Enforcement in South-East Asia
an Overview

Waiting for the Organiser...

The webinar will begin shortly
Enforcement in South-East Asia
an Overview

South-east Asia IPR SME Helpdesk

17 April 2019
Welcome to the Webinar

Moderator:

HONG THI MY OANH
Project Assistant
South-east Asia IPR SME Helpdesk
Webinar Interaction Tools

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

(Brussels time zone)

• 11:00 – 11:20: Introduction to the Helpdesk and its services
  Enforcement options available in South-East Asia
  Marta Bettinazzi, IP Business Advisor

• 11:20 – 11:35: Introduction to IPKey SEA/ARISE+ IPR
  IP Enforcement Tools in the EU, can they be adapted to ASEAN?
  Tiago Guerreiro, Team Leader of IP Key SEA/ARISE+IPR

• 11:35 – 11:50: Case studies in IP enforcement in South-East Asia
  Take-away messages
  Chan Wai Yeng, External expert from SEA Helpdesk

• 11:50 – 11:55: Q&A

• 11:55 – 12:00: Closing
Enforcement in South-East Asia
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MARTA BETTINAZZI
IP Business Advisor at the South-East Asia IPR SME Helpdesk

17 April 2019
Core Services – What we offer

Enquiry Helpline

Website & Blog
Newsletter, E-Bulletin

Training Workshops

Webinars and E-learning modules

Guides and factsheets

SOUTH-EAST ASIA
IPR SME HELPDESK

Main problems in the region

Backdoor sales

Infringement by third party manufacturing

Infringement by potential partners

Import and sales counterfeits

Online infringements

Bad-faith registrations
Is it worth to register?

Yes!

Without registration no enforcement is possible.

Enforcement exists!

Companies have to learn how to play smart and protect themselves.
Play smart!

Identify your IP assets to protect

• Prioritize protection needs
• Assess vulnerability of your business asset

Sign NDA and NNN agreement with partners and employee

• Agreements can be enforced independently from the IP violations
• Trade secrets are a powerful tool

Monitor the Market for possible infringements

• Time is a key factor!

Choose the right form of enforcement

• Custom registration
• Cease and desist letter
Poll question 1:

Did you consider enforcing your IPRs in South-east Asia?

A. YES
B. NO
What do you need before enforcement?

Be sure you own the right

Make your own investigation and collect evidences

Notarization and Legalization of Documents

Request for a preliminary infringement assessment from IP legal service providers

ACT!

• Yes but how?
Enforcement option
Administrative action

AVAILABLE in: Brunei, Cambodia, Indonesia, Laos, Philippines, and Vietnam

- cost-effective and quick
- suitable for IP issues that may not be understandable or appreciated by the regular courts
- the reliefs include the grant of an injunction, an award for monetary damages and the disposal of the infringing goods

NOT Available in: Malaysia, Myanmar, Singapore and Thailand

- not to address the long-established or larger-volume infringers
- lack of sufficient resources (both financial and human)
- lack of training of the enforcement agencies
- no deterrent punishments imposed on infringers.

SOUTH-EAST ASIA
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Enforcement option
Civil procedure

Available in all countries

• suitable if commercial damage sought to be collected is substantial and the adverse party has the ability to compensate the IP
• reliefs include the grant of an injunction, an award for damages, and the disposal of the infringing goods

Cost and effort intensive

• not in all the counties the award for damages is high enough
• mostly worth for larger-scale infringers which have significant commercial operations
Enforcement option
Criminal action

Available in all countries
• used as a last resort
• criminal penalties involve the payment of a fine or imprisonment, or in some cases both

In some ASEAN country can be limited
• requires securing the necessary legal clearances to effect, such as a warrant
• intense legal work because it involves participation and coordination with law enforcement
• SMEs have to conduct some research and look for proofs
## Custom protection

<table>
<thead>
<tr>
<th>Ex officio or upon request</th>
<th>effective for counterfeit items that are already known to be sourced from outside the country or exported to another country</th>
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<tbody>
<tr>
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<td>customs measures are generally limited to the vigilance of border control law enforcement and only to counterfeit items</td>
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<td>It allows the seizure of bulk of products before they enter the market</td>
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<tr>
<td>IP recordal</td>
<td>Available only in certain countries (Myanmar, the Philippines, Thailand and Vietnam)</td>
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<tr>
<td></td>
<td>Only for the IPR registered in the country</td>
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Alternative dispute resolution

Lawyers’ communication:
• Cease and desist letters are good for most small infringements cases

Negotiations and Mediation:
• Good when the party foresee the possibility to still do business together

Arbitration:
• Involves a third independent party that act as arbiter
• Faster more transparent, than a traditional court.
• Good when an infringing product is being distributed in several countries because it would be possible to call the principal licensor to one arbitration.
Conclusions

Chose wisely

Know your IP

Know the enforcement options

2 EU COMPLEMENTARY ACTIONS ON IPR CURRENTLY ACTIVE IN THE SEA REGION:

**Objectives**
- To support FTA negotiations and further cooperation among EU & SEA stakeholders
- Engaged primarily at the national/bilateral level
- Includes other IPRs, such as patents, plant variety protection, copyrights and trade secrets

**Geographical Focus**
- Regional focus, in line with ASEAN objectives
- Oriented predominantly towards trademarks, GIs, and designs

**IPR Covered**
- To support ASEAN development objectives and regional integration
EU TOOLS AND DATABASES ON IPR ENFORCEMENT
The European Observatory on Infringements of Intellectual Property Rights

- Core element of Observatory Mandate - The development of tools and systems to gather, analyse, report and exchange key information on the scope, scale of, and trends in counterfeiting and piracy in the European Union.
- The tools are intended to help law enforcers and rights holders to step up the fight against counterfeiting and piracy.
- The Enforcement tools are free, multilingual and secure.
Enforcement Tools

**EDB**
Enforcement Database

Information on products that have been granted an IP right. Police and customs officials can access this tool to view information and product details, making it easier for them to identify counterfeits and take action.

**ACIST**
Anti-Counterfeiting Intelligence Support Tool

Gathers statistics on detentions of articles that are suspected of infringing IP at borders and in the internal markets; converts the collected data into a harmonised format.

**ACRIS**
Anti-Counterfeiting Rapid Intelligence System

Testimonies from EU companies affected by IP infringements in countries outside the EU and information on the respective follow-up of these cases by local authorities.
Poll question 2:

Have you ever used one of the enforcement tools?

A. Yes  The EDB
B. Yes  ACIST
C. Yes ACRIS
D. Yes more than one
E. No
The Enforcement Database (EDB)

A free of charge, secure, web based platform developed to help enforcement authorities to distinguish genuine goods from counterfeits.

BUILT UPON TMview AND DesignView


The Anti-Counterfeiting Intelligence Support Tool (ACIST) is the European Union database that gathers statistics on customs detentions, at borders and in the internal markets, of articles that are suspected of infringing intellectual property rights.

More information at: https://www.tmdn.org/enforcementintelligence-webapp/
ACRIS: COLLECTING TESTIMONIES OF IPR INFRINGEMENTS

What are the benefits of the tool?

• With ACRIS rights holders can report directly to the European Commission (DG Trade) on infringement issues in third countries.

• Infringement cases can be monitored throughout the enforcement cycle until the case is closed.

• Updates are also provided on upcoming European Commission IPR Dialogues with third countries.

More information at: https://www.tmdn.org/acris/
EU IP Enforcement Tools: Can They Be Adapted To ASEAN?
Under the ASEAN IPR Enforcement Action Plan, cite a need to introduce institutional mechanisms and information exchange among ASEAN public authorities.

- Dialogue needs to continue on a regional level on the steps that need to be taken to implement appropriate ASEAN enforcement tools.
- Dialogue needs to take place between different participants (IP Office, Customs, Enforcement Agencies) with regulations streamlined between all agencies.
Useful Links:

- https://ipkey.eu/en
- https://www.tmdn.org/network/

Any questions?

Please send an e-mail to: IPKEY-SEA@euipo.europa.eu
Case Studies of IP enforcement in South East Asia
Trade mark infringement / ‘passing off’ in Malaysia

DANONE BISCUITS MANUFACTURING (M) SDN BHD

HWA TAI INDUSTRIES BHD
Poll question 3:

Do you agree with the judgment? The two products were so similar to deceive or cause deception or confusion to a consumer of chocolate chip cookies?

A. YES
B. NO
Counterfeit contact lens offered for sale in Singapore
Take Away Messages

• Register your brands as trade marks in Southeast Asia

• A competitor’s brand does not have to be identical to infringe your trade mark

• Some countries provide a Common Law right of 'passing off’

• If left unchecked, inferior counterfeit goods can seriously damage the goodwill of your business.
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Comments?
Questions?
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