodia</th>
<th>Brunei</th>
</tr>
</thead>
<tbody>
<tr>
<td>Copyright</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
</tr>
<tr>
<td>Related right</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
</tr>
<tr>
<td>Invention Patent</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
</tr>
<tr>
<td>(except for pharmaceutical patent)</td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>Utility model Patent</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
</tr>
<tr>
<td>Industrial design</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
</tr>
<tr>
<td>Trademark</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
</tr>
<tr>
<td>Trade name</td>
<td>✓</td>
<td>✓</td>
<td>✓ (considered as trademark)</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
</tr>
<tr>
<td>Geographical indication</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
</tr>
<tr>
<td>Layout designs of Integrated circuits</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
</tr>
<tr>
<td>Trade secret/Undisclosed Information</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
</tr>
<tr>
<td>Plant varieties</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
</tr>
</tbody>
</table>
### TRADEMARK PROSECUTION IN THE ASEAN

#### Legal Framework on Trademark

<table>
<thead>
<tr>
<th>Country</th>
<th>Law/Act Details</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Indonesia</strong></td>
<td>Law No. 20 of 2016 on Trademark</td>
</tr>
</tbody>
</table>
                       - Republic Act 623 (1951): Use of Duly Stamped and Marked Containers amended by R.A. 5700 |
| **Singapore** | Trade Marks Act (Chapter 332), revised in 2005                                   |
| **Thailand**  | Trademark Act B.E. 2534 amended by Trademark Acts B.E. 2543 and B.E. 2559         |
| **Myanmar**   | Trademark Law and Industrial Design Law 2019                                       |
| **Laos**      | Law on Intellectual Property No. 38/NA (2017)                                      |
| **Cambodia**  | Law Concerning Marks, Trade Names and Acts of Unfair Competition 2002              |
| **Brunei**    | Trade Marks Act, 2000 amended by Orders Nos. S 42/2014 and S 3/2017               |
Trademark rights are established on the basis of registration (except for well-known trademarks).

**Scope of protection:** Within the country where the mark is registered or granted of protection (if designated under international conventions).

**Term of trademark protection:** 10 years (renewable indefinitely).

Trademark rights can be assigned or licensed.

Trademark owners are obliged to use their registered marks during the course of trade in some countries (e.g. Singapore, Vietnam, the Philippines, etc.).

In these countries, the trademark registration may be subject to cancellation if the mark has not been used for a certain period (e.g. 3-5 consecutive years).
First to File and First to Use are legal principles to determine who would have the right to be granted registration among the similar trademarks.

**First to File**

- The trademark with **earlier filing date** will be granted registration.
- For some countries, **convention priority date** must be taken into consideration.
- This principle is usually **not absolute**. There are varying degrees of recognition of the goodwill built up by a prior creator and user of the brand (e.g. well-known marks).
- **Keywords**: filing date, priority date

**First to Use**

- The trademark **used earlier in commerce** will be granted registration.
- Evidences of **use/intention of use** must be submitted when filing the application.
- There are specific **limitations and conditions** regarding “first to use” rights, variable in each country.
- **Keyword**: use in commerce/in the course of trade
# TRADEMARK PROSECUTION IN THE ASEAN

## First to File vs First to Use

<table>
<thead>
<tr>
<th>Country</th>
<th>First to file or first to use?</th>
</tr>
</thead>
<tbody>
<tr>
<td>Brunei</td>
<td>First to file</td>
</tr>
<tr>
<td>Cambodia</td>
<td>First to file</td>
</tr>
<tr>
<td>Indonesia</td>
<td>First to file</td>
</tr>
<tr>
<td>Laos</td>
<td>First to file</td>
</tr>
<tr>
<td>Malaysia</td>
<td>First to use</td>
</tr>
<tr>
<td>Myanmar</td>
<td>First to file (under the new law)</td>
</tr>
<tr>
<td>The Philippines</td>
<td>First to file</td>
</tr>
<tr>
<td>Singapore</td>
<td>First to file</td>
</tr>
<tr>
<td>Thailand</td>
<td>First to file</td>
</tr>
<tr>
<td>Vietnam</td>
<td>First to file</td>
</tr>
<tr>
<td></td>
<td>Indonesia</td>
</tr>
<tr>
<td>---------------------------</td>
<td>-----------</td>
</tr>
<tr>
<td>Disclaimer practice?</td>
<td>x</td>
</tr>
<tr>
<td>Application for series mark accepted?</td>
<td>x</td>
</tr>
<tr>
<td>Addition of house marks to overcome trade mark objection?</td>
<td>x</td>
</tr>
<tr>
<td>Foreign language marks accepted for filing?</td>
<td>v</td>
</tr>
<tr>
<td>Mark filed in black and white protected in all colours?</td>
<td>x</td>
</tr>
<tr>
<td>Question</td>
<td>Indonesia</td>
</tr>
<tr>
<td>------------------------------------------------------------------------</td>
<td>-----------</td>
</tr>
<tr>
<td>Mark filed in block letters protected for all forms of stylization?</td>
<td>✗</td>
</tr>
<tr>
<td>Adopted Nice classification?</td>
<td>✓</td>
</tr>
<tr>
<td>Are charges imposed for each item of the specification of goods/services?</td>
<td>✗</td>
</tr>
<tr>
<td>Are well-known marks protected?</td>
<td>✓</td>
</tr>
<tr>
<td>Is it possible to obtain a declaration for a well-known mark?</td>
<td>✗</td>
</tr>
<tr>
<td>Are three-dimensional marks protectable?</td>
<td>✓</td>
</tr>
</tbody>
</table>
## TRADEMARK PROSECUTION IN THE ASEAN
### National Practices

<table>
<thead>
<tr>
<th>Feature</th>
<th>Indonesia</th>
<th>Malaysia</th>
<th>Philippines</th>
<th>Singapore</th>
<th>Thailand</th>
<th>Vietnam</th>
<th>Myanmar</th>
<th>Laos</th>
<th>Cambodia</th>
<th>Brunei</th>
</tr>
</thead>
<tbody>
<tr>
<td>Are colours protectable as trade marks?</td>
<td>✓</td>
<td>✓</td>
<td>✗</td>
<td>✓</td>
<td>✓ (combination)</td>
<td>✓</td>
<td>✗ (combination)</td>
<td>✓</td>
<td>✗ (combination)</td>
<td>✓</td>
</tr>
<tr>
<td>Are non-traditional marks protectable?</td>
<td>✓</td>
<td>✗</td>
<td>✗</td>
<td>✓</td>
<td>✓ (sound marks)</td>
<td>✗</td>
<td>✗</td>
<td>✗</td>
<td>✗</td>
<td>✗</td>
</tr>
<tr>
<td>Is online filing available?</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✗</td>
<td>✓</td>
<td>✓</td>
</tr>
<tr>
<td>Is online search available?</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓ (through WIPO's global brand database)</td>
<td>✗ (through WIPO's global brand database)</td>
<td>✓</td>
<td></td>
</tr>
<tr>
<td>Is expedited procedure available?</td>
<td>✗</td>
<td>✓</td>
<td>✓</td>
<td>✗</td>
<td>✗</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✗</td>
</tr>
<tr>
<td>Timeline from filing to registration</td>
<td>9-12 months</td>
<td>18 months</td>
<td>6-9 months</td>
<td>6-9 months</td>
<td>24 months</td>
<td>16-18 months</td>
<td>6-8 weeks</td>
<td>12-18 months</td>
<td>10-12 months</td>
<td>12-18 months</td>
</tr>
</tbody>
</table>
• What is the Madrid Protocol?

An international treaty, administered by the International Bureau of the World Intellectual Property Organization (WIPO). It provides a method of achieving expanded international protection for a trademark that has already been applied for or registered in the applicant’s country of origin.

• How it works:

The international application does not result in a single "international trademark" but instead in a bundle of national or regional trademark rights.

This bundle of rights is based on the acceptance of the request for extension of protection by each designated contracting party. The national/regional trademark office will review this request based on the respective local law.
TRADEMARK PROSECUTION IN THE ASEAN
International Trademark Registration – The Madrid Protocol

• Advantages:
  ❖ **Centralised filing procedures:** The applicant only has to file one application in one language, pay one fee. Any recordal of changes on the registration would take effect for several designated countries at the same time.
  ❖ Cancelled basic application can be transformed into national application.

• Disadvantages:
  ❖ **Dependency and Central Attack:** For the first 5 years from the date of international registration, anything which affects the basic application (e.g. refusal, limitation, cancellation) will have the same effect on the international registration and in turn, the trademark protection in each designated territory.
    Third-party may take advantage of this dependency and challenge the basic application → “central attack”.
  ❖ It can be difficult to fit the international registration into the unique prosecution practice of each local trademark office.
TRADEMARK PROSECUTION IN THE ASEAN
International Trademark Registration – Madrid System

• **Procedures:**

Source: WIPO

- **Stage 1:** Basic application/registration “Basic Mark”
  - Applicant
  - Office of Origin: Certifies the international application and forwards it to WIPO

- **Stage 2:** Formal examination; registers the mark in the International Register and publishes the international registration in the Gazette.
  - Issues a certificate of registration and notifies the designated Contracting Parties
  - WIPO

- **Stage 3:** Scope of protection of the international registration will be determined by substantive examination under domestic law, within 12/18 months
  - Office of the designated Contracting Party

• **In the ASEAN:** Most member states have acceded to the Madrid Protocol, except for Malaysia and Myanmar.

Source: WIPO
TRADEMARK PROSECUTION IN THE ASEAN
Trade Mark Filing Trends and Developments

- Protection of marks filed in block letters / black and white is not uniform across ASEAN countries.
- Charges for each item of goods may be imposed in some ASEAN countries.
- Protection of 3-D marks and color-only marks is not uniform.
- Be mindful of “first to file” countries to ensure filings are prioritized.
- Trademark filings will be allowed in Myanmar shortly.
- Malaysia’s new Trademark Bill 2019 was passed on 2 July 2019 and is expected to take effect soon.

The Bill reflects Malaysia’s accession to the Madrid Protocol and introduces certain new trademark prosecution regulations, e.g. protection of non-traditional marks, the calculation of filing date, etc.
TRADEMARK ENFORCEMENT IN THE ASEAN
TRADEMARK ENFORCEMENT IN THE ASEAN

Overview

• **Types of trademark infringements and violations:**
  - Unauthorized use of the mark in the course of trade;
  - Counterfeiting;
  - Passing-off;
  - Unfair Competition.

• **Main approaches to enforce trademark rights:**
  - Watch system
  - Demands or Negotiation
  - Self Protection
  - Enforcement Measures
  - Conducted by competent authorities

TRADEMARK ENFORCEMENT IN THE ASEAN
Watch System Example – Our Watch Service

1. Bi-weekly Online Searches
   - Revisit these websites to ensure that the infringing advertisements have been removed.

2. Bi-weekly report
   - For major websites identified above

3. Instructions from Client
   - Action will be taken upon receiving client’s instructions

4. Issuance of Cease and Desist Letter
   - If no action is taken by the infringer or web operator, further recommended action will be provided.

Master report capturing all cases to ease matter tracking
TRADEMARK ENFORCEMENT IN THE ASEAN

Enforcement Measures

**Civil action (litigation)**
- Actions filed in **court**.
- Usually used when IP owners seek **compensation** for the infringement committed by a third party.
- Civil actions are generally more **cost and effort intensive**.

**Criminal action**
- Usually applied when there is very **strong evidence of infringement** or as the last resort against **recurrent infringers** or when the infringement acts **do harm to the public**.
- Can be effective during negotiation or making infringers comply with demands.

**Administrative action**
- Conducted **ex-officio** or on claim basis by **administrative bodies**.
- Cost and time effective against **small and individual infringers**.

**Border measures**
- Conducted by **customs agencies**, affecting exported, imported and transited shipments.
- Effective against **cross-border illegal trade of counterfeits**.

---

## TRADEMARK ENFORCEMENT IN THE ASEAN

### Enforcement Measures

<table>
<thead>
<tr>
<th></th>
<th>Indonesia</th>
<th>Malaysia</th>
<th>Philippines</th>
<th>Singapore</th>
<th>Thailand</th>
<th>Vietnam</th>
<th>Myanmar</th>
<th>Laos</th>
<th>Cambodia</th>
<th>Brunei</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Civil action against infringement</strong></td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
</tr>
<tr>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td><strong>Injunction</strong></td>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td><strong>Civil action against passing off/unfair competition</strong></td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
</tr>
<tr>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td><strong>Injunction</strong></td>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td><strong>Criminal action</strong></td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
</tr>
<tr>
<td>(For all IP rights)</td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>(Copyright and Trademark)</td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>(Copyright and Trademark)</td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>(Copyright, trademark and patent infringement) Fine or imprisonment</td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>(Copyright and trademark)</td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>(Copyright and use of false trademark)</td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td><strong>Border control/Customs recordal</strong></td>
<td>✓</td>
<td>✗</td>
<td>✓</td>
<td>✗</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
</tr>
<tr>
<td>Monitor importations and transits of suspected counterfeits at the border gates in Vietnam.</td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td><strong>Administrative procedures</strong></td>
<td>✗</td>
<td>✓</td>
<td>✓</td>
<td>✗</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
</tr>
<tr>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td><strong>Safe harbours for online infringers/intermediaries</strong></td>
<td>***</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✗</td>
<td>✓</td>
<td>✗</td>
<td>✗</td>
<td>✗</td>
<td>✗</td>
</tr>
</tbody>
</table>

* Private prosecution is available
** Safe harbour provision is not regulated but is used in practice
*** Rarely recommended due to lack of experienced IP officers and uncertainty of outcomes
**** Trademark owners can file a request to temporarily suspend customs clearance of suspected goods and/or destroy counterfeit goods.
TRADEMARK ENFORCEMENT IN THE ASEAN
Trademark Enforcement Trends and Developments

- **Administrative measures** are **not** available in every ASEAN countries.
- All of ASEAN countries provide for **civil judicial procedures** against trademark infringements, yet, they are **not equally effective**.

In countries where **administrative measures** are available, they are often recommended over civil measures due to efficiency and effectiveness.

- **Criminal penalties** may be **ineffective** in some ASEAN countries due to ambiguous regulations and the courts’ lack of experience in dealing with trademark infringement cases.
- The traditional enforcement measures **are changing** in order to adapt with the commercial movement from physical marketplaces to **online/virtual marketplaces**. For example, the enforcement process now also involves online service providers (e.g. social media, e-commerce platforms).
Vietnam’s **new Amended IP Law** will take effect in November 2019. Under the Amended Law, **trademark use of authorized licensees** can also be considered the use of the right owners.

Under the current framework in **Vietnam**, customs agencies have the authority to apply **border measures** on **imported or transited shipments**. The laws are inconsistent in whether these agencies can take action against potential infringements of exportation.

This matter will be put under consideration during Vietnam’s compliance with **the CPTPP** in the future.

Notably, the same development is also expected in **Singapore**.

**Border measures**, including Customs Recordal, Customs Restraint and Customs Suspension have recently been available in **Indonesia** (since June 2018).

Yet, customs recordal applications can only be submitted by **Indonesian business entities**. Foreign right holders must request recordal applications through their **local subsidiaries**.
TRADEMARK ENFORCEMENT IN THE ASEAN

ASEAN Cooperation in IP Enforcement*

FRAMEWORK

• ASEAN Framework Agreement on Intellectual Property Cooperation 1995: the ASEAN Member States agreed to undertake cooperative activities, which shall include, *inter alia*, activities to enhance intellectual property enforcement and protection.

  Such activities include the: (a) effective protection and enforcement of intellectual property rights; (b) cross border measures cooperation; and (c) networking of judicial authorities and intellectual property enforcement agencies.

• The ASEAN Economic Community Blueprint (AEC Blueprint): emphasizes the principle that IP can influence both the volume and quality of external trade and investment, and the transfers of advanced, proprietary technologies, as well as being a major determinant of local value added and external competitiveness.

• The ASEAN IPR Enforcement Action Plan: seeks to foster the exchange of information and best practices among ASEAN Member States.

TRADEMARK ENFORCEMENT IN THE ASEAN

ASEAN Cooperation in IP Enforcement

A HOLISTIC APPROACH

Within the context of the principles embodied in the agreements adopted by ASEAN, the approach of the ASEAN IPR Enforcement Action Plan is four-fold:

- From the point of view of **CONSUMERS**, to raise awareness about IP rights and the dangers posed by counterfeit and pirated goods, aimed at fostering a social consciousness of rejecting counterfeit goods and substandard products;

- From the point of view of **IPR OWNERS**, to establish collaborative mechanisms with public officials and agencies towards effective apprehension, case build-up, prosecution, and prevention of the production, distribution, and transportation of pirated and counterfeit goods;

- From the point of view of **PUBLIC AUTHORITIES**, to strengthen the capacities of officials and government agencies to effectively investigate, prosecute and adjudicate cases of IPR violations;

- From the point of view of **ASEAN AS A REGION**, to establish institutional mechanisms and linkages for collaboration and information exchange among public authorities of each AMS, geared towards developing regional platforms for strategically curbing counterfeiting and piracy in the ASEAN, and to share best practices and benchmarks on effective enforcement policies and procedures.
Any Questions?
Thank you for your attention!
Stay connected!

News
Developments
Projects
Activities
Training materials

South-East Asia
IPR SME Helpdesk

@iprSEAsia
South-East Asia
IPR SME Helpdesk

www.ipr-hub.eu
www.yourIPinsider.eu
Channel: http://www.ipr-hub.eu/desk TV

An initiative of the European Commission