



# How to record Trade Marks with Customs

## 1. Overview: Functions of Customs

The responsibilities of customs vary from country to country, and are often the subject of regular review and modification to ensure their ongoing relevance in a constantly changing world.

Traditionally, the customs' role has been one of a "gatekeeper", with customs authorities representing a barrier through which international trade must pass, in an effort to protect the interests of the nation. Customs has been responsible for implementing a wide range of government policies, spanning areas as diverse as revenue collection, trade compliance and facilitation, interdiction of prohibited substances, protection of cultural heritage and enforcement of intellectual property laws.

In recent years, due to the increase of trans-border trades, the customs' role in curtailing infringing products has become increasingly important. Each country's customs administrations are conferred with specific administrative measures to help them deal with counterfeit or infringing products. It bears stressing, however, that customs do not decide on the infringement of intellectual property rights (IPR), a power generally attributed to courts. Customs intervention is, therefore, aimed at being triggered when goods being transborderly moved are on suspicion of infringing IPR so that, when the infringement is established, they can be destroyed and removed from the supply chain.

## 2. How can Customs help in protecting IP?

Customs have a key role in enforcing intellectual property rights at the border. When goods are internationally traded, they

have to pass through the customs to leave a country and enter another. Thus, border measures is a useful tool in dealing with the international trade of counterfeit or infringing products.

Border measures can be understood as those actions taken by the local custom authorities regarding goods under their control, in particular, but not exclusively, at the exit and at the entrance of goods into the internal (national or economically integrated) market. In this regard, it has to be acknowledged that the final destination of goods going through customs may not always be the national-internal market. There are different possible custom situations and procedures such as importation, exportation, re-exportation, placement under a suspensive procedure or mere control. Either way, border measures constitute an effective way to counter acts of infringement, because it is frequently easier to prevent the distribution of counterfeit or infringing products at the border rather than after they have already been brought into or out of the country and put into circulation.

EU SMEs shall become more aware of the role of customs in South-East Asia and how it can be a helpful authority in helping protecting IPR and combating infringements.

## 3. Why do you need to record your trade marks with Customs?

Some countries provide a trade mark recordation system with customs. Recording one's trade marks allows customs to monitor shipments and exclude, detain and/or seize merchandise that it suspects is counterfeit or infringing the recorded mark.

Generally, recording trade mark with

1. Overview: Functions of Customs
2. How can Customs help in protecting IP?
3. Why do you need to record your trade marks with Customs?
4. How to record your trade marks with Customs in South-East Asia?
5. Case studies
6. Take-away messages
7. Related links and additional information



For free, confidential, business-focused IPR advice within three working days E-mail: [question@southeastasia-iprhelpdesk.eu](mailto:question@southeastasia-iprhelpdesk.eu)

Co-funded by:



European Union

customs is straightforward and inexpensive. Thus, it can be a quick and cost-effective method of preventive enforcement of a trade mark owner's rights for EU SMEs trading in South-East Asia. However, each trade mark recorded must be constructed carefully to avoid the accidental seizure of the owner's own goods or the goods of an authorised licensee or distributor. Recordal with customs is available for valid registration in the country of reference, therefore, EU SMEs will need to have a trade mark registered in that country to be able to perform the recordal with the competent customs.

### 4. How to record trade marks with Customs in South-East Asia?

The Philippines, Thailand, and Vietnam currently accepts recording of trade marks at their customs, while variations of notifications to the customs are available for the rest of the South-East Asia countries. Other countries, not having an expressly trade mark recordation system, can still help to monitor infringing goods.

Please see below useful information in relation to each of the ten country of South-East Asia.

#### 4.1. Brunei

Brunei does not have a trade mark recordation system. However, Brunei's Royal Customs and Excise (Brunei's customs authority) continues to monitor all goods entering and leaving Brunei.

Under the Trade Mark Law of Brunei, trade mark owners or the local licensee may, at no cost, give written notice to the Controller of Customs requesting the customs authorities to detain infringing goods that may come under customs control. Such notice shall only be in force for no longer than five (5) years.

*The notice from the trade mark proprietor or the local licensee should contain at least:*

- a. A claim stating trade mark proprietorship or, as the case may be, a licensing of such trade mark registered in respect of the goods specified in the notice; and
- b. A request to the Customs to detain any infringing goods that are or at any time come under customs control.

The customs authorities will subsequently notify the trade mark proprietor whether the notice has been accepted or declined.

#### CONTACT DETAILS

Royal Customs and Excise Department  
Ministry of Finance  
Jalan Menteri Besar  
Berakas BB3910  
Negara Brunei Darussalam  
Tel : +673-2382333  
Fax : +673-2382666  
E-mail : [info@customs.mof.gov.bn](mailto:info@customs.mof.gov.bn)

For more information about IPR in Brunei, please refer to our Brunei Factsheet at [http://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/Brunei\\_factsheet.pdf](http://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/Brunei_factsheet.pdf)

#### 4.2. Cambodia

Cambodia does not have a trade mark recordation system. However, trade mark owners can file a request to temporarily suspend customs clearance and destroy counterfeit goods if the case.

*An application for suspension of customs clearance should be submitted to the customs authority and must contain:*

- a. A statement showing prima facie evidence (evidence which supports the claim) of counterfeit;
- b. A description of the goods;
- c. Proof of trade mark registration; and
- d. Information relating to the applicant.

There is no fixed official cost to file the request, but customs authorities may require the applicant to pay a security deposit or provide other assurance for the suspension.

The customs authorities must notify the applicant within ten (10) working days from the submission of the request if the application has been granted, rejected or reserved for further consideration.

Upon acceptance, the customs authorities will suspend clearance of the goods for a defined period and this period may not be extended for more than ten (10) working days. Moreover, if the applicant wishes to destroy the counterfeit goods, civil court proceedings must be initiated within ten working days of suspension of the goods because the customs authorities may only destroy counterfeit goods with a court's approval. The customs authority will release the goods if the applicant does not initiate court proceedings.

#### CONTACT DETAILS

General Department of Customs and Excise of Cambodia  
N°: 6-8, Preah Norodom Blvd., Sangkat Phsar Thmei III, Khan Daun Penh, Phnom Penh, Cambodia.  
Tel : +855 23214065  
Fax : +855 23214065  
E-mail : [info-pru@customs.gov.kh](mailto:info-pru@customs.gov.kh)

For more information about IPR in Cambodia, please refer to our Cambodia Factsheet at [http://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/Cambodia\\_Factsheet.pdf](http://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/Cambodia_Factsheet.pdf)

#### 4.3. Indonesia

Indonesia's Custom Law does not provide a trade mark recordation system.

Under Article 62 of Customs Law No. 10 of 1995 (as amended in 1996), Customs Official, in his official capacity, may detain imported or exported goods if there is strong evidence that such goods violate trademark rights or copyrights. In order to preserve the temporary detention, IP holders must file a full civil action for infringement.

In 2012, the Supreme Court issued Regulation No. 4 regulating the requirements and procedures for the suspension of the release of the imported or exported counterfeit trade mark or pirated copyright goods by the customs authorities. Under this Regulation, the IPR holder may request a Temporary Suspension Order from the Commercial Court to temporarily suspend the release of suspected infringing goods.

*The requirements to conduct an impound of counterfeit goods:*

- a. The copyright or trademark ownership evidence;
- b. Supplementary evidence which shows the indication of the copyright or trademark infringement;
- c. Description of suspension requested goods, namely: bill of lading, airway bill, ship number, classification and amount of goods, original port/harbour, original country;
- d. Pay the warranty in the form of cash or bank guarantee equivalent with the amount of suspended goods, including the fees incurred due to temporary suspension; and
- e. Pay the fees arose from the estimation of warehouse rent, demurrage, freight expenses.

The period of suspension is ten working days, extendable for another ten working days if an additional warrant is obtained from the Commercial Court. During this time, the IP holder must notify the customs official of any legal action taken in order to maintain your rights - otherwise, the customs official may terminate the suspension of goods.

*In addition, the Supreme Court issued its Regulation No. 5 of 2012 which regulates the request for Temporary Injunction. Temporary injunction is an instruction issued by the Court that should be binding for all relevant parties based on the request of the applicant against an Intellectual Property Rights violation on Industrial Design, Patent, Trademark, and Copyrights to:*

- a. Prevent imported goods, which presumed as the infringement goods that against intellectual property rights violations.
- b. Protect and prevent the evidence elimination by the suspected/offender.
- c. Stop the infringement to prevent the greater losses.

*The applicant (the IPR holder) can request the temporary injunction by completing the requirements as below:*

- a. Intellectual Property Rights ownership evidence;
- b. Evidence that proves there is a strong indication of intellectual property right's infringement;
- c. Clear description regarding the goods/documents, which will be requested, sought, collected and protected for the evidentiary purposes;
- d. Pay warranty in the form of cash or bank guarantee equivalent with the amount of suspended goods.

#### CONTACT DETAILS

Indonesian Customs and Excise  
Ministry of Finance  
Jl. Ahmad Yani By Pass - Rawamangun, Jakarta Timur  
Jakarta - 13230  
Phone: 1500225 (08.00 to 16.00 Western Indonesian Time)  
Email: [info@customs.go.id](mailto:info@customs.go.id)

For more information about IPR in Indonesia, please refer to our Indonesia Factsheet at [http://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/Indonesia\\_factsheet.pdf](http://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/Indonesia_factsheet.pdf)

#### 4.4. Lao PDR

Lao PDR does not have a formal trade mark recordation system. However, if the trade mark owner is aware of a shipment containing counterfeit goods, he or she may inform

customs and file a motion to initiate actions for suspension of customs clearance of suspicious counterfeit goods by submitting an application form provided by customs and pay a bond or deposit.

Customs may maintain the suspension for ten (10) working days.

However, suspension may continue if the applicant has provided evidence that judicial action has been initiated. The applicant must initiate judicial action with the Court against the owner of the allegedly infringing goods within ten (10) working days upon receipt of the notice of suspension. Failure to initiate judicial action within the statutory time entitles the customs officer to release the goods immediately and to enforce the applicant to compensate for damages suffered by the owner of the goods.

*The IPR holder must provide the following documents prior to inspection and suspension:*

- a. A motion for inspection and suspension using the standard form issued by the Customs Department;
- b. Evidence of relevant IPRs and adequate evidence of prima facie infringement of such rights in compliance with the IP Law;
- c. The names of the relevant checkpoint(s) or place(s) where goods will be imported or exported;
- d. A detailed description of the goods sufficient enough to make them readily recognizable by the customs officer;
- e. Any other information (if any) such as photos of infringing goods or details of importer or exporter as information for customs officers;
- f. A security deposit of LAK 10,000,000 (approximately EUR 1,000) deposited in cash, by check or by a bank guarantee;
- g. An execution of a guarantee for covering any expenses of customs authorities which may arise from the requested suspension; and
- h. A receipt of payment of the security deposit.

In case of an emergency where the filing of a written application is impossible, the right holder may verbally request the customs authority to take actions.

#### CONTACT DETAILS

Customs Department  
Ministry of Finance  
Lane Xang Avenue  
Vientiane  
Lao PDR  
Tel: +856 21 213810, 223520, 2235224

For more information about IPR in Lao PDR, please refer to our Lao PDR Factsheet at [http://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/Laos\\_Factsheet.pdf](http://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/Laos_Factsheet.pdf)

#### 4.5. Malaysia

There is no recordal system of registered trade marks with the Royal Malaysian Customs (RMC) in Malaysia. Whilst the RMC has no power to conduct any enforcement action at the border, they can detain containers that are suspected to contain counterfeit products. They will then alert the Ministry of Domestic Trade, Cooperatives and Consumerism (MDTCC), which will then exercise its powers and carry out further action.

The Trade Marks Act of 1976 provides power to the RMC to act in an ex-officio capacity under provisions relating to border measures and includes provisions under Section 70D relating to applications to restrict importation of counterfeit trade mark goods.

*Under Section 70D of the Trade Marks Act of 1976, any IPR holder may file an application with the Registrar of Trade Marks to restrict importation of counterfeit trademarks goods by submitting:*

- a. details of the applicant which should be the proprietor of the registered mark or an agent of the proprietor having the power to submit such application;
- b. details of the registered mark;
- c. details of the importer; and
- d. time and place, goods which, in relation to the registered trade mark, are counterfeit trade mark goods are expected to be imported for the purpose of trade.

The application should be made on Form TM 30 (link) and be supported by such documents and information relating to the goods as to enable them to be identified by the customs officer, and accompanied by the official fee of RM 330 (manual submission).

Upon receipt of the application, the Registrar will within a reasonable period inform the applicant whether the application has been approved. Such approval will remain in force until the end of the period of sixty (60) days commencing on the day on which the approval was given, unless it is withdrawn before the end of that period by the applicant by giving a notice in writing to the Registrar.

Upon giving his approval, the Registrar shall immediately take the necessary measures to notify the authorised officer, either a proper customs officer or authorized public officer, and the latter shall take the necessary action to prohibit any person from importing goods identified in the notice, not being goods in transit, and shall seize and detain the identified goods.

However, to the best of our knowledge, we have not seen any cases taken under this provision, as certain requirements and information must be provided i.e. description of infringing goods, date, time and port of arrival in Malaysia, which can be difficult to accurately provide.

### CONTACT DETAILS

Intellectual Property Corporation of Malaysia (MyIPO)  
Unit 1-7, Aras Bawah, Tower B, Menara UOA Bangsar  
No. 5, Jalan Bangsar Utama 1,  
59000 Kuala Lumpur  
Malaysia  
Tel: + 6082-459 075

Customs Department,  
Ministry of Finance Complex No. 3,  
Persiaran Perdana,  
Precinct 2,  
62596 Putrajaya  
Tel: 1300 888 500  
Email: [ccc@customs.gov.my](mailto:ccc@customs.gov.my)

For more information about IPR in Malaysia, please refer to our Malaysia Factsheet at [http://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/Malaysia\\_factsheet.pdf](http://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/Malaysia_factsheet.pdf).

## 4.6. Myanmar

Myanmar Customs Department provides a recordal system for trade marks upon application of the trade mark owner. Goods bearing the recorded trade mark imported by any party other than the local company granted with sole distributorship will be detained at customs.

In addition, the IPR holder may inform the customs of suspected importation of infringing goods by notifying Customs when he/she is aware of specific import of counterfeits for Customs to take action.

*The requirements and procedures for voluntary recordal are as follows:*

- a. Application letter from the right holder or the authorised agent (law firm) addressed to the Director General, Myanmar Customs Department, Yangon;
- b. Contract between local company (authorized sole distributorship) and the right holder;
- c. Authorisation letter of sole distributorship to the local company from the right holder (legalised and notarised at the nearest Myanmar embassy from the country of the right holder);
- d. Trade mark sample;
- e. Registered declaration of the ownership of trade mark in Myanmar;
- f. Publication of cautionary notices in the newspaper;
- g. Power of attorney from right holder to law firm ( legalised and notarised at the nearest Myanmar embassy); and
- h. Description of product.

The application should be delivered to the Dispatch Unit of customs. The application will be forwarded from the Director General to the Director of Import/ Export to the Staff Officer who will review the application.

Upon successful application, a notification of the protection from the importation of counterfeited goods will be issued to the applicant.

If all required information/ documentatio have been provided, the application will be processed within one-two (1 – 2) weeks. Also, the recordal application does not involve any fee. However, the application has to be affixed with a 1,000 MMK (approximately EUR 0.70) stamp.

To our knowledge, the officers strictly require all documents listed above to approve the application and have rejected applications where item b) had been omitted due to sensitive commercial details included in the document.

### CONTACT DETAILS

Myanmar Customs Department  
No.132, Strand Road, Kyauktada Township, Yangon City,  
Myanmar.  
Tel: 951-391435, Ext 150  
Email: [mcd.ygn@mptmail.net.mm](mailto:mcd.ygn@mptmail.net.mm)

For more information about IPR in Myanmar, please refer to our Myanmar Factsheet at [http://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/Myanmar\\_Factsheet.pdf](http://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/Myanmar_Factsheet.pdf)

## 4.7. Philippines

In the Philippines, a recordal system for trade marks in the

Bureau of Customs (BOC) is in place.

*An IPR holder, or his agent, may apply with the BOC for the recording of his IPR and the the product(s) covered by such right(s) upon the submission of the following requirements:*

- a. An affidavit attesting that the applicant is the rightful owner of the IPR sought to be recorded, or in case of a representative or an agent, that he is duly authorised by the IPR Holder/ Owner to make the application.
  - In the case of IPR registered with the Intellectual Property Office of the Philippines (“IPOPPL”), three certified true copies of the Certificate of Registration issued by the said office.
  - In the case of IPR not registered with the IPOPPL, three certified true copies of a decision or resolution of a court or other competent authority declaring or recognizing the claim to an IPR.
- b. Payment of recordation fee of PhP 2,000 (approximately EUR 39) per product but in no case to exceed PhP 20,000.00 (approximately EUR 385) per IPR Holder/ Owner.

The foregoing documentary requirements are solely for the purpose of identifying the IPR holder and providing the Bureau with minimum information that will help its officers in effectively monitoring and evaluating infringing goods at the border. Such requirements therefore may in certain meritorious circumstances be liberalised for as long as the basic purposes for which the above requirements are imposed are achieved. The IPR holder or his representative shall be notified of the time and place of examination.

The recordation of IPRs and product or products covered therein shall be valid for two years from date of the recording and renewable every two years thereafter.

On the basis of the recordation, the Bureau shall monitor and inspect on its own initiative suspect imports to determine whether or not they are liable to seizure and forfeiture pursuant to law and existing rules and regulations.

In the event that the IPR holder or his duly designated agent has not recorded his IPR and the product or products protected thereunder, he may request the Commissioner of Customs or the District Collector of Customs concerned in case of ports of entry outside of Metro Manila (outports) to issue an alert or hold order against any importation suspected to contain infringing goods upon submission of the above-mentioned documents.

#### CONTACT DETAILS

Bureau of Customs  
Customer Assistance & Response Service (BOC-Cares)  
Tel: (02) 705-6000  
Email: [boc.cares@customs.gov.ph](mailto:boc.cares@customs.gov.ph)

For more information about IPR in the Philippines, please refer to our Philippines Factsheet at [http://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/Philippines\\_factsheet.pdf](http://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/Philippines_factsheet.pdf).

#### 4.8. Singapore

Singapore does not have a trade mark recordation system with its customs administrations. However, Singapore Customs, together with the Immigration and Checkpoints

Authority (ICA) whose officers are vested with the powers of Customs officers, is responsible for border enforcement.

Previously, Singapore Customs’ responsibilities on IPR border enforcement were in respect of the importation of goods infringing copyrights and trademarks into Singapore for local consumption, via a lodgement of notice system.

In 2004, the Border Enforcement Measures of the Trade Marks Act and the Copyright Act were enhanced to include ex-officio border enforcement action on imports, exports and re-exports (transshipment with local consignee). Both the lodgement of notice system and the ex-officio system now run concurrently.

Under the lodgement of notice system, the rights owner is required to lodge a complaint to Singapore Customs about a particular shipment before the border authorities detain the shipment at the border.

*The IPR holder may simply initiate communication with the Customs about suspected import of infringing goods by providing:*

- a. Details of the suspected infringer;
- b. Details of IPR holder;
- c. Details relating to the import of infringing products
- d. A fee of Singapore Dollars 200 (approximately EUR 125 ); and
- e. Details of to IPR holder’s registered trade mark in Singapore

to [customs\\_intelligence@customs.gov.sg](mailto:customs_intelligence@customs.gov.sg) or calling their reporting hotline at 1800-2330-000. The officer attending to the request will review the details and within a reasonable period inform the applicant whether the application has been approved or request for further information from the applicant to approve the request.

Under the *ex-officio* approach, border authorities can detain suspected IPR-infringing items without the need for any formal complaint. Any appropriate officer of Customs or authorised officer may exercise his power to detain goods that he reasonably suspects are infringing a registered trade mark. The goods may be imported into or exported from Singapore or are goods in transit that are consigned to a person with a commercial or physical presence in Singapore. Such authorised officer also has a wide power to examine any goods, including goods in transit, which he reasonably suspects are counterfeit goods in relation to a registered trade mark.

#### CONTACT DETAILS

Singapore Customs  
55 Newton Road #10-01  
Revenue House  
Singapore 307987  
Fax: (65) 6250 8663

For more information about IPR in Singapore, please refer to our Singapore Factsheet at [http://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/Singapore\\_Factsheet.pdf](http://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/Singapore_Factsheet.pdf).

#### 4.9. Thailand

Thailand provides a trade mark recordation system with Department of Intellectual Property (DIP).

In the past, trade mark owners are allowed to record their

trademarks with the Royal Thai Customs Department. Upon recordation, Customs will directly monitor and make the mark's detailed information as well as the name of its authorized importer available in their internal system, so that these information can be easily retrieved when they encounter goods which they suspect are infringing the recorded trade mark.

However, the new system under the Intellectual Property Rights Coordination Center (IPR Center) requires trade mark owners to act in accordance with the regulation concerning the importation and exportation of goods into and out of Thailand, and trade mark owners who would like Customs to continue monitoring their trade marks must file for recordation with the DIP. As a result, trade mark owners must now only submit an application for recordation to the competent authorities at the DIP, and the trade mark registrar must be notified of the trade mark owner's request to prohibit the importation/ exportation of products bearing a counterfeit mark.

*A trade mark owner must submit the following documentary evidence together with the application:*

- a. a certified copy of the trade mark registration certificate or certified copy of the trade mark registration official record, which can be obtained from the DIP;
- b. an original/ certified true copy of the power of attorney, when authorizing a person to act on behalf of the trade mark owner;
- c. an original/ certified true copy of the juristic person certificate, issued not more than 6 months from the date of issuance of the certificate, when the owner of the trade mark is a juristic person;
- d. a letter of consent to bear liability from the trade mark owner assuming responsibility for any damages that may arise due to the application for protection; and
- e. a sample of the actual trade mark label used with the trade mark owner's product.

If a non-domiciliary of Thailand owns the mark and seeks protection he/she must have an office in Thailand to provide a local contact for the Registrar.

Please note that no official fee is charged for the recordation of trademarks in Thailand.

Following submission of the above-mentioned documentary evidence to the Registrar, the request and all supporting documents will finally be provided to the Customs for its records and follow up. The entire process of recordation will take around twenty (20) to thirty (30) days to complete.

In addition, the IPR Center has developed a new software program to facilitate the filings of the recordation with the DIP. Such program will contain up-to-date contact details of trademark owners and their representatives, and information on trademarks including their validity and lists of goods. These information will be stored in the database of the program and accessible to Customs officers throughout Thailand. Thus, when a custom officer finds suspected infringing goods bearing a trade mark recorded through the recordation procedure at the DIP, Customs will contact the trade mark owner or his or her representative.

### CONTACT DETAILS

Department of Intellectual Property  
563 Nonthaburi 1Rd., Bangkrasor, Muang Nonthaburi 11000 Thailand

Tel: (66 2) 547 46 21 to 5; (66 2) 547 46 52  
Email: [nuntawans@moc.go.th](mailto:nuntawans@moc.go.th)

The Customs Department  
1 Sunthornkosa Road, Klong Toey, Bangkok, 10110, THAILAND  
Tel: 02 667 6000/ 02 667 7000  
Email: [customs\\_clinic@customs.go.th](mailto:customs_clinic@customs.go.th)

For more information about IPR in Thailand, please refer to our Thailand Factsheet at [http://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/Thailand\\_factsheet.pdf](http://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/Thailand_factsheet.pdf).

### 4.10. Vietnam

*Under the Ministry of Finance's Circular 13/2015/TT-BTC, trade mark owners can now file a request with the Customs Control and Supervision Department to monitor trade mark-protected goods at ports of entry. An application must be filed to request the monitoring and detection of the infringing goods. Particularly, an application must be filed with the Customs Control and Supervision Department in Vietnamese together with the following documents:*

- a. Certified copies of your IP certificates of registration, e.g. a trade mark registration certificate;
- b. Documents relevant to the goods you wish to register with customs, including; a list of authorised importers/exporters, mode of import/export of genuine goods, descriptions of how to distinguish genuine goods from infringing copies, documents on the origin of genuine goods, and pictures of genuine goods;
- c. A notarized and legalized power of attorney, where the application is filed by a local IP agent; and
- d. Any supporting documents, e.g. information on estimated times and location of import and export, expert opinions on known infringing goods, any sanctioning decisions made by enforcement agencies in previous cases of infringement of the goods you are registering, where applicable.

Confirmation is usually given by the customs office within twenty (20) days of application. Also, there is no official fee for filing the request for recordal.

Once recorded, the customs will notify the trade mark owners upon the discovery of nay goods suspected of infringing their rights. The recordal form is valid for two (2) years, with the option to renew for another two (2) years.

### CONTACT DETAILS

General Department of Vietnam Customs  
Area E, Duong Dinh Nghe Street, Cau Giay District, Hanoi, Vietnam  
Tel: 00844 44520606 - ext. 8624  
Email: [webmaster@customs.gov.vn](mailto:webmaster@customs.gov.vn)

Additionally, if you know of a suspected illegal shipment of your products you can also work together with Vietnamese customs to detain such shipments.

Vietnamese IP right holders may file the request with the General Department of Customs directly. Foreign IP right holders must file the request via an IP Agent.

For more information about IPR in Vietnam, please refer to our Vietnam Factsheet at [http://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/Vietnam\\_Factsheet.pdf](http://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/Vietnam_Factsheet.pdf).

## 5. Case studies

### Case study 1: Seizures of Counterfeit Goods by Singapore Customs

#### *Background:*

In late March and early April 2013, Singapore Customs received two lodgements of notice from a brand owner on two containers arriving from China to Singapore. The brand owner believed the containers contained items which infringed their trade marks.

Acting on the information, Customs officers inspected two 40-footer containers which were consigned to a local company on 2 and 4 April 2013. Instead of "household goods", over 30,900 counterfeit fashion items were discovered. The items were detained immediately.

#### *Outcome:*

Over 30,900 counterfeit items that infringed trade marks belonging to six (6) separate trade mark owners were discovered. Customs assisted the other five brand owners, whose trade marks were suspected to be infringed, to detain the goods – thereby allowing them to institute civil cases against the local consignee. All six brand owners applied successfully to the court for Singapore Customs to further detain the goods in April 2013, in order for their cases to be heard in court.

#### *Lessons Learned:*

Businesses that commit large scale, wilful infringement of multiple trade mark rights exist and trade mark rights owners should establish comprehensive monitoring system to combat such infringers.

Specific information provided by the brand owner enabled Singapore Customs to act swiftly to detain the counterfeited goods at the border.

### Case study 2: Vietnam's "SANTAK" Enforcement Case

#### *Background:*

A power supply company (Company A) has registered its mark "SANTAK" in Vietnam since 1995 for "Uninterruptible Power Systems - UPS". Further, "SANTAK" is a well-known trade mark which has a large portion of the Asian market. Company A had information of a shipment of products bearing the sign "SANTAKUPS" being imported from China by a Vietnamese company.

#### *Advice:*

Company A was advised to register its mark "SANTAK" with Customs and cooperate with the IP Enforcement and Anti-Counterfeiting Department within the General Customs Office and the Haiphong Customs Office to investigate and detect the shipment of products bearing the sign "SANTAKUPS".

#### *Outcome:*

After the discovery of the shipment of 162 products bearing the sign "SANTAKUPS" imported from China by a Vietnamese company, Company A's representative requested the competent authorities to suspend the import procedures of the shipment. Haiphong Department of Custom issued a Decision to keep the shipment under custody according to administrative procedures.

"SANTAKUPS" was written as one word, but the intent was to make a customer think that this was a combination of the words Santak and UPS. In this context, UPS is an abbreviation of uninterruptible power supply, so UPS did not create a distinction. Because of this, a comparison was only made with the word "SANTAK" which was identical to the protected trade mark. Upon consideration of these findings, the competent Authority issued a Decision to apply sanctions under regulations of relevant Law: imposition of a high monetary fine and removal of "SANTAKUPS" from all infringing goods.

#### *Lessons Learned:*

Through the registration of the mark with Customs as well as cooperation between Company A and Customs, Company A timely prevented the risk of infringement of trade mark in Vietnam by not only protecting their own interests in the market but also their reputation for the trade mark "SANTAK".

## 6. Take-away messages

Although not all South-East Asian countries have established a trade mark recordation system, all ten countries have legal and regulatory mechanisms in place to combat import/export of counterfeit or infringing goods passing through customs.

Where available, IPR holders should make use of this quick and cost-effective method of preventive enforcement of their IP rights and record their trade marks as early as possible.

## 7. Related links and additional information

- Visit our Guide to Trademarks Protection in South-East Asia - [www.southeastasia-iprhelpdesk.eu/en/helpdesk-guides](http://www.southeastasia-iprhelpdesk.eu/en/helpdesk-guides).
- Visit the country factsheets of South-East Asia countries - [www.southeastasia-iprhelpdesk.eu/en/country-factsheets](http://www.southeastasia-iprhelpdesk.eu/en/country-factsheets).
- Visit other publications at South-East Asia IPR SME Helpdesk website - [www.ipr-hub.eu](http://www.ipr-hub.eu).
- Visit the Helpdesk blog [www.yourIPinsider.eu](http://www.yourIPinsider.eu) for related articles on IP in South-East Asia and China.

The South-East Asia IPR SME Helpdesk provides free, confidential, business-focused advice to European Small and Medium Enterprises (SMEs) relating to Intellectual Property Rights (IPR) in South-East Asia.

**Helpdesk Enquiry Service:** Submit further questions to the Helpdesk via phone, email ([question@southeastasia-iprhelpdesk.eu](mailto:question@southeastasia-iprhelpdesk.eu)) or in person and receive free and confidential first-line advice within three working days from a South-East Asia IP expert.

**Training:** The Helpdesk arranges training on South-East Asia IPR protection and enforcement across Europe and South-East Asia, tailored to the needs of SMEs.

**Materials:** Helpdesk business-focused guides and training materials on South-East Asia IPR issues are all downloadable from the online portal.

**Online Services:** Our multi-lingual online portal ([www.ipr-hub.eu](http://www.ipr-hub.eu)) provides easy access to Helpdesk guides, case studies, E-learning modules, event information and webinars.

*For more information please contact the Helpdesk:*

Room 2B, 15<sup>th</sup> Floor, The Landmark  
5B Ton Duc Thang, Ben Nghe Ward, District 1,  
Ho Chi Minh City, Vietnam  
T +84 28 3825 8116  
F +84 28 3827 2743  
[question@southeastasia-iprhelpdesk.eu](mailto:question@southeastasia-iprhelpdesk.eu)  
[www.ipr-hub.eu](http://www.ipr-hub.eu)

Download guide:



An initiative co-funded by the European Union

Project implemented by:

DEVELOPMENT  
Solutions



Disclaimer:

The contents of this publication do not necessarily reflect the position or opinion of the European Commission. The services of the South-East Asia IPR SME Helpdesk are not of a legal or advisory nature and no responsibility is accepted for the results of any actions made on the basis of its services. Before taking specific actions in relation to IPR protection or enforcement all customers are advised to seek independent advice.