



ASEAN IPR SME Helpdesk Guide:

Protecting your IP at Trade Fairs in Southeast Asia

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1. **Protecting your IP at trade fairs**

Trade fairs provide intellectual property (IP) owners with the opportunity to present their innovations and ideas to potential business partners and customers and they allow them to learn from and collaborate with other innovators. There is, however, a risk, in that disclosing your innovations to the public leaves you exposed to third parties copying and infringing on your IP. When infringement is discussed in this guide, it is important to bear in mind that it may not be evident in the ‘counterfeiting’ sense, such as your entire product and brand being reproduced without authorisation. It is more likely that competitors could be using, intentionally or otherwise, a certain part of your product or innovation. It is therefore advised to be as diligent as possible and to know your competitor’s products almost as well as your own.

A practical and realistic approach must be taken when preparing for and attending trade fairs. IP owners must also be patient and pragmatic, as it is unlikely that immediate action can be taken against an infringer. There are, however, steps that IP owners can take before, during and after the event to best protect their IP.

2. **Advance planning**

When exhibiting at trade fairs, there are two very important factors to consider in relation to your IP: geography and timing. With a basic understanding of the types of IP that can be applied – and most importantly, where and how long it takes to protect that IP – SMEs can put themselves in a strong position to protect one of their most valuable assets.

The geographical issue

Standard advice from a specialised IP lawyer to an SME would be to protect your IP in your own local jurisdiction and also in foreign markets you are trading in. In relation to patents, designs and trade marks,

this means filing for registration. For copyright and trade secrets, this usually means ensuring you can prove ownership (in some countries it is possible to record these as proof).

Trade fairs are made up of local and foreign exhibitors and visitors. Therefore, when it comes to trade fairs, owners of IP, being the exhibitors, are opening up and disclosing their IP to a much wider audience. For example, if the trade fair is in Singapore but you know that the majority of the visitors are from China, then it will be important to explore protecting your IP in China, as well as in Singapore. Budget will be a consideration when SMEs decide where to file for protection, but it is strongly advised that if you are unsure, then a few hundred euros (perhaps more for a patent) to file a trade mark or design application is certainly worthwhile.

The timing issue

Patents can take over five years to obtain grant, or in some cases longer. Trade marks and designs can take 9-12 months and sometimes up to two years. This should not, however, dissuade an SME from applying for protection if the time leading up to the trade fair is insufficient to allow for the registration of your IP*.

Having a registered right puts the IP owner in the best position. Therefore, it is essential that if you are an innovative SME, you incorporate an IP protocol into your normal business operations. Such a protocol should regularly check for new IP and then consider whether and where to file for such new IP. This will help avoid situations, such as exhibiting at a trade fair, where you may realise you lack sufficient IP protection. However, even if you do not have time to obtain a registration, it is still important to file an application in the country of interest. Once the IP has been registered, it is then possible to take action against the infringer (for example, to obtain an injunction to immediately cease production or distribution of an infringing product, or to recover damages). It may also be possible to notify an infringer by referring to a pending application.

Preparing for the trade fair

When preparing your materials for the exhibition, it is wise to notify the public – where appropriate – of your IP ownership. This can be done by using the following symbols and phrases:

©	This can be combined with the year of creation or publication to assert copyright ownership in works such as brochures, websites, software, pictures, music, etc.
TM	If you have applied for a trade mark but it is not yet registered or even if you have not applied but are using the trade mark, the TM abbreviation can be used to assert your rights over the trade mark.
®	This symbol can only be used for registered trade marks. It can be a criminal offence to use this symbol if the trade mark is not registered (prosecutions are, however, very rare).
Patent Pending	If the patent application has been made but has not yet been granted, this phrase can be used.
Patent WO/12345678	Once the patent is granted, usually the patent number and jurisdiction are used to show where the patent has been issued.

It is a good idea to research the trade fair organiser’s material as much as possible. For example, it is worth taking the below steps in advance:

- i) Checking for an IP or business centre that may be able to provide assistance or advice during the trade fair and review carefully the terms and conditions of the trade fair.
- ii) Liaising with a local lawyer and providing that lawyer with a Power of Attorney (for example, three to four months in advance) and other proof of IP ownership so that legal action can be taken swiftly, if necessary.
- iii) Checking the list of exhibitors and making a note to check their stands.

* For more information on registration processes for all types of IP in Southeast Asia, visit the ASEAN IPR SME Helpdesk website www.asean-iprhelpdesk.eu or contact our confidential enquiry helpline at question@asean-iprhelpdesk.eu.

3. Attending the trade fair

Trade fairs can provide a genuine opportunity to learn about new innovations and to partner with potential businesses. Whether you are investigating such potential collaboration or gathering evidence of a possible infringement, it is vital to collect as much evidence and materials as possible, for example, business cards, photos, catalogues and brochures etc.

Disclosure of my IP – how much is too much?

An innovation without the means to manufacture and sell the product may well simply stay as an idea. Trade fairs present the IP owner with the opportunity to show their potential business partners their innovation. This can occur at various stages in the business's innovation process. Throughout the course of a year, you may attend three trade fairs, and at each one, your innovation could be at a different 'stage' of development. SMEs must therefore consider very carefully whether their innovation is ready to be disclosed to the public. Much of this will depend on commercial considerations such as whether you have a genuinely marketable product. A disclosure that is made too early may result in others seeing the nascent innovation and improving on it, before claiming that innovation as their own. This is a common practice and one that is usually legal.

Hopefully, the SME wishing to exhibit will have already applied for a patent or design covering their innovation. Once this has been applied for, the IP owner can exhibit without falling foul of one of the patentability requirements of 'novelty' (one requirement of filing for a patent is that the product has not yet been disclosed to the public). You can disclose certain elements of your inventions, but it is advisable to check with a patent lawyer or patent agent if you are uncertain if your exhibition may prevent you from obtaining a patent in the future. Some countries allow for a grace period for inventions that are disclosed at trade fairs, but not all. In relation to designs, it is very important to apply to register them prior to showing them to the public.

Visiting trade fairs – best practices summary

- a) Save or collect all trade fair material and exhibitor information.
- b) Take as many photos as you can.
- c) Gather as much technical data as possible about your competitors and their products.
- d) Do not threaten legal proceedings without the advice of a lawyer. Groundless threats could result in you being counter-sued.
- e) If you suspect an infringement, immediately seek competent advice.
- f) Involve the organisers of the trade fair if you believe it would assist your case.

4. Taking action against an infringer

As advised above, it is unlikely that immediate action can be taken at a trade fair, but in some emergency cases, it can be possible to bring administrative or criminal proceedings at short notice. Within Southeast Asia, each country will have its own remedies, and generally speaking, most countries will have a system to search and seize infringing goods – but there must be very strong evidence of infringement. In many countries, such as Thailand, Indonesia or Vietnam, in the case of patent infringement, the court, authorities or police may refuse to seize the goods, since there may be complex factual and legal issues involved. It is more likely that products infringing trade marks or copyright would be suitable for such an action.

However, trade fairs usually provide the opportunity for the IP owner to collect evidence of infringement. Such evidence may need to be notarised in order to be admissible in court (e.g. Vietnam). This can then be considered by the IP owner, after which, initial advice on infringement can be obtained. The IP owner can then decide whether to proceed with an enforcement action or not.

There are several enforcement options that are usually recommended:

- a) **A notification letter.** This letter simply provides the infringer with notice of your IP rights. You may wish to also include a statement that you would be willing to discuss the issue or license the IP to them. These are seen as a softer approach and are often used when there is not strong evidence of infringement. It may be possible to send such a letter on the letterhead of the IP owner (i.e., without instructing lawyers).
- b) **A ‘cease and desist’ letter.** This letter will usually threaten legal proceedings and demand that the infringer ceases and desists from infringing the IP in question. It is possible to ask for damages and legal costs in such letters. The letter may be accompanied by a form of settlement agreement known as ‘undertakings’ to contractually bind the infringer by the settlement terms. Usually lawyers are instructed to send these letters.
- c) **Raid or ‘search and seize’ actions.** These are usually done *ex parte* i.e., without informing the infringer, so as to take them by surprise. The procedure and relevant authority will be different in each Southeast Asian nation, but these raids can usually be organised with two to three days’ notice. If successful, the infringer will usually be charged with a criminal offence, so there must be evidence of criminal intention (such as counterfeit goods). More common however, would be a civil case, where the infringer is copying without criminal intention. Search and seize orders from courts in such cases across Southeast Asia are rare, but not unheard of. Local legal advice for this type of case is essential**.
- d) **Investigate the infringer.** It may be that the infringer is sourcing infringing materials from a larger supplier that may reside in another country. It may be that an investigation would help provide you with information about their customers and network. Your local lawyer or business partner may be able to assist with an investigation. There are investigation companies specialising in IP across Southeast Asia.
- e) **Issue legal proceedings.** This is often a last resort. Legal actions are not as costly in Southeast Asia as in Europe, but they are still a significant drain on resources, particularly for a SME. Both criminal and civil actions may be available to the IP owner for injunctions and damages. Awards from the court to recover legal costs are generally very rare in Southeast Asia. Local legal advice is essential.

- f) **Alternative dispute resolution.** Some countries in Southeast Asia will offer mediation or arbitration services which can be an efficient way of resolving certain IP disputes**. The arbitration services offered by the Singapore International Arbitration Centre (SIAC) are considered to be the most viable and mostly chosen option by the lawyers based in the region of Southeast Asia.

*** For more information on enforcement processes for all types of IP in Southeast Asia such as about enforcement authorities or mediation/arbitration services in specific ASEAN countries, contact our confidential enquiry helpline at question@asean-iprhelpdesk.eu, or visit the ASEAN IPR SME Helpdesk website www.asean-iprhelpdesk.eu.*

5. Identifying a business partner at trade fairs

Of course, the main reason why people attend trade fairs is to learn more about the industry and to find business partners with whom they can trade. From the perspective of protecting your IP, you will have already decided how much of your 'innovation' to disclose at the trade fair. Before conducting further business and disclosing more information – some of which may be confidential – you may consider requesting the other party to sign a Non-Disclosure Agreement (NDA). These are very simple and short legal contracts that help protect you from trade secret theft and they can help you demonstrate that you have not disclosed your full invention (for example, for the purposes of maintaining novelty for a patent application). Such agreements can be obtained relatively cheaply from a local lawyer and, generally speaking, can be re-used.

It will not be possible to conduct substantive due diligence at a trade fair and so it would be unwise to enter into large scale agreements without first checking on your potential partner. If the parties insist on some form of written record on which to base a future agreement, then a Memorandum of Understanding (MOU) could be entered into. Again, it would be advisable for all parties to sign up to a Non-Disclosure Agreement.

6. Take-away message

Trade fairs present huge opportunities for collaboration and progressive business, but at the same time, they present a degree of risk in relation to theft of IP or copying and consequent incremental innovation. With a robust and well-prepared approach to trade fairs, IP value can be maximised to the benefit of the IP owner.

More information on developing an IPR strategy in Southeast Asia and on how to secure your IP at trade fairs can be found on the ASEAN IPR SME Helpdesk website: www.asean-iprhelpdesk.eu; or by contacting the Helpdesk confidential enquiry service: question@asean-iprhelpdesk.eu.

7. SME case study

A British industrial cleaning company is looking at selling into the Southeast Asian market. It has no previous sales experience in the region, but its managing director has attended a few trade fairs in Singapore and Kuala Lumpur in the past year. As an innovative business, the company has quite a robust patenting strategy and, as such, has applied for an international patent (through the Patent Cooperation Treaty – PCT – but it should be noted that this was a few years ago and so only Singapore and Vietnam have been designated). The company only has a trade mark registration in Europe (in the form of a

Community Trade Mark).

The company's managing director will exhibit its newest technology (covered in their PCT patent application) in Singapore in six months' time, as two orders have already been placed by a Singaporean distribution company. At the trade fair, the company finds a small distributor using a name almost identical to the name covered by its European registered trade mark. This party appears to have links to China and all of its exhibitor material is in the Chinese language.

ASEAN IPR SME Helpdesk advice and considerations

- a) File a trade mark application in Singapore. The distribution company that has ordered goods from the European company will need to use, to some extent, the trade mark to promote the goods. This must be controlled through use of a distribution agreement, which will also license the use of the trade mark to the distributor. Without a trade mark registration, there would be nothing to stop the distributor or a third party (for example, a trade fair visitor) from applying for the trade mark.
- b) The Singaporean trade mark registration could form the basis of the company taking action against the smaller distributor that is using a similar trade mark. Also consider filing a trade mark in China.
- c) Take care when discussing business with parties from countries in which you do not have patent protection. Whilst there is nothing you can do to stop such a company from reverse-engineering the product, clearly, it would be more effective to simply not sell the product to such a party in the first place.
- d) If the distribution deal will cover other Southeast Asia countries, consider filing your trade mark in key jurisdictions in the region, including China.
- e) Use the trade fair to gather information about your competitors. If you can improve on your own technology (and, of course, on the technology of other exhibitors) the 'new' jurisdictions in Southeast Asia (and China) should be incorporated into your patenting strategies going forward.

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