

LIVE WEBINAR

TOP IP TIPS WHEN DOING BUSINESS IN SOUTH-EAST ASIA, INDIA & HONG KONG

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24 January 2024



10:00 (CET) / 14:30 (IST) / 16:00 (ICT) / 17:00 (SGT)



Via ZOOM



Welcome to the Webinar

Moderator:

Benoît Tardy

IP Business Advisor
South-East Asia IP SME Helpdesk



SPEAKERS



Javier Méndez Repiso
Chairman

Spanish Chamber of Commerce
in Vietnam (SCCV)



Elio De Tullio
External Expert & Managing Partner

International IP SME Helpdesks
De Tullio & Partners



Helika Jürgenson
Project Manager

China IP SME Helpdesk



Girish Somwarpet Nagraj
IP Business Advisor

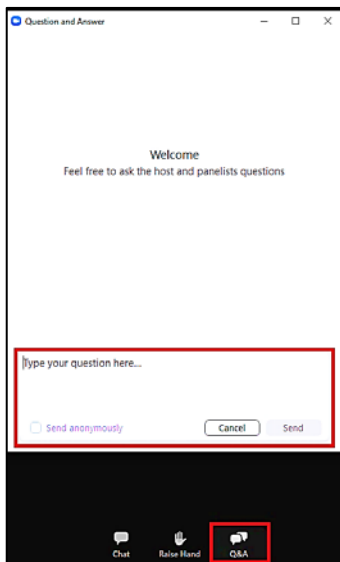
India IP SME Helpdesk

Agenda (CET)

TIME	OVERVIEW	SPEAKER(S)/ MODERATOR
10:00 – 10:05	Opening remarks + Housekeeping rules + Intro to International IP SME Helpdesks (5 mins)	- Benoît Tardy, SEA IP SME Helpdesk.
10:05 – 10:15	Setting the scene for business expansion into new markets (10 mins)	- Javier Méndez Repiso, SCCV.
10:15 – 10:45	Understanding the importance of IP protection in the target markets (30 mins)	- Elio De Tullio, International IP SME Helpdesks.
10:45 – 11:00	Q&A + Panel Discussion (15 mins)	- Helika Jürgenson, China IP SME Helpdesk. - Girish Somwarpet Nagraj, India IP SME Helpdesk.

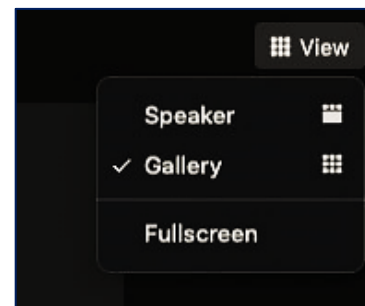
How to use the Zoom Panel?

- Participants' microphone will be muted during the live session.
- It is recommended to switch to Gallery View (Click View in the top-right corner, and then select Gallery).
- In case there is any internet disruption, please be patient and try to join the Zoom link again.



Q&A Feature:

Select 'Q&A' box to type your questions



Viewscreen Feature:

Click on 'View' in the top-right corner, and then select Gallery

International IP SME Helpdesks



www.ec.europa.eu/ip-helpdesk

International IP SME Helpdesks



Training

free online and on-site sessions



Website

frequent updates from the world of IP and innovation



Publications

practical IP knowledge through high-level publications



Helpline

confidential treatment of individual IP questions



Events

info point at key networking events and conferences



Website & social media

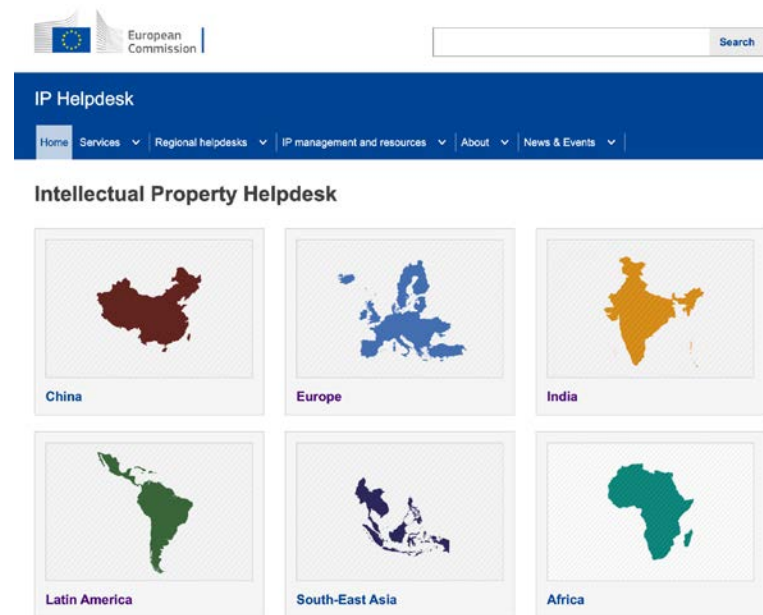
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@China IP SME Helpdesk



@latinamericaipr
@IndiaIPhelpdesk
@AfricaIPR
@ipSEAsia
@IPRHelpdesk
@iprchina



The screenshot shows the IP Helpdesk website interface. At the top, there is the European Commission logo and a search bar. Below the navigation bar, the main heading is "Intellectual Property Helpdesk". The content area features six regional helpdesk tiles, each with a map of the region and a label: China (dark red), Europe (blue), India (orange), Latin America (green), South-East Asia (dark blue), and Africa (teal).

SPANISH CHAMBERS IN SOUTH EAST ASIA, HONG KONG AND INDIA

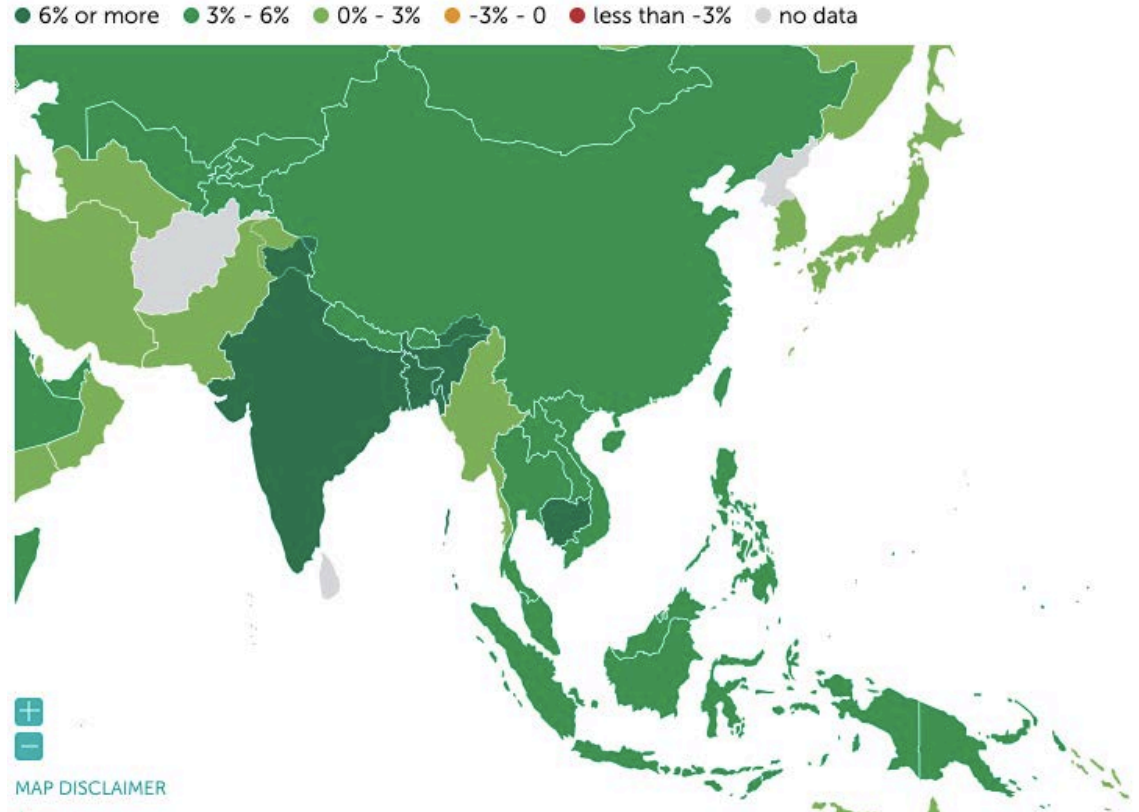
SPANISH CHAMBERS ABOARD
Promoting and fostering business
and cultural exchanges between
Spain and Asian countries.

- Spanish Chamber of Commerce in the Philippines - La Cámara
- Malaysian Spanish Chamber of Commerce & Industry - La Cámara
- Spanish - Thai Chamber of Commerce
- Spanish-Singaporean Chamber of Commerce
- Spanish Chamber of Commerce in Vietnam
- Spanish Chamber of Commerce in Hong Kong
- Indo Spanish Chamber Of Commerce
- ASEMPEA Asociación Empresarial España Asean



REAL GDP GROWTH - ANNUAL PERCENT CHANGE

South Asia – 5,9 %
Southeast Asia – 4,6 %
India – 6.3%
Hong Kong – 2.9%
Thailand – 3.2%
Vietnam – 5.8%
Philippines – 5.9%
Malaysia – 4.3%
Singapore – 2.1%



BUSINESS EXPANSION INTO ASIA AS A NEW MARKET

REASONS MAKING ASIA ATTRACTIVE

- ✓ Large and Growing Consumer Markets
- ✓ Economic Growth
- ✓ Technological Boom
- ✓ Diversification
- ✓ Startup Scene

It's also crucial to create an expansion strategy, hire local talent, adapt your offer to the new market, and launch and test your offer in the new market.

CHALLENGES

- ✓ Diverse Cultures and Languages
- ✓ Local Competition
- ✓ Infrastructure and Logistics
- ✓ Foreign Ownership and Restrictions
- ✓ Minimum Capital Requirements
- ✓ Corruption
- ✓ Intellectual Property Rights

It's important to note that these challenges can be overcome with careful planning, local partnerships, and a deep understanding of the local market.



Understanding the importance of IP protection in the target markets

South-East Asia – Hong Kong – India

24 January 2024

INTERNATIONAL
IP SME HELPDESKS



Speaker's Bio



Name: Elio De Tullio

Firm: De Tullio & Partners

Location: Italy

Elio De Tullio is an Italian lawyer admitted at the bar of Bari and trade mark attorney. After 10 years of experience in IP matters, he founded in 2005 the law firm De Tullio & Partners, with offices in Rome and Bari and a liaison office in New York. Managing Partner of De Tullio & Partners, he acts as trade mark attorney in the strategic assessment of IP protection and in prosecution and opposition processes at domestic and international level. He is also a litigation lawyer before the Italian Courts specialized in Intellectual Property. He specializes on trademark, design and patent issues, from a strategy, business intelligence, competition, filing and prosecution perspective. Since the start of his activity, he supported Italian and EU SMEs to protect and prosecute their rights in South-East Asian countries, with particular attention to Singapore, Malaysia, Indonesia, Vietnam and Myanmar.

Since 2014 he acted as speaker at several webinars and training events on the protection of IPR in South-East Asian countries on behalf of the South-East Asian IPR SME Helpdesk. As Chair of the Geographical Indications Committee of INTA (International Trademark Association), he is often requested to study, comment and prepare papers on the new Bills regarding Trademarks and Geographical Indications to be adopted in South-East Asian Countries. He has written some articles on Italian and European law on intellectual property rights which have been translated into Chinese and South-East Asian languages.

Agenda

How to protect your IP in South-East Asia, India and Hong Kong

- Introduction
- IP protection in South-East Asia
- IP protection in India
- IP protection in Hong Kong
- Tips & tricks and Takeaways

Introduction

Intellectual Property Rights (IPRs)

- **Principle of first-to-file**
 - gives priority to those who first file an application to register the IPR
 - searches are important for assessment of novelty and inventive step (or distinctive capacity)

- A key issue for SMEs in some relevant markets, especially in China and South-East Asia, is the **bad-faith registration**. This happens when a third party (a trademark squatter, local company or any other party) first registers, in one of these markets, a trademark of a foreign company with the express intention of **selling it back to the foreign company at a higher price** or to **take advantage of the successful business of the foreign company for commercial gain in the target market**. This prior registration can limit the foreign company's freedom to operate by restricting its ability to enter the market or can damage its reputation.

- However, after a trademark filing, IP offices will usually publish the trademark application for public inspection for a specific period of time, to allow third parties to file an opposition.

Intellectual Property Rights (IPRs)

- **Principle of territoriality** (geographic limitation)
 - this means that IPRs are only protected and enforceable in the territories in which they have been registered
 - therefore, EU SMEs wishing to ensure that their IP is protected in SEA, India or Hong Kong must take the relevant steps to protect them in the corresponding country/ies.

- **Principle of national treatment**
 - each State must grant the same protection to nationals of other States that it grants to its own nationals.

- **Principle of limitation in time and scope**
 - e.g. patents expire within 20 years after filing; trademarks expire after 10 years, but can be renewed (if used)

The Paris Convention / Priority Rights

- Most of the Countries of the world are **signatory parties of the Paris Convention** for the Protection of Industrial Property of 1883.
- On the basis of the Paris Convention, **the owner/applicant of an application for registration of an IP right (filed in one of the Member States of the Paris Convention) may use a priority period of six months (for designs and trademarks) or twelve months (for patents and utility models)** – from the filing of the application in the Country of Origin – to extend the protection (of the first filing in the Country of Origin) in any other Country of the world that is also member of the Convention, through:
 - 1) an **International Filing claims protection in the Country/ies of interest**

AND/OR

 - 2) a **national filing in the specific Country/ies of interest.**

In this way the priority date is safeguarded, and it is possible to avoid interferences from third parties.

How to check your trademark availability:

- The World Intellectual Property Organization (WIPO) and national/regional IP offices make trademark databases available (free and without the need to create an account).
- **WIPO's Global Brand Database** (<https://www3.wipo.int/branddb/en/>) is an aggregate search portal; it enables applicants to search for trademarks previously registered under the Madrid system and it also includes many national trademarks. However, do not forget to check **online database of national/regional IP offices** as the WIPO's Global Brand Database does not include national trademarks filed directly with some of the contracting parties.
- Other aggregate search portals are **TMview** (<https://www.tmdn.org/>) and **ASEAN TMview** (<http://www.asean-tmview.org>).



TM availability searches should be performed by IP experts/agents since results need to be analyzed and, in some countries (as SEA or India), databases are not always up-to-date.

IP protection in South-East Asia

Patent in SEA

Patent in SEA

- **Myanmar** is not a member of the Paris Convention, nor of the PCT.
- The deadline for entering the national phases of the PCT for Singapore, Cambodia, Brunei, Laos, Malaysia, the Philippines, and Thailand is **30 months from the priority date** (first filing).
- Regarding Vietnam and Indonesia, the deadline for entering the national phases of the PCT is **31 months from the priority date** (first filing).
- It is necessary to **appoint a local agent for the national phases of the PCT** in: Cambodia, Vietnam, Brunei, Indonesia, Laos, Malaysia, the Philippines, and Thailand; in Singapore, indicating an address for service is sufficient.

Patent in SEA / Translations and Utility Models

- In Singapore, Brunei, Cambodia, the Philippines, and Malaysia, the patent application and its related documents (description, claims, etc.) **must be translated into English**.
- In other countries, translation into the **local languages** is required: Khmer (for Cambodia), Vietnamese, Indonesian, Lao, Filipino and Thai.
- In Cambodia, Indonesia, Laos, Malaysia, the Philippines, Thailand, and Vietnam, the concept of "**simple patents**" exists. These are known as "**Petty Patents**" in Laos, "**Utility Models**" in the Philippines and Cambodia, "**Utility Innovation**" in Malaysia, or "**Utility Solution Patent**" in Vietnam.
- **In some cases, the inventive step is not required** (i.e., in Indonesia, the Philippines, Thailand, and Vietnam); **in other cases, it is required to a lesser extent compared to a "standard patent"** (in Malaysia and Laos).

Patent in SEA / Duration of the process

- The process to obtain a "simple patent" is generally shorter compared to that of a "standard patent"; however, the duration of protection is also shorter (7 or 10 years depending on the country).
- In some countries, such as Thailand, it is **better to file a local foreign application** (instead of the PCT) as this foreign national procedure allows for faster processing times and more affordable costs.
- Some SEA Patent Offices (for example, in Cambodia or Indonesia) may **expedite patent registration** if the patent has already been granted by other offices in countries with more advanced IP systems (such as the USA, Japan, South Korea, or the EU).

Acceleration Programmes to speed up patent grant process

1) [International] **The Patent Prosecution Highway (PPH)**

- Between IP Offices where the examination process of a patent application in one IP Office can be accelerated by referencing the examination results from another IP Office.
- Allows applicants to obtain faster patent rights at no additional cost.

Brunel	PPH agreement with Japan.
Indonesia	PPH agreement with Japan.
Malaysia	PPH and PCT-PPH ² agreement with Japan, China, the EPO, and Korea.
Philippines	PPH and PCT-PPH agreement with the US, Korea, the EPO, and Japan.
Singapore	PPH agreement with Brazil, China, Mexico, and the EPO. Also a member of the Global PPH (a plurilateral PPH pilot program covering several types of PPH).
Thailand	PPH agreement with Japan.
Vietnam	PPH agreement with Japan and Korea.

Acceleration Programmes to speed up patent grant process (Cont.)

2) [Regional] **ASEAN Patent Examination Co-operation** ("ASPEC")

- Regional patent work-sharing programme among 9 participating ASEAN Member States IP Offices (ø MM).
- Applicants may use the search and examination (S&E) reports of participating IP Offices to accelerate the patenting process in any of the other participating IP Offices.
- Applicants can also rely on two specific programmes (since 2019):
 - **ASPEC AIM** - a committed turnaround time of 6 months to receive the first office action if an ASPEC request is made for Industry 4.0 patent applications. This industry specific programme was further extended until 26 August 2025. (<https://www.aseanip.org/home/2023/08/25/further-two-years-extension-of-asper-aim-pilot-programme-till-26-august-2025>).
 - **PCT-ASPEC** - additional choice of relying on a Patent Cooperation Treaty (PCT) report issued by an ASEAN International Searching Authority/International Preliminary Examining Authority. This pilot programme was also further extended until 26 August 2025 (<https://www.aseanip.org/home/2023/03/03/three-year-extension-of-the-pct-asper-pilot-programme-till-26-august-2025>).

3) **Programmes related to Singapore**

- The SG IP Fast Track = available to patent applications filed in SG covering all technological sectors.
- Patent cooperation with KH and LA (re-registration of SG patents or submit S&E reports to local IP Offices).
- Collaborative search & examination with VN (this pilot programme will run until 28 February 2025).

*More details here: <https://www.ipos.gov.sg/about-ip/patents/how-to-register/acceleration-programmes>

Design in SEA / Duration

Period of protection in SEA

- **[Brunei, Cambodia, Laos, Malaysia, The Philippines, Singapore, Vietnam]** they have an initial period of 5 years protection, which can be extendable for 2 periods of 5 years each, up to a maximum of 15 years from the filing date.
- **[Myanmar]** the **Industrial Design Law from 2019** is now in force since October 31, 2023, enabling the protection of industrial designs with a total protection period of 15 years (5 years from filing date + renewable twice each time of 5-year period).
- **[Indonesia and Thailand]** have a fixed 10 years protection.

Design in SEA / Ownership

Who can register in SEA

- **[Brunei]** The owner of the design is entitled to register it, which could be the designer, commissioning party, or employer depending on the circumstances. Any other party may register the industrial design if they hold rights over it (e.g. assignment).
- **[Cambodia and Laos]** the owner of the design is entitled to register it, which could be the designer or employer depending on the circumstances. Any other party may register the ID if they hold rights over it (e.g. assignment).
- **[Indonesia]** The owner of the design is entitled to register it, which could be the designer, commissioning party, or employer depending on the circumstances. If filed by a person other than the designer, a statement providing details of the designer must be provided.
- **[Malaysia and the Philippines]** the designer, commissioning party (unless otherwise agreed by contract), and employer where the design was created by the employee in the course of the employment are entitled to apply for registration. Any other party may register the ID if they hold rights over it (e.g. assignment).

Design in SEA / Ownership

- **[Myanmar]** ID application should be filed electronically, in person by the applicant or its local representative, or by post. Industrial design creators or their legal successors or transferees can file applications. However, applicants not incorporated/resident in Myanmar must appoint a local representative using a notarized ID-2 form.
- **[Singapore]** the designer, commissioning party (unless otherwise agreed by contract), and employer where the design was created by the employee in the course of the employment are entitled to apply for registration. Whilst there are no restrictions as to nationality or residency, a Singapore address for service (AFS) must be provided, to which all correspondences will be sent.
- **[Thailand and Vietnam]** the designer and employer where the design was created by the employee in the course of the employment are entitled to apply for registration.

The Hague Agreement

- The **Hague Agreement** is an international registration system that allows individuals to seek protection for their industrial designs across various States and intergovernmental organizations through a single international application submitted to WIPO
- In essence, the Hague Agreement simplifies the process by replacing multiple applications that would otherwise be required with different national (or regional) Offices. This streamlining is achieved through a unified international application under the auspices of WIPO.
- The Hague Agreement comprises three international treaties:
 - a) **The Geneva Act of July 2, 1999 (the "1999 Act");**
 - b) **The Hague Act of November 28, 1960 (the "1960 Act");**
 - c) **The London Act of June 2, 1934 (the "1934 Act").**
- It is noteworthy that the application of the 1934 Act has been frozen since January 1, 2010. Consequently, no new designations under this Act are permissible in the International Register. On the other hand, the 1999 and 1960 Acts of the Hague Agreement operate autonomously and independently of each other. Each of these Acts constitutes a comprehensive international treaty, affording States the flexibility to become a party to either one or both of them based on their preferences.
- List of contracting parties: https://www.wipo.int/wipolex/en/treaties/ShowResults?search_what=C&treaty_id=9

Trademark in SEA / Types of trademarks

What can be registered as a TM in SEA

- **[Singapore and Malaysia]** words, names, signatures, numerals, devices, headings, labels, shapes, colours, sounds, scents, holograms, positionings, sequences/motions.
- **[Thailand and Vietnam]** words, names, signatures, devices, headings, labels, shapes, colours, sounds.
- **[The Philippines]** words, names, signatures, numerals, devices, headings, labels, shapes, colours, holograms, positionings, sequences/motions.
- **[Brunei]** words, names, signatures, numerals, devices, headings, labels, shapes, colours, sounds, scents, holograms, sequences/motions.
- **[Laos, Cambodia and Myanmar]** words, names, signatures, numerals, devices, headings, labels, shapes, colours.
- **[Indonesia]** words, names, signatures, numerals, devices, headings, labels, shapes, colours, sounds, holograms.

Trademark in SEA

- Two options: **local filing** and **international filing** (Madrid system).
- **As of today, Myanmar is the only SEA country which is not part of the Madrid system.**
- All SEA countries have a **multi-class filing system** (Cambodia recently made the use of this system mandatory i.e. since 1 August 2023).
- **Indonesia, Thailand, and Vietnam require national applications to be submitted in their respective local languages.**

Trademark in SEA / Duration, translation and system

- In SEA countries, the duration of the trademark varies: **10 years from the date of filing** (Brunei, Cambodia, Indonesia, Malaysia, Singapore, Thailand, Vietnam) or **10 years from the date of registration** (Laos and the Philippines).
- Linguistic problem -> translation. **Registration in Latin characters does not protect against use or registration in the local language.**
- The procedure to obtain a trademark varies from country to country. Most SEA countries follow the "**first-to-file**" system, where the first person or entity to file a trademark becomes the owner when registration is granted. In these countries, it is important to initiate protection as soon as possible, as IPRs may be compromised if third parties manage to register a trademark before the official owner.
- Other countries, such as **Brunei** and **Malaysia** use the "**first-to-use**" system.

Enforcement in trade fairs in SEA

1) **Before the Fair**

- **Registering one's IPRs in SEA countries or proceeding with an International registration, extended to such country/countries.**
- **Prepare the necessary documentation to demonstrate ownership of IPRs:**
 - [Trademarks] original certificate of national registration, certificate of international registration (in the required language) obtained from the Trademarks Office, renewal certificates.
 - [Patents, utility models, and designs] original certificates of registration, translation into the required language of technical documentation and claims, proof of payment of annual fees.
 - [Registered Geographical Indications] original registration certificate.
- **Verify that one's IPRs are not the subject of proceedings or invalidation procedures within SEA.**

Enforcement in trade fairs in SEA

- **Checking competitors' websites to identify potential cases of counterfeiting.**
- **Applying symbols and phrases related to the rights on the products:**
 - ™ if the trademark is in use or not yet registered, or if the application has been filed but the trademark is not yet registered;
 - ® only in the case of a registered trademark;
 - "Patent n. ____" if the patent has been granted;
 - "Patent pending" if the patent application has been filed but the patent has not yet been granted.

Enforcement in trade fairs in SEA

2) During the fair

- **Check if the organizers have established a Temporary IPR Bureau Office.** Sometimes, if the fair lasts one or 2 days and the organizers have not set up a center for complaints, the exhibitor can check if there is any local authority at the fair.
- **If a suspected counterfeit product is identified, it is important to gather as much evidence as possible** (photographs, brochures, business cards, catalogs, etc.). In order to use evidence in any future legal proceedings, it is recommended to invite a notary to the fair to authenticate and verify the source of the collected evidence.
- **In the case of suspected counterfeiting, file a complaint** (attaching the collected evidence) with the IPR Bureau, if available, or with the authorities otherwise present at the fair.

Enforcement in trade fairs in SEA

3) Once the fair is over, it is possible to:

- Initiate a **civil action** to obtain precautionary measures, injunctions, seizure of counterfeit goods and the machinery used to produce them, or compensation for damages.
- Initiate a **criminal action** that may result in the arrest of the party responsible for the violation or monetary penalties against the same.
- Initiate an **administrative procedure** to obtain injunctions to cease the violation, seizure and destruction of counterfeit goods and the machinery used to produce them, or monetary penalties.

IP protection in India

IP protection in India

- While India has committed to numerous international agreements addressing the safeguarding of IPR, **distinctions** persist between EU and Indian IP laws concerning the precise provisions for protection, registration, and enforcement of such rights.
- Consequently, it is **strongly advised to tailor the intellectual property strategy accordingly**.
- India's adherence to a majority of international treaties governing IP protection reflects a substantial alignment of its substantive law with global standards. Notably, the Agreement on Trade-Related Aspects of Intellectual Property Rights (**TRIPS agreement**). Moreover, India actively engages in **international collaborations**, exemplified by its ratification of the **Madrid Protocol** for the international registration of trademarks and the **Patent Cooperation Treaty (PCT)**. These treaties not only bring India's substantive law in closer conformity with international norms on trademark and patent protection **but also significantly enhance the safeguarding of these IP rights within Indian borders for European Union SMEs**.

IP Rights in India

- The **Office of the Controller General of Patents, Designs, and Trademarks** (CGPD TM), situated in Mumbai, serves as the governmental body responsible for the issuance and administration of all IPR in India. It supervises the activities of its various branches, each dedicated to a specific IP right, located across different cities in the country.
- The CGPD TM has two working languages: **English and Hindi**. Any application must be filed in one of these two languages.
- **Applicants from abroad** who lack residence or a business presence in India **must engage the services of an Indian legal representative** when submitting an IP application or conducting any transactions with the various branches of the CGPD TM. In such instances, a power of attorney must be included as a requisite component of the application.

Copyright in India

- The work to be protected must be **original**, not only imaginative but also fruit of the work and skill of its creator, as opposed to a copy of a pre-existing work.
- Copyright safeguards original works including literature, drama, music, and art, along with cinematographic films and sound recordings, original databases and software.
- **The presumption is that the creator of the work is the copyright owner, although certain exceptions may apply.**
- **In India, the default ownership of copyright for works produced by employees during the regular course of their employment rests with the employer**, unless specified otherwise in the employment contract. Similarly, in the case of works generated under a service contract, it is presumed that the client holds the copyright.

Copyright in India

- Duration for musical, artistic and literary works, **lifetime of the author plus 60 years after his/her death**. For films, photographs, and software the protection last for **60 years from the year of their public disclosure**. The rights over broadcasts last for **25 years from the year of broadcast** and performers rights last for **50 years from the year the performance was made**.
- Although copyright registration is not mandatory, **it is advisable to register copyright as a registration certificate is considered as “proof of ownership”**.
- The copyright application can be filed either in person, by mail or online **with the Copyright Register**. After submission, **a 30 days period starts during which third party may file objections to the Copyright Register**. In the event of an objection, a hearing is convened, allowing both parties to articulate their respective arguments. Should the third party's objection be dismissed, the application then advances to the examination stage.

Patent in India

- **The Indian patent system does not include provisions to protect Utility Models.**
- In accordance with Indian law, there is provision for **filing a preliminary application** that offers a **partial disclosure of an invention**, particularly when the invention is still in the experimental stage. However, it is imperative to submit a comprehensive disclosure, known as a complete patent specification, to the Patent Office **within 12 months of filing the provisional patent application** in India. Failure to meet this deadline results in the application being deemed abandoned.
- To obtain a patent protection the invention must be new and must not be disclosed in public domain (**novelty**); must be substantially different from already publicly known information and must not be an obvious development of pre-existing knowledge to a specialist in the particular technology domain (**inventive step**); must be produced or utilized in any kind of industry (**industrial application**).
- Indian law contains provision which does not allow patenting certain types of invention (**subject matter**). In the case, additional documents must be filed as part of the application.

Patent in India

- Certain invention categories, that are patentable in Europe, but **NOT in India**:
 - a) **Secondary uses of known products** (including secondary medical use of medicines);
 - b) **New forms** (e.g. salts or isomers) **of known products**, unless they result in enhanced efficacy (and more specifically, for medicines, therapeutic efficacy);
 - c) **Methods of agriculture or horticulture**;
 - d) **Inventions which can be considered traditional knowledge**;
 - e) **Inventions relating to atomic energy**.
- International Agreements (Convention of Paris), even via the PCT enable a patent applicant to “claim priority” when filing a patent application in India for inventions for which patent applications have already been filed in other countries up to 12 months earlier.
- Patents are valid for **20 years**, counting from the date of filing of the patent application.

Patent in India

- There are two ways to file a patent application in India:
 - 1) **National filing – Indian Patent Office:** a patent application can be filed with the Indian Patent Office either in hard copy or through online filing system by submitting a complete or provisional specification along with requested forms and fees. The full patent application procedure can take **between 4 to 6 years**.
 - 2) **International filing – Patent Cooperation Treaty (PCT):** filing of a single patent application with the same effect as national applications filed in each of the PCT-participating countries elected. The application must enter the Indian national phase within 31 months from the priority date of the earliest application.
- **In India, patent applicants need to provide information about similar patent applications filed outside India for the same or very similar invention.** Failure to comply with this rule can lead to serious consequences, including the potential invalidation of the patent through pre-grant and post-grant opposition, as well as revocation.

Industrial design in India

- To obtain the protection under Indian law, a design must fulfil following criteria:
 - a) It should be **new or original**, and not being known from any previous publications in any country before the date of application and it is **not contrary to public order and morality**.
 - b) It must be the **application of a shape, configuration or pattern to an article by an industrial process**.
 - c) The feature of design must be **obvious and visible** on the finished article and be capable of being solely judged by the eye.
 - d) The design should **not include any trademark or property mark or artistic works**.

- There is a **grace period of 6 months** from the date of the disclosure of the design if it was used or disclosed during an exhibition recognized by the government, and the applicant had given previous notice to the Indian Design Office on a prescribed form.

Industrial design in India

- **India is not member of the Hague Agreement.**
- A design application can be filed with the Indian Design Office either in hard copy or through an online filing system.
- The design registration procedure takes **between 6 to 12 months** from the date of filing.
- India adopts the **Locarno Classification** to align its classification system with international standards. Applicants are advised to utilize this classification when categorizing their designs in the application. One application may cover more than one class.

Once an industrial design is registered, the copyright protection for such work ceases to exist as the dual protection is not allowed.

If a work could have been registered as an industrial design (but was not), copyright protection will come to an end whenever any article to which the work is applied, has been reproduced by an industrial process more than 50 times.

Industrial design in India

- Under Indian law, the original creator of the design is presumed to be the owner of said design, and therefore the person entitled to file for protection. At the time of filing for registration of a design, the applicant may be:
 - a) The **author** of the design;
 - b) A **person who has acquired the design** (with proof of such acquisition);
 - c) A **person for whom the design has been developed by the author** (with proof of such relationship between the applicant and the author).

- The duration of the protection of industrial design is for a period of **10 years** from date of filing the design application. The design registration can be **renewed** once for an additional period of **5 years**.

- The application for extension of a design for the additional period of 5 years must be filed before design registration expires.

Trademark in India

- The trademark can consist of words, numbers, logos, shape of goods, packaging and combination of colours, or the combinations of all such elements.
- Non-traditional trademarks such as **colour** and **sound**, are also protected in India provided that they are represented graphically in the application form. In the case of sounds, the graphical representation requirement is met by the use of a musical stave showing the musical notes and the rhythm of the sound being applied for.
- In India, there are different types of trademarks: **individual, collective and certification marks**.
- In order to be eligible for registration, a trademark must not fall within one of the following grounds under which an application will be refused (**absolute grounds for refusal**):
 - i. **Lack of distinctiveness**
 - ii. **Illegal signs**
 - iii. **Functional signs**
- Similarity with an earlier sign? (**relative grounds of refusal**).

Trademark in India

- Trademark rights are valid for **10 years** and can be renewed indefinitely.
- A trademark can be registered through the “national” (examination takes between **12 to 18 months**) or “international” route and can only be effectively protected once it has been registered in India.
- India uses the Nice Classification for the description of goods and services for which a trademark is registered. India accepts “**multi-class**” application, i.e. an application covering goods and services from several classes of the Nice Classification.
- Indian law follows the “**first-to-use**” principle.
- Indian law provides remedy for misuse of an unregistered trademark by the common law doctrine of **passing off**.
- Any person can file notice of opposition against the trademark application **within a period of four months from the date on which the mark is advertised in the Trade Marks Journal**.

Customs in India

- In India, holders of IPRs have the option to **register their IPRs with Customs**. This allows Customs authorities to inform both the IPR holder and the importer/consignee about any suspected infringing goods during importation. The notification includes the grounds for suspension and directs the parties involved to participate in the proceedings within the stipulated period.
- Upon confirming that the goods are counterfeit, **the Customs Authority will issue a notification to the importer and all relevant parties involved in the importation process. Simultaneously, the Consignment Specific Bond and Bank Guarantee will be retained.**
- The Customs Authority will arrange a **hearing for both parties to present their arguments**. If it is established that the suspended goods indeed infringe on intellectual property rights, the Customs Authority **will issue an order for absolute confiscation and impose penalties on the importer and other relevant parties.**
- Subsequently, the goods will be either **destroyed or disposed of under official supervision**. The **intellectual property rights holder is responsible for covering the costs associated with destruction**, as well as any demurrage and detention charges incurred until the point of destruction or disposal.

IP protection in Hong Kong

IP protection in Hong Kong

- Hong Kong operates under a '**first-to-file**' system, meaning that the first person to file an IP right within the Hong Kong jurisdiction will own that right once the application is granted.
- Hong Kong maintains a **separate legal system from Mainland China**. To gain broad protection proprietors must register in both Hong Kong and Mainland China.
- Hong Kong has a well-established and **comprehensive IP legal framework**, and is generally considered as one of the most sound in the East Asian region.
- Hong Kong is a party to the following international agreements: **Paris Convention for the Protection of Industrial Property, Berne Convention for the Protection of Literary and Artistic Works, Universal Copyright Convention, Nice Agreement Concerning the International Classification of Goods and Services, Geneva Convention for the Protection of Producers of Phonograms Against Unauthorised Duplication of their Phonograms, Patent Cooperation Treaty, WIPO Copyright Treaty and the WIPO Performances and Phonograms Treaty.**

IP protection in Hong Kong

- The Hong Kong government has proposed the Trademarks (Amendment) Bill 2019, aiming to modify the Trademarks Ordinance and related legislation to **incorporate the provisions of the Madrid Protocol for international trademark registration in and from Hong Kong**. This amendment enables a trademark applicant in Hong Kong to submit an application for international trademark registration through Hong Kong's Trademarks Registry.
- Until the implementation of the Madrid protocol to enjoy protection in Hong Kong, **trademarks must still be registered directly in Hong Kong**.

Copyright in Hong Kong

- The original work must be reduced into a material form of expression i.e. a **tangible form**. The copyright owner has the exclusive right to exploit their work for commercial gain.
- The author of a literary, dramatic, musical or artistic work and the director of a film enjoys moral rights, i.e. the right to be identified as the author or director.
- **No formal procedures are necessary for acquiring or registering copyright protection for works in Hong Kong.** Copyright is inherently granted upon the creation of the work by the author, and this protection applies to works by authors from any location globally. Additionally, works first published anywhere in the world are eligible for copyright protection in Hong Kong.
- **Given the absence of a universal registration system for copyright works, it is advisable for copyright holders to maintain thorough records of the work creation process.** These records serve as valuable evidence for enforcement purposes and are instrumental in defending against allegations of copyright infringement.

Copyright in Hong Kong

Duration of Copyright:

- a) **Literary, dramatic, musical and artistic works:** 50 years from the end of the year in which the author dies.
- b) **Sound recordings:** 50 years from the end of the year in which it is made or 50 years from the end of the year in which it is released.
- c) **Films:** 50 years from the end of the year after the last of the principal director, author of the screenplay, author of the dialogue or composer of music specially created for and used for the film dies.
- d) **Broadcasts and cable programmes:** 50 years from the end of the year in which the broadcast was made or the programme was included in a cable programme service.
- e) **Typographical arrangements:** **25 years from the end of the year in which the typographical arrangement was first published.**

Patent in Hong Kong

- There are two types of patents granted in Hong Kong: **Standard Patents** and **Short-Term Patents**.
- The grant of a **Standard Patent** can be based on:
 - a) **Standard patents (R)**: it refers to the **re-registration of a corresponding patent - granted by one of the three designated patent offices in Mainland China, the United Kingdom or the European Patent Office** (for patent applications designating the United Kingdom) – that shall be made within about six to nine months.
 - b) **Standard patents (O)**: it refers to a new application filed before the HK IP Office and follows the local original grant patent route.
- **SMEs should be aware that filing a standard patent (O) application directly from a PCT application is not feasible. International PCT applications must still undergo the re-registration process for standard patents (R).**
- **Short-Term Patents** can also be filed directly for inventions with a shorter commercial lifespan, providing a **maximum protection term of 8 years**. Individuals filing in HK have a priority right concerning their corresponding applications filed in a Paris Convention country or a WTO member.

Patent in Hong Kong

- Standard patents (both R and O) in HK have a term of protection of **up to 20 years** from the date of filing, subject to payment of annual renewal fees starting from the end of the third year.
- Short-term patents in HK have a protection term of **up to 8 years** from the date of filing, subject to payment of renewal fee at the end of the fourth year.
- The owner(s) of the invention can apply for a patent.
- There are no restrictions as to nationality or residency of the applicant. However, a **HK address must be provided** for service, to which correspondence from the Registry will be sent.
- **Patent registration applications can be submitted in either English or Chinese. However, it is mandatory to provide the title and abstract of the patent application in both English and Chinese.**

Patent in Hong Kong

- A Standard Patent (O) is particularly advantageous for SMEs seeking patent protection exclusively in Hong Kong.
- Those planning to file patents in HK, Mainland China, Europe, or the UK may find the current re-registration system for Standard Patents (R) more economical. Consequently, European SMEs aiming for patent protection in both Mainland China and Hong Kong are advised to **opt for the re-registration filing route**.
- It is not feasible to seek a Standard Patent (O) through the international PCT filing route. SMEs contemplating the use of this international route should opt for a Standard Patent (R) under the re-registration system.
- **Obtaining a Short-Term Patent does not involve substantive examination initially.** However, in cases of infringement, owners must initiate a request for substantive examination or possess a certificate of substantive examination to enforce their short-term patents.

Trademark in Hong Kong

- To be eligible of being registered, a Trademark must be:
 - a) A sign such as words, indications, designs, letters, characters, numerals, figurative elements, colors, sounds, smells, the shape of goods or their packaging or a combination of such signs.
 - b) Capable of being represented graphically.
 - c) Capable of distinguishing the goods and/or services.
 - d) Inherently or factually distinctive of the goods or services.
- Registered for a period of **10 years** from the date of filing and may be renewed for further periods of 10 years upon payment of renewal fee.
- The average time for a smooth registration of a TM in Hong Kong is between **6 and 9 months** (without any issues or objections).

Trademark in Hong Kong

- The owner of a trademark can make an application for a TM.
- There are no restrictions as to nationality or residency of the applicant. However, **a Hong Kong address must be provided** for service, to which correspondence from the Registry will be sent.
- Applications for TM registrations may be made in **English or Chinese**.
- **Oppositions should be filed within 3 months beginning from the date of publication of the trade mark application in the Hong Kong Trademark Official Journal** (if an application is published on 1 March, the deadline to oppose will fall on 31 May). The deadline is extendable once only for a period of 2 months subject to the discretion of the authority.

Registered design in Hong Kong

- In order to be registered, the design must be **new** and have an **appearance that appeals to and can be judged by the eye**.
- It is possible to claim the filing date of an earlier application filed in a country that is a member of the Paris Convention or WTO for protection of the same design, provided that the Hong Kong application is **filed within six months of the earlier application**.
- Average time to register designs in Hong Kong is less than **3 months**.
- The registration of a design lasts for **5 years** beginning from the filing date. It may be extended for additional periods of five years, up to a maximum of **25 years** from the filing date.
- **Only the owner of a design is entitled to register a design**.
- Applications for design registrations may be made in English or Chinese.

Customs in Hong Kong

- Hong Kong Customs possesses **extensive authority for conducting searches and seizures, making arrests, and exercising discretion in deciding whether to prosecute individuals who violate regulations.**
- Hong Kong **lacks an official recordal system**, yet owners of intellectual property rights can address instances of copyright infringement and trademark counterfeiting **by submitting written notices to Hong Kong Customs.**
- **The complaint can be lodged in Chinese or English.**
- **There is no fee charge for lodging a written notice with Hong Kong Customs.**

Trade secrets protection

Trade secrets in general

- The safeguarding of a **trade secret** can endure indefinitely, contingent upon its confidentiality. Therefore, businesses must implement diverse measures to secure their sensitive information. These measures may involve the use of **confidentiality agreements** for employees or business partners, **restricting access** to confidential data through passwords, or physically limiting access to the information.
- For their confidential nature, trade secrets are **not required to be registered to be protected**.
- The best practice which can be adopted for trade secret protection is to implement a **robust contractual arrangement through which confidentiality is assured**.
- Even if there is no formal written agreement between parties, if the receiving party was **aware of the confidential nature** of the information, it can be treated as a trade secret.
- Trade secrets **can be protected for an unlimited period of time** so long as they do not become common knowledge or become generally available to the public. Any trade secret should only be shared with a recipient after entering into an NDA.

Trade secrets in general

TIPS AND WATCH-OUTS

- **Identify and enumerate assets, including but not limited to recipes, formulas, proposals, know-how, programs, drawings, and databases containing confidential customer information, that could qualify as trade secrets.**
- It is recommended to **establish a trade secret policy** within your organization to mitigate the risk of confidential information misuse, potentially leading to the loss of trade secrets.
- Take **proactive measures** within your organization to safeguard trade secrets effectively.
- **Raise awareness among your employees** regarding the significance of maintaining confidentiality in handling sensitive information.
- Prior to sharing confidential information or initiating negotiations, **enter into non-disclosure agreements with third parties to ensure the protection of sensitive data.**

Tips & tricks and Takeaways

- **Start protecting your IP before entering the market.**
- **Develop a strategy to enhance the protection of your IP.**
- **Conduct preliminary IP research, even in destination countries.**
- **Manage your first filing, including the national one, and seek assistance in preparing the application.**
- **Secure your brand even in local writing (transliteration).**
- **Collect all documents related to brand usage and create a database with all relevant materials.**
- **Monitor markets and competitors' behaviors to be ready for a response.**
- **Activate a global surveillance system through your trademark consultant or lawyer.**
- **Monitor IP bulletins and legal actions.**
- **Verify the compliance of contracts that stipulate local legislation as applicable law.**



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South-East Asia – Snapshot of our joint publications



- 1 The importance of trade mark protection
- 2 How to manage your trade mark portfolio through the Madrid system
- 3 SME case studies
- 4 Take-away messages
- 5 Glossary of terms
- 6 Related links and additional information

1. The importance of trade mark protection

What is protectable as a trade mark?

A trade mark is a sign that is capable of distinguishing the goods or services of one undertaking from those of others.

- In general, it is possible to distinguish several trade mark categories:
 - word marks consist exclusively of words, letters, numerals and other standard typographic characters;
 - figurative marks consist exclusively of figurative elements;
 - figurative marks containing word elements are signs with a combination of word and figurative elements;
 - shape marks consist of a three-dimensional shape;
 - shape marks containing word elements are shape marks containing verbal elements;
 - position marks protect the specific way in which the mark is placed on or affixed to the product;
 - pattern marks are signs where a set of elements are regularly repeated.

Some trade mark systems grant protection to non-traditional trade marks. This special category includes marks that differ from the usual concepts (i.e. words, logos, signs, letters or combinations of letters), such as colours, 3D symbols, 3D sounds, 3D scents and 3D vibrations. Although non-traditional marks exist across the world, not all countries allow them to be registered. For example, sounds are registrable as marks in Ireland, China, France, Indonesia, Malaysia, Singapore, Thailand, Argentina, Bolivia, Chile, Colombia, Costa Rica, the Dominican Republic, Ecuador, El Salvador, Guatemala, Mexico, Nicaragua, Panama, Paraguay, Peru, Uruguay and Venezuela. Scents are protected in Malaysia, Singapore, Argentina, Bolivia, Colombia, the Dominican Republic, Ecuador, El Salvador, Guatemala, Mexico, Nicaragua, Panama and Peru. In Argentina, Malaysia and Singapore, it is also possible to register motion as trade marks. Although not all countries can be registered as trade marks in Indonesia, Malaysia, Singapore and Vietnam.



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Protecting your IP at Trade Fairs

Note that the section 'The China, India, Latin America and South-East Asia IP SME Helpdesk' also provides information on the European Intellectual Property (IP) Rights at Trade Fairs (IPRT) project. This project is a joint effort of the European Commission and the Intellectual Property Office (IPO) in London. The project aims to provide SMEs with a checklist and an online tool to protect their IP at trade fairs. The project also provides information on the IPRT project. The project aims to provide SMEs with a checklist and an online tool to protect their IP at trade fairs. The project also provides information on the IPRT project.

1. INTRODUCTION

The guide provides an overview of intellectual Property (IP) protection strategy for IP SMEs operating in the IP SME Helpdesk region and offers a few tips on how to protect your IP at trade fairs. The guide also provides information on the IPRT project. The project aims to provide SMEs with a checklist and an online tool to protect their IP at trade fairs. The project also provides information on the IPRT project.

From a protection point of view, although attending a trade fair or an exhibition can be a great opportunity for SMEs, it also carries the risk that your IP will be infringed. Therefore, it is important to take steps to protect your IP before attending a trade fair. This guide is a helpful tool to help you do this. It provides information on the IPRT project. The project aims to provide SMEs with a checklist and an online tool to protect their IP at trade fairs. The project also provides information on the IPRT project.



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1. INTRODUCTION

Purpose of this guide

This guide is for enterprises interested in pursuing patent applications under the Patent Cooperation Treaty (PCT). It specifically targets small and medium-sized enterprises (SMEs) wanting to protect their inventions in a simple and cost-effective way at an international level. The guide provides a detailed overview of the first phases of the PCT application procedure and outlines the costs and requirements of the national phase in Latin America, China and South-East Asia. The guide also discusses the role of the European Patent Office (EPO) under the PCT.

Why do you need a patent strategy

Sustained product innovation and product quality standards substantially contribute to a company's reputation on the market. Moreover, more and more companies build their reputation around the ability and willingness to innovate. Intellectual property rights (IPRs) and especially patents can significantly contribute to making a name for one's company and reinforcing its innovative image which is particularly important when entering new markets.

A diversified IP portfolio and an efficient marketing strategy serve as a good basis for acquiring customers' loyalty, brand name and reputation, resulting in an increased value of the company and improved future profitability. Although SMEs often have limited time and resources to dedicate to obtaining IP protection, patents together with other IPRs can strongly benefit your businesses in both domestic and international markets. IPRs as intangible assets are a key factor in the competitiveness of SMEs in the global economy. They are also instrumental for securing a return on investments in innovation and are particularly relevant to SMEs as they internationalise their business.

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