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Protecting Your IP at Trade Fairs in ASEAN

Trade fairs provide intellectual property (IP) owners with a forum to present their innovations and ideas to potential business partners and customers. They also offer the opportunity to learn from and collaborate with other innovators. Disclosing your innovations to the public in this way does, however, leave you exposed to third parties replicating and infringing on your IP.

In the following article, we will elaborate on steps that IP owners can take before, during, and after a trade fair to minimize this risk and better protect their IP.

Advance Planning

Geography. It is advised to protect your IP both in your own local jurisdiction and in the foreign markets you trade in. In relation to patents, designs, and trademarks, this means filing for registration. For copyrights and trade secrets, this usually means ensuring you can prove ownership (and in some countries, it is possible to record these as a means of proof).

Trade fairs are attended by local and foreign exhibitors, who open up and disclose their IP to a wide audience. It is strongly advised that a few hundred dollars (perhaps more for a patent) to file a trademark or design application is certainly worthwhile.

Timing. If you are unable to obtain registration in time, this should not dissuade you from applying for protection in the time leading up to the trade fair. Once your IP has been registered, it is then possible to take action against infringers (e.g., by obtaining an injunction or recovering damages). It may also be possible to notify an infringer by referring to a pending application.

It is essential that you incorporate an IP protocol into your normal business operations if you are an innovative company. Such a protocol should regularly check for new IP, and then consider whether and where to file for such IP.

Preparations. When preparing your exhibition materials, it is advised to notify the public—where appropriate—of your IP ownership. This can be done by using ©, TM, ®, or the “Patent Pending” and patent issue number.

It is also wise to research the trade fair organizer’s material as much as possible to:

- ▶ have, if needed, an IP or business center that may be able to provide assistance or advice during the trade fair;
- ▶ review carefully the terms and conditions of the trade fair;
- ▶ be able to liaise with a local lawyer and provide that lawyer with a Power of Attorney (three to four months in advance) and other proof of IP ownership so that legal action can be taken swiftly, if necessary; and
- ▶ obtain the list of exhibitors and make a note to check their stands.

Attending the Trade Fair

When attending the trade fair, you need to determine how much of your IP to disclose. Much of this depends on

commercial considerations such as whether your product is genuinely marketable. A disclosure that is made too early may result in others seeing the nascent innovation and improving on it, claiming the innovation as their own. This is a common practice and one that is usually legal.

Exhibitors should apply for patent or design protection covering their innovation beforehand. Once this has been applied for, they can exhibit without falling foul of one of the patentability requirements of “novelty.” You can disclose certain elements of your inventions, but it is advisable to check with a patent lawyer or patent agent if you are uncertain as to whether your exhibition may prevent you from obtaining a patent in the future.

Visiting Trade Fairs—Summary of Best Practices

1. Save or collect all trade fair material and exhibitor information.
2. Take as many photos as you can.
3. Gather as much technical data as possible about your competitors and their products.
4. Do not threaten legal proceedings without the advice of a local lawyer. Groundless threats could result in being counter-sued.
5. If you suspect an infringement, immediately seek the advice of local counsel.

Involve the organizers of the trade fair if you believe it would assist your case.

Taking Action against an Infringer

There are several measures of enforcement that can be taken against infringers:

Notification letter. This letter notifies the infringer of your IP rights. You may wish to include a statement that you are willing to discuss the issue or license the IP to them.

Cease-and-desist letter. This letter usually threatens legal proceedings and demands that the infringer ceases and desists from infringing on the IP in question. It is possible to ask for damages and legal costs in such letters.

Raid or “search-and-seize” actions. Raids are usually carried out *ex parte*. The procedure and relevant authority will be different in each ASEAN nation, but they can usually be done on two to three days’ notice. Civil search-and-seize orders from courts in such cases across ASEAN are rare, but not unheard of.

Investigate the infringer. Investigations can reveal crucial information ahead of a trial.

Issue legal proceedings. This is often a last resort. Awards from the court to recover legal costs are generally very rare in ASEAN.

Alternative dispute resolution. Some countries in ASEAN will offer mediation or arbitration services.

Identifying a Business Partner at Trade Fairs

Before conducting further business and disclosing more information—some of which may be confidential—you may consider requesting the other party to sign a nondisclosure agreement (NDA) to help protect you against trade secret theft and to demonstrate that you have not disclosed your full invention (e.g., for the purposes of maintaining novelty for a patent application).

It is not possible to conduct substantive due diligence at a trade fair, and so it is unwise to enter into large-scale agreements without first checking on your potential partner. If the parties insist on some form of written record on which to base a future agreement, then a Memorandum of Understanding and an NDA can be entered into.

Summary

Trade fairs present huge opportunities for collaboration and progressive business, but at the same time, they present a degree of risk in the form of IP theft and consequent incremental innovation. With a robust and well-prepared approach, immense value can be derived from trade fairs. 🏠