

Lex Mundi ASEAN IP Guide

Overview of Regulatory
Framework for Patent and
Trademark Protection in the
ASEAN Countries

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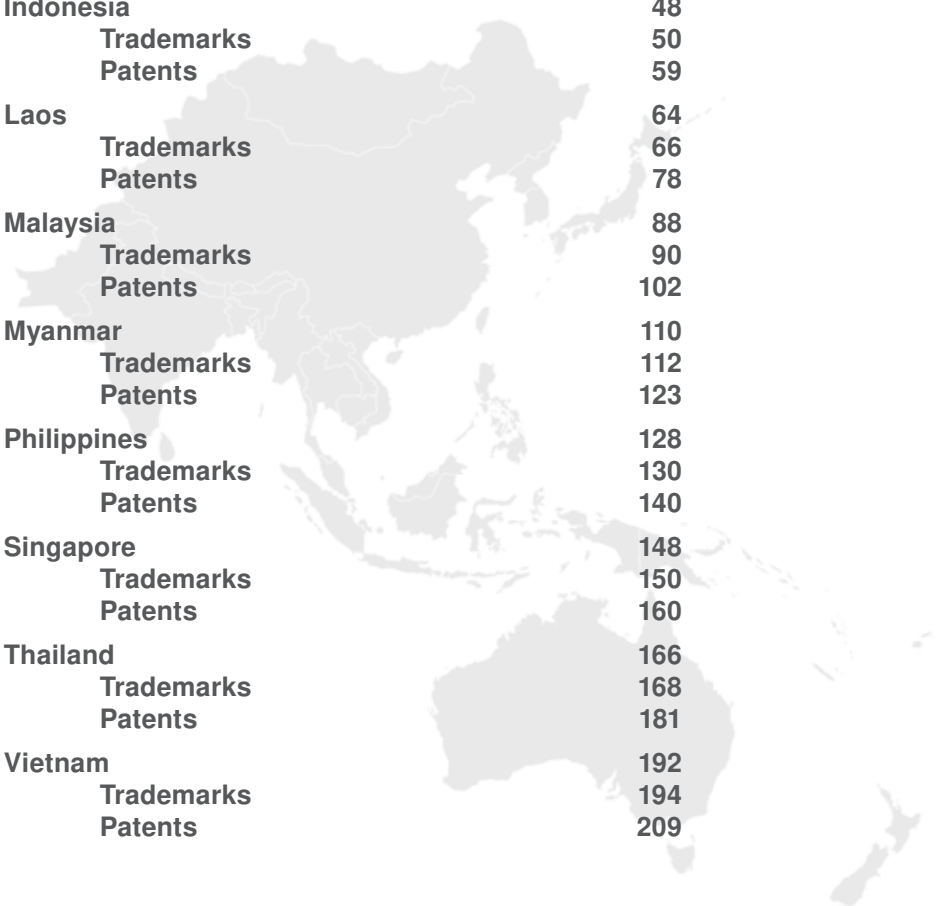
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Please note that the information in this publication is not intended to represent a comprehensive guide nor formal legal advice on the matters covered but rather to provide a general overview on the subject. It should only be used as an indication. Any required legal advice should always be sought from the appropriate Lex Mundi member law firm.

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About This Guide

With the growing trend of cross border and digital business, small and large companies around the world are continuously assessing new markets for their products and services. The rapid growth of the consumer market in the ASEAN countries has attracted more businesses to explore this region. Similarly, small and medium enterprises in ASEAN countries are keen to venture beyond their local market into the regional one.

The relative strength and accessibility of intellectual property rights (IPRs) protection in prospective markets is an important consideration for most businesses when venturing beyond their shores. Value is increasingly ascribed to intellectual assets such as brands, know-how and technology as opposed to a focus on tangible assets alone.

When it comes to the member countries of ASEAN, there are certain procedural peculiarities and varying levels of protection available for IPRs in each country, although to a large extent all either have or are in the process of entering into and ratifying various international IPR conventions and treaties which will eventually make the process in each more streamlined.

With this background in mind, Lex Mundi member firms have collaborated to produce this ASEAN IP Guide for the benefit of existing and potential investors who wish to obtain some basic understanding of how to obtain protection for their IPRs in the ASEAN member countries. This guide aims to provide an overview of the regulatory framework for the protection of trademarks and patents systems and the respective enforcement rights in each of the ASEAN countries.

The guide is laid out in a Q&A format, for convenient reading and easy understanding of key aspects of the protection and enforcement of trademarks and patents in each of the ten ASEAN countries. It also allows for easy comparison of the law and related procedures in each jurisdiction.

This guide is not exhaustive, as it would be impossible to explain succinctly the numerous and nuanced differences in each jurisdiction. By covering the main areas of interest, it is hoped that we have helped you and your business take steps towards better securing your patents and trademarks in the ASEAN region.

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Brunei

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About The Firm

Skrine is one of the largest full-service law firms in Malaysia with a depth of experience in a range of legal matters acquired through its more than 54 years of practice. The firm is currently led by 48 partners with over 100 lawyers across the Corporate, Dispute Resolution and Intellectual Property Divisions.



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Skrine's IP Division advises on the overall protection and management of intellectual property rights. In this regard, the lawyers act as IP consultants for their clients. The lawyers are all qualified Advocates and Solicitors and several of them are also registered trade mark, patent and industrial design agents with rights of audience before the different intellectual property registries and also the Courts in West Malaysia.

Foreword

Brunei signed the Agreement on Trade-Related Aspects of Intellectual Property (TRIPs) on April 1994. TRIPs came into force on 1 January 1995. Brunei passed IPR legislation to meet its TRIPs commitments which took effect on January 1, 2000.

The current IPR framework is as follows: the Trade Marks Act (Cap 98), Inventions Act (Cap 72), Patents Order 2011, Emergency (Copyright) Order 1999, the Emergency (Layout Designs) Order 1999 and the Emergency (Industrial Designs) Order 1999, Plant Varieties Protection Order 2015. IP owners could take civil proceedings or in some cases, criminal sanctions are imposed to protect their rights. Brunei does not have a strong track record in IPR enforcement due to lack of capacity and enforcement agencies do not have police powers under the respective IP legislation.

Trademarks

Trademark protection in Brunei is governed by the Trade Marks Act, Cap 98 which came into force on 1st June 2000 and its subsidiary legislation, the Trade Mark Rules, which also came into force on the same date. It is useful to bear in mind that the legislation was adopted from the English Trade Mark Act 1994. Trademark is defined under the legislation as any visually perceptible sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings; and it may consist of words, designs, letters, numerals or the shape of goods or their packaging.

Brunei Darussalam is a member of the Paris Convention, which not only adopts the concept of “priority” for trademark applications, but also affords protection for persons in a member state of the Convention in terms of unregistered marks that are “well known” in a member state of the Convention, provided that the person is domiciled in a member state of the Convention or has a “real and effective” industrial or commercial establishment in a member state. Further, Brunei Darussalam has just recently acceded to the Madrid Protocol on 6 January 2017.

To obtain protection, the mark has to be registered with the Brunei Intellectual Property Office. Brunei Darussalam adopts a multi-class application system which means that for purposes of renewal, the registered mark will be considered as one application. Brunei Darussalam also follows the International Classification of Goods and Services Systems under the Nice Agreement (11th Edition). To register the trademark, the applicant will need to make an application for registration to the registrar of trade marks with form TM1, together with a prescribe application fee of BND 150 for each class of goods or services in which registration is sought. Upon registration, the duration of protection is for an initial period of 10 years, after which it can be renewed every 10 years indefinitely provided that the registration has not expired and the renewal application made, and renewal fees paid, 6 months prior to the expiry.

Patents

A patent is an exclusive right granted for an invention, which can be a product or a process that gives a new technical solution to a problem. The patent protection regime in Brunei Darussalam is governed by the Patents Order 2011 and the Patents Rules 2012. Brunei Darussalam is a member of the Patent Cooperation Treaty (PCT) for the International Filing of Patent and the Paris Convention. The former makes it possible to seek patent protection for an invention simultaneously in each of a large number of countries by filing an international patent application, while the latter allows Brunei Darussalam to follow the “priority” concept which enables inventors to use the filing date of the first application made in any Paris Convention signatory states if they are made within 12 months after the original application.

Brunei Darussalam is also part of the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure, the significance of which is that it eliminates the need for a depositor to deposit the microorganism in each country in which protection is sought but instead to deposit the microorganism once with a depositary authority, thereby saving money while increasing security. Further, Brunei Darussalam is also a member of ASEAN Patent Search & Examination Cooperation (ASPEC) which allows applicants in participating countries to obtain corresponding patents faster and more efficiently.

Patent protection is obtained by registration with the Brunei Intellectual Property Office. In order to be registrable, the invention must be new, involve an inventive step, be capable of industrial application and must not encourage offensive, immoral or anti-social behaviour. The invention must also not fall under categories of inventions which cannot be registered, namely an invention of a method of treatment of the human or animal body by surgery or therapy or of diagnosis practiced on the human or animal body. The invention can be registered by filing an application containing a request for the grant of a patent (Patents Form 1), a specification containing a description of the invention and an abstract, and also the application fee payable within a month of the date of filing.

Once registered, the duration of the protection will be for a period of 20 years from the date of filing the application, subject to payment of annual renewal fees. The patent owner may lose his rights if the annual renewal fees are not paid. It should be noted that although the registration system in Brunei Darussalam is not restricted on grounds of nationality or residency, a foreign application is nevertheless required to be filed through an authorised representative with a local address in Brunei Darussalam.

Trademarks

Trademark Rights and Protection in Brunei

General

1. What is the system for trademark protection in Brunei?

- Registration Common law
 Co-existing rights under registration and common law

2. Does first to use or first to register have prior rights in Brunei?

- First to use First to register

3. Is Brunei a member of the Madrid Union and the Paris Convention?

- Madrid System Paris Convention

4. If Brunei is a member of Madrid Union is it a party to the Agreement or the Protocol and are there any peculiarities in relation to the implementation of the Madrid System for international registration in Brunei?

Brunei has made the declaration referred to in Article 5(2)(b) and (c) of the Madrid Protocol. Under this provision, the time limit to notify a provisional refusal of protection is extended to 18 months, and a provisional refusal resulting from an opposition may be notified after the expiry of the 18-month time limit.

Brunei also made a declaration referred to in Article 7(2) of the Madrid Protocol requiring applicants to sign a declaration of intention to use the mark.

Trade Mark Registration

A. Registration System

5. What are the benefits of registering a trade mark in Brunei?

- Prevails over common law rights
 It is the only form of protection available for trademarks
 Entitles the proprietor to bring an infringement action
 Others: _____

6. Is it possible to obtain registration for the following types of marks under the registration system in Brunei?

a. Service marks

- Yes No

b. Defensive marks

- Yes No

If yes, what are the requirements?

c. Collective marks

- Yes No

If yes, what are the requirements?

The applicant must file the copy of the regulations governing the mark within 9 months.

d. Certification marks

- Yes No

If yes, what are the requirements?

The applicant must file the copy of the regulation governing the mark within 9 months.

e. Well-known marks

(i.e. registration of a mark as a well-known mark and not an ordinary trademark)

Yes No

If yes, what are the requirements?

Protection is provided to the proprietor of a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark. Such a mark is defined as a mark which is well known in Brunei as being the mark of a person who is a national of a Convention country or who is domiciled in or has a real and effective industrial or commercial establishment in, a Convention country, whether or not that person carries on any business, or has any goodwill in Brunei.

f. Series marks

Yes No

If yes, what are the requirements?

Section 42 of the Trade Marks Act, Cap 98 ("the Act") provides that a series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.

g. Marks in different language or characters other than Roman characters

Yes No

If yes, what are the requirements?

Rule 20 of the Trade Mark Rules provide that where a trade mark contains or consists of a word or words in characters other than Roman or in a language other than English or Malay, there shall, unless the Registrar otherwise directs, be endorsed on the application form:

- (a) A translation and, if the case requires, a transliteration, of each word in English to the satisfaction of the Registrar; and
- (b) The language to which each word belongs. The Registrar may at any time require a copy of the translation or transliteration, certified or verified to the satisfaction of the Registrar, to be filed with the Registrar.

h. Non-traditional marks: Sound marks

Yes No

If yes, what are the requirements?

There are no guidelines given by the Brunei IP office yet. The Act was amended on 26 January 2017: The word "visually" has been deleted from the definition of trademarks, opening the door for the Brunei Registry of Trade Marks to be able to accept non-traditional marks such as sound and smell marks.

i. Non-traditional marks: Smell marks

Yes No

If yes, what are the requirements?

There are no guidelines given by the Brunei IP office yet as the amendment to allow smell marks is a recent amendment.

j. Non-traditional marks: Position marks

Yes No

If yes, what are the requirements?

There are no guidelines given by the Brunei IP office yet due to the recent amendment (see 6h).

k. Non-traditional marks: Colour marks

(i.e. registration of a single colour or a combination of colours)

Yes No

If yes, what are the requirements?

There are no guidelines from the Brunei IP office. It may be useful to consider the Singapore IP office's requirement which may be applicable:

A representation of the colour mark needs to be shown on the application form. It is recommended that the applicant includes on the application form, a designation from an internationally recognised identification code where the colour or shade exists in the coding system.

An appropriate description should also be included in the application form to indicate whether the mark consists of the colour(s) applied to the goods or their packaging or to other commercial item. Where colour is applied to the whole (or substantially the whole) surface of the object in question, a statement

in words to this effect will suffice. In other cases a picture or diagram may be necessary to identify the area(s) of the item to which the colour(s) is/are applied.

I. Non-traditional marks: Shape or three-dimensional marks

Yes No

If yes, what are the requirements?

It must be stated in the application form that it is a shape or 3-dimension mark.

There are no guidelines given by the Brunei IP office but we are of the view that Singapore Intellectual Property Office's guideline may be applicable:

The representation of a shape trade mark (referred herein as "shape mark") should where practicable, be in the form of a perspective or isometric drawing that shows clearly all the features of the shape mark.

The parts of the configuration claimed to constitute the shape mark should be shown in solid lines, while the unclaimed parts, if any, should be shown in broken lines.

The relationship between the description and graphical representation of the shape mark must be clearly spelled out, for example by including a cross reference to the graphical representation in the description. It is important to note that such a description is an integral part of the graphical representation of the shape mark.

m. Others:

7. Is it possible to claim a colour limitation?

Yes No

If yes, what are the requirements?

A colour limitation would limit the owner's right to the colour claimed in the application form and it may also be taken into account when considering the distinctiveness of the mark.

8. What is the official name of the trademark office in Brunei?

Brunei Intellectual Property Office (BrulPO).

B. Trade Mark Filing

9. What are the documents and information required for filing a trade mark application in Brunei?

- Name and address of the applicant
- Representation of the trade mark
- Goods and services and the class(es) for which the trade mark is to be registered
- Certificate of Incorporation (if the applicant is a company)
- Statutory Declaration
- Power of Attorney
- Others:
 - A TM22 form to appoint an agent is also required to be filed with the application.

10. Can a trade mark application be based on intent to use in Brunei?

Yes No

If yes, please specify any conditions:

There should be genuine use of the trade-mark within 5 years the mark is put on the register, otherwise it may be liable to revocation proceedings.

11. Is priority claim allowed in Brunei?

Yes No

If yes, what are the requirements?

Details of the priority claim is required to be stated in the application form (TM1) and unless it has been filed at the time of the filing of the application for registration, there shall be filed, within three months of the filing of the application, a certificate by the registering or other competent authority of that country certifying, or verifying to the satisfaction of the Registrar, the date of the filing of the application, the country or registering or competent authority, the representation of the mark, and the goods or services covered by the application.

12. Are multi-class applications permitted in Brunei?

Yes No

If yes, is there a maximum number of classes that can be applied for?

No maximum number of classes.

13. Does Brunei adopt the Nice Classification for specification of goods and services?

Yes No

If yes, please specify the edition:
11th Edition.

14. Are there any specific requirements in relation to the classification of goods and services in Brunei?

a. Must the specification of goods and services be limited to items from the list of goods and services under the Nice Classification only?

Yes No

b. Can the class heading be included in the specification?

Yes No Subject to conditions
Please specify:

c. Are there sub-classes of goods and services applied by the trademark office in Brunei?

Yes No

If yes, please elaborate:

d. Others:

C. Trade Mark Examination

15. What marks, signs, representations, emblems or words are specifically prohibited from registration in Brunei?

- Signs contrary to morality or public order
- Signs of such a nature as to deceive the public

- Signs benefiting protection from other international convention (e.g. Red Cross, Olympic symbols)
- Signs protected by national laws (e.g. royal emblems)
- Others: _____

16. Is there substantive examination of trademarks?

Yes No

If yes, what are the grounds?

- Absolute grounds
- Relative grounds

Others: _____

17. Is substantive examination conducted before or after publication of a trademark for opposition by third parties?

Before publication After publication

18. What are the absolute grounds for refusal?

- Mark consists of a non-invented word(s)
- Mark has direct reference to the character or quality of the goods or services
- Mark is not distinctive
- Mark consists of a geographical name
- Mark consists of a surname
- Mark consists of letters of the alphabet
- Mark consists of numerals
- Mark consists of geometric shapes
- Others: _____

19. What are the relative grounds for refusal?

- There is a prior application for registration or registration for an identical or confusingly similar mark in relation to the same goods or services as the subject mark
- There is a prior application for registration or registration for an identical or confusingly similar mark in relation to similar goods or services (although in different class) as the subject mark
- Well known mark: There is a well-known mark which is identical or so nearly resembling the subject mark for the same goods or services as the subject mark

- Well known mark: There is an earlier registered mark which is well known for different good or services and use of the subject mark would indicate a connection between goods or services covered by the subject mark with the proprietor of the well-known mark
- Others: _____

20. Is there a right of appeal?

- Yes No

If yes, please describe:

Notice of appeal against a Registrar's decision to the Court shall be forwarded to the Registrar within one month of the date of the Registrar's decision which is the subject of the appeal accompanied by a statement in writing of the appellant's grounds of appeal and of his case in support of the appeal.

An appeal lies against the High Court's decision to the Court of Appeal within one month of the decision. A notice of appeal is required to be filed in that one month and a petition of appeal is required to be filed one month from when a notice is given by the Registrar that the notes of proceedings are available. An extension of time has to be applied before the expiration of the stated timelines. An appeal filed out of time may be allowed in limited circumstances.

An appeal may lie from the Court of Appeal's decision to the Privy Council provided certain conditions are satisfied.

D. Publication and Opposition

21. Is there an opposition procedure upon publication?

- Yes No

22. How long is the opposition term once the trade mark application is published in Brunei?

3 months

23. Is the opposition term extendible?

- Yes No Others: _____

24. Who may initiate opposition proceedings?

- Any person
- Anyone with a legitimate interest
- Any competent authorities
- Others: _____

25. What are the usual grounds for opposition?

- Prior use of a mark which is identical or confusingly similar to the opposed mark
- Prior registration of a mark which is identical or confusingly similar to the opposed mark
- Bad faith in application for registration of the opposed mark
- Applicant is not the rightful proprietor of the opposed mark
- If the opposed mark is identical with or so nearly resembles the Opponent's mark which is well-known in Brunei for the same goods or services
- If the opposed mark is identical with or so nearly resembles the Opponent's mark which is well-known and registered in Brunei for goods or services not the same as those claimed in the opposed mark; provided that the use of the opposed mark in relation to the goods or services claimed would indicated a connection between those goods or services and the proprietor of the well-known mark, and the interests of the proprietor of the well-known mark are likely to be damaged by such use
- Opposed mark lacks distinctiveness
- Lack of intention to use the opposed mark
- Opposed mark consists of false geographical indication
- Use of opposed mark likely to cause confusion or deception
- Others: _____

E. Timeline

26. What is the time period from application to registration for a straightforward trademark application in Brunei?

- Between 6 months - 12 months
- Between 12 months - 18 months
- 18 months above

27. Is there any process for accelerated/ expedited examination of trade mark applications?

- Yes No

If yes, what are the requirements?

Maintenance of Trademark Registration

A. Renewal

28. Is there a mechanism to renew a trade mark registration in Brunei?

- Yes No

If yes, how long is the validity of the renewal?

10 years

29. Is late renewal of a trade mark registration permissible in Brunei?

- Yes No

If yes, what are the conditions?

A request for renewal is required to be filed within 6 months from the date of the last expiration of the registration together with any additional renewal fee.

30. Are there any provisions to restore a lapsed registration?

- Yes No

If yes, what are the conditions:

The proprietor must file the request in TM9 within 6 months of the date of the removal of the mark accompanied by the appropriate renewal fee and appropriate restoration fee to restore the mark to the register and renew its registration if, having regard to the circumstances of the failure to renew, the Registrar is satisfied that it is just to do so.

B. Use Requirement

31. Does evidence of use need to be submitted to the trademark office at any time in order to maintain an application for registration or a registration of a trademark in Brunei?

- Yes No

If yes, what are the requirements?

C. Rectification/Cancellation

32. Are rectification or cancellation proceedings available in Brunei?

- Yes No

If yes, what is the forum?

Either the Registrar or the Court.

33. What are the grounds for rectification or cancellation proceedings?

- Any entry made in the Register without sufficient cause

- Any entry wrongfully remaining in the Register

- Non-use of the mark

- Others: _____

34. When would a presumption of validity arise in relation to a trademark registration?

- [10] years from ~~date certificate of registration issued~~ / date of application

- No such presumption

35. When are the grounds for rectification or cancellation proceedings assessed?

- At the time of filing of the application

- At the time of issuance of the certificate of registration

- At the time of the application for rectification or cancellation proceedings

- Others: _____

36. When is a trade mark registration vulnerable to cancellation on grounds of non-use?

- [] years from the deemed date of registration
- [5] years from the date of certificate issuance
- Not applicable
- Others: _____

37. Who bears the burden of proof in a non-use cancellation action?

- Applicant for cancellation
- Defendant / Respondent (trademark owner)

38. If the answer to the above is the Applicant, what are the examples of evidence which can be relied on to support an application for cancellation for non-use?

- Full market survey conducted by an independent or professional surveyor of an appropriate sample size
- Simple market survey or enquiries in the trade
- Declaration from the applicant for cancellation
- Others: _____

D. Assignment, Transmission and Licensing

39. Are there any mechanisms to record assignment of a trade mark in Brunei?

- Yes No
- If yes, what are the grounds?*

The certified true copy of the deed of assignment signed by or on behalf of the parties to the assignment is required to be filed with the Registry.

40. Are there different requirements for recording assignment with or without the goodwill of the business?

- Yes No
- If yes, what are the requirements?*
- _____

41. Are there any mechanisms to record transmission of a trade mark in Brunei, for example transmission by way of merger?

- Yes No

If yes, what are the requirements?

To provide documents evidencing the merger or other grounds giving rise to the transmission.

42. Are trade mark licensees required to record themselves with the Registrar?

- Mandatory Recommended No

If yes, what are the requirements?

A licence is not effective unless it is in writing and signed by or on behalf of the grantor.

E. Change of Particulars

43. Should any change in the name or address of the proprietor on record of a registered trademark be updated on the register?

- Yes No

If yes, what are the requirements?

It is advisable to file a TM13 form to record any change of particulars.

44. Is it possible to change the representation of a registered trade mark?

- Yes No

If yes, what are the requirements?

The Registrar may, on the application of the proprietor, allow the alteration of a registered trade mark where the mark includes the proprietor's name or address and the alteration is limited to alteration of that name or address and does not substantially affect the identity of the mark.

45. Is it possible to correct and rectify any errors on the Register?

- Yes No

If yes, what are the requirements?

Any person having a sufficient interest may apply for rectification. The rectification of an error or omission in the register under section 61 shall be made on Form TM 18 together with a statement of the grounds on which the application is made. The application for rectification can also be made to the Court.

Enforcement

46. What are the available enforcement methods in Brunei?

- Civil enforcement
- Infringement action
 - Passing off
- Criminal enforcement
- Border or other administrative enforcement measures

47. What are the requirements to bring an action for infringement of trademark?

- Valid registration of the trademark
- Unauthorised use by a 3rd party in the course of trade of a mark which is:
- Identical to the registered trademark
 - So nearly resembling the registered mark as is likely to cause confusion
 - In relation to the goods or services for which the proprietor's mark is registered
 - In relation to goods or services which are similar to the goods or services for which the proprietor's mark is registered though not the same

If yes, what are the criteria?

- (a) The registered trade mark must have had a reputation; and
- (b) The use of the sign must be with out due cause and must take unfair advantage of or be detrimental to the distinctive character of the repute of the trade mark.

48. For a trademark infringement action, is it necessary to establish

- Actual confusion?
- Likelihood of confusion?

49. For a trademark infringement action, is it necessary to establish damage or loss to the proprietor of the trademark?

- Yes No Others

If yes, what are the requirements?

50. Is there a period of limitation for filing a suit for trade mark infringement?

- Yes No

If yes, what is the time period?

6 years from the date of the infringement.

51. What are the remedies available for an infringement action?

- Damages or account of profits
- Injunction
- Delivery and/or destruction of the infringing goods
- Others: _____

52. Is it possible to claim for 'passing off' in Brunei?

- Yes No

53. If yes, what are the criteria to establish 'passing off'?

- That the proprietor has goodwill and reputation in the trademark

a. Must the goodwill and reputation subsist in Brunei i.e. goodwill and reputation outside Brunei will not be taken into consideration?

- Yes ◦ No

b. Must there be actual use or business presence in Brunei?

- Yes ◦ No

c. What is the usual form of evidence used to establish such goodwill and reputation?

Evidence of sales such as invoices, purchase orders, delivery orders and/ or receipts.

- That there is misrepresentation caused to members of the public

a. Is it necessary to establish actual confusion or is likelihood of confusion sufficient?

- Actual confusion
 Likelihood of confusion

b. What is the usual form of evidence used to establish such misrepresentation?

Members of the public giving evidence or actual evidence of deception.

- That there are damage/likelihood of damage

a. Is it necessary to establish actual damages or is likelihood of damage sufficient?

- Actual damage
 Likelihood of damage

b. What is the usual form of evidence used to establish such damage or likelihood of damage?

If the goods in question are in direct competition with one another, the court will readily infer the likelihood of damage to the plaintiff's goodwill, not merely through loss of sales but also through loss of the exclusive use of his name or mark in relation to the particular goods or business concerned.

- Others: _____

54. Are there other forms of actions or claims that can be brought by a trademark owner against an infringer or unauthorised user?

- Unfair competition Others:
 Competition Order 2015 is not in force in Brunei as yet.

55. What are the elements that need to be established to bring the claim(s) above?

Not Applicable

56. Can a trade mark owner lodge a complaint to any administrative authorities on counterfeit trade mark goods?

- Yes No
If yes, please state the authority:
 Royal Brunei Police Force

57. What are the actions that can be taken by such authorities?

- Conduct a raid
 Seize the infringing goods
 Impose a fine
 Refer for criminal prosecution
 Others: _____

58. Are border measures available to restrict the importation of counterfeit trademark goods?

- Yes No
If yes, what are the measures?
 Detention of goods. The goods can then be forfeited or destroyed by a Court order.

59. Do these border measures apply for counterfeit goods of unregistered trademarks?

- Yes No
 Not applicable, there are no rights for unregistered trademarks in Brunei

60. Is there an authority or ministry responsible for the enforcement of trademark rights?

- Yes No

If yes, please state:

Royal Brunei Police Force and the Royal Customs and Excise Enforcement Unit.

Peculiarities

61. Are there any peculiarities not mentioned above in the system of protection for trademarks in Brunei of which it is important for clients to be aware?

None.

Patents

Patent Rights and Protection in Brunei

General

1. What is the system for patent protection?

- Examination system
 Non-examination system

2. Is Brunei a member of the Patent Cooperation Treaty (PCT)?

- Yes No

3. Is Brunei a member of the Paris Convention?

- Yes No

Patent Registration

A. Registration System

4. What kinds of patent protection are available?

- Inventions Utility models
 Others: _____

5. What kinds of subject matter are excluded from patent protection?

- Methods of medical treatment or diagnosis
 Computer programs
 Business methods
 Others: _____

B. Patent Filing

6. What are the documents and information required for filing a patent application?

- Name and address of the applicant
 Name and address of the inventor
 Specification
 Abstract
 Power of Attorney
 Deed of Assignment (if any)
 Others: _____

7. Is there a fee for extra claims?

- Yes No

If yes, please describe:

B\$20.00 for each claim in excess of 25 claims.

8. Does Brunei require obtaining a foreign filing license before filing a foreign patent application?

- Yes No

If yes, please describe:

Section 33 of the Patents Order 2011 provides that no person resident in Brunei shall without the written authority granted by the Registrar, file or cause to be filed outside Brunei an application for a patent for an invention unless:

- (a) An application for patent for the same invention has been filed in the Registry not less than 2 months before the application outside Brunei; and
 (b) No directions have been given under Section 32 in relation to the application in Brunei or all such directions have been revoked (Section 32 deals with information prejudicial to the defence of Brunei or safety of public).

B.1 Patent Specification

9. In which language must a patent specification be?

- English Others: _____

10. Is it possible to file an application first with an English specification, and then later submit its translation in the official language?

- Yes No

Not Applicable. English specification is required.

B.2 Publication, Amendment and Divisional Application

11. Is it possible to request a deferment of publication?

- Yes No

If yes, please describe:

12. Is it possible to request an early publication?

- Yes No

If yes, please describe:

A request for early publication of an application in accordance with section 27(2) shall be made on Patents Form 9.

13. Does the applicant have a provisional right upon the publication of an application?

- Yes No

If yes, please describe:

Section 74 of the Patents Order 2011 provides that once an application for a patent has been published, the applicant has the same rights to bring proceedings for damages for infringement as if the patent had been granted on the date of publication of the application, in respect of any act which would have been infringed. However, he is only entitled to bring such proceedings once the patent has actually been granted, and only if the relevant act would have infringed both the patent as granted and the claims in the application immediately before the Registry completes the preparations for its publication.

14. When is it possible to file a voluntary amendment to specification?

- At the time of entry into the national phase (for PCT application)
 At any time during prosecution
 At the time of requesting examination
 Others: _____

15. When is it possible to voluntarily file a divisional application?

- At any time during prosecution
 At the time of granting a patent
 Others: _____

16. Is it possible to file a divisional application based on a previous pending divisional application if the parent application has already been granted a patent?

- Yes No

The Brunei Patents Order 2011 does not address such a situation and the situation is currently uncertain.

C. Examination

17. Is there a requirement to submit certain information on corresponding applications, or prior art known to the applicant?

- Yes No

If yes, please describe:

A copy of the search report together with each of the document referred to in the search report.

18. Is there a grace period (exception to novelty)?

- Yes No

If yes, please describe:

Sections 14(4)-(6) of the Patents Order 2011 provide for certain matters to be disregarded for the purposes of determining novelty – if the disclosure was made under certain circumstances, and if within a 12-month “grace period”.

These circumstances include disclosures made as a result of a breach of confidence or where the inventor revealed the invention at an International Exhibition or before a learned society.

19. Is it required to file a request for substantive examination?

- Yes No

If yes, what are the requirements?

21 months from priority date or filing date of the application (if there is no priority date) or an extended deadline of 39 months from priority date or filing date of the application (if there is no priority date).

20. Can a third party file a request for substantive examination?

- Yes No

21. Is there a right of appeal?

- Yes No

If yes, what are the requirements?

Applicant may file a written response to the examiner and or amend the specification within 5 months from the date of the Registrar's notification enclosing the written opinion.

22. Are multiple dependent claims admissible?

- Yes No

D. Opposition

23. Is there an opposition procedure upon publication?

- Yes No

24. How long is the opposition term once the application is published?

- 2 months 3 months
 Prior to the grant Others: Not Applicable

25. Who may initiate opposition proceedings?

- Any person
 Anyone with a legitimate interest
 Any competent authorities
 Others: Not Applicable

E. Timeline

26. What is the time period from application to grant for a straightforward application?

- Between 2 - 3 years
 Between 3 - 4 years
 Others: _____

27. Is there any process for accelerated examination of application?

- Yes No
If yes, what are the requirements?
- _____

Maintenance of Patent

A. Annuity

28. To maintain the validity of patent, is it required to pay an annuity in Brunei?

- Yes No

29. Is late payment of annuity permissible?

- Yes No
If yes, what are the requirements?

- (a) For a filed patent (before grant):
 Late payment of annuity is possible provided the renewal fee and additional fee is paid during 6 months immediately following the end of the prescribed period being 3 months ending with the fourth year from the date of filing (or the succeeding anniversary of the date of filing, as the case may be).
- (b) For a granted patent
 Late payment of annuity is permissible provided the renewal fee and additional fee is paid during the 9 months from the date in which the patent is granted.

30. Is government annuity fixed for each year?

- Yes No
If yes, what is the base for calculation of annuity?
- _____

31. Can annuity be paid once for all years or once for several years?

- Yes No

32. Is power of attorney required for annuity payment?

- Yes No

33. Are there any provisions to restore a lapsed patent?

- Yes No

If yes, what are the requirements?

An application to restore a lapsed patent may be made at any time within 30 months from the day on which the patent ceased to have effect. The Registrar needs to be satisfied that the proprietor of the patent took reasonable care to see that any renewal fee was paid within 3 months from the date the patent was granted or that that fee and any prescribed additional fee were paid within the 6 months immediately following the end of that period, the Registrar shall by order restore the patent on payment of any unpaid renewal fee and any prescribed additional fee.

34. Is patent term extension available in Brunei?

- Yes No

If yes, what are the conditions?

The proprietor of a patent may apply to the Registrar to extend the term of the patent on any of the following grounds:

- (a) That there was an unreasonable delay by the Registrar in granting the patent;
- (b) Where the patent was granted on the basis of prescribed information relating to a corresponding application referred to in section 29(2)(c)(ii), that-
 - (i) there was an unreasonable delay in the issue of the corresponding patent; and
 - (ii) the patent office that granted the corresponding patent has extended the term of the corresponding patent on the basis of such delay;
- (c) Where the subject of the patent includes any substance which is an active

ingredient of any pharmaceutical product, that:

- (i) there was an unreasonable curtailment of the opportunity to exploit the patent caused by the process of obtaining marketing approval for a pharmaceutical product, being the first pharmaceutical product to obtain marketing approval which uses the substance as an active ingredient; and
- (ii) The term of the patent has not previously been extended on this ground.

B. Compulsory Licence**35. Is a compulsory licence available in Brunei?**

- Yes No

If yes, what are the requirements?

Any interested person may apply to the court for the grant of a licence under a patent on the ground that the grant of the licence is necessary to remedy an anti-competitive practice.

36. Can a request for termination of compulsory licence be filed?

- Yes No

If yes, what are the requirements?

Any licence granted under this section may, on the application of any interested party, be terminated by the court where the court is satisfied that the ground upon which the licence was granted has ceased to exist and is unlikely to recur.

C. Use Requirement**37. Does the patentee need to submit evidence of obligation of use to the Patent Office in order to maintain a patent in Brunei?**

- Yes No

If yes, please describe:

38. Is a compulsory licence granted based on failing to perform an obligation to use?

- Yes No

If yes, please describe:

D. Cancellation

39. Are termination or cancellation proceedings available in Brunei?

- Yes No

If yes, what are the grounds?

The Registrar may, on the application of any person, by order revoke a patent for an invention on (but only on) any of the following grounds:

- (a) The invention is not a patentable invention;
- (b) The patent was granted to a person who was not entitled to be granted that patent;
- (c) The specification of the patent does not disclose the invention clearly and completely for it to be performed by a person skilled in the art;
- (d) The matter disclosed in the specification of the patent extends beyond that disclosed:
 - (i) In the application for the patent, as filed; or
 - (ii) Where the patent was granted on a new application filed under section 20(3) or 48(4), or in accordance with section 26(11), in the earlier application made under this Order from which the filing date and the right of priority has been derived, as filed;
- (e) An amendment or a correction has been made to the specification of:
 - (i) The patent; or
 - (ii) The application for the patent, which should not have been allowed;
- (f) The patent was obtained:
 - (i) Fraudulently;
 - (ii) On any misrepresentation; or
 - (iii) On any non-disclosure or inaccurate disclosure of any prescribed material information, whether or not the person under a duty to provide the information knew or ought reasonably to have known of such information or the inaccuracy;

- (g) The patent is one of 2 or more patents for the same invention having the same priority date and filed by the same party or his successor in title.

40. What is the time limit for termination or cancellation?

- 3 years 5 years
 Whole Others: _____
 protection _____
 term of patent _____

E. Assignment, Transmission and Licensing

41. Are there any mechanisms to record assignment of a patent in Brunei?

- Yes No

If yes, what are the requirements?

The deed of assignment must be in writing and it must be signed by parties to the transaction.

42. Are there any mechanisms to record transmission of a patent in Brunei, for example, transmission by way of merger?

- Yes No

If yes, what are the requirements?

To provide documents evidencing the merger or other grounds giving rise to the transmission.

43. Are patent licensees required to record themselves with the Patent Office?

- Yes No

If yes, what are the requirements?

The licence needs to be in writing and signed by both parties to the transaction. A Form 33 would also have to be filed.

F. Change of Details

44. Are there any mechanisms to record change of name or address of the patent proprietor?

- Yes No

If yes, what are the requirements?

Filing a Patents Form 28 form for change of address or name.

45. Is it possible to amend a granted patent?

- Yes No

If yes, what are the requirements?

An application to the Registrar for leave to amend the specification of a patent shall be made on Patents Form 22 and shall be advertised by publication of the application and the reasons for the proposed amendment in the journal.

46. Is it possible to correct and rectify any errors on the patent?

- Yes No

If yes, what are the requirements?

If the Registrar is satisfied that any request to alter or correct any name, address or address for service may be allowed, he shall cause the register, application or other document to be altered or corrected accordingly.

Enforcement**47. What are the available enforcement methods in Brunei?**

- Civil enforcement
 Administrative enforcement
 Criminal enforcement
 Border measures
 Others: _____

48. What are the criteria for infringement?

- Literal infringement
 Infringement under the doctrine of equivalents
 Use of the patent without permission of patent owner
 Others: _____

49. Is there a statute of limitations for filing a suit for patent infringement?

- Yes No

If yes, what is the time period?

6 years from the date of the cause of action accrued.

50. What are the remedies available for an infringement action?

- Damages
 Injunction
 Destruction of the infringing goods
 Others:
 A declaration that the patent is valid and has been infringed.

51. What are the actions taken by such authorities?

- Conduct a raid
 Seize the infringing goods
 Impose a fine
 Others: _____

52. Is there an authority or ministry responsible for the enforcement of patent rights?

- Yes No

If yes, please state:

Brunei Police Force

Peculiarities**53. Are there any peculiarities in the system of protection for patents in Brunei of which it is important for clients to be aware?**

Section 115 of the Patents Order 2011 provides for patents from Malaysia, Singapore and United Kingdom to be re-registered in Brunei in certain circumstances. One example is where an application for patent has been made before 1 January 2012 and the application is pending, the applicant can re-register their patent in Brunei provided it is registered 12 months the date of issue of the grant.

The term of the re-registered patent will be 20 years from the date of grant and not the date of filing.

Cambodia

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Foreword

Protection for trademarks and patents under Cambodian law are in their infancy, but are developing quickly and have seen a lot of positive movement in recent years. The government has shown a determination to improve legislation, prosecution and enforcement and has been making positive steps on all counts. However, a lack of funding and other problems inherent in developing countries make improvement a slow process.

In respect of patents, although Cambodia lacks the infrastructure to properly examine most patent applications itself, bilateral examination mechanisms with Singapore and Japan have been put into place, and patents are now being registered under them with some degree of regularity. Cambodia is also a signatory to the Patent Cooperation Treaty and has signed an Agreement on Validation of European Patents with the European Patent Office. At the time of writing both developments are too recent to have yet had a practical impact. They are expected to have a significant impact in the years to come.

Cambodia's strong history of participation in international treaties, including the Nice Agreement, the Paris Convention, and most recently, the Madrid Protocol, has made the registration of trademarks a relatively straightforward process. Enforcing a protected trademark is less straightforward, however, and although the government has made strong efforts to improve the situation—including the foundation of a dedicated counter-counterfeit commission and several high-profile prosecutions—trademark infringement remains rampant.

In summary, trademark and patent protection in Cambodia are improving, but still have a way to go. Foreign parties seeking to protect and enforce their rights in the market should exercise caution and ensure that they receive thorough, up-to-date, practical, advice on provisions available to them, as they emerge.

Trademarks

Trademark Rights and Protection in Cambodia

General

1. What is the system for trademark protection in Cambodia?

- Registration Common law
 Co-existing rights under registration and common law

2. Does first to use or first to register have prior rights in Cambodia?

- First to use First to register

3. Is Cambodia a member of the Madrid Union and the Paris Convention?

- Madrid System Paris Convention

4. If Cambodia is a member of Madrid Union is it a party to the Agreement or the Protocol and are there any peculiarities in relation to the implementation of the Madrid System for international registration in Cambodia?

Cambodia became a party to Madrid Protocol on 5th June 2015.

Trade Mark Registration

A. Registration System

5. What are the benefits of registering a trade mark in Cambodia?

- Prevails over common law rights
 It is the only form of protection available for trademarks
 Entitles the proprietor to bring an infringement action

Others:

Cambodia adopts the first-to-file rule. Registering a trademark in Cambodia will give the owner exclusive rights to use, assign, or license the registered trademark and to prevent unauthorised use and registration of identical and similar trademarks by other parties.

6. Is it possible to obtain registration for the following types of marks under the registration system in Cambodia?

a. Service marks

- Yes No

b. Defensive marks

- Yes No
If yes, what are the requirements?

c. Collective marks

- Yes No
If yes, what are the requirements?

The requirements for filing application for collective marks are:

- Full name and address of the applicant;
- Trademark specimens (15 specimens) with the size not larger than 80mm x 80 mm and not smaller 50mm x 50mm;
- Translation and transliteration of the mark if the mark is not in English;
- Vienna Code of the device of the mark (if known);
- A list of goods/services and the International Classification of respective goods/services (if known). From January 1, 2007, class heading is not accepted by the Cambodian IPD. The applied goods/services should be specified;

- (f) Priority data for claiming priority right under the Paris Convention (if any), including application number, priority date, country. Original certified copy of the priority application and the English translation can be lodged later, after filing;
- (g) A notarised Power of Attorney from the applicant. The POA should be notarised by a Notary Public. One POA can be used for multiple marks if no particular mark is identified in the POA. A scanned copy of a notarised POA is acceptable at filing, provided that the original is submitted later.

An application for registration of Collective Mark shall be accompanied with a copy of the Regulation of the Management and Use of the Collective Mark;

An application for registration of a collective mark shall designate the mark as a collective mark and shall be accompanied by a copy of the regulation governing the use of the collective mark

Rules on Use and Management of the Collective Mark shall include:

- (a) The names, addresses and titles of the members using the collective mark;
- (b) Principles and procedures for use of the collective mark;
- (c) The quality of the commodity for which the collective mark is used;
- (d) Rights and obligations in connection with the use of the collective mark;
- (e) The liability for members violating the rules of administration and use of the collective mark; and
- (f) The inspection and system of supervisory oversight for the commodity for which the collective mark will be used.

The applicant shall provide written notification of any change in the regulations which affects the governing of the use of collective mark to the Department of Intellectual Property Rights. The regulation shall be translated into Khmer.

d. Certification marks

- Yes No

If yes, what are the requirements?

The requirement for filing applications for certification marks are:

- (a) An oath letter by the applicant not to compete with the production, marketing, or providing service, which is the same or similar to the certified goods or services;
- (b) Proof of legal entity of the applicant;
- (c) Regulations governing the use of Certification Mark, which contains the following information:
 - (i) Standards related to material, source, methodology to produce goods or services, quality, clarity or other features which will be confirmed by the certification mark;
 - (ii) The methodology by the certification mark owner to evaluate compliance with the abovementioned standards;
 - (iii) The mechanism that the certification mark owner will employ to supervise the correct use of the certification mark and the continued compliance with the above standards;
 - (iv) The methodology in which the certification mark will be used on the goods/services;
 - (v) The fees payable to the certification mark owner for the use of the certification mark (if any);
 - (vi) Dispute resolution procedures;
- (d) For foreign applications, an application for registration or the registration certificate of Certification Mark from the country of origin is required;
- (e) Notarised Power of Attorney.

e. Well-known marks

(i.e. registration of a mark as a well-known mark and not an ordinary trademark)

- Yes No

If yes, what are the requirements?

f. Series marks

- Yes No

If yes, what are the requirements?

g. Marks in different language or characters other than Roman characters

- Yes No

If yes, what are the requirements?

If the trademark contains words in a language other than Khmer, English, or French, a translation and transliteration of those words must be supplied at the time of filing the application for trademark registration.

h. Non-traditional marks: Sound marks

- Yes No

If yes, what are the requirements?

i. Non-traditional marks: Smell marks

- Yes No

If yes, what are the requirements?

j. Non-traditional marks: Position marks

- Yes No

If yes, what are the requirements?

k. Non-traditional marks: Colour marks

(i.e. registration of a single colour or a combination of colours)

- Yes No

If yes, what are the requirements?

Distinctive color combination is registrable. However, a color is not registrable in Cambodia.

l. Non-traditional marks: Shape or three-dimensional marks

- Yes No

If yes, what are the requirements?

Distinctive three dimensional marks are registrable in Cambodia.

m. Others:

7. Is it possible to claim a colour limitation?

- Yes No

If yes, what are the requirements?

There are no specific provisions relating to a claim of color. When filing an application with color specimen of mark, the applicant needs to list the colors used in the mark. As such, the mark will be protected in the claimed color form.

In practice, filing the mark in black and white is usually recommended because it will enable the trademark owner to use the mark in a broader way with any colors, and such use can be proved as evidence of use of the mark even if it is in colors other than black and white. In contrast, if the mark is filed with claiming color, the use of the mark in colors other than the claimed color is not considered use of the mark because the mark has to be used in the claimed color form.

8. What is the official name of the trademark office in Cambodia?

The official name of Cambodia's trademark office is the Department of Intellectual Property Rights.

B. Trade Mark Filing**9. What are the documents and information required for filing a trade mark application in Cambodia?**

- Name and address of the applicant
- Representation of the trade mark
- Goods and services and the class(es) for which the trade mark is to be registered
- Power of Attorney
- Others:

An original notarised Power of Attorney must be submitted when filing a trademark application in Cambodia. In cases of a priority claim, an original certified copy of the priority document must be submitted within 3 months from the filing date in Cambodia.

10. Can a trade mark application be based on intent to use in Cambodia?

- Yes No

If yes, please specify any conditions:

The mark does not have to be used before filing in Cambodia. When filing an application, the applicant may:

- (a) Use or intend to use the trademark in Cambodia;
- (b) Authorize or intend to authorize its use in Cambodia;
- (c) Intend to assign the trademark to a body corporate that is about to be constituted, that will use the trademark in Cambodia.

11. Is priority claim allowed in Cambodia?

- Yes No

If yes, what are the requirements?

To claim a convention priority date, the applicant must supply the following details at filing;

- (a) The country(s) applied to;
- (b) The date of the convention applications;
- (c) The number(s) of the convention application(s). (If not available at the time of filing, this must be provided within 3 months from filing or before the registration, whichever comes first.);
- (d) Certified copy of the convention application. (The original certified copy of the priority document must be submitted within 3 months from the filing date in Cambodia).

12. Are multi-class applications permitted in Cambodia?

- Yes No

If yes, is there a maximum number of classes that can be applied for?

Currently, there is no regulation limiting the number of classes per application.

13. Does Cambodia adopt the Nice Classification for specification of goods and services?

- Yes No

If yes, please specify the edition:

Cambodia has adopted the latest version of the Nice Classification. Therefore, Cambodia is now adopting the 11th edition of the Nice Classification.

14. Are there any specific requirements in relation to the classification of goods and services in Cambodia?**a. Must the specification of goods and services be limited to items from the list of goods and services under the Nice Classification only?**

- Yes No

b. Can the class heading be included in the specification?

- Yes No Subject to conditions:
Class heading alone is not acceptable.

c. Are there sub-classes of goods and services applied by the trademark office in Cambodia?

- Yes No
If yes, please describe:

d. Others:

C. Trade Mark Examination**15. What marks, signs, representations, emblems or words are specifically prohibited from registration in Cambodia?**

- Signs contrary to morality or public order
- Signs of such a nature as to deceive the public
- Signs benefiting protection from other international convention (e.g. Red Cross, Olympic symbols)
- Signs protected by national laws (e.g. royal emblems)
- Others:

A mark cannot be registered if any of the following apply:

- (a) If it is a sign that cannot distinguish the goods or service of one enterprise from those of other enterprises;

- (b) If it is identical with, or confusingly similar to, or constitutes a translation of, a mark or trade name which is well known in Cambodia for identical or similar goods or services of another enterprise;
- (c) If it is identical with, or confusingly similar to, or constitutes a translation of a mark or trade name which is well-known and registered in the Kingdom of Cambodia for goods or services which are not identical or similar to those in respect of which registration is applied for, provided that use of the mark in relation to those goods or services would indicate a connection between those goods or services and the owner of the well-known mark that the interests of the owner of the well-known mark are likely to be damaged by such use;
- (d) If it is identical with a mark belonging to a different proprietor and already on the Register, or with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services, or if it so nearly resembles such a mark as to be likely to deceive or cause confusion.

16. Is there substantive examination of trademarks?

- Yes No
If yes, what are the grounds?
- Absolute grounds
 - Relative grounds

Others: _____

17. Is substantive examination conducted before or after publication of a trademark for opposition by third parties?

- Before publication After publication

18. What are the absolute grounds for refusal?

- Mark consists of a non-invented word(s)
- Mark has direct reference to the character or quality of the goods or services
- Mark is not distinctive
- Mark consists of a geographical name

- Mark consists of a surname
- Mark consists of letters of the alphabet
- Mark consists of numerals
- Mark consists of geometric shapes
- Others:

Besides the items mentioned above, the mark will be rejected based on absolute grounds such as:

- (a) If it is incapable of distinguishing the goods or services of one enterprise from those of other enterprises;
- (b) If it is contrary to public order or morality or good custom;
- (c) If it is likely to mislead the public or trade circles, in particular as regards the geographical origin of the goods or services concerned or their nature or characteristics;
- (d) If it is identical with, or is an imitation of or contains as an element, an armorial bearing, flag and other emblem, a name or abbreviation or initials of the name of, or official sign or hallmark adopted by, any State, intergovernmental organization or organization created by an international convention, unless authorised by the competent authority of that State or organization'

19. What are the relative grounds for refusal?

- There is a prior application for registration or registration for an identical or confusingly similar mark in relation to the same goods or services as the subject mark
- There is a prior application for registration or registration for an identical or confusingly similar mark in relation to similar goods or services (although in different class) as the subject mark
- Well known mark: There is a well known mark which is identical or so nearly resembling the subject mark for the same goods or services as the subject mark
- Well known mark: There is an earlier registered mark which is well known for different goods or services and use of the subject mark would indicate a connection between goods or services covered by the subject mark with the proprietor of the well-known mark
- Others: _____

20. Is there a right of appeal?

- Yes No

If yes, please describe:

According to the Law concerning Marks, Trade Names, and Acts of Unfair Competition, a decision of the Registrar at the end of opposition proceedings or a hearing to refuse to register the trademark, or to register it (with or without conditions or limitations), may be appealed to the Appeal Board or to the Municipal Court by the opponent or the applicant. A decision from the Appeal Board can be appealed to the proposed commercial and IP Tribunal. A decision of the Commercial and IP Tribunal or the Municipal Court can be appealed to the Appeal Court. A decision of the Appeal Court can be appealed to the Supreme Court. However, in practice, the Appeal Board will only be available on request by the opponent or the applicant.

D. Publication and Opposition**21. Is there an opposition procedure upon publication?**

- Yes No

22. How long is the opposition term once the trade mark application is published in Cambodia?

3 months - The deadline to file an opposition after the publication of the mark is 90 days from the publication date.

23. Is the opposition term extendible?

- Yes No Others:

For 2 months. The deadline can be extended upon request.

24. Who may initiate opposition proceedings?

- Any person
 Anyone with a legitimate interest
 Any competent authorities
 Others: _____

25. What are the usual grounds for opposition?

- Prior use of a mark which is identical or confusingly similar to the opposed mark
 Prior registration of a mark which is identical or confusingly similar to the opposed mark
 Bad faith in application for registration of the opposed mark
 Applicant is not the rightful proprietor of the opposed mark
 If the opposed mark is identical with or so nearly resembles the Opponent's mark which is well-known in Cambodia for the same goods or services
 If the opposed mark is identical with or so nearly resembles the Opponent's mark which is well-known and registered in Cambodia for goods or services not the same as those claimed in the opposed mark; provided that the use of the opposed mark in relation to the goods or services claimed would indicate a connection between those goods or services and the proprietor of the well-known mark, and the interests of the proprietor of the well-known mark are likely to be damaged by such use
 Opposed mark lacks distinctiveness
 Lack of intention to use the opposed mark
 Opposed mark consists of false geographical indication
 Use of opposed mark likely to cause confusion or deception
 Others: _____

E. Timeline**26. What is the time period from application to registration for a straightforward trademark application in Cambodia?**

- Between 6 months - 12 months
 Between 12 months - 18 months
 18 months above

27. Is there any process for accelerated/expedited examination of trade mark applications?

- Yes No

If yes, what are the requirements?

Maintenance of Trademark Registration

A. Renewal

28. Is there a mechanism to renew a trade mark registration in Cambodia?

- Yes No

If yes, how long is the validity of the renewal?

Trademarks can be renewed for an unlimited number of 10-year terms.

29. Is late renewal of a trade mark registration permissible in Cambodia?

- Yes No

If yes, what are the conditions?

There is a grace period of 6 months from the deadline to file renewals.

30. Are there any provisions to restore a lapsed registration?

- Yes No

If yes, what are the conditions?

B. Use Requirement

31. Does evidence of use need to be submitted to the trademark office at any time in order to maintain an application for registration or a registration of a trademark in Cambodia?

- Yes No

If yes, what are the requirements?

In Cambodia, the trademark owner is required to file an Affidavit of Use/Non-use within one year following the fifth anniversary of the date of registration of the mark, in order to maintain and renew the registration. If the mark has been used, an Affidavit of Use needs to be filed. The owner can submit an Affidavit of Use form along with evidence of use such as bills of lading, photos of packaging, advertising materials, brochure, etc.

C. Rectification/Cancellation

32. Are rectification or cancellation proceedings available in Cambodia?

- Yes No

If yes, what is the forum?

Any interested person may request for invalidation or removal of a mark, in respect of any goods or services of which it is registered to the Department of Intellectual Property of the Ministry of Commerce, based on the grounds, specified under Article 13, 14 and 15 of the Trademark Law.

33. What are the grounds for rectification or cancellation proceedings?

- Any entry made in the Register without sufficient cause
- Any entry wrongfully remaining in the Register
- Non-use of the mark
- Others:
- The Ministry of Commerce has the right to order cancellation to the registered mark where:
- (a) The owner of the mark has not applied for renewal within the specified period;
 - (b) The owner of the mark requests removal;
 - (c) The owner of a registered mark has not complied, within 90 days, with the conditions or restrictions prescribed under Article 8;
 - (d) The owner of the mark ceases to have an address for service in the Kingdom of Cambodia;
 - (e) It is proven that the owner of the mark is not the legitimate owner;
 - (f) The Registrar is satisfied that the registered mark is similar or identical to a well-known mark owned by a third party.

The cancellation of a registered mark is deemed effective as of the date of the cancellation order.

In addition to a cancellation proceeding, any interested person can request to the Ministry of Commerce to invalidate a registered mark where:

- (a) Sign is incapable of distinguishing the goods (trademark) or services (service mark) of an enterprise;
- (b) Sign is contrary to public order or morality or good custom;
- (c) Sign is likely to mislead the public or trade circles, in particular as regards the geographical origin of the goods or services concerned or their nature or characteristics;
- (d) Sign is identical with, or is an imitation of or contains as an element, an armorial bearing, flag and other emblem;
- (e) Sign is identical with or confusingly similar to the unregistered well known marks;
- (f) Sign is identical with or confusingly similar to registered well known marks;
- (g) Sign is identical with a mark belonging to a different proprietor and already on the Register, or with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services, or if it so nearly resembles such a mark as to be likely to deceive or cause confusion.

The invalidation of a registered mark is deemed effective as of the date of registration.

34. When would a presumption of validity arise in relation to a trademark registration?

- [] years from date certificate of registration issued/date of application
- No such presumption

35. When are the grounds for rectification or cancellation proceedings assessed?

- At the time of filing of the application
- At the time of issuance of the certificate of registration
- At the time of the application for rectification or cancellation proceedings
- Others: _____

36. When is a trade mark registration vulnerable to cancellation on grounds of non-use?

- [5] years from the deemed date of registration
- [] years from the date of certificate issuance
- Not applicable
- Others: _____

37. Who bears the burden of proof in a non-use cancellation action?

- Applicant for cancellation
 - Defendant / Respondent (trademark owner)
- The applicant for cancellation must prove that there is no existing evidence of use of the mark on Cambodian market and that the defendant did not file an Affidavit of Non-use within the specified deadline, while the defendant needs to provide rebuttal evidence.

38. If the answer to the above is the Applicant, what are the examples of evidence which can be relied on to support an application for cancellation for non-use?

- Full market survey conducted by an independent or professional surveyor of an appropriate sample size
- Simple market survey or enquiries in the trade
- Declaration from the applicant for cancellation
- Others: Evidence that the mark has not been used in relation to goods or services in the market since registered.

D. Assignment, Transmission and Licensing**39. Are there any mechanisms to record assignment of a trade mark in Cambodia?** Yes No*If yes, what are the requirements?*

The required documents for recording an assignment are:

- (a) Original notarised Power of Attorney in the name of the assignee;
- (b) Original notarised Deed of Assignment;
- (c) Original Certificate of Trademark Registration.

40. Are there different requirements for recording assignment with or without the goodwill of the business? Yes No*If yes, what are the requirements?***41. Are there any mechanisms to record transmission of a trade mark in Cambodia, for example transmission by way of merger?** Yes No*If yes, what are the requirements?*

The procedure to record such transmission is the same as the procedure to record an assignment, with a different type of document proving transmission. For example, the required documents for recording a merger are:

- (a) Original notarised Power of Attorney in the name of the assignee;
- (b) Original notarised Declaration of Merger;
- (c) Original Certificate of Trademark Registration.

42. Are trade mark licensees required to record themselves with the Registrar? Mandatory Recommended No*If yes, what are the requirements?*

A Trademark License Agreement must be recorded with the Department of Intellectual Property Rights in order to be enforceable against third parties in Cambodia. A License Agreement remains enforceable between the parties even without such recordal.

E. Change of Particulars**43. Should any change in the name or address of the proprietor on record of a registered trademark be updated on the register?** Yes No*If yes, what are the requirements?*

The required documents for recording such changes are:

- (a) Original notarised Power of Attorney;
- (b) Original notarised Declaration of Change of Name/Address;
- (c) Original Certificate of Trademark Registration.

44. Is it possible to change the representation of a registered trade mark? Yes No*If yes, what are the requirements?*

It is possible to amend the registered trademark if the amendment would not affect the identity of the mark as registered, i.e. amendments of substantial elements of the registered mark such that the DIPR deems the amended mark to be new and requiring registration. This is to avoid “incremental changes” to a trademark that may eventually result in it becoming significantly different from the registered mark as a result of a series of amendments after registration.

It is also possible to amend the goods and/or services, if the amendments do not extend the rights of the original registration. Amendments cannot be made to increase the scope of the original claim, or to add new goods or services that do not fall within the scope immediately prior to the amendment. Additional classes cannot be added after registration.

The requirement for amendment of registered marks include:

- (a) Original Registration Certificate(s);
- (b) 15 Specimens of the amended mark ;
- (c) Original notarised Power of Attorney and Deed of Substitution, if the Agent/Attorney is newly appointed.

45. Is it possible to correct and rectify any errors on the Register?

- Yes No

If yes, what are the requirements?

Depending on the situation, it is normally possible to request correction and rectification of an error by filing a formal request to the Department of Intellectual Property Rights.

Enforcement

46. What are the available enforcement methods in Cambodia?

- Civil enforcement
 - Infringement action
 - Passing off
- Criminal enforcement
- Border or other administrative enforcement measures

The Trademark Law does not specifically mention passing off.

47. What are the requirements to bring an action for infringement of trademark?

- Valid registration of the trademark
- Unauthorised use by a 3rd party in the course of trade of a mark which is
 - identical to the registered trademark;
 - so nearly resembling the registered mark as is likely to cause confusion
 - in relation to the goods or services for which the proprietor's mark is registered
 - in relation to goods or services which are similar to the goods or services for which the proprietor's mark is registered though not the same?
- Others:
 - (a) Use of mark in advertising, business stationary or any other documents.
 - (b) Use of a mark or a confusingly similar mark on goods services which are identical or similar to those of a well-known mark

48. For a trademark infringement action, is it necessary to establish

- Actual confusion?
 - Likelihood of confusion?
- Likelihood of confusion alone is also enough to establish trademark infringement.

49. For a trademark infringement action is it necessary to establish damage or loss to the Proprietor of the trademark?

- Yes No Others
- If yes, what are the requirements?*
-

50. Is there a period of limitation for filing a suit for trade mark infringement?

- Yes No
- If yes, what is the time period?*
- There is no special regulatory procedures regarding trademark infringement.

51. What are the remedies available for an infringement action?

- Damages or account of profits
- Injunction
- Delivery and/or destruction of the infringing goods
- Others:
 - (a) Suspension clearance of goods;
 - (b) The court may issue an injunction to prevent infringement, imminent infringement, or other unlawful act, to award damages and/or to grant anyother remedy provided in the general law;
 - (c) The violator may be subjected to fine and imprisonment under criminal law.

52. Is it possible to claim for 'passing off' in Cambodia?

- Yes No
- Passing off claims can be filed as acts of unfair competition.

53. If yes, what are the criteria to establish 'passing off'?

- That the proprietor has goodwill and reputation in the trademark

a. Must the goodwill and reputation subsist in Cambodia i.e. goodwill and reputation outside Cambodia will not betaken into consideration?

- Yes No

b. Must there be actual use or business presence in Cambodia?

- Yes No

c. What is the usual form of evidence used to establish such goodwill and reputation?

Not Applicable.

- That there is misrepresentation caused to members of the public

a. Is it necessary to establish actual confusion or is likelihood of confusion sufficient?

- Actual confusion
 Likelihood of confusion

b. What is the usual form of evidence used to establish such misrepresentation?

Not Applicable.

- That there are damage/likelihood of damage

a. Is it necessary to establish actual damages or is likelihood of damage sufficient?

- Actual damage
 Likelihood of damage

b. What is the usual form of evidence used to establish such damage or likelihood of damage?

Not Applicable.

- Others: _____

54. Are there other forms of actions or claims that can be brought by a trademark owner against an infringer or unauthorised user?

- Unfair competition Others:
Counterfeiting or imitating a trademark is also an infringement.

55. What are the elements that need to be established to bring the claim(s) above?

The elements to bring the above claims are: Any use of a mark by a third party for goods or services for which it is protected are generally considered as acts of infringement.

Use of mark means:

- (a) Affixing or production of the mark on goods, or containers;
(b) Sale or offer for sale;
(c) Advertising, or printing on business stationery or any other documents;
(d) Import or export of such goods.

56. Can a trade mark owner lodge a complaint to any administrative authorities on counterfeit trademark goods?

- Yes No

If yes, please state the authority:

The owner of the registered trademark may make an application to customs, the competent authorities or the courts.

57. What are the actions that can be taken by such authorities?

- Conduct a raid
 Seize the infringing goods
 Impose a fine
 Refer for criminal prosecution

Others:

Other actions that can be taken by the authorities include:

- (a) Destruction of counterfeit goods after obtaining a court order;
- (b) Suspension of the clearance of goods suspected of being counterfeit.

58. Are border measures available to restrict the importation of counterfeit trademark goods?

Yes No

If yes, what are the measures?

The border measures to customs include:

- (a) Suspension of clearance of goods referred to in an application. The suspension shall remain in force for the initial; period, and any extension thereof which is not more than 10 working days;
- (b) Suspension of clearance of goods where customs has acquired *prima facie* evidence that importation of counterfeit trademark goods is taking place or is imminent;
- (c) Destruction of infringing goods by customs or other competent authorities, pursuant to a court decision.

59. Do these border measures apply for counterfeit goods of unregistered trademarks?

Yes No

Not applicable, there are no rights for unregistered trademarks in Cambodia

60. Is there an authority or ministry responsible for the enforcement of trademark rights?

Yes No

If yes, please state:

The authorities include:

- (a) Competent court and appellate courts;
- (b) Customs and Excise Department of the Ministry of Economy and Finance;
- (c) Economic Police (under the Ministry of Interior);
- (d) Cambodia Import-Export Inspection and Fraud Repression Directorate-General of the Ministry of Commerce (CAMCONTROL).

Peculiarities

61. Are there any peculiarities not mentioned above in the system of protection for trademarks in Cambodia of which it is important for clients to be aware?

None.

Patents

Patent Rights and Protection in Cambodia

General

1. What is the system for patent protection?

- Examination system
 Non-examination system

Cambodia does not conduct substantive examination on its own. Please refer to Section C of Patent Registration below for information relating to the examination of patents in Cambodia.

2. Is Cambodia a member of the Patent Cooperation Treaty (PCT)?

- Yes No

3. Is Cambodia a member of the Paris Convention?

- Yes No

Patent Registration

A. Registration System

4. What kinds of patent protection are available?

- Inventions Utility models
 Others: _____

5. What kinds of subject matter are excluded from patent protection?

- Methods of medical treatment or diagnosis
 Computer programs
 Business methods
 Others:
 Pharmaceutical products; discoveries and scientific theories and mathematical methods; schemes, plans, rules, or methods for performing purely mental acts, or playing games; presentations of information; solutions of aesthetic characteristics only; plant and animal other than micro-organisms, and essentially biological processes for

the production of plants or animals; plants varieties.

B. Patent Filing

6. What are the documents and information required for filing a patent application?

- Name and address of the applicant
 Name and address of the inventor
 Specification
 Abstract
 Power of Attorney
 Deed of Assignment
 Others:

To file a patent application in Cambodia, we need the following:

- (a) Notarised Power of Attorney (POA), appointing Tilleke & Gibbins Cambodia Ltd. as an agent. The original POA must be submitted within two months from the filing date. A four-month extension is available subject to applicable charges;
- (b) Notarised Deed of Assignment (DOA) from the inventor(s) to the applicant. The original DOA must be submitted within two months from the filing date. A four-month extension is available subject to applicable charges;
- (c) English version of the specifications (description, claims, abstract) in Word format, and a set of drawings. The English language specifications must be submitted on the filing date;
- (d) Original or certified copy of priority document (if claiming priority). This item must be submitted within three months from the filing date. A four-month extension is available subject to applicable charges;
- (e) Certified English translation of the priority document (if the priority document is not in English). The certified English translation must be submitted within three months from the filing date. A four-month extension is available with applicable charges;

- (f) Duly signed declaration by the translator (if the priority document is not in English). The translator's original declaration for the priority document must be filed within three months from the filing date. A four-month extension is available subject to applicable charges.

Please note that the specifications and other documents must also be translated into Khmer and submitted within six months from the filing date.

7. Is there a fee for extra claims?

- Yes No

If yes, please describe:

There will be an additional official fee of USD 5 for each additional claim exceeding the first 10 claims.

8. Does Cambodia require obtaining a foreign filing license before filing a foreign patent application?

- Yes No

If yes, please describe:

B.1 Patent Specification

9. In which language must a patent specification be?

- English Others: Khmer

An English version of the specifications (description, claims, abstract) in Word format, and set of drawings, must be submitted on the date the application is filed in Cambodia. The Khmer translation of such document must be submitted within six months from the date that the application is filed in Cambodia.

10. Is it possible to file an application first with an English specification, and then later submit its translation in the official language?

- Yes No

If yes, what is the deadline?

The deadline to submit the translation is six months from the filing date on which the application is filed in Cambodia.

B.2 Publication, Amendment and Divisional Application

11. Is it possible to request a deferment of publication?

- Yes No

If yes, please describe:

There is no procedural regulation regarding the deferment of publication. However, in practice the applicant may request that the Registration Department defer publication.

12. Is it possible to request an early publication?

- Yes No

If yes, please describe:

13. Does the applicant have a provisional right upon the publication of an application?

- Yes No

If yes, please describe:

According to the law, a patent has already been granted at the time of publication. Therefore the applicant has the right to the patent application.

14. When is it possible to file a voluntary amendment to specification?

- At the time of entry into the national phase (for PCT application)
 At any time during prosecution
 At the time of requesting examination
 Others:

The applicant may amend the application up to the time when the application is in order for grant, provided that the amendment does not go beyond the disclosure in the initial application.

15. When is it possible to voluntarily file a divisional application?

- At any time during prosecution
 At the time of granting a patent
 Others:

The applicant may, up to the time when the application is in order for grant, divide the application into two or more applica-

tions (“divisional applications”), provided that each divisional application does not go beyond the disclosure in the initial application. Each divisional application shall be entitled to the filing date and, where applicable, the priority date of the initial application.

16. Is it possible to file a divisional application based on a previous pending divisional application if the parent application has already been granted a patent?

Yes No

C. Examination

17. Is there a requirement to submit certain information on corresponding applications, or prior art known to the applicant?

Yes No

If yes, please describe:

According to article 30 of the law, Law on Patents, Utility Models and Industrial Designs, the applicant must, at the request of the registrar, furnish him with the date and number of any application for a patent filed by him abroad (“foreign application”) relating to the same or essentially the same invention as that claimed in the application filed with the ministry in charge of industry.

According to article 31, the applicant must, at the request of the registrar, furnish him with the following documents relating to one or more of the foreign applications referred to in article 30:

- (a) A copy of any communication received by the applicant concerning the results of any search or examination carried out in respect of the foreign application;
- (b) A copy of the patent granted on the basis of the foreign application;
- (c) A copy of any final decision rejecting the foreign application or refusing the grant requested in the foreign application.

The applicant must, at the request of the registrar, furnish him with a copy of any final decision invalidating the patent granted on the basis of the foreign application referred

to in the first paragraph of this article.

18. Is there a grace period (exception to novelty)?

Yes No

If yes, please describe:

Disclosure to the public of an invention shall not be taken into consideration:

- (a) If it occurred within 12 months preceding the filing date or, where applicable, the priority date of the application; and
- (b) If it was by reason or in consequence of acts committed by the applicant or his predecessor in title or of an abuse committed by a third party with regard to the applicant or his predecessor in title.

19. Is it required to file a request for substantive examination?

Yes No

If yes, what are the requirements?

The deadline for filing the request for examination in Cambodia is 18 months after the filing date.

20. Can a third party file a request for substantive examination?

Yes No

The Cambodian Patent Office does not conduct substantive examination on their own. The current practice is that the request for substantive examination of a patent application will be submitted to the Cambodian Patent Office by the applicant, and then the Cambodian Patent Office will forward it to the desired foreign examining patent office.

21. Is there a right of appeal?

Yes No

If yes, please describe:

Any decision of the Ministry of Industry and Handicrafts, in particular the grant of a patent or the grant of a utility model certificate or the registration of an industrial design, or the refusal of an application for such a grant or registration, may be appealed by any interested party before the competent court, any such appeal must be filed within three months of the date of the decision.

22. Are multiple dependent claims admissible?

- Yes No

D. Opposition**23. Is there an opposition procedure upon publication?**

- Yes No

There is no procedure for opposition upon publication. Article 65 of the Law on Patents, Utility Model Certificates and Industrial Designs merely states that "any interested person may request that the competent court invalidate the registration of a patent."

24. How long is the opposition term once the application is published?

- 2 months 3 months
 Prior to the grant Others:
 Not Applicable

25. Who may initiate opposition proceedings?

- Any person
 Anyone with a legitimate interest
 Any competent authorities
 Others: Not Applicable

E. Timeline**26. What is the time period from application to grant for a straightforward application?**

- Between 2 - 3 years
 Between 3 - 4 years
 Others:

The Cambodian Patent Office does not conduct substantive examination on its own. They rely on the examination result from other countries; for example, the USPTO for applications claiming priority from a US patent or the IPOS for an application to re-register a granted Singapore patent. Depending on the method the applicant chooses, it will usually take from six months to several years from the filing date in Cambodia.

27. Is there any process for accelerated examination of application?

- Yes No

If yes, what are the requirements?

There are several options to accelerate patent applications in Cambodia, including:

1. Re-registration of Singapore Patents and Designs

It is now possible for the right holders of Singapore-granted patents to obtain protection in Cambodia under a streamlined re-registration process. There is no deadline to re-register a Singapore-granted patent in Cambodia, but the Singapore patent must:

- (a) Be in force at the time that the re-registration request was filed;
- (b) Have a filing date on or after February 11, 2003; and
- (c) Be patentable in Cambodia as indicated under Articles 4 and 9 of the Law on Patents.

In order to re-register a Singapore patent in Cambodia, we need the following:

- (a) The correct information relating to the applicant's name, address, nationality or country of incorporation, and country of residency (for individual applicants);
- (b) An original certified copy of the certificate of grant for the Singapore patent and a certified copy of the final specifications of the Singapore patent;
- (c) A copy of the abstract of the granted Singapore patent;
- (d) Notarised Power of Attorney (POA), appointing Tilleke & Gibbins Cambodia Ltd. as an agent. The original POA must be submitted within two months from the date of filing request for re-registration in Cambodia. A four-month extension is available for an additional charge.

All of the documents must be translated into Khmer and submitted within six months from the date of filing a request for re-registration in Cambodia.

2. Facilitating Grant of Japanese Patents and Designs

The Cooperation for Facilitating Patent Grant (CPG) program between the MIH and the Japan Patent Office (JPO) allows applicants to request accelerated decisions on patent applications filed in Cambodia if their patent has previously been examined and granted in Japan.

In order to participate in the CPG program, the following requirements must be met:

- (a) There is a Japanese patent application which has the same earliest date (whether a priority date or a filing date) as the MIH patent application;
- (b) The corresponding Japanese patent application has been granted by the JPO; and the claims in the MIH patent application have been amended to be the same as one or more claims in the corresponding granted Japanese patent application.

After verifying that all requirements have been met, it takes approximately two to three months for an MIH patent application to be granted.

3. Patent Cooperation Treaty

Cambodia became the 151st contracting state of the Patent Cooperation Treaty (PCT) on September 8, 2016, with the treaty entering into force in the country on December 8, 2016. Thus, any international patent application filed on or after December 8, 2016, will automatically include the designation of Cambodia and will automatically elect any demand filing in Cambodia.

The Cambodian Patent Office will rely on the international search report in order to facilitate the granting of protection for the patent. The formal procedural regulation concerning this matter is not yet available.

4. Validation of European Patents

European patent applicants who wish to validate their patents in Cambodia on or after July 1, 2017, will be able to benefit from new procedures, which involve filing a request for validation with the EPO and paying a validation fee within six months of the date of publication of the European search report

in the European Patent Bulletin or within the required period for gaining entry into the European national phase of the qualified PCT international application. At the date of writing, the formal procedural regulation concerning this matter is not yet available.

5. The China Memorandum of Understanding (MOU) on Intellectual Property

The MOU on intellectual property cooperation between the State Intellectual Property Office of China (SIPO) and the Ministry of Industry and Handicrafts of the Kingdom of Cambodia (MIH) states that valid invention patents authorised by SIPO will be allowed to be directly registered and protected in Cambodia and that relevant departments of SIPO will provide the MIH with searching and evaluation services for invention patent applications. This memorandum was signed on September 21, 2017, and, at the date of writing, formal procedural regulations concerning this matter are not yet available.

Maintenance of Patent

A. Annuity

28. To maintain the validity of patent, is it required to pay an annuity in Cambodia?

- Yes No

29. Is late payment of annuity permissible?

- Yes No

If yes, what are the requirements?

Late payments should be made no more than six months from the due date. There are no conditions for late payment, except a late payment charge must be paid.

30. Is government annuity fixed for each year? Yes No

If no, what is the base for calculation of annuity?

There is a set government annuity fee, provided by the Joint-Prakas on Public Service Fees and Fines of the Ministry of Industry and Handicraft. Please refer to the table below.

Annuity Government fee in USD

1. Second year	20
2. Third year	20
3. Fourth year	40
4. Fifth year	100
5. Sixth year	140
6. Seventh year	180
7. Eighth year	220
8. Ninth year	260
9. Tenth year	300
10. Eleventh year	350
11. Twelfth year	400
12. Thirteenth year	450
13. Fourteenth year	500
14. Fifteenth year	550
15. Sixteenth year	610
16. Seventeenth year	670
17. Eighteenth year	740
18. Nineteenth year	810
19. Twentieth year	890

31. Can annuity be paid once for all years or once for several years? Yes No**32. Is power of attorney required for annuity payment?** Yes No**33. Are there any provisions to restore a lapsed patent?** Yes No

If yes, what are the requirements?

34. Is patent term extension available in Cambodia? Yes No

If yes, what are the conditions?

B. Compulsory Licence**35. Is a compulsory licence available in Cambodia?** Yes No

If yes, what are the requirements?

Compulsory licences are available in Cambodia under Articles 47 to 55 of the Law on Patents, Utility Model Certificates, and Industrial Designs. According to Article 47, the Minister of Ministry of Industry and Handicraft may decide that, even without the agreement of the owner of a patent, a government agency or a third person designated by the minister may exploit the invention where:

- (a) the public interest, in particular, national security, nutrition, health or the development of other vital sectors of the national economy so requires; or
- (b) a judicial body has determined the manner of exploitation.

36. Can a request for termination of compulsory licence be filed? Yes No

If yes, what are the requirements?

Patent owners have the right to request termination of a compulsory licence when the bases for compulsory licensing cease to exist and are unlikely to recur, provided that such termination shall not be prejudicial to the licensee.

C. Use Requirement**37. Does the patentee need to submit evidence of obligation of use to the Patent Office in order to maintain a patent in Cambodia?** Yes No

If yes, please describe:

38. Is a compulsory licence granted based on failing to perform an obligation to use?

- Yes No

If yes, please describe:

On a request made to the Minister of Ministry of Industry and Handicraft, after the expiration of a period of four years from the filing date or three years from the date of grant, a compulsory licence may be granted based on the failure to perform an obligation to use in Cambodia.

D. Cancellation

39. Are termination or cancellation proceedings available in Cambodia?

- Yes No

If yes, what are the grounds?

Termination: According to Article 46 of Law on Patents, Utility Models and Industrial Designs of Cambodia, if the owner of the patent does not pay the annual fee in accordance with the law, the patent application shall be deemed withdrawn or lapsed.

Cancellation (invalidation): According to Article 66 of Law on Patents, Utility Models and Industrial Designs of Cambodia, the competent court shall invalidate a patent if the person requesting the invalidation proves that any of the below requirements are fulfilled:

- (a) The invention does not permit in practice the solution to a specific problem in the field of technology;
- (b) The invention is not related to a product or process;
- (c) The invention is related to discoveries, scientific theories and mathematical methods; schemes, rules or methods for doing business, performing purely mental acts or playing games; methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods practised on the human or animal body; pharmaceutical products under Article 136; plants and animals other than micro-organisms; essentially biological processes for the production of plants or animals; and plant varieties;
- (d) The invention is not new, does not involve an inventive step and is not

industrially applicable;

- (e) The invention is anticipated by prior art that consists of everything disclosed to the public, anywhere in the world, by publication in tangible form or by oral disclosure, by use or in any other way, prior to the filing or, where appropriate, the priority date, of the application claiming the invention;
- (f) An invention which is contrary to public order or morality, or would be dangerous to human, animal or plant life or health, or would cause serious prejudice to the environment, or is prohibited by law, are excluded from patentability;
- (g) Insufficient written description or best mode;
- (h) Unclear, verbose, or unsupported claims;
- (i) Lack of drawings necessary to understand the invention;
- (j) The patent owner is not the inventor or his successor in title, or a person who has a right to the patent.

40. What is the time limit for termination or cancellation?

- 3 years 5 years
 Whole protection term of patent
 Others:

If the annual fee is not paid within the six-month grace period allowed for the late payment of the annual fee, the patent application shall be deemed to have been withdrawn or shall lapse.

E. Assignment, Transmission, and Licensing

41. Are there any mechanisms to record assignment of a patent in Cambodia?

- Yes No

If yes, what are the requirements?

It is possible to record an assignment in Cambodia. In order to do so, the following documents are required:

- (a) Original notarised deed of assignment;
- (b) Original notarised power of attorney in the name of the assignee;
- (c) Original patent certificate (for granted patents)

42. Are there any mechanisms to record transmission of a patent in Cambodia, for example, transmission by way of merger?

- Yes No

If yes, what are the requirements?

It is possible to record the transmission of a patent in Cambodia, for example by way of merger. In order to do so in the case of a merger, the following documents are required:

- (a) Original notarised declaration of merger;
- (b) Original notarised power of attorney in the name of the new entity; and
- (c) Original patent certificate (for granted patent)

43. Are patent licensees required to record themselves with the Patent Office?

- Yes No

If yes, what are the requirements?

Patent licensees are not required to record themselves, and a patent license contract is valid as agreed upon by the involved parties. However, such a contract is only legally effective against a third party if it is recorded with the Patent Office of the Ministry of Industry and Handicrafts (Art. 115).

F. Change of Details

44. Are there any mechanisms to record change of name or address of the patent proprietor?

- Yes No

If yes, what are the requirements?

It is possible to change the recorded name or address of the patent owner for both pending patent applications and granted patents. In order to do so, the following documents are needed:

- (a) Original notarised declaration of name/address change;
- (b) Original notarised power of attorney with the new name/address of the owner;
- (c) Original patent certificate (for granted patent).

45. Is it possible to amend a granted patent?

- Yes No

If yes, what are the requirements?

According to Article 40 of the Law on Patents, Utility Model Certificates and Industrial Designs, the registrar shall, upon request of the owner of the patent, make changes in the text or drawings of the patent in order to limit the extent of the protection conferred thereby, provided that the change would not result in the disclosure contained in the patent going beyond the disclosure contained in the initial application on the basis of which the patent was granted.

46. Is it possible to correct and rectify any errors on the patent?

- Yes No

If yes, what are the requirements?

Yes, the registrar may, subject to any provision in the regulations, correct any error of translation, clerical error or mistake in any application or document filed with the Registration Department or in any recording effected pursuant to the law.

Enforcement

47. What are the available enforcement methods in Cambodia?

- Civil enforcement
- Administrative enforcement
- Criminal enforcement
- Border measures
- Others:

In cases of patent infringement, patent owners may enforce their rights through civil litigation or criminal prosecution. In many cases, private mediation via patent professionals is more effective and should be considered as a viable option.

48. What are the criteria for infringement?

- Literal infringement
- Infringement under the doctrine of equivalents
- Use of the patent without permission of patent owner
- Others:
Infringement is found by the exploitation of a patent invention in Cambodia by any person other than the owner of the patent. In respect of products, such acts of exploitation include making, importing, offering for sale, selling and using patented products, and stocking such products for the purposes of offering for sale, selling or using. In respect of a process, such acts of exploitation include using a patented process, or doing any acts above in respect of a product obtained directly by means of a patented process.

49. Is there a statute of limitations for filing a suit for patent infringement?

- Yes No

If yes, please state the time period:

50. What are the remedies available for an infringement action?

- Damages
- Injunction
- Destruction of the infringing goods
- Others:
In a civil infringement suit, the court has wide discretion to award monetary damages and to order injunctive relief. Further, the law provides for criminal penalties for infringement equal to five million to twenty million Riels (approximately US\$1,250 to US\$5,000), or one to five years imprisonment, or both. If an offence is repeated within five years of the previous conviction, penalties for the subsequent infringement can be doubled.

51. What are the actions taken by such authorities?

- Conduct a raid
- Seize the infringing goods
- Impose a fine
- Others:

According to Article 126, on the request of the patent owner, or the patent license if he has requested that the patent owner institute court proceedings for specific relief and the patent owner has refused or failed to do so, the competent court may grant an injunction to prevent infringement or an imminent infringement, award damages and grant any other remedy provided for in the general law.

According to Article 133, any person who knowingly performs an act which constitutes an infringement as defined in Article 125, shall be guilty of an offence punishable by a fine of five million (5,000,000) Riels to twenty million (20,000,000) Riels, or by imprisonment of one year to five years, or both. The maximum penalty for a repeat offence committed within five years from the date of conviction shall be doubled.

According to Article 134, where a person is found guilty of an offence, the competent court may order seizure, forfeiture and destruction of the infringing goods and of any materials and implements the predominant use of which has been to commit the crime.

52. Is there an authority or ministry responsible for the enforcement of patent rights?

- Yes No

If yes, please state the name of such authority or ministry:

Generally, the courts are the proper authority to assert jurisdiction over patent infringements.

Peculiarities

53. Are there any peculiarities in the system of protection for patents in Cambodia of which it is important for clients to be aware?

- (a) Despite the lack of examination mechanisms, accelerated patent registration via the IPOS, JPO, PCT, and EPO channels has great potential to facilitate increased intellectual property protection in Cambodia.
- (b) Pharmaceutical-related patents are subject to a notable exception under all of the patent-granting methods described above. Article 4 of the Law on Patents excludes pharmaceutical products from patent protection in Cambodia until January 2016.

However, since Cambodia is a least-developed country, the World Trade Organization's Council for Trade-Related Aspects of Intellectual Property Rights (Council for TRIPS) has decided that Cambodia is not obligated to provide protection to pharmaceutical-related patents until 2033. The Law on Patent is expected to have an amendment that reflects that extension soon. The MIH is therefore reluctant to accept applications for pharmaceutical-related patents or maintenance fees, and is likely to reject any such applications altogether.

Indonesia

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About The Firm

Ali Budiardjo, Nugroho, Reksodiputro ("ABNR") was established in Jakarta in 1967. It presently consists of 105 Indonesian lawyers, three Dutch lawyers and one Australian lawyer. The firm is one of Indonesia's largest independent full-service law firms. ABNR is principally engaged in the provision of legal services to foreign companies, banks and international institutions operating or setting up business in Indonesia, as well as to Indonesian enterprises contracting with foreign companies and institutions or with other Indonesian companies.

ABNR's IP practice includes advice on the registration, protection and enforcement of trademarks (but only limited to the process of deletion and cancellation of marks), patents and copyrights, industrial designs, and geographical indications and on all aspects of franchising arrangements in Indonesia. ABNR also advises on the negotiation and drafting of the relevant documents and agreements, applications for registration, assignment, and public announcements, both for international and Indonesian clients.



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Foreword

The influence of globalization in all areas of Indonesia's society including social, economic and cultural has increased the pace of development substantially over recent years. Rapid development in areas such as information technology, infrastructure and transportation has resulted in an increasing rate of invention and development of intellectual property within Indonesia as well as importation of technology, know-how and other intellectual property from outside Indonesia into the country.

All of this has led not only to economic growth but also to an increased awareness of the need for a strong and effective legal regime for protection of intellectual property rights particularly in the areas of trademarks and patents.

Indonesia's ratification of the Convention on Establishment of World Trade Organization which also covers the agreement on Trade Related Aspect of Intellectual Property Rights/TRIPs pursuant to Law Number 7 Year 1994 requires Indonesia to comply with and implement the contents of the international agreement.

In order to fulfill the country's obligations under TRIPs, Indonesia has enacted 7 (seven) laws relating to Intellectual Property Rights, namely copyright, patent, trademark, industrial design, trade secret, integrated circuit lay-out design and plant variety.

Keeping up with developments in the law both nationally and internationally Indonesia has recently enacted the new Trademark Law (Law No. 20 of 2016) and the new Patent Law (Law No. 13 of 2016). The new Trademark Law includes provisions which may improve efficiency in the application procedure (i.e. shortened and simplified examination period that may reduce Indonesia's protection for non-traditional marks, including three dimensional, sound and holographic marks) and also improve consumer protection; while the new Patent Law introduces, amongst others, an online filing system and extension of the scope of simple patents. We have focused on Trademark and Patent Laws in this ASEAN IP Guide based on these recent developments and hope this Guide will be an interesting and useful read.

Trademarks

Trademark Rights and Protection in Indonesia

General

1. What is the system for trademark protection in Indonesia?

- Registration Common law
 Co-existing rights under registration and common law

2. Does first to use or first to register have prior rights in Indonesia?

- First to use First to register

3. Is Indonesia a member of the Madrid Union and the Paris Convention?

- Madrid System Paris Convention

4. If Indonesia is a member of Madrid Union is it a party to the Agreement or the Protocol and are there any peculiarities in relation to the implementation of the Madrid System for international registration in Indonesia?

Indonesia is a party of both and there are no peculiarities.

Trade Mark Registration

A. Registration System

5. What are the benefits of registering a trade mark in Indonesia?

- Prevails over common law rights
 It is the only form of protection available for trademarks
 Entitles the proprietor to bring an infringement action
 Others:
 To obtain the exclusive right from the government for a period of time to use by him/herself or to give a consent to other party to use the registered mark.

6. Is it possible to obtain registration for the following types of marks under the registration system in Indonesia?

a. Service marks

- Yes No

b. Defensive marks

- Yes No
If yes, what are the requirements?
-

c. Collective marks

- Yes No
If yes, what are the requirements?
 (a) Mark Application Form;
 (b) Special Power of Attorney (if the application is filed by a Proxy);
 (c) Declaration of Mark Ownership;
 (d) Declaration of the Mark will be used collectively;
 (e) Mark label;
 (f) Payment Receipt.

d. Certification marks

- Yes No
If yes, what are the requirements?
-

e. Well-known marks

(i.e. registration of a mark as a well-known mark and not an ordinary trademark)

- Yes No
If yes, what are the requirements?
-

f. Series marks

- Yes No
If yes, what are the requirements?
-

g. Marks in different language or characters other than Roman characters

- Yes No

If yes, what are the requirements?

Providing the mark with the translation and the pronunciation in the provided box of the application form.

h. Non-traditional marks: Sound marks

- Yes No

If yes, what are the requirements?

- (a) Mark Application Form;
 (b) Special Power of Attorney (if the application is filed by a Proxy);
 (c) Declaration of Mark Ownership;
 (d) Notation and Recording;
 (e) Payment Receipt.

i. Non-traditional marks: Smell marks

- Yes No

If yes, what are the requirements?

j. Non-traditional marks: Position marks

- Yes No

If yes, what are the requirements?

k. Non-traditional marks: Colour marks

(i.e. registration of a single colour or a combination of colours)

- Yes No

If yes, what are the requirements?

Only for combination of colors.

l. Non-traditional marks: Shape or three-dimensional marks

- Yes No

If yes, what are the requirements?

The attached mark label is in the form of characteristic of the Mark (visually) and the description of the protection.

m. Others:

7. Is it possible to claim a colour limitation?

- Yes No

If yes, what are the requirements?

8. What is the official name of the trademark office in Indonesia?

Direktorat Jenderal Kekayaan Intelektual
 (Directorate General of Intellectual Property).

B. Trade Mark Filing**9. What are the documents and information required for filing a trade mark application in Indonesia?**

- Name and address of the applicant
 Representation of the trade mark
 Goods and services and the class(es) for which the trade mark is to be registered
 Certificate of Incorporation (if the applicant is a company)
 Statutory Declaration
 Power of Attorney
 Others:
 Certificate of incorporation is for local company only.

10. Can a trade mark application be based on intent to use in Indonesia?

- Yes No

If yes, please specify any conditions:

Evidence of use is not required at the time of application. An application can be based on intent to use in Indonesia. However, a non-use of registered mark for 3 (three) years consecutively is subject to deletion.

11. Is priority claim allowed in Indonesia?

- Yes No

If yes, what are the requirements?

- (a) Mark Application Form;
 (b) Special Power of Attorney
 (if the application is filed by a Proxy);
 (c) Declaration of Mark Ownership;
 (d) Mark label;
 (e) Certified copy of the Priority Document
 (notarized and consularized) with its translation into Indonesian language;
 (f) Payment Receipt.

12. Are multi-class applications permitted in Indonesia?

- Yes No

If yes, is there a maximum number of classes that can be applied for?

No, there is no maximum number of classes.

13. Does Indonesia adopt the Nice Classification for specification of goods and services?

- Yes No

If yes, please specify the edition:

11th edition.

14. Are there any specific requirements in relation to the classification of goods and services in Indonesia?

a. Must the specification of goods and services be limited to items from the list of goods and services under the Nice Classification only?

- Yes No

b. Can the class heading be included in the specification?

- Yes No Subject to conditions

Please specify:

c. Are there sub-classes of goods and services applied by the trademark office in Indonesia?

- Yes No

If yes, please elaborate:

d. Others:

C. Trade Mark Examination

15. What marks, signs, representations, emblems or words are specifically prohibited from registration in Indonesia?

- Signs contrary to morality or public order
 Signs of such a nature as to deceive the

public

- Signs benefiting protection from other international convention (e.g. Red Cross, Olympic symbols)
 Signs protected by national laws (e.g. royal emblems)
 Others: _____

16. Is there substantive examination of trademarks?

- Yes No

If yes, what are the grounds?

- Absolute grounds
 Relative grounds
 Others: _____

17. Is substantive examination conducted before or after publication of a trademark for opposition by third parties?

- Before publication After publication

18. What are the absolute grounds for refusal?

- Mark consists of a non-invented word(s)
 Mark has direct reference to the character or quality of the goods or services
 Mark is not distinctive
 Mark consists of a geographical name
 Mark consists of a surname
 Mark consists of letters of the alphabet
 Mark consists of numerals
 Mark consists of geometric shapes
 Others: _____

19. What are the relative grounds for refusal?

- There is a prior application for registration or registration for an identical or confusingly similar mark in relation to the same goods or services as the subject mark.
 There is a prior application for registration or registration for an identical or confusingly similar mark in relation to similar goods or services (although in different class) as the subject mark
 Well known mark: There is a well known mark which is identical or so nearly resembling the subject mark for the same goods or services as the subject mark

- Well known mark: There is an earlier registered mark which is well known for different goods or services and use of the subject mark would indicate a connection between goods or services covered by the subject mark with the proprietor of the well known mark
- Others: _____

20. Is there a right of appeal?

- Yes No

If yes, please describe:

- (a) An Extension is not possible;
- (b) The forum to apply for an appeal is to the Commission of Appeal;
- (c) The form of appeal is in writing;
- (d) An appeal can be applied on the refusal of application of mark for registration. This appeal is submitted in writing by explaining the objection with the reason of it. This kind of appeal must be submitted within 90 (ninety) business days from the date of mail delivery. The appeal decision shall be given within 3 months at the latest from the acceptance of appeal request.
- (d) An appeal can also be made against the objection of the refusal of renewal application; and the refusal of Geographical Indication Application.

D. Publication and Opposition

21. Is there an opposition procedure upon publication?

- Yes No

22. How long is the opposition term once the trade mark application is published in Indonesia?

[2] months

23. Is the opposition term extendible?

- Yes No Others: _____

24. Who may initiate opposition proceedings?

- Any person
- Anyone with a legitimate interest
- Any competent authorities
- Others: _____

25. What are the usual grounds for opposition?

- Prior use of a mark which is identical or confusingly similar to the opposed mark
- Prior registration of a mark which is identical or confusingly similar to the opposed mark
- Bad faith in application for registration of the opposed mark
- Applicant is not the rightful proprietor of the opposed mark
- If the opposed mark is identical with or so nearly resembles the Opponent's mark which is well-known in Cambodia for the same goods or services
- If the opposed mark is identical with or so nearly resembles the Opponent's mark which is well-known and registered in Cambodia for goods or services not the same as those claimed in the opposed mark; provided that the use of the opposed mark in relation to the goods or services claimed would indicate a connection between those goods or services and the proprietor of the well-known mark, and the interests of the proprietor of the well-known mark are likely to be damaged by such use
- Opposed mark lacks distinctiveness
- Lack of intention to use the opposed mark
- Opposed mark consists of false geographical indication
- Use of opposed mark likely to cause confusion or deception
- Others: _____

E. Timeline

26. What is the time period from application to registration for a straightforward trademark application in Indonesia?

- Between 6 months - 12 months
- Between 12 months - 18 months
- 18 months above

27. Is there any process for accelerated/ expedited examination of trade mark applications?

- Yes No

If yes, what are the requirements?

Maintenance of Trademark Registration

A. Renewal

28. Is there a mechanism to renew a trade mark registration in Indonesia?

- Yes No

If yes, how long is the validity of the renewal?

Mark protection of 10 (ten) years is renewable for the same protection period (i.e 10 years).

29. Is late renewal of a trade mark registration permissible in Indonesia?

- Yes No

If yes, what are the conditions?

A renewal application can still be submitted within 6 (six) months after the expiration date at the latest (subject to fine fee).

30. Are there any provisions to restore a lapsed registration?

- Yes No

If yes, what are the conditions:

B. Use Requirement

31. Does evidence of use need to be submitted to the trademark office at any time in order to maintain an application for registration or a registration of a trademark in Indonesia?

- Yes No

If yes, what are the requirements?

C. Rectification/Cancellation

32. Are rectification or cancellation proceedings available in Indonesia?

- Yes No

If yes, what is the forum?

A cancellation proceeding by a third party shall be filed to the Commercial Court.

33. What are the grounds for rectification or cancellation proceedings?

- Any entry made in the Register without sufficient cause
- Any entry wrongfully remaining in the Register
- Non-use of the mark
- Others:
- Deletion of registered mark could be done on the initiative of the Minister if:
- The registered mark has similarity in principal and/or entirely with Geographical Indication;
 - The registered mark is contrary to state ideology, legislation, morality, religion, ethics and public order; or
 - The registered mark has similarity entirely with traditional culture expression, non-objects cultural heritage, or hereditary name or logo.

Cancellation of registered mark shall be submitted by interested parties based on:

- The registered mark is contrary to state ideology, legislation, morality, religion, ethics and public order;
- The registered mark is equal to, connected with, or only mentioning the applied good and/or service;
- The registered mark contains elements which is possible to mislead the people about the origin, quality, type, size, category, nature of the use of goods and/or service which is applied or as a name of protected plant variety for similar goods and/or services;
- The registered mark contains information which is not in accordance with the quality, benefits, or efficacy of produced goods and/or service;
- The registered mark has no distinguishing features;

- (f) The registered mark is a common name and/or general sign;
- (g) The registered mark is a registered mark of other party's which is applied before by other party to similar goods and/or service;
- (h) The registered mark is a well-known mark of other party for the similar goods and/or services;
- (i) The registered mark is a well-known mark of other party for different type of goods and/or services but fulfilling certain requirements;
- (j) The registered mark is a registered Geographical Indication;
- (k) The registered mark is or resembles with name or abbreviation/nick name of a famous person, picture/photo-graph, or other's legal entity, except with a written consent of the entitled party;
- (l) The registered mark is a copy or similar with name or abbreviation/nick name, flag, logo or symbol or emblem of a country, or national and international entity, except with a written consent of the entitled party;
- (m) The registered mark is a copy or similar with sign or stamp or official stamp which has been used by a country or government agencies, except with a written consent of the entitled party; and/or
- (n) The registered mark was applied based on bad-faith.

34. When would a presumption of validity arise in relation to a trademark registration?

- [] years from date certificate of registration issued/date of application
- No such presumption

35. When are the grounds for rectification or cancellation proceedings assessed?

- At the time of filing of the application
- At the time of issuance of the certificate of registration
- At the time of the application for rectification or cancellation proceedings
- Others: _____

36. When is a trade mark registration vulnerable to cancellation on grounds of non-use?

- [3] years from the deemed date of registration (Registration date and not application date)
- [] years from the date of certificate issuance
- Not applicable
- Others: Or 3 years from the last use.

37. Who bears the burden of proof in a non-use cancellation action?

- Applicant for cancellation
- Defendant / Respondent (trademark owner)

38. If the answer to the above is the Applicant, what are the examples of evidence which can be relied on to support an application for cancellation for non-use?

- Full market survey conducted by an independent or professional surveyor of an appropriate sample size
- Simple market survey or enquiries in the trade
- Declaration from the applicant for cancellation
- Others: _____

D. Assignment, Transmission and Licensing

39. Are there any mechanisms to record assignment of a trade mark in Indonesia?

- Yes No

If yes, what are the requirements?

The assignor shall file a request to record the mark assignment to the Directorate of Mark in the Directorate General of Intellectual Property of the Ministry of Law and Human Right by attaching:

- (a) Evidence of Mark Assignment;
- (b) Copy of the mark certificate;
- (c) Certified copy of the deed of legal entity if the assignee is a legal entity;
- (d) Copy of ID card of the assignee as the applicant of recordation;
- (e) Special Power of Attorney if the recorda-

- tion filed by a proxy (IP consultant residing or domiciled in the territory of Indonesian Republic);
(f) Payment receipt.

40. Are there different requirements for recording assignment with or without the goodwill of the business?

- Yes No
If yes, what are the requirements?
-

41. Are there any mechanisms to record transmission of a trade mark in Indonesia, for example transmission by way of merger?

- Yes No
If yes, what are the requirements?
-

42. Are trade mark licensees required to record themselves with the Registrar?

- Mandatory Recommended No
(a) Copy of license agreement or evidence of license agreement;
(b) Copy of the licensed mark certificate;
(c) Original of specific Power of Attorney if the recordation will be submitted by the proxy;
(d) Original evidence of payment of recordation of license agreement;
(e) Declaration Letter of the recorded license agreement is still in the protection period, not harming national economic interest, not hampering the development of technology, and not contrary to the provisions of the regulations legislation, ethics, and public order

E. Change of Particulars

43. Should any change in the name or address of the proprietor on record of a registered trademark be updated on the register?

- Yes No
If yes, what are the requirements?

- The required documents are:
(a) Evidence of change of name and/or address of registered mark owner;
(b) Copy of mark certificate;
(c) Certified copy of deed of legal entity changes of the mark owner is a legal entity;
(d) Copy of applicant's ID card;
(e) Special Power of Attorney if applied by a proxy (IP consultant residing or domiciled in the territory of Indonesian Republic);
(f) Payment receipt.

44. Is it possible to change the representation of a registered trade mark?

- Yes No
If yes, what are the requirements?
-

45. Is it possible to correct and rectify any errors on the Register?

- Yes No
If yes, what are the requirements?
The correction and rectification of the application is only possible for the change of name and/or address of the Applicant or the Representative. The procedure is to file a letter of rectification to the Directorate of Mark.

Enforcement

46. What are the available enforcement methods in Indonesia?

- Civil enforcement
 ◦ Infringement action
 ◦ Passing off
 Criminal enforcement
 Border or other administrative enforcement measures

47. What are the requirements to bring an action for infringement of trademark?

- Valid registration of the trademark
- Unauthorised use by a 3rd party in the course of trade of a mark which is:
 - o identical to the registered trademark
 - o so nearly resembling the registered mark as is likely to cause confusion
 - o in relation to the goods or services for which the proprietor's mark is registered
 - o in relation to goods or services which are similar to the goods or services for which the proprietor's mark is registered though not the same

If yes, what are the criteria?

48. For a trademark infringement action, is it necessary to establish

- Actual confusion?
- Likelihood of confusion?

49. For a trademark infringement action, is it necessary to establish damage or loss to the proprietor of the trademark?

- Yes
- No
- Others

If yes, what are the requirements?

50. Is there a period of limitation for filing a suit for trade mark infringement?

- Yes
- No

If yes, what is the time period?

51. What are the remedies available for an infringement action?

- Damages or account of profits
- Injunction
- Delivery and/or destruction of the infringing goods
- Others:
 - (a) Compensation of the lawsuit;
 - (b) Termination of all acts relating to the use of such marks.

52. Is it possible to claim for 'passing off' in Indonesia?

- Yes
- No

53. If yes, what are the criteria to establish 'passing off'?

- That the proprietor has goodwill and reputation in the trademark

a. Must the goodwill and reputation subsist in Indonesia i.e. goodwill and reputation outside Indonesia will not be taken into consideration?

- o Yes
- o No

b. Must there be actual use or business presence in Indonesia?

- o Yes
- o No

c. What is the usual form of evidence used to establish such goodwill and reputation?

- That there is misrepresentation caused to members of the public

a. Is it necessary to establish actual confusion or is likelihood of confusion sufficient?

- o Actual confusion
- o Likelihood of confusion

b. What is the usual form of evidence used to establish such misrepresentation?

- That there are damage/likelihood of damage

a. Is it necessary to establish actual damages or is likelihood of damage sufficient?

- o Actual damage
- o Likelihood of damage

b. What is the usual form of evidence used to establish such damage or likelihood of damage?

Others: _____

54. Are there other forms of actions or claims that can be brought by a trademark owner against an infringer or unauthorised user?

Unfair competition Others: _____

55. What are the elements that need to be established to bring the claim(s) above?

All evidence of the infringement.

56. Can a trade mark owner lodge a complaint to any administrative authorities on counterfeit trade mark goods?

Yes No

If yes, please state the authority:

Penyidik Pegawai Negeri Sipil (PPNS) / Civil Servant Investigator.

57. What are the actions that can be taken by such authorities?

- Conduct a raid
- Seize the infringing goods
- Impose a fine
- Refer for criminal prosecution
- Others:
 - (a) Investigation;
 - (b) Request of statement;
 - (c) Search.

58. Are border measures available to restrict the importation of counterfeit trademark goods?

Yes No

If yes, what are the measures?

The Directorate General of Customs and Excise shall cooperate with the Chairman of the Commercial Court where there is an importation of infringed goods.

59. Do these border measures apply for counterfeit goods of unregistered trademarks?

Yes No

Not applicable, there are no rights for unregistered trademarks in Indonesia. However this border measures can apply for counterfeit goods of well-known unregistered trademarks.

60. Is there an authority or ministry responsible for the enforcement of trademark rights?

Yes No

If yes, please state:

The Police, Public Prosecutors and Judges.

Peculiarities

61. Are there any peculiarities not mentioned above in the system of protection for trademarks in Indonesia of which it is important for clients to be aware?

The protection of trademark in Indonesia is only based on registration. No registration means no protection. Therefore, it is highly recommended to any trademark owner who will use or trade the products and/or services within Indonesian territory to immediately register their trademarks since the Indonesia Trademark Law applies the "first-to-file" principle.

Patents

Patent Rights and Protection in Indonesia

General

1. What is the system for patent protection?

- Examination system
 Non-examination system

2. Is Indonesia a member of the Patent Cooperation Treaty (PCT)?

- Yes No

3. Is Indonesia a member of the Paris Convention?

- Yes No

Patent Registration

A. Registration System

4. What kinds of patent protection are available?

- Inventions Utility models
 Others: _____

5. What kinds of subject matter are excluded from patent protection?

- Methods of medical treatment or diagnosis
 Computer programs
 Business methods
 Others:
 Theory and method in the field of science and mathematics

B. Patent Filing

6. What are the documents and information required for filing a patent application?

- Name and address of the applicant
 Name of the inventor
 Specification
 Abstract
 Power of Attorney

- Deed of Assignment (Notarised)

- Others:
 A Statement from the applicant

7. Is there a fee for extra claims?

- Yes No
If yes, please describe:
 Rp. 50.000 per claim for the extra claims

8. Does Indonesia require obtaining a foreign filing license before filing a foreign patent application?

- Yes No
If yes, please describe:
-

B.1 Patent Specification

9. In which language must a patent specification be?

- English Other:
 Indonesian language

10. Is it possible to file an application first with an English specification, and then later submit its translation in the official language?

- Yes No
 [1] month as of the submission date

B.2 Publication, Amendment and Divisional Application

11. Is it possible to request a deferment of publication?

- Yes No
If yes, please describe:
-

12. Is it possible to request an early publication?

- Yes No

If yes, please describe:

The patent application can be published minimum 6 months as of the filing date.

13. Does the applicant have a provisional right upon the publication of an application?

- Yes No

If yes, please describe:

14. When is it possible to file a voluntary amendment to specification?

- At the time of entry into the national phase (for PCT application)
 At any time during prosecution
 At the time of requesting examination
 Others: _____

15. When is it possible to voluntarily file a divisional application?

- At any time during prosecution
 At the time of granting a patent
 Others: _____

16. Is it possible to file a divisional application based on a previous pending divisional application if the parent application has already been granted a patent?

- Yes No

C. Examination**17. Is there a requirement to submit certain information on corresponding applications, or prior art known to the applicant?**

- Yes No

If yes, please describe:

PCT documents and international search report.

18. Is there a grace period (exception to novelty)?

- Yes No

If yes, please describe:

A priority convention application has 12 months as of the filing date.

19. Is it required to file a request for substantive examination?

- Yes No

If yes, what are the requirements?

At the latest 36 months as of the filing date.

20. Can a third party file a request for substantive examination?

- Yes No

21. Is there a right of appeal?

- Yes No

If yes, please describe:

The applicant can file an appeal with the Patent Appeal Commission.

22. Are multiple dependent claims admissible?

- Yes No

D. Opposition**23. Is there an opposition procedure upon publication?**

- Yes No

24. How long is the opposition term once the application is published?

- 2 months 3 months
 Prior to the grant Others: 6 months

25. Who may initiate opposition proceedings?

- Any person
 Anyone with a legitimate interest
 Any competent authorities
 Others: _____

E. Timeline

26. What is the time period from application to grant for a straightforward application?

- Between 2 - 3 years
 Between 3 - 4 years
 Others: _____

27. Is there any process for accelerated examination of application?

- Yes No
If yes, what are the requirements?

Maintenance of Patent**A. Annuity**

28. To maintain the validity of patent, is it required to pay an annuity in Indonesia?

- Yes No

29. Is late payment of annuity permissible?

- Yes No
If yes, what are the requirements?

30. Is government annuity fixed for each year?

- Yes No
If yes, what is the base for calculation of annuity?

31. Can annuity be paid once for all years or once for several years?

- Yes No

32. Is power of attorney required for annuity payment?

- Yes No

33. Are there any provisions to restore a lapsed patent?

- Yes No
If yes, what are the requirements?

34. Is patent term extension available in Indonesia?

- Yes No
If yes, what are the conditions?

B. Compulsory Licence

35. Is a compulsory licence available in Indonesia?

- Yes No
If yes, what are the requirements?
Article 84 para (1) of Patent Law No. 13 of 2016.

- (a) The applicant or his/her proxy can show evidence of his/her ability to implement the said Patent completely by himself/herself and has facilities to implement the relevant Patent immediately;
 (b) The applicant or his/her proxy has attempted to take actions in the maximum period of 12 months to obtain a license from the Patent Holder on the basis of reasonable terms and conditions, but without success; and
 (c) The Minister is of the opinion that the said Patent may be performed in Indonesia within an appropriate economic scale and may be beneficial for the society.

36. Can a request for termination of compulsory licence be filed?

- Yes No
If yes, what are the requirements?

Article 103 para (2) of Patent Law No. 13 of 2016. The patent holder can request a termination of compulsory licence.

The grounds:

- (a) The reasons used as the basis to grant the mandatory license no longer exist;
 (b) The recipient of mandatory license does not implement the mandatory license or does not make any appropriate preparatory attempt to immediately

- implement the mandatory license; or
 (c) The recipient of the mandatory license does not comply with other terms and conditions.

C. Use Requirement

37. Does the patentee need to submit evidence of obligation of use to the Patent Office in order to maintain a patent in Indonesia?

- Yes No
 If yes, please describe:
-

38. Is a compulsory licence granted based on failing to perform an obligation to use?

- Yes No
 If yes, please describe:
 36 months from granting date.

D. Cancellation

39. Are termination or cancellation proceedings available in Indonesia?

- Yes No
 If yes, what are the grounds?
 Article 130 of Patent Law No. 13 of 2016.

The grounds:

- (a) An application for annulment from the Patent Holder is granted by the Minister;
 (b) A court's decision which annuls the said Patent has a binding legal force;
 (c) A decision of Patent annulment is issued by the Patent Appeal Commission; or
 (d) the Patent Holder does not fulfill the obligation to pay the annual fee.

40. What is the time limit for termination or cancellation?

- 3 years 5 years
 Whole Others:
 protection term of patent _____

E. Assignment, Transmission and Licensing

41. Are there any mechanisms to record assignment of a patent in Indonesia?

- Yes No
 If yes, what are the requirements?
 (a) a patent certificate;
 (b) a Deed of Patent Assignment;
 (c) a Power of Attorney;
 (d) a payment receipt of the latest annuity; and
 (e) a payment receipt of the request for recordal of patent assignment.

42. Are there any mechanisms to record transmission of a patent in Indonesia, for example, transmission by way of merger?

- Yes No
 If yes, what are the requirements?
 It is the same as the recordal of assignment.

43. Are patent licensees required to record themselves with the Patent Office?

- Yes No
 If yes, what are the requirements?
 (a) a copy of license agreement;
 (b) a copy of valid patent certificate;
 (c) a Power of Attorney;
 (d) a Statement for the recordal of license agreement; and
 (e) a payment receipt of the request for recordal of license agreement.

F. Change of Details

44. Are there any mechanisms to record change of name or address of the patent proprietor?

- Yes No
 If yes, what are the requirements?
 (a) A Power of Attorney;
 (b) A notarised document of the change of name/address of the patent proprietor issued by the authority;
 (c) A copy of the patent certificate; and
 (d) A payment receipt of the recordal of the change of name/address.

45. Is it possible to amend a granted patent?

- Yes No

If yes, what are the requirements?

46. Is it possible to correct and rectify any errors on the patent?

- Yes No

If yes, what are the requirements?

Only for typographical error.

- (a) A Power of Attorney;
 (b) A copy of the previous application form;
 (c) A copy of the patent certificate; and
 (d) Payment receipt.

Enforcement**47. What are the available enforcement methods in Indonesia?**

- Civil enforcement
 Administrative enforcement
 Criminal enforcement
 Border measures
 Others: _____

48. What are the criteria for infringement?

- Literal infringement
 Infringement under the doctrine of equivalents
 Use of the patent without permission of patent owner
 Others: _____

49. Is there a statute of limitations for filing a suit for patent infringement?

- Yes No

If yes, what is the time period?

50. What are the remedies available for an infringement action?

- Damages
 Injunction
 Destruction of the infringing goods
 Others: _____

51. What are the actions taken by such authorities?

- Conduct a raid
 Seize the infringing goods
 Impose a fine
 Others: _____

52. Is there an authority or ministry responsible for the enforcement of patent rights?

- Yes No

If yes, please state:

The Police, Public Prosecutors and Judges.

Peculiarities**53. Are there any peculiarities in the system of protection for patents in Indonesia of which it is important for clients to be aware?**

- (a) The request for substantive examination must be made within 36 months from the filing date.
 (b) The first annuity payment must be made within 6 months from the date of patent certificate.
 (c) The next annuity payment must be made at the latest 1 month before the due date.

Laos

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Foreword

Patents and trademarks in Laos are generally protected under the Law on Intellectual Property No. 01/NA, which is a broad and comprehensive piece of legislation covering a wide range of IP topics. Intellectual property protection has been bolstered in recent years by Laos' membership of the World Trade Organization in 2013 and accession to the Madrid Protocol in 2015.

Although the intellectual property regime can be somewhat vague, registration of rights is a relatively straightforward process. As a member of the Madrid Protocol, international protection of trademarks can be extended to Laos, and the trademark registration system generally meets international standards. Patents and petty patents are also protected under Laos law, and registration is relatively simple.

But while IP law is developing in accordance with international standards, progress can often be hindered by factors beyond legislative and administrative procedure, given that Laos remains a developing nation. Although registration of rights is uncomplicated, enforcement is very much a rarity, and infringement remains an endemic issue. Foreign holders seeking to protect their rights in Laos therefore have a good starting point in the registration regime, but would be well-advised to investigate the potential routes for enforcement in detail to gain an accurate picture of the protection available to them.

Trademarks

Trademark Rights and Protection in Laos

General

1. What is the system for trademark protection in Laos?

- Registration Common law
 Co-existing rights under registration and common law

2. Does first to use or first to register have prior rights in Laos?

- First to use First to register

3. Is Laos a member of the Madrid Union and the Paris Convention?

- Madrid System Paris Convention

4. If Laos is a member of Madrid Union is it a party to the Agreement or the Protocol and are there any peculiarities in relation to the implementation of the Madrid System for international registration in Laos?

Laos is a contracting party to the Madrid Protocol. The implementation of the Madrid Protocol has been made by way of the Decision of the Minister of Science and Technology on the Procedures for the Registration and Protection of Trademark through the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks No. 0142/MOST, dated February 13, 2017. The provisions follow the principles laid out in the Madrid Protocol.

Trade Mark Registration

A. Registration System

5. What are the benefits of registering a trade mark in Laos?

- Prevails over common law rights
 It is the only form of protection available for trademarks

- Entitles the proprietor to bring an infringement action
 Others: _____

6. Is it possible to obtain registration for the following types of marks under the registration system in Laos?

a. Service marks

- Yes No

b. Defensive marks

- Yes No
If yes, what are the requirements?

c. Collective marks

- Yes No
If yes, what are the requirements?
 In addition to the usual requirements for registering a trademark, if the application relates to a collective mark, the application shall so indicate and shall include a description of the way the mark is to be used.

d. Certification marks

- Yes No
If yes, what are the requirements?
 If the application relates to a certification mark, the application has to include a description of the way the mark is to be used. Likewise, the following will be required in addition to the usual requirements for registering a trademark:
- A statement identifying what the mark certifies;
 - A statement that the applicant is exercising legitimate control over the use of the certification mark or has a good faith intention to do so;
 - A statement that the applicant is not engaged in and will not engage in the production or marketing of the goods or services to which the mark is applied.

e. Well-known marks

(i.e. registration of a mark as a well-known mark and not an ordinary trademark)

Yes No

If yes, what are the requirements?

Well-known marks are marks that can benefit from protection under the law on intellectual property, as they are widely recognised by the public in Laos. Other factors may also be taken into account, such as whether the goods or services of the well-known mark are circulated within the territory, the regularity of the use of the trademark, the goodwill associated with the use of the trademark, and value of investment in the trademark. In order to be registered, well-known marks do not have specific requirements other than those for traditional trademarks.

f. Series marks

Yes No

If yes, what are the requirements?

g. Marks in different language or characters other than Roman characters

Yes No

If yes, what are the requirements?

If the mark is in a foreign language or contains foreign characters or words, a statement to that effect and a statement of the meaning of such foreign terms or characters, if any, including a transliteration of words or characters into the Lao language or other rendering from which the pronunciation can be ascertained must be provided.

h. Non-traditional marks: Sound marks

Yes No

If yes, what are the requirements?

i. Non-traditional marks: Smell marks

Yes No

If yes, what are the requirements?

j. Non-traditional marks: Position marks

Yes No

If yes, what are the requirements?

k. Non-traditional marks: Colour marks

(i.e. registration of a single colour or a combination of colours)

Yes No

If yes, what are the requirements?

According to Lao intellectual property law, a trademark may be a color or a combination of colors capable of distinguishing the goods or services delivered. If color is a feature of the mark, a statement to that effect must be given specifying the colors of the mark and portions of the mark associated with each color.

l. Non-traditional marks: Shape or three-dimensional marks

Yes No

If yes, what are the requirements?

Where a mark has three-dimensional features, the drawing must depict a single rendition of the mark, and the applicant must indicate that the mark is three-dimensional. The drawing presented on the application form must be a minimum of 4 cm by 4 cm and shall not exceed 8 cm by 8 cm.

m. Others:**7. Is it possible to claim a colour limitation?**

Yes No

If yes, what are the requirements?

The trademark application must indicate whether the mark is in black-and-white or in color. When the mark is in color, the color(s) should be indicated as well. Applicant can add a color claim and may also claim a specific color.

8. What is the official name of the trademark office in Laos?

The Department of Intellectual Property

B. Trade Mark Filing

9. What are the documents and information required for filing a trade mark application in Laos?

- Name and address of the applicant
- Representation of the trademark
- Goods and services and the class(es) for which the trade mark is to be registered
- Certificate of Incorporation (if the applicant is a company)
- Statutory Declaration
- Power of Attorney
- Others:
In Laos, foreign applicants must be represented by a local IP agent. As such a power of attorney is mandatory for foreign applicants. Powers of attorney must be notarised. Legalization is not necessary.

10. Can a trade mark application be based on intent to use in Laos?

- Yes No
- If yes, please specify any conditions:*
There are no special conditions for this.

11. Is priority claim allowed in Laos?

- Yes No
- If yes, what are the requirements?*
The applicant can claim priority for a period of six months under the Paris Convention. An application may claim priority on the basis of an earlier-filed application. A claim for priority is made by submitting a written statement that requests priority and identifies the trademark application that can serve as a basis for a priority claim under the Paris Convention. The applicant must substantiate the priority claim with certified copies from the issuing office of the application, which serve as the basis for the priority claim.

12. Are multi-class applications permitted in Laos?

- Yes No
- If yes, is there a maximum number of classes that can be applied for?*
No maximum of number of classes has been set by the Department of Intellectual Property.

13. Does Laos adopt the Nice Classification for specification of goods and services?

- Yes No
- If yes, please specify the edition:*
The Department of Intellectual Property refers to the 11th Edition of the Nice Classification.

14. Are there any specific requirements in relation to the classification of goods and services in Laos?

a. Must the specification of goods and services be limited to items from the list of goods and services under the Nice Classification only?

- Yes No

b. Can the class heading be included in the specification?

- Yes No Subject to conditions
- Please specify:*

The applicant must specify the goods or services for which the applicant uses the mark, or in good faith intends to use the mark, grouped according to the applicable class. A specification of goods and services that refers to "all goods", "all services", "all other goods", or "all other services," or that merely identifies goods or services by the class number or the title of the class, will not be acceptable to specify the goods or services or both in respect of which registration is sought. The specifications of the goods and services should follow the Nice Classification, although the Department of Intellectual Property will accept goods/services that do not exactly match those of the Nice Classification.

c. Are there sub-classes of goods and services applied by the trademark office in Laos?

- Yes No
- If yes, please elaborate:*

d. Others:

C. Trade Mark Examination

15. What marks, signs, representations, emblems or words are specifically prohibited from registration in Laos?

- Signs contrary to morality or public order
- Signs of such a nature as to deceive the public
- Signs benefiting protection from other international conventions (e.g., Red Cross, Olympic symbols, etc.)
- Signs protected by national laws (e.g., royal emblems)
- Others:
 - (a) Marks consisting of or containing, without authorization, images of cultural symbols or historical monuments, or the name, image, or likeness of a national hero or a leader;
 - (b) Marks identical to a well-known mark for the same/similar related class of goods or services
 - (c) Marks of such a nature that their use in the course of trade would discredit the establishment, the goods, or the industrial or commercial activities of a competitor;
 - (d) Marks consisting exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production, or of signs that have become customary in the current language or in the good faith and established practices of the trade in the Lao PDR;
 - (e) Marks consisting of or comprising indications that, when used in the course of trade, are liable to mislead the public as to the origin, nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods or services
 - (f) Marks consisting of or containing without authorization from the relevant governmental entity, armorial bearings, flags, or other national emblems, and official signs, hallmarks, abbreviations or full names of towns, municipalities, provinces or capital of the Lao PDR or foreign countries;

- (g) Marks consisting of or containing, without authorization, the name, image, or likeness of a living person;
- (h) Marks that are identical or similar to well-known marks for the same, similar or related goods or services
- (i) Marks that are identical or similar to a trade name for a business that provides the same, similar, or related goods and services;
- (j) Marks consisting of or incorporating a geographical indication which identifies a place other than the true origin of the goods;
- (k) Marks consisting of or containing matter that may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.

16. Is there substantive examination of trademarks?

- Yes No

If yes, what are the grounds?

- Absolute grounds
- Relative grounds

Others: _____

17. Is substantive examination conducted before or after publication of a trademark for opposition by third parties?

- Before publication After publication

18. What are the absolute grounds for refusal?

- Mark consists of a non-invented word(s)
- Mark has direct reference to the character or quality of the goods or services
- Mark is not distinctive
- Mark consists of a geographical name
- Mark consists of a surname
- Mark consists of letters of the alphabet
- Mark consists of numerals
- Mark consists of geometric shapes
- Others:
 - (a) Marks contains elements that may disparage or discredit other persons;
 - (b) Marks is contrary to "social order and the fine tradition of Laos";

- (c) In addition, when a mark includes terms that are descriptive, or customary terms for goods or services, the Department of Intellectual Property may require the applicant to disclaim the descriptive or customary terms displayed in the application, so that other applicants can use the terms in connection with their goods.

19. What are the relative grounds for refusal?

- There is a prior application for registration or registration for an identical or confusingly similar mark in relation to the same goods or services as the subject mark.
- There is a prior application for registration or registration for an identical or confusingly similar mark in relation to similar goods or services (although in different class) as the subject mark.
- Well-known mark: There is a well-known mark that is identical or so nearly resembling the subject mark for the same goods or services as the subject mark.
- Well-known mark: There is an earlier registered mark that is well known for different goods or services and use of the subject mark would indicate a connection between goods or services covered by the subject mark with the proprietor of the well-known mark.
- Others: _____

20. Is there a right of appeal?

- Yes No

If yes, please describe:

The Department of Intellectual Property conducts a substantive evaluation of the application and notifies the applicant of any conditions, objections, or grounds for refusal of part or all of the rights for which the applicant has applied. The applicant will be given 60 days in order to respond and to amend the application or provide supplementary information to respond to the Department of Intellectual Property. If the applicant fails to comply with this provision within 60 days from such notification, the application will be deemed to be abandoned; however, the Department may extend the time for complying with this provision for

good cause shown by the applicant.

D. Publication and Opposition

21. Is there an opposition procedure upon publication?

- Yes No

22. How long is the opposition term once the trade mark application is published in Laos?

Not Applicable

23. Is the opposition term extendible?

- Yes No
 Others: Not Applicable

24. Who may initiate opposition proceedings?

- Any person
 Anyone with a legitimate interest
 Any competent authorities
 Others: Not Applicable

25. What are the usual grounds for opposition?

- Prior use of a mark that is identical or confusingly similar to the opposed mark.
- Prior registration of a mark that is identical or confusingly similar to the opposed mark.
- Bad faith of the applicant for applying for registration of the opposed mark.
- Applicant is not the rightful proprietor of the opposed mark.
- If the opposed mark is identical to or so nearly resembles the Opponent's mark, which is well-known in Laos for the same goods or services.

- If the opposed mark is identical with or so nearly resembles the Opponent's mark, which is well-known and registered in Laos for goods or services not the same as those claimed in the opposed mark; provided that the use of the opposed mark in relation to the goods or services claimed would indicate a connection between those goods or services and the proprietor of the well-known mark, and the interests of the proprietor of the well-known mark are likely to be damaged by such use.
- Opposed mark lacks distinctiveness.
- Lack of intention to use the opposed mark.
- Opposed mark consists of a false geographical indication.
- Use of opposed mark likely to cause confusion or deception.
- Others: Not Applicable

E. Timeline

26. What is the time period from application to registration for a straightforward trademark application in Laos?

- Between 6 months - 12 months
- Between 12 months - 18 months
- 18 months above

27. Is there any process for accelerated/expedited examination of trade mark applications?

- Yes No
- If yes, what are the requirements?*
-

Maintenance of Trademark Registration

A. Renewal

28. Is there a mechanism to renew a trade mark registration in Laos?

- Yes No
- If yes, how long is the validity of the renewal?*

Similar to the registration of a trademark, the renewal of trademark protection is valid for a period of 10 years, renewable an unlimited number of times.

29. Is late renewal of a trademark registration permissible in Laos?

- Yes No

If yes, what are the conditions?

There is a grace period of six months, which allows the applicant to renew the trademark within six months after the protection term expires. The trademark owner will have to pay an additional fee for this.

30. Are there any provisions to restore a lapsed registration?

- Yes No

If yes, what are the conditions?

B. Use Requirement

31. Does evidence of use need to be submitted to the trademark office at any time in order to maintain an application for registration or a registration of a trademark in Laos?

- Yes No

If yes, what are the requirements?

C. Rectification/Cancellation

32. Are rectification or cancellation proceedings available in Laos?

- Yes No

If yes, what is the forum?

As per the law on intellectual property, at any time within five years from the date of publication of a registered trademark, any interested party may request the cancellation of the trademark with the Department of Intellectual Property.

33. What are the grounds for rectification or cancellation proceedings?

- Any entry made in the Register without sufficient cause
- Any entry wrongfully remaining in the Register
- Non-use of the mark
- Others:
- (a) A mark that disparages or discredits

another.

- (b) A mark that is not distinctive, or is identical to a previously registered mark, or is similar to a previously registered mark or a well-known mark and would cause confusion as to the source of the goods or services, or create a false impression that they are connected or associated with another party.
- (c) A mark containing prohibited characteristics as described in question 15 above.

34. When would a presumption of validity arise in relation to a trademark registration?

- [] years from date certificate of registration issued/date of application
- No such presumption

35. When are the grounds for rectification or cancellation proceedings assessed?

- At the time of filing of the application
- At the time of issuance of the certificate of registration
- At the time of the application for rectification or cancellation proceedings
- Others: _____

36. When is a trade mark registration vulnerable to cancellation on grounds of non-use?

- [5] years from the deemed date of registration
- [] years from the date of certificate issuance
- Not applicable
- Others: _____

37. Who bears the burden of proof in a non-use cancellation action?

- Applicant for cancellation
- Defendant / Respondent (trademark owner)

38. If the answer to the above is the Applicant, what are the examples of evidence which can be relied on to support an application for cancellation for non-use?

- Full market survey conducted by an independent or professional surveyor of an appropriate sample size
- Simple market survey or enquiries in the trade
- Declaration from the applicant for cancellation
- Others: Not Applicable

To the extent of our knowledge, there has not been any requests to file a cancellation of a trademark in Laos. Therefore, there is no precedent to specifically indicate what proof substantiates use of a trademark. The law on intellectual property simply states that a trademark is used when “used on or in connection with the goods or services of the trademark for which it is registered, by the owner or by another with authorization of the owner and subject to the owner’s control.”

D. Assignment, Transmission and Licensing

39. Are there any mechanisms to record assignment of a trade mark in Laos?

- Yes No

If yes, what are the requirements?

- In order to assign rights, the applicant will have to execute the following documents:
- (a) A notarised POA from the assignee. A copy of the notarised POA must be filed along with the application. The original can be submitted within 60 days after the new application has been filed.
- (b) A notarised deed of assignment. A copy of the notarised deed of assignment must be filed along with the application. The originals can be submitted within 60 days.
- (c) Copies of the trademark certificates.

40. Are there different requirements for recording assignment with or without the goodwill of the business?

- Yes No

If yes, what are the requirements?

41. Are there any mechanisms to record transmission of a trade mark in Laos, for example transmission by way of merger?

- Yes No

If yes, what are the requirements?

In the event of merger, a declaration of merger can be filed with the Department of Intellectual Property in order to record transmission of a trademark in Laos. The following documents are required:

- (a) A notarised POA from the absorbing company, which will enable our law firm or IP agent to act on its behalf. A copy of the notarised POA must be filed along with the application. The original can be submitted within 60 days after the new application has been filed.
- (b) A notarised declaration of merger. A copy of the notarised declaration of merger must be filed along with the application. The originals can be submitted within 60 days.
- (c) Copies of the trademark certificates.

42. Are trade mark licensees required to record themselves with the Registrar?

- Mandatory Recommended No

If yes, what are the requirements?

The recordal of a trademark license is not mandatory *per se* under the Lao regulatory framework. However, in order for the trademark license between the licensee and the licensor to be fully enforceable against all third parties, the registration with the Department of Intellectual Property is recommended. License agreements can be registered by means of a short form trademark license agreement.

E. Change of Particulars

43. Should any change in the name or address of the proprietor on record of a registered trademark be updated on the register?

- Yes No

If yes, what are the requirements?

Changes of name and/or address can be filed and registered with the Department of Intellectual Property. In order to change the name of the proprietor of record of a registered trademark the following documents are required:

- (a) An original notarised power of attorney under the applicant's new name, enabling the IP Agent/law firm to act on its behalf. A copy must be filed along with the application. The original can be submitted within 60 days after the new application has been filed.
- (b) An original notarised declaration of change of name. A copy must be filed along with the application. The original can be submitted within 60 days after the new application has been filed.
- (c) Copy of the trademark registration certificate.

In order to change the address of the applicant, the following documents are required:

- (a) An original notarised power of attorney substantiating the applicant's new address, enabling the IP agent/law firm to act on its behalf. A copy must be filed along with the application. The original can be submitted within 60 days after the new application has been filed.
- (b) An original notarised declaration of change of address. A copy must be filed along with the application. The original can be submitted within 60 days after the new application has been filed.
- (c) Copy of the trademark registration certificate.

44. Is it possible to change the representation of a registered trade mark?

- Yes No

If yes, what are the requirements?

In order to change representation of a registered trademark, the following documents are required:

- (a) Notarized declaration of revocation.
- (b) Notarized power of attorney enabling the new IP agent/law firm to act on behalf of the applicant.

45. Is it possible to correct and rectify any errors on the Register?

- Yes No

If yes, what are the requirements?

In order to correct and rectify any errors on the Register, the following documents are required:

- (a) Notarised power of attorney enabling the IP agent/law firm to act on the applicant's behalf.
- (b) Original trademark certificate.
- (c) Copy of the application form submitted at the time of the trademark registration.

Enforcement

46. What are the available enforcement methods in Laos?

- Civil enforcement
 - Infringement action
 - Passing off
- Criminal enforcement
- Border or other administrative enforcement measures

47. What are the requirements to bring an action for infringement of trademark?

- Valid registration of the trademark.
- Unauthorised use by a third party in the course of trade of a mark that is:
 - identical to the registered trademark;
 - so nearly resembling the registered mark as is likely to cause confusion; or
 - in relation to the goods or services for which the proprietor's mark is registered.

- in relation to goods or services that are similar to the goods or services for which the proprietor's mark is registered though not the same?

If yes, what are the criteria?

48. For a trademark infringement action, is it necessary to establish

- Actual confusion?
- Likelihood of confusion?

49. For a trademark infringement action, is it necessary to establish damage or loss to the proprietor of the trademark?

- Yes No Others

If yes, what are the requirements?

50. Is there a period of limitation for filing a suit for trade mark infringement?

- Yes No

If yes, what is the time period?

The law on intellectual property and the related regulations do not set any limitation for filing a suit for a trademark infringement. This may be considered on a case-by-case basis by the relevant authorities.

51. What are the remedies available for an infringement action?

- Damages or account of profits
- Injunction
- Delivery and/or destruction of the infringing goods
- Others:

Administrative remedies are available under the IP Law. To implement administrative remedies, the Department of Intellectual Property may, for example, initiate mediation proceedings between the infringer and the plaintiff or carry out raid actions on shops/markets/warehouses selling counterfeit goods. Different officers from different administration units will take part in this action as required, such as the Economic Police from a department related to the Ministry of Industry and Commerce and officers from the Department of Intellectual Property stationed in

the location where the raid will be led.

52. Is it possible to claim for 'passing off' in Laos?

- Yes No

53. If yes, what are the criteria to establish 'passing off'?

- That the proprietor has goodwill and reputation in the trademark

a. Must the goodwill and reputation subsist in Laos i.e. goodwill and reputation outside Laos will not be taken into consideration?

- Yes No

b. Must there be actual use or business presence in Laos?

- Yes No

However, this remains circumscribed to well-known trademarks.

c. What is the usual form of evidence used to establish such goodwill and reputation?

- That there is misrepresentation caused to members of the public

a. Is it necessary to establish actual confusion or is likelihood of confusion sufficient?

- Actual confusion
 Likelihood of confusion

b. What is the usual form of evidence used to establish such misrepresentation?

The usual form of evidence will be provided by way of investigation and comparison of the genuine and counterfeit products. An affidavit from the IP owner can also support a claim and provide further explanation on how to differentiate genuine goods from counterfeit.

- That there are damage/likelihood of damage

a. Is it necessary to establish actual damages or is likelihood of damage sufficient?

- Actual damage
 Likelihood of damage

b. What is the usual form of evidence used to establish such damage or likelihood of damage?

This could be based on economic damages incurred by the IP owner. In addition, damages to the goodwill or reputation of the IP owner can be taken into account by the relevant authorities at the time of substantiating damages.

- Others: _____

54. Are there other forms of actions or claims that can be brought by a trademark owner against an infringer or unauthorised user?

- Unfair competition Others: _____

55. What are the elements that need to be established to bring the claim(s) above?

The intellectual property law addresses that acts of unfair competition described below:

- (a) Direct or indirect use of a false indication of the source of goods or the identity of the producer, manufacturer, or merchant;
- (b) All acts of such a nature as to create confusion by any means whatsoever as to the establishment, the goods, or the industrial or commercial activities, of a competitor;
- (c) False allegations of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities, of a competitor;
- (d) Use of indications or allegations liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods.

56. Can a trade mark owner lodge a complaint to any administrative authorities on counterfeit trade mark goods?

- Yes No

If yes, please state the authority:

According to the law on intellectual property, "Counterfeit trademark goods shall mean any goods, including packaging, bearing without authorization a trademark that is identical to the trademark validly registered in respect of such goods, or which cannot be distinguished in its essential aspects from such a trademark, and which thereby infringes the rights of the owner of the trademark in question under the law on intellectual property." As such, an IP owner can file a complaint to the Department of Intellectual Property seeking administrative remedies. The Department of Intellectual Property will then initiate mediation between the concerned parties. Administrative remedies can also lead to the seizing of counterfeit goods. In addition, the law on civil procedure provides the possibility to file a petition to the Lao People's Court in regard to IP matters and counterfeit goods-related issues.

57. What are the actions that can be taken by such authorities?

- Conduct a raid
 Seize the infringing goods
 Impose a fine
 Refer for criminal prosecution
 Others: _____

58. Are border measures available to restrict the importation of counterfeit trademark goods?

- Yes No

If yes, what are the measures?

Currently, any trademark owner may inform customs by filing a motion including an application form provided by customs and a bond payment, as prescribed by customs. Accordingly, brand owners can initiate an action to request that customs suspend clearance for said counterfeit goods. Tariff officers have the authority and responsibility to inspect any suspected goods, seize them, and to confiscate and/or destroy any infringing goods.

The trademark owner is required to provide the following information to customs:

- (a) A motion for inspection and suspension using the standard form issued by the customs department;
 (b) Evidence of the brand owner's relevant intellectual property rights, such as a trademark certificate, and adequate evidence of *prima facie* infringement of such rights in compliance with the Intellectual Property Law;
 (c) The name(s) of the relevant check-point(s) or place(s) where the goods will be imported or exported and a detailed description of the vehicle that will be transporting said goods;
 (d) A detailed description of the goods, sufficient to make the goods readily recognizable by the customs officer;
 (e) Other information (if any), such as photos of the infringing goods or details of the importer or exporter, to assist the customs officers;
 (f) A security deposit of LAK 10,000,000 (approximately USD 1,200) deposited in cash, by check or by bank guarantee;
 (g) An execution of a guarantee to cover any expenses of customs authorities which may arise from the requested suspension;
 (h) A copy of the enterprise registration certificate;
 (i) Power of attorney (POA); and
 (j) A receipt for the payment of the security deposit.

59. Do these border measures apply for counterfeit goods of unregistered trademarks?

- Yes
 No (except for well-known trademarks).
 Not applicable, there are no rights for unregistered trademarks in Laos

60. Is there an authority or ministry responsible for the enforcement of trademark rights?

Yes No

If yes, please state:

The Department of Intellectual Property of Laos, which is under the Ministry of Science and Technology, is the authority responsible for the enforcement of trademark rights.

Police officers will be involved during any raid actions to seize the counterfeit goods.

In addition, a representative from the Trade Department, which is under the Ministry of Industry and Commerce, and an officer from the Ministry of Finance, Tax Department, will also be present during the raid action in order to verify business licenses and tax compliance of the shops involved in the sale of counterfeit goods.

Peculiarities

61. Are there any peculiarities not mentioned above in the system of protection for trademarks in Laos of which it is important for clients to be aware?

The current law on intellectual property dates from December 20, 2011. However, it is noteworthy that the law on intellectual property will soon be revised. The new law on intellectual property is currently under debate at the National Assembly and is supposed to be implemented as soon as January 2018. As such, some of the above statements may need updating to be in accord with the new IP law.

Patents

Patent Rights and Protection in Laos

General

1. What is the system for patent protection?

- Examination system
- Non-examination system

2. Is Laos a member of the Patent Cooperation Treaty (PCT)?

- Yes
- No

3. Is Laos a member of the Paris Convention?

- Yes
- No

Patent Registration

A. Registration System

4. What kinds of patent protection are available?

- Inventions
- Utility models
- Others: Industrial design

5. What kinds of subject matter are excluded from patent protection?

- Methods of medical treatment or diagnosis
- Computer programs
- Business methods
- Others:

Under Section 21 of the Intellectual Property Law, the following inventions and devices are not eligible for patent or petty patent protection:

 - (a) inventions or utility innovations that are not novel because they are discoveries of existing things, including living organisms or parts of living organisms that exist in nature;

- (b) subject matter that is not an invention does not constitute a technical solution because it is merely a scientific principle or theory, a mathematical algorithm, or a set of rules for doing business or playing games, provided, however, that such subject matter may constitute an element of an invention or utility innovation;
- (c) diagnostic, therapeutic and surgical methods for the treatment of humans or animals;
- (d) plants and animals other than micro-organisms, and essentially biological processes for the production of plants or animals, provided, however, that such subject matter may constitute an element of an invention or utility innovation.

B. Patent Filing

6. What are the documents and information required for filing a patent application?

According to Article 13 (revised), in order to obtain a patent, an invention shall meet all the following requirements:

- (a) shall be new, meaning such invention has not existed, and has not been disclosed to the public by publication, or by use, or by or in any other means in the Lao PDR or any place in the world prior to the date of filing the application for registration, or where priority is claimed prior to the priority date of the application for a patent;
- (b) shall involve an inventive step: meaning that a step that would not be obvious to a person having ordinary knowledge in that field of technology;
- (c) shall be industrially applicable in the fields of industry, handicraft, agriculture, fishery, services, etc.

Required documents:

(a) National patent application

- (i) Notarised power of attorney must be filed simultaneously with the application
- (ii) Notarised inventorship deed of assignment (when applicant and inventor are not the same) must be filed simultaneously with the application.

(b) Convention-based application

There is a time limit of 12 months from the earliest priority date to claim on the basis of the conventional patent application under Paris convention.

- (i) Notarised power of attorney must be filed simultaneously with the application
- (ii) Certified copy of the priority document which is issued by the first receiving office. English and Laos translation are required. The original document must be submitted within 60 days from the filing date.
- (iii) Notarised priority deed of assignment (required when the applicant is any other than the one in the priority document) must be submitted within 60 days from the filing date.

(c) PCT National phase application

There is a time limit of 30 months from the earliest priority date claimed in PCT application to enter the national phase.

- (i) Notarised power of attorney must be filed simultaneously with the application
- (ii) Notarised priority deed of assignment (required when the applicant is any other than the one in the priority document) must be must be filed simultaneously with the application.

If copies of the above documents are submitted with the application, the original documents must be submitted within 60 days from the filing date.

The Lao translation of the accompanying documents above must be submitted within 90 days from the filing date.

7. Is there a fee for extra claims?

- Yes No

8. Does Laos require obtaining a foreign filing license before filing a foreign patent application?

- Yes No

If yes, please describe:

B.1 Patent Specification

9. In which language must a patent specification be?

- English Other: Laos

10. Is it possible to file an application first with an English specification, and then later submit its translation in the official language?

- Yes No

Lao translation of the specification can be filed within 90 days from the date of filing the application in Laos.

B.2 Publication, Amendment and Divisional Application

11. Is it possible to request a deferment of publication?

- Yes No

If yes, please describe:

A deferment of publication can be requested as long as the time frame for postponement is reasonable.

12. Is it possible to request an early publication?

- Yes No

If yes, please describe:

An applicant can request early publication. If such a request is filed, the patent application will be published within 2 - 3 months from the date of the request, or from the date of issuance of a decision on acceptance of the application as valid after formal examination, depending on which date is later.

13. Does the applicant have a provisional right upon the publication of an application?

- Yes No

If yes, please describe:

Before an invention/utility model is granted, the intellectual property rights (IPR) owner has a provisional right to the invention/utility model. In particular, the IPR owner could send a warning letter stating the filing date and publication date in the Industrial Property Gazette and ask the user to cease the use of the invention/utility model. If the user continues using the invention/utility model, then as soon as a patent for invention/utility model is granted, the owner of the patent shall have the right to request that the user pay compensation equivalent to the price for licensing the invention/utility model within the corresponding scope and duration of use.

14. When is it possible to file a voluntary amendment to specification?

- At the time of entry into the national phase (for PCT application)
 At any time during prosecution
 At the time of requesting examination
 Other:

An amendment can be filed at any time during prosecution of an application, but must be filed before any decision is issued invalidating, granting, or accepting the application.

15. When is it possible to voluntarily file a divisional application?

- At any time during prosecution
 At the time of granting a patent
 Other:

One or more divisional application(s) can be filed any time during prosecution of an application but must be filed before any decision is issued invalidating, granting, or accepting the application.

16. Is it possible to file a divisional application based on a previous pending divisional application if the parent application has already been granted a patent?

- Yes No

C. Examination

17. Is there a requirement to submit certain information on corresponding applications, or prior art known to the applicant?

- Yes No

If yes, please describe briefly:

Upon request by the registration office, the applicant must provide information on registration of industrial property in a foreign country; especially the industrial property corresponding to that being applied for in Laos. Such information shall comprise:

- (a) A copy of the industrial property examination report in the foreign country; and
 (b) A copy of the registration certificate of industrial property obtained in the foreign country.

18. Is there a grace period (exception to novelty)?

- Yes No

If yes, please describe:

19. Is it required to file a request for substantive examination?

- Yes No

If yes, what are the requirements?

If the applicant cannot submit a substantive examination report on the invention or device for which registration is requested, the applicant can request that the registration office perform a substantive examination of the application. This can be done within 32 months for an invention and 12 months for a device from the application date or the priority date.

20. Can a third party file a request for substantive examination?

- Yes No

21. Is there a right of appeal?

- Yes No

If yes, please describe briefly:

Under the regulations, every applicant may appeal to the Director of Patents against a final refusal of the examiner to grant a patent within two months from the mailing date of the final refusal. The decision or order of the Director shall become final and executory fifteen days after receipt of a copy by the appellant unless within the same period, a motion for reconsideration is filed with the Director or an appeal to the Director General is filed together with the payment of the required fee. The decision of the Director General may be appealed to the Court of Appeals. If the applicant is still not satisfied with the decision of the Court of Appeals, he may appeal to the Supreme Court.

22. Are multiple dependent claims admissible?

- Yes No

D. Opposition**23. Is there an opposition procedure upon publication?**

- Yes No

24. How long is the opposition term once the application is published?

- 2 months 3 months
 Prior to the grant Other:

25. Who may initiate opposition proceedings?

- Any person
 Anyone with a legitimate interest
 Any competent authorities
 Others: _____

E. Timeline**26. What is the time period from application to grant for a straightforward application?**

- Between 2 - 3 years
 Between 3 - 4 years
 Other: _____

27. Is there any process for accelerated examination of application?

- Yes No

If yes, what are the requirements?

Laos has a Cooperation for Facilitating Patent Grant (CPG) agreement with the Japanese Patent Office, and hence patent applicant in Laos is hence entitled to file a request for substantive examination under the CPG Program based on a corresponding Japanese patent.

A request for acceleration under the CPG can be made at the stage of substantive examination OR upon filing the Lao application. The request must comprise:

- (a) A copy of the entire corresponding patent as granted in Japanese-language;
 (b) An English translation of the final specification, claims, abstract; the granted JP claims and specification must be translated into Lao;
 (c) A copy of the industrial property registration certificate obtained in Japan along with the English translation thereof.

To initiate the CPG acceleration process, it is advised that the Lao translation of the specification and claims granted by the JPO must be completed at the date of making the request.

Maintenance of Patent**A. Annuity****28. To maintain the validity of patent, is it required to pay an annuity in Laos?**

- Yes No

29. Is late payment of annuity permissible? Yes No*If yes, what are the conditions?*

Late payment should be made no more than six months from the due date. There are no conditions for late payment, although a late payment charge must be paid.

30. Is government annuity fixed for each year? Yes No*If yes, what is the base for calculation of annuity?*

Government annuity is calculated for each year and based on number of independent claim(s).

31. Can annuity be paid once for all years or once for several years? Yes No**32. Is power of attorney required for annuity payment?** Yes No**33. Are there any provisions to restore a lapsed patent?** Yes No*If yes, what are the requirements?***34. Is patent term extension available in Laos?** Yes No*If yes, what are the conditions?***B. Compulsory Licence****35. Is a compulsory license available in Laos?** Yes No*If yes, what are the requirements?*

If necessary for protection of the country, protection of peace, food supply, safety concerning health of the people of Lao, without the purpose of trade, the government may permit a person or organization to exploit the patent or petty patent without the consent of the owner of that patent or petty patent. However, the exploitation must be based on the scope of permission of the government. The owner of the patent or petty patent must be informed and paid a suitable royalty. If the country is in emergency status due to natural causes or war, the prime minister can order a person or organization to exploit the patent or petty patent and to proceed as stated earlier.

36. Can a request for termination of compulsory licence be filed? Yes No*If yes, what are the requirements?*

According to Article 53 of the IP Law, the owner of the patent or petty patent can submit an argument against an unsuitable order or royalty within 60 days from the date of being informed of such order.

C. Use Requirement**37. Does the patentee need to submit evidence of obligation of use to the Patent Office in order to maintain a patent in Laos?** Yes No*If yes, please describe:*

38. Is a compulsory licence granted based on failing to perform an obligation to use?

- Yes No

If yes, please describe:

If the invention or device which has been granted a patent or petty patent has not been exploited or not fully exploited three years after grant of the patent or petty patent, the government shall instruct the owner of the rights to submit an explanation in writing within 90 days. If there is no response or the response is not satisfactory, the government shall allow others who apply for exploitation to do so.

D. Cancellation

39. Are termination or cancellation proceedings available in Laos?

- Yes No

If yes, what are the grounds?

Yes, the following grounds for cancellation are found in Law No. 01/NA of December 20, 2011, on Intellectual Property (as amended), article 45, patents, petty patents, and industrial property registrations:

- (a) the term of protection has expired;
- (b) the industrial property owner fails to renew the registration and pay the applicable fees, in which case, rights shall terminate as of the end of the term for which protection was granted and the fee was paid;
- (c) the patent, petty patent, or registration is invalidated based on a finding that one or more requirements for protection have not been satisfied; where such finding applies to only a portion of the industrial property, the termination shall apply only to such portion as is invalidated. In such case, the invalidation shall be effective as from the grant of the patent, petty patent, or registration;
- (d) failure to commercially exploit, the industrial property rights will cause them to be terminated after a final decision by the competent court.

Additionally, article 136 stipulates “Where a patent, petty patent, industrial design registration, trademark registration, integrated circuit layout-design registration, or plant variety protection certificate is held invalid by the People’s Court, the Ministry of Science and Technology shall cancel such intellectual property accordingly. In the case of patents or petty patents, such holding shall specify the patent or petty patent claims to which the holding applies.”

40. What is the time limit for termination or cancellation?

- 3 years 5 years
 Whole Others: _____
 protection term of patent

E. Assignment, Transmission and Licensing

41. Are there any mechanisms to record assignment of a patent in Laos?

- Yes No
If yes, what are the requirements?

Change of Ownership of Patent Application

- (a) An executed and notarised deed of assignment—the original document is required at the time of filing.
- (b) A notarised power of attorney in the name of new patentee —the original document is required at the time of filing.

42. Are there any mechanisms to record transmission of a patent in Laos, for example, transmission by way of merger?

- Yes No
If yes, what are the requirements?

Change of Ownership of Patent Application

- (a) An executed and notarised deed of assignment—the original document is required at the time of filing.
- (b) A notarised power of attorney in the name of new patentee —the original document is required at the time of filing.

43. Are patent licensees required to record themselves with the Patent Office?

- Yes No

If yes, what are the requirements?

46. Is it possible to correct and rectify any errors on the patent?

- Yes No

If yes, what are the requirements?

F. Change of Details

44. Are there any mechanisms to record change of name or address of the patent proprietor?

- Yes No

If yes, what are the requirements?

Change of Address

- (a) A notarised power of attorney. The original and notarised POA is required at the time of filing the change of address with the Laos Patent Office.
- (b) A certified copy of company registration certificate. The original and certified document is required at the time of filing the change of address with the Laos Patent Office. A notarised copy can be used in lieu of the certified document.

Change of Ownership of Patent Application

- (a) An executed and notarised deed of assignment—the original document is required at the time of filing.
- (b) A notarised power of attorney in the name of new patentee —the original document is required at the time of filing.

Change of Ownership of Patent

- (a) An executed and notarised deed of assignment—the original document is required at the time of filing.
- (b) A notarised power of attorney in the name of new patentee —the original document is required at the time of filing.
- (c) The original patent certificate.

45. Is it possible to amend a granted patent?

- Yes No

If yes, what are the requirements?

Enforcement

47. What are the available enforcement methods in Laos?

- Civil enforcement
 Administrative enforcement
 Criminal enforcement
 Border measures
 Others: _____

48. What are the criteria for infringement?

- Literal infringement
 Infringement under the doctrine of equivalents
 Use of the patent without permission of patent owner
 Others: _____

49. Is there a statute of limitations for filing a suit for patent infringement?

- Yes No

If yes, what is the time period?

There is no specific statute of limitations for patent infringement under Lao law, but as the Lao courts have not yet handled a patent infringement case it is unclear whether one would be applied. Broadly speaking however Laos law applies a three year limitation period to most commercial rights.

50. What are the remedies available for an infringement action?

- Damages
 Injunction
 Destruction of the infringing goods
 Others:

The following measures can be taken to settle intellectual property infringement matters:

- (a) Mediation between the rights' owner and the infringer;
(b) Administrative settlement;

- (c) Settlement by the board of economic disputes settlement;
- (d) Bringing the case to the court for judgement.

International Disputes Settlement

Section 114: Mediation

The owner of intellectual property can mediate with the infringer when it is of the view there its rights have been infringed.

Section 115: Administrative Settlement

The owner of the intellectual property can request that the intellectual property protection organization settle the infringement of its intellectual property.

Section 116: Settlement by the Board of Economic Disputes Settlement

When administrative settlement cannot be accomplished by the intellectual property protection organization, the owner of the intellectual property can request the board of economic disputes settlement to conduct an inquiry and make a decision.

Section 117: Bringing the Case to the Court

If a dispute relating to intellectual property cannot be settled by administrative procedures or by the board of economic disputes, the owner of the intellectual property can bring the case to court for adjudication.

Section 118: International Disputes Settlement

International disputes relating to intellectual property shall be settled in compliance with international treaties and international procedures related thereto.

51. What are the actions taken by such authorities?

- Conduct a raid
- Seize the infringing goods
- Impose a fine
- Others:

After conducting a raid into the infringer's premises/place of business, the administrative authorities may take the following actions against the infringer:

- (a) Primary sanctions, which are monetary fines;
- (b) Additional sanctions, which include, *inter alia*, confiscation and/or destruction of infringing goods as well as means for producing the infringing goods;
- (c) Suspension of business license; and
- (d) Remedial measures, which include, *inter alia*, removal of infringing elements; compulsory distribution or use of infringing goods as well as means primarily used to produce the infringing goods for non-commercial purposes provided that such distribution and use does not influence the exploitability of the rights of the patent holder; recall of infringing goods on the market; and recovery of illegal profits from the infringement to the state budget.

If the case otherwise goes to civil court, the court may order the following actions:

- (a) Compulsory cessation of the infringing act;
- (b) Compulsory public retraction of the false information on the ownership of the IP assets which have been published, and an apology;
- (c) Compulsory performance of civil obligations (a task under which the obligors must transfer an object, transfer rights, pay money or return valuable papers, perform other tasks, or refrain from doing certain tasks in the interest of the obligees);
- (d) Compulsory compensation for damages; and
- (e) Compulsory destruction of infringing goods or distribution of them for non-commercial purposes without prejudice to the rights of the patent holder;

In addition, attorney's fees may be recovered in civil proceedings.

52. Is there an authority or ministry responsible for the enforcement of patent rights?

Yes No

If yes, please state:

Generally, the following administrative authorities will assert jurisdiction over patent infringement: the Inspectorate of Science and Technology; customs; and the Market Surveillance Agency (for certain infringement actions, for example, violations of provisions on indications on protection of industrial property rights). In addition, a patent owner can also submit his/her complaint to the competent court.

Peculiarities

53. Are there any peculiarities in the system of protection for patents in Laos of which it is important for clients to be aware?

Laos has a Cooperation for facilitating Patent Grant (CPG) agreement with the Japanese Patent Office, and hence an applicant of a Lao Patent Application is entitled to file a request for substantive examination under the CPG program based on the corresponding Japanese patent.

A request for acceleration under the CPG can be made at the substantive examination stage OR upon filing the Lao application.

The request must include:

- (a) A copy of the entire corresponding patent as granted in Japanese-language;
- (b) An English translation of the final specification, claims, abstract;
- (c) the granted JP claims and specification must be translated into Lao; and
- (d) A copy of registration certificate of industrial property obtained in Japan along with the English translation thereof.

To initiate the CPG acceleration process, it is advised that the Lao translation of the specification and claims granted by the JPO must be completed at the date of making the request.

Malaysia

Prepared by Skrine

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About The Firm

Skrine is one of the largest full-service law firms in Malaysia with a depth of experience in a range of legal matters acquired through its more than 54 years of practice. The firm is currently led by 48 partners with over 100 lawyers across the Corporate, Dispute Resolution and Intellectual Property Divisions.

Skrine's IP Division advises on the overall protection and management of intellectual property rights. In this regard, the lawyers act as IP consultants for their clients. The lawyers are all qualified Advocates and Solicitors and several of them are also registered trade mark, patent and industrial design agents with rights of audience before the different intellectual property registries and also the Courts in West Malaysia.



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Foreword

The Malaysian government has taken steps over the years to be on par with the international community in relation to intellectual property protection. It recognises that strong protection of intellectual property rights is an essential tool in the development of the nation and has cultivated a strong legislative, administrative and enforcement environment within the country to ensure vigorous protection of intellectual property rights of both Malaysian and foreign individuals and entities in Malaysia.

Malaysia has acceded to various international conventions and treaties such as the Patent Cooperation Treaty, the Paris Convention and the Berne Convention, the Agreement on Trade-Related Aspect of Intellectual Property Rights (TRIPS) as well as the Nice Agreement Concerning the International Classification of Goods and Services and the Vienna Agreement.

The regulation of most areas of intellectual property rights are governed by statute such as the Trade Marks Act 1976, the Patents Act 1983, the Copyright Act 1987, the Industrial Designs Act 1996, the Geographical Indications Act 2000 and the Layout Design of an Integrated Circuit Act 2000. At the same time, common law rights continue to exist side by side for instance the common law tort of passing off protects trademarks against unauthorised use which can lead to misrepresentation even where the trademark is not registered, and action can be taken for breach of confidential information in relation to the unauthorised use and/or disclosure of trade secrets and confidential information.

Malaysia has established a specialised Intellectual Property Court since July 2007 which allows for more efficient and effective disposal of intellectual property litigation and enforcement.

There is always room for improvement and various changes are in the pipeline for the legal landscape relating to intellectual property in Malaysia. For starters, Malaysia is expected to accede to the Madrid Protocol soon and amendments to the Trade Marks Act to give effect to this are expected to come into force soon. Various other changes are also anticipated, including possible registration of security interest in relation to trademarks and patents.

We, at Skrine will be watching the coming changes in the Malaysian intellectual property landscape closely and will endeavour to keep you abreast of the same. We hope you find this Guide an insightful and easy read and would be happy to assist with any questions you may have.

Trademarks

Trademark Rights and Protection in Malaysia

General

1. What is the system for trademark protection in Malaysia?

- Registration Common law
 Co-existing rights under registration and common law

- (a) There is a system for registration of trademarks. Registration of a trademark gives the proprietor exclusive rights of use of the trademark and the right to bring an action for infringement of trademark against unauthorised use by a 3rd party in the course of trade of an identical or confusingly similar mark in relation to the goods or services for which the mark is registered. No person is entitled to initiate any action to prevent or to recover damages for the infringement of an unregistered trademark.
- (b) Notwithstanding lack of registration for a trademark, a person is entitled to bring an action for the common law tort of passing off and obtain remedies in respect thereof.
- (c) The first to use a mark in Malaysia has prior rights as compared to the first to register. The Trade Marks Act 1976 provides that the Registrar shall not refuse to register a trade mark which is identical or confusingly similar to another trademark which is already on the register if the applicant of the first mentioned trade mark has continuously used that trade mark from a date before the use or registration of the other trade mark by the registered proprietor.

2. Does first to use or first to register have prior rights in Malaysia?

- First to use First to register

3. Is Malaysia a member of the Madrid Union and the Paris Convention?

- Madrid System Paris Convention

4. If Malaysia is a member of Madrid Union is it a party to the Agreement or the Protocol and are there any peculiarities in relation to the implementation of the Madrid System for international registration in Malaysia?

Not Applicable.

Trade Mark Registration

A. Registration System

5. What are the benefits of registering a trade mark in Malaysia?

- Prevails over common law rights
 It is the only form of protection available for trademarks
 Entitles the proprietor to bring an infringement action
 Others:
- (a) The proprietor of a registered trade mark has exclusive rights to use the mark.
- (b) A registered trade mark is assignable and transmissible with or without the goodwill of the business.
- (c) Registration of a trade mark for goods will block a subsequent application for an identical or confusingly similar trade mark in respect of the same goods or description of goods or closely related services and registration of a trade mark for services will block a subsequent application for an identical or confusingly similar trade mark in respect of the same services or description of services or closely related goods.

6. Is it possible to obtain registration for the following types of marks under the registration system in Malaysia?

a. Service marks

- Yes No

b. Defensive marks

- Yes No

If yes, what are the requirements?

To obtain a defensive mark registration:

- (a) the mark must consist of an invented word or words; and
- (b) The mark must have become so well known in relation to certain goods or services in respect of which it is registered that the use of the mark in relation to other goods or services would likely be taken as indicating a connection in the course of trade between such other goods or services and a person entitled to use the trade mark in relation to the first mentioned goods or services.

The application for registration is made using the same application form as for an ordinary trade mark but must be accompanied by a statement of case verified by a statutory declaration setting out full particulars of the facts and evidence to establish the above requirements.

c. Collective marks

- Yes No

If yes, what are the requirements?

d. Certification marks

- Yes No

If yes, what are the requirements?

To obtain registration of a certification mark:

- (a) The mark must be capable of distinguishing in the course of trade goods or services certified in respect of origin, materials, mode of manufacture, quality, accuracy or other characteristics from goods or services not so certified;
- (b) The applicant must not carry on a trade in goods or services of the kinds certified;

- (c) The rules governing the use of the trade mark must be satisfactory to the Registrar;
- (d) The applicant must satisfy the Registrar that he is competent to certify the goods or services in respect of which the mark is to be registered; and
- (e) The registration should be to the public advantage

The application for registration is made using the same application form as for an ordinary trade mark but must be accompanied by a statement of case verified by a statutory declaration setting out full particulars of the facts and evidence to establish the above requirements as well as the draft rules governing the use of the trade mark.

e. Well-known marks

(i.e. registration of a mark as a well-known mark and not an ordinary trademark)

- Yes No

If yes, what are the requirements?

f. Series marks

- Yes No

If yes, what are the requirements?

The marks in the series should resemble each other in material particulars but may differ in respect of:

- (a) Statement or representations as to the goods or services;
- (b) Statement or representations as to number, price, quality or names of places;
- (c) Other matter which is not distinctive and does not substantially affect the identity of the trade mark; or
- (d) Colour.

g. Marks in different language or characters other than Roman characters

- Yes No

If yes, what are the requirements?

A certified transliteration and translation of each word in any language other than English or the national language Bahasa Malaysia as well as a certified transliteration of any characters or alphabets other than Roman alphabets is required.

h. Non-traditional marks: Sound marks

- Yes No
If yes, what are the requirements?
-

i. Non-traditional marks: Smell marks

- Yes No
If yes, what are the requirements?
-

j. Non-traditional marks: Position marks

- Yes No
If yes, what are the requirements?
-

k. Non-traditional marks: Colour marks

(i.e. registration of a single colour or a combination of colours)

- Yes No
If yes, what are the requirements?

A description of the mark must be included in the application form, for instance “the mark consists of the colour [] applied to []”. Generally such marks are not considered inherently distinctive and substantial evidence of use is required to establish acquired distinctiveness in order to obtain registration.

l. Non-traditional marks: Shape or three-dimensional marks

- Yes No
If yes, what are the requirements?
-

m. Others, please specify

7. Is it possible to claim a colour limitation?

- Yes No
If yes, please describe:

Where a trade mark is registered without limitation as to colour it shall be deemed to be registered for all colours. A trade mark may be limited in whole or in part to one or more specified colours. The limitation must be specifically claimed in the application and the colours must be described either

by reference to the Pantone code or the representation in the application form. Such colour limitation is required to be taken into consideration by the Registry for the purpose of determining whether the trade mark is distinctive.

8. What is the official name of the trademark office in Malaysia?

Intellectual Property Corporation of Malaysia (MyIPO)

B. Trade Mark Filing**9. What are the documents and information required for filing a trade mark application in Malaysia?**

- Name and address of the applicant
 Representation of the trade mark
 Goods and services and the class(es) for which the trade mark is to be registered
 Certificate of Incorporation (if the applicant is a company)
 Statutory Declaration
 Power of Attorney
 Others:

A Statutory Declaration stating that the applicant is the bona fide proprietor of the mark is required for each trade mark application. The Statutory Declaration must be signed by an authorised officer of the Applicant and duly sworn or declared usually before a Commissioner for Oaths or Notary Public. The Statutory Declaration can be filed after the application is filed at no additional charge. There is no specific deadline although it must be filed within 12 months of the filing date of the application.

10. Can a trade mark application be based on intent to use in Malaysia?

- Yes No
If yes, please specify any conditions:
-

11. Is priority claim allowed in Malaysia?

- Yes No

If yes, what are the requirements?

The trade mark number of the priority application and the Convention country in which it is filed as well as the application date must be stated in the prescribed application form.

An extract of the priority application certified by the registering authority of the relevant Convention country must be submitted together with a certified English translation if the document is not in English. The supporting documents can be filed after the application is filed at no additional charge. There is no specific deadline although it must be filed within 12 months of the filing date of the application.

12. Are multi-class applications permitted in Malaysia?

- Yes No

If yes, is there a maximum number of classes that can be applied for?

13. Does Malaysia adopt the Nice Classification for specification of goods and services?

- Yes No

If yes, please specify the edition:
11th edition

14. Are there any specific requirements in relation to the classification of goods and services in Malaysia?

a. Must the specification of goods and services be limited to items from the list of goods and services under the Nice Classification only?

- Yes No

b. Can the class heading be included in the specification?

- Yes No Subject to conditions
Please specify:

The Registry may object to inclusion of a class heading and require proof that the

applicant uses or intends to use the mark in relation to all the goods or services claimed. Broad class headings such as Classes 5, 9 and 42 are generally not allowed.

c. Are there sub-classes of goods and services applied by the trademark office in Malaysia?

- Yes No

If yes, please elaborate:

d. Others, please specify:

C. Trade Mark Examination

15. What marks, signs, representations, emblems or words are specifically prohibited from registration in Malaysia?

- Signs contrary to morality or public order
- Signs of such a nature as to deceive the public
- Signs benefiting protection from other international convention (e.g. Red Cross, Olympic symbols)
- Signs protected by national laws (e.g. royal emblems)
- Others:
 - Marks which contain or consist of the following words or representations:
 - (a) "Patent", "Patented", "By Royal Letters Patent", "Registered", "Registered Design", "Copyright", "To counterfeit this is a forgery", "Registered Trade Mark" and "Registered Service Mark";
 - (b) "Bunga Raya" and representations of the hibiscus;
 - (c) Referring to a Ruler of the Country or State Seri Paduka Baginda Yang di-Pertuan Agong;
 - (d) Any royal palace or building owned by the Federal Government or State Government;
 - (e) "ASEAN" and the representation of the ASEAN logotype;
 - (f) "Red Crescent" or "Geneva Cross" and other crosses in red, or of the Swiss Federal Cross in white or silver on a red ground;
 - (g) Referring to, the royal or imperial arms, crest, armorial bearings or

- insignia, crowns, royal, imperial or national flags; or
- (h) Referring to, the crests, armorial bearings or insignia of the Malaysian Army, Royal Malaysian Navy, Royal Malaysian Air Force and of the Royal Malaysia Police.

16. Is there substantive examination of trademarks?

- Yes No

If yes, what are the grounds?

- Absolute grounds
- Relative grounds

Others: _____

17. Is substantive examination conducted before or after publication of a trademark for opposition by third parties?

- Before publication After publication

18. What are the absolute grounds for refusal?

- Mark consists of a non-invented word(s)
- Mark has direct reference to the character or quality of the goods or services
- Mark is not distinctive
- Mark consists of a geographical name
- Mark consists of a surname
- Mark consists of letters of the alphabet
- Mark consists of numerals
- Mark consists of geometric shapes
- Others: _____

19. What are the relative grounds for refusal?

- There is a prior application for registration or registration for an identical or confusingly similar mark in relation to the same goods or services as the subject mark
- There is a prior application for registration or registration for an identical or confusingly similar mark in relation to similar goods or services (although in different class) as the subject mark
- Well known mark: There is a well known mark which is identical or so nearly resembling the subject mark for the same

- goods or services as the subject mark
- Well known mark: There is an earlier registered mark which is well known for different goods or services and use of the subject mark would indicate a connection between goods or services covered by the subject mark with the proprietor of the well known mark
- Others:
For co-pending applications the Registrar may refuse to register any of them until their rights have been determined by the Court or have been settled by agreement between the parties in a manner approved by the Registrar or by the Court.

20. Is there a right of appeal?

- Yes No

If yes, what are the requirements?

Within two months of the date of a notice of objection or such extended time as allowed by the Registry, the Applicant may file written submissions appealing against the objections raised by the Registry. If the objections are maintained, the Applicant may, within two months of the date of the notice, appeal by request for a hearing conducted by designated officers at the Registry. If the application is refused thereafter, it is possible to request for the grounds of decision, and within one month of receipt of the same, file an appeal to the High Court of Malaya.

D. Publication and Opposition

21. Is there an opposition procedure upon publication?

- Yes No

22. How long is the opposition term once the trade mark application is published in Malaysia?

[2] months

23. Is the opposition term extendible?

- Yes No Others:
The opposition term is extendible at the discretion of the Registrar by 1 month per application for up to a maximum of 6 months. Any further extension of time after

6 months must be supported by a statutory declaration setting out sufficient grounds for the extension of time, and the Registry has the discretion to require the opponent to obtain consent from the Applicant to such further extension.

24. Who may initiate opposition proceedings?

- Any person
- Anyone with a legitimate interest
- Any competent authorities
- Others: _____

25. What are the usual grounds for opposition?

- Prior use of a mark which is identical or confusingly similar to the opposed mark
- Prior registration of a mark which is identical or confusingly similar to the opposed mark
- Bad faith in application for registration of the opposed mark
- Applicant is not the rightful proprietor of the opposed mark
- If the opposed mark is identical with or so nearly resembles the Opponent's mark which is well-known in Malaysia for the same goods or services
- If the opposed mark is identical with or so nearly resembles the Opponent's mark which is well-known and registered in Malaysia for goods or services not the same as those claimed in the opposed mark; provided that the use of the opposed mark in relation to the goods or services claimed would indicate a connection between those goods or services and the proprietor of the well-known mark, and the interests of the proprietor of the well-known mark are likely to be damaged by such use
- Opposed mark lacks distinctiveness
- Lack of intention to use the opposed mark
- Opposed mark consists of false geographical indication
- Use of opposed mark likely to cause confusion or deception
- Others: _____

E. Timeline

26. What is the time period from application to registration for a straightforward trademark application in Malaysia?

- Between 6 months - 12 months
- Between 12 months - 18 months
- 18 months above

27. Is there any process for accelerated/expedited examination of trade mark applications?

- Yes
- No

If yes, what are the requirements?

In order to qualify for expedited examination, the Applicant must establish that:

- (a) It is in the national or public interest;
- (b) There are infringement proceedings taking place or evidence showing potential infringement in respect of the trade mark applied for;
- (c) Registration of the trade mark is a condition to obtain monetary benefits from the Government or institutions recognised by the Registrar; or
- (d) There are other reasonable grounds which support the request.

A request for approval for expedited examination is made by using the prescribed form, together with a statutory declaration stating the reasons for requesting the expedited examination and the prescribed fee within 4 months from the date of filing of the application. If the approval is granted, the applicant must then file the request for expedited examination within 5 working days from the date of receipt of the approval by using the prescribed form and paying the prescribed fee. The application will then be examined in the expedited track. If there are no objections and the application proceeds smoothly, registration can be obtained within 6 months and 3 weeks.

Maintenance of Trademark Registration

A. Renewal

28. Is there a mechanism to renew a trade mark registration in Malaysia?

- Yes No

If yes, how long is the validity of the renewal?
10 years

29. Is late renewal of a trade mark registration permissible in Malaysia?

- Yes No

If yes, what are the conditions?

If within 1 month from the expiration of the last registration, the applicant files the prescribed form for late renewal accompanied by the late renewal fee, the Registrar shall renew the registration without removing the mark from the Register.

30. Are there any provisions to restore a lapsed registration?

- Yes No

If yes, what are the conditions?

If, within 1 year from the expiry of the last registration, the applicant files the prescribed form for restoration and renewal accompanied by the restoration and renewal of registration fee, the Registrar may restore the mark to the Register and renew its registration.

B. Use Requirement

31. Does evidence of use need to be submitted to the trademark office at any time in order to maintain an application for registration or a registration of a trademark in Malaysia?

- Yes No

If yes, what are the requirements?

C. Rectification/Cancellation

32. Are rectification or cancellation proceedings available in Malaysia?

- Yes No

If yes, what is the forum?
High Court of Malaya.

33. What are the grounds for rectification or cancellation proceedings?

- Any entry made in the Register without sufficient cause
 Any entry wrongfully remaining in the Register
 Non-use of the mark
 Others: _____

34. When would a presumption of validity arise in relation to a trademark registration?

- [7] years from ~~date certificate of registration issued~~/date of application
 No such presumption

35. When are the grounds for rectification or cancellation proceedings assessed?

- At the time of filing of the application
 At the time of issuance of the certificate of registration
 At the time of the application for rectification or cancellation proceedings
 Others:
 This depends on the grounds on which the applicant seeks to rectify, expunge or cancel the registered trademark. For example:
 (a) Where the complaint is based on another trader's prior rights, the position will be examined as at the date of first use and/or the deemed date of registration;
 (b) Where the complaint is based on lack of distinctiveness, this may be assessed either as at the deemed date of registration or at the time of the application for rectification or cancellation proceedings; and

- (c) Where the complaint is based on non-use, then relevant use or the lack thereof for 3 years up to 1 month prior to the application for cancellation and following the issuance of the certificate of registration will be considered.

36. When is a trade mark registration vulnerable to cancellation on grounds of non-use?

- [] years from the deemed date of registration
- [3] years from the date of certificate issuance
- Not applicable
- Others:
Where the application was filed without an intention to use and there has in fact been no bona fide use of the mark upto 1 month before the application to cancel the mark.

37. Who bears the burden of proof in a non-use cancellation action?

- Applicant for cancellation
- Defendant / Respondent (trademark owner)

38. If the answer to the above is the Applicant, what are the examples of evidence which can be relied on to support an application for cancellation for non-use?

- Full market survey conducted by an independent or professional surveyor of an appropriate sample size
- Simple market survey or enquiries in the trade
- Declaration from the applicant for cancellation
- Others: _____

D. Assignment, Transmission and Licensing

39. Are there any mechanisms to record assignment of a trade mark in Malaysia?

- Yes No
- If yes, what are the requirements?*
Completed prescribed application form for recordal and certified copy of the assign-

ment agreement signed by both parties and witnesses. No notarisation or legalisation of the application form or assignment agreement is required.

40. Are there different requirements for recording assignment with or without the goodwill of the business?

- Yes No
- If yes, what are the requirements?*
If the assignment is without goodwill, the assignment shall not be deemed to have taken effect unless the assignment has been advertised in the prescribed manner (usually in one national newspaper) and the application for recordal of the assignment without goodwill accompanied by the advertisement has been sent to the Registrar.

41. Are there any mechanisms to record transmission of a trade mark in Malaysia, for example transmission by way of merger?

- Yes No
- If yes, what are the requirements?*
Original or certified true copy of document evidencing the transmission, for instance, in the case of a merger, extract from the Registry of Companies or similar authority evidencing the merger of the original proprietor of the mark into the surviving entity and, in the case of transmission by reason of court order, a certified copy of the court order ordering the transfer of the mark. In the absence of such document, a statement of case verified by a statutory declaration of the new proprietor setting out the grounds for transmission.

42. Are trade mark licensees required to record themselves with the Registrar?

- Mandatory Recommended No
- If yes, what are the requirements?*
Completed and executed prescribed form for recordal is required. License agreement need not be submitted to the Registry but the Registrar has the discretion to request for the same at any time.

E. Change of Particulars

43. Should any change in the name or address of the proprietor on record of a registered trademark be updated on the register?

- Yes No

If yes, what are the requirements?

For recordal of change of name, the original or a certified extract from the Registrar of Companies or equivalent authority evidencing the change of name and the date thereof. If the document is not in English, a certified English translation is required. For recordal of change of address, no supporting document is required, the date of the change of address needs to be stated in the prescribed form.

44. Is it possible to change the representation of a registered trade mark?

- Yes No

If yes, what are the requirements?

The registered proprietor of a trade mark may apply to the Registrar by using the prescribed form for leave to add or alter the trade mark in any manner not substantially affecting the identity of the trade mark. The Registrar may refuse leave or may grant it on such terms and subject to such limitations as he may think fit, including a request for such application to be advertised.

45. Is it possible to correct and rectify any errors on the Register?

- Yes No

If yes, what are the requirements?

The registered proprietor of a trade mark may, by using the prescribed form with prescribed fee, request the Registrar to amend or alter the Register:

- (a) By correcting an error or entering any change in the name, address or description of the registered proprietor of a trade mark;
- (b) By cancelling the entry of a trade mark in the Register;
- (c) By amending the specification of the goods or services in respect of which the trade mark is registered or entering a

disclaimer or memorandum relating to the trade mark without extending in any way the rights given by the existing registration of the trade mark.

Enforcement

46. What are the available enforcement methods in Malaysia?

- Civil enforcement
- ⊙ Infringement action
 - ⊙ Passing off
- Criminal enforcement
- Border or other administrative enforcement measures

47. What are the requirements to bring an action for infringement of trademark?

- Valid registration of the trademark
- Unauthorised use by a 3rd party in the course of trade of a mark which is
- ⊙ identical to the registered trademark
 - ⊙ so nearly resembling the registered mark as is likely to cause confusion
 - ⊙ in relation to the goods or services for which the proprietor's mark is registered
 - ⊙ in relation to goods or services which are similar to the goods or services for which the proprietor's mark is registered though not the same
- If yes, what are the criteria?*
-

48. For a trademark infringement action, is it necessary to establish

- Actual confusion?
- Likelihood of confusion?

49. For a trademark infringement action, is it necessary to establish damage or loss to the proprietor of the trademark?

- Yes No Others
- If yes, what are the requirements?*
-

50. Is there a period of limitation for filing a suit for trade mark infringement?

- Yes No

If yes, what is the time period?

6 years from the date on which the cause of action accrued.

51. What are the remedies available for an infringement action?

- Damages or account of profits
 Injunction
 Delivery and/or destruction of the infringing goods
 Others: _____

52. Is it possible to claim for 'passing off' in Malaysia?

- Yes No

53. If yes, what are the criteria to establish 'passing off'?

- That the proprietor has goodwill and reputation in the trademark

a. Must the goodwill and reputation subsist in Malaysia i.e. goodwill and reputation outside Malaysia will not be taken into consideration?

- Yes No

b. Must there be actual use or business presence in Malaysia?

- Yes No

c. What is the usual form of evidence used to establish such goodwill and reputation?

- (a) Evidence of continuous sale of goods or services under the trademark, e.g. randomly selected invoices for each year since date of first use until present, annual turnover data, etc.;
- (b) Evidence of continuous advertising and promotion of the goods or services under the trademark, e.g. copies of invoices for TV spots and

print publications, data of annual expenditure on advertising and promotion, media schedules for TV and radio advertisements, etc.;

- (c) Samples of advertisement and promotion materials, such as brochures, catalogues, buntings, flyers, print advertisements in magazines, newspapers, copies of TV spots and radio advertisement, etc.; and
- (d) Details of distribution channels and retail outlets where the goods are sold or services are supplied, etc.

- That there is misrepresentation caused to members of the public

a. Is it necessary to establish actual confusion or is likelihood of confusion sufficient?

- Actual confusion
 Likelihood of confusion

b. What is the usual form of evidence used to establish such misrepresentation?

- (a) Evidence of infringing mark in use, get-up or promotional material showing similarity;
- (b) Evidence of similar trade and distribution channels, e.g. photos of both parties' goods in the same retail area; or
- (c) Evidence of actual confusion, e.g. wrongly returned items, enquiries or calls to customer service line regarding infringing item or service, etc.

- That there are damage/likelihood of damage

a. Is it necessary to establish actual damages or is likelihood of damage sufficient?

- Actual damage
 Likelihood of damage

b. What is the usual form of evidence used to establish such damage or likelihood of damage?

If the first 2 elements (goodwill and misrepresentation) are present, likelihood of damage will be presumed.

Others: _____

54. Are there other forms of actions or claims that can be brought by a trademark owner against an infringer or unauthorised user?

Unfair competition Others: Not Applicable

55. What are the elements that need to be established to bring the claim(s) above?

Not Applicable

56. Can a trademark owner lodge a complaint to any administrative authorities on counterfeit trade mark goods?

Yes No

If yes, please state the authority:

The Royal Malaysia Police and the enforcement division of the Ministry of Domestic Trade, Co-operatives and Consumerism.

57. What are the actions that can be taken by such authorities?

- Conduct a raid
 Seize the infringing goods
 Impose a fine
 Refer for criminal prosecution
 Others: _____

58. Are border measures available to restrict the importation of counterfeit trademark goods?

Yes No

If yes, what are the measures?

Border measures are provided under the Malaysian Trade Marks Act 1976 (S.70D to S.70P) where a registered trademark proprietor may apply to the Intellectual Property Corporation of Malaysia (MyIPO)

for a restriction on importation of counterfeit trademark goods.

In summary, to obtain these measures, a registered trademark proprietor can apply to the Registrar by providing proof of registration and ownership of the trademark. The registered trademark proprietor must also give details of the time and place that the counterfeit goods are expected to be imported, and the registered trademark proprietor must state the objections to the importation of the goods.

An application must be supported by documents and information relating to the goods to allow the authorised officer to identify the counterfeit goods. The Registrar will decide whether or not to approve the application, and any such approval remains in force for 60 days. If approved, the Registrar shall also require a security to be paid. The sum will be fixed by the Registrar, and should be sufficient to reimburse the Registrar for any liability or expense it is likely to incur as a result of the seizure of the goods, or prevent abuse and to protect the importer, or to pay such compensation as may be ordered by the Court.

59. Do these border measures apply for counterfeit goods of unregistered trademarks?

- Yes No
 Not applicable, there are no rights for unregistered trademarks in Malaysia

60. Is there an authority or ministry responsible for the enforcement of trademark rights?

Yes No

If yes, please state:

Ministry of Domestic Trade, Co-operatives and Consumerism.

Peculiarities

61. Are there any peculiarities not mentioned above in the system of protection for trademarks in Malaysia of which it is important for clients to be aware?

None.

Patents

Patent Rights and Protection in Malaysia

General

1. What is the system for patent protection?

- Examination system
 Non-examination system

2. Is Malaysia a member of the Patent Cooperation Treaty (PCT)?

- Yes No

3. Is Malaysia a member of the Paris Convention?

- Yes No

Patent Registration

A. Registration System

4. What kinds of patent protection are available?

- Inventions Utility models
 Others:
 Utility innovation which may only contain 1 claim

5. What kinds of subject matter are excluded from patent protection?

- Methods of medical treatment or diagnosis
 Computer programs
 Business methods
 Others:
 Plant or animal varieties or essentially biological processes for the production of plants or animals

B. Patent Filing

6. What are the documents and information required for filing a patent application?

- Name and address of the applicant
 Name and address of the inventor
 Specification
 Abstract
 Power of Attorney
 Deed of Assignment
 Others:
 PCT/RO/101 (for PCT route application), information on how applicant acquired rights to the invention, simple signature for Power of Attorney.

7. Is there a fee for extra claims?

- Yes No

If yes, please describe:

For each claim in excess of 10 claims, official fee is RM20 (USD5).

8. Does Malaysia require obtaining a foreign filing license before filing a foreign patent application?

- Yes No

If yes, please describe:

If applicant and/or inventor are residents of Malaysia, then written authorisation (foreign filing license) must be obtained from the Patent Office for a first filing outside Malaysia.

B.1 Patent Specification

9. In which language must a patent specification be?

- English Other:
 For non-PCT route application, Malay language is possible.

10. Is it possible to file an application first with an English specification, and then later submit its translation in the official language?

- Yes No Not Applicable

B.2 Publication, Amendment and Divisional Application

11. Is it possible to request a deferment of publication?

- Yes No
If yes, please describe:
-

12. Is it possible to request an early publication?

- Yes No
If yes, please describe:
-

13. Does the applicant have a provisional right upon the publication of an application?

- Yes No
If yes, please describe:

An applicant may demand that a person who has commercially or industrially worked the invention pay compensation to the applicant in respect of the invention from the time the person is given a written warning or, in the absence of a warning, after the patent application in respect of the invention has been made available for public inspection (after 18 months from the priority date).

14. When is it possible to file a voluntary amendment to specification?

- At the time of entry into the national phase (for PCT application)
 At any time during prosecution
 At the time of requesting examination
 Other:
 If the first examination report is the clear substantive report, then the last day is 2 months from the mailing date of the report.

15. When is it possible to voluntarily file a divisional application?

- At any time during prosecution
 At the time of granting a patent
 Other:
 Last day is 3 months from the mailing date of the first report on examination on substance.

16. Is it possible to file a divisional application based on a previous pending divisional application if the parent application has already been granted a patent?

- Yes No

C. Examination

17. Is there a requirement to submit certain information on corresponding applications, or prior art known to the applicant?

- Yes No
If yes, please describe:

Filing details on counterpart applications in the prescribed countries (AU, EP, JP, KR, US, UK, PCT) together with any supporting documents (search report, examination report or granted patent).

18. Is there a grace period (exception to novelty)?

- Yes No
If yes, please describe:

A disclosure to the public, anywhere in the world, by written publication, by oral disclosure, by use, or in any other way, prior to the priority date of the patent application, claiming the invention may be disregarded for prior art purposes,
 (a) If such disclosure occurred within 1 year preceding the date of the patent application and if such disclosure was by reason or in consequence of acts committed by the applicant or his predecessor in title;
 or

- (b) If such disclosure occurred within 1 year preceding the date of the patent application and if such disclosure was by reason or in consequence of any abuse of the rights of the applicant or his predecessor in title.

19. Is it required to file a request for substantive examination?

- Yes No

If yes, what are the requirements?

For a non-PCT route application, 18 months from the local filing date.

For a PCT route application, 4 years from the PCT filing date.

20. Can a third party file a request for substantive examination?

- Yes No

21. Is there a right of appeal?

- Yes No

If yes, please describe briefly:

According to Section 81, anyone adversely affected by the decision of the Patent Registrar may be given a hearing upon payment of the official fee.

According to Section 88, any person aggrieved by any decision or order of the Registrar may appeal to the High Court.

22. Are multiple dependent claims admissible?

- Yes No

D. Opposition

23. Is there an opposition procedure upon publication?

- Yes No

24. How long is the opposition term once the application is published?

- 2 months 3 months
 Prior to the grant Other: Not Applicable

25. Who may initiate opposition proceedings?

- Any person
 Anyone with a legitimate interest
 Any competent authorities
 Others: Not applicable

E. Timeline

26. What is the time period from application to grant for a straightforward application?

- Between 2 - 3 years
 Between 3 - 4 years
 Other: 4 - 5 years

27. Is there any process for accelerated examination of application?

- Yes No

If yes, what are the requirements?

- Upon applicant filing a request for an expedited examination, the Registrar may do so if the Registrar is reasonably satisfied that—
- (a) it is in the national or public interest;
 - (b) there are infringement proceedings taking place or evidence showing potential infringement with regards to the patent being applied;
 - (c) the applicant has already commercialised the invention or plans to commercialise the invention within 2 years from the filing date of a request for expedited examination;
 - (d) application for grant of the patent is a condition to obtain monetary benefits from the Government or institutions recognised by the Registrar;
 - (e) the invention relates to green technologies that will enhance the quality of the environment or conservation of energy resources; or
 - (f) there are other reasonable grounds which support the request.

According to the workflow of the Patent Office, upon the Registrar's approval on a request for expedited examination and after filing the request for expedited examination by the applicant, the Examination Report and applicant's response should be completed within 6 weeks' time (minimum). Assuming that the application proceeds to an allowance, the grant will be issued in 2 weeks' time (minimum) from the applicant's response. In other words, it would take approximately 2 months after the Registrar's approval on a request for expedited examination.

Maintenance of Patent

A. Annuity

28. To maintain the validity of patent, is it required to pay an annuity in Malaysia?

Yes No

29. Is late payment of annuity permissible?

Yes No

If yes, what are the requirements?

After normal expiration, patent owner is given 6 additional months to pay, with penalty of 100% of the official fee for the year concerned.

30. Is government annuity fixed for each year?

Yes No

If yes, what is the base for calculation of annuity?

It is according to the MyIPO fee schedule as follows:

	<u>Annual Fee for Patent:</u>	<u>E-Filing Fee (RM)</u>	<u>Manual Fee (RM)</u>
(d) for 5 th year after grant of patent		460	490
(e) for 6 th year after grant of patent		520	560
(f) for 7 th year after grant of patent		600	640
(g) for 8 th year after grant of patent		650	690
(h) for 9 th year after grant of patent		720	760
(i) for 10 th year after grant of patent		780	820
(j) for 11 th year after grant of patent		850	890
(k) for 12 th year after grant of patent		900	940
(l) for 13 th year after grant of patent		1,050	1,100
(m) for 14 th year after grant of patent		1,200	1,250
(n) for 15 th year after grant of patent		1,300	1,350
(o) for 16 th year after grant of patent		1,600	1,660
(p) for 17 th year after grant of patent		1,850	1,900
(q) for 18 th year after grant of patent		2,100	2,200
(a) for 2 nd year after grant of patent		260	290
(b) for 3 rd year after grant of patent		330	360
(c) for 4 th year after grant of patent		390	420

	<u>Annual Fee for Patent:</u>	<u>E-Filing Fee (RM)</u>	<u>Manual Fee (RM)</u>
(r)	for 19 th year after grant of patent	2,400	2,500
(s)	for 20 th year after grant of patent	2,600	2,700

31. Can annuity be paid once for all years or once for several years?

Yes No

32. Is power of attorney required for annuity payment?

Yes No

If the agent is not the patent agent on record, Form No. 17 (Appointment of Patent Agent) signed by the proprietor needs to be filed together with the payment of the renewal fee.

33. Are there any provisions to restore a lapsed patent?

Yes No

If yes, what are the requirements?

Within 2 years from the date on which a notice of the lapsing of a patent is published in the Gazette, the owner of the patent or his successor in title may apply to the Registrar in the prescribed form to have the patent reinstated.

The Registrar may reinstate a patent upon payment of all annual fees due and of a prescribed surcharge for reinstatement and upon being satisfied that the non-payment of annual fees was due to accident, mistake or other unforeseeable circumstances.

34. Is patent term extension available in Malaysia?

Yes No

If yes, what are the conditions?

B. Compulsory Licence

35. Is a compulsory licence available in Malaysia?

Yes No

If yes, what are the requirements?

At any time after the expiration of 3 years from the grant of a patent, or 4 years from the filing date of the patent application, whichever is the later, any person may apply to the Registrar for a compulsory licence under any of the following circumstances:

- Where there is no production of the patented product or application of the patented process in Malaysia without any legitimate reason;
- Where there is no product produced in Malaysia under the patent for sale in any domestic market, or there are some but they are sold at unreasonably high prices or do not meet the public demand without any legitimate reason.

However, a compulsory licence shall not be applied for unless the person making the application has made efforts to obtain authorisation from the owner of the patent on reasonable commercial terms and conditions but such efforts have not been successful within a reasonable period of time.

36. Can a request for termination of compulsory licence be filed?

Yes No

If yes, what are the requirements?

Upon the request of the owner of the patent, the Patent Office will cancel the compulsory licence:

- If the ground for the grant of the compulsory licence no longer exists;
- If the beneficiary of the compulsory licence has, within the time limit fixed in the decision granting the licence, neither begun the working of the patented invention in Malaysia nor made serious preparations towards such working;
- If the beneficiary of the compulsory licence does not respect the scope of the licence as fixed in the decision granting the licence;

- (d) If the beneficiary of the compulsory licence is in arrears of the payment due, according to the decision granting the licence.

C. Use Requirement

37. Does the patentee need to submit evidence of obligation of use to the Patent Office in order to maintain a patent in Malaysia?

- Yes No
If yes, please describe:

38. Is a compulsory licence granted based on failing to perform an obligation to use?

- Yes No
If yes, please describe:

At any time after the expiration of 3 years from the grant of a patent, or four years from the filing date of the patent application, whichever is the later.

D. Cancellation

39. Are termination or cancellation proceedings available in Malaysia?

- Yes No
If yes, what are the grounds?

The Court shall invalidate the patent if the person requesting the invalidation proves-

- (a) That what is claimed as an invention in the patent is not an invention under the Patents Act, or is excluded from protection or is not patentable because it is not novel, not inventive and not industrially applicable;
- (b) That the description or the claim does not comply with the requirements of the Patent Regulations;
- (c) That any drawings which are necessary for the understanding of the claimed invention have not been furnished;
- (d) That the right to the patent does not belong to the person to whom the patent was granted; or

- (e) That incomplete or incorrect information has been deliberately provided or caused to be provided to the Registrar when submitting the request for substantive examination by the person to whom the patent was granted or by his agent.

40. What is the time limit for termination or cancellation?

- 3 years 5 years
 Whole Other:
 protection
 term of patent

In practice, the courts have invalidated patents past 6 years from grant but it has not been specifically determined in any case.

E. Assignment, Transmission and Licensing

41. Are there any mechanisms to record assignment of a patent in Malaysia?

- Yes No
If yes, what are the requirements?

Filing Form 6, prescribed fee and a certified copy of the assignment document signed by both parties.

42. Are there any mechanisms to record transmission of a patent in Malaysia, for example, transmission by way of merger?

- Yes No
If yes, what are the requirements?

Same as in item (41) above except, in place of the assignment document, the merger certificate should be submitted.

43. Are patent licensees required to record themselves with the Patent Office?

- Yes No
If yes, what are the requirements?

Filing Form 9, prescribed fee and a certified copy of the licence, if possible.

F. Change of Details

44. Are there any mechanisms to record change of name or address of the patent proprietor?

- Yes No

If yes, what are the requirements?

Evidence from the Registry of Companies on the name/address change.

45. Is it possible to amend a granted patent?

- Yes No

If yes, what are the requirements?

The Registrar may, upon a request made by the owner of a patent, amend the description, the claim or claims, or the drawings, of the patent, or amend any other document associated with the patent, for the purpose of correcting a clerical error or an obvious mistake or for any other reason acceptable to the Registrar. However, the Registrar shall not make an amendment if the amendment would have the effect of disclosing a matter which extends beyond that disclosed before the amendment or if the amendment would have the effect of extending the protection conferred at the time of grant of the patent.

46. Is it possible to correct and rectify any errors on the patent?

- Yes No

If yes, what are the requirements?

Same comments as in item (45) above.

Enforcement

47. What are the available enforcement methods in Malaysia?

- Civil enforcement
 Administrative enforcement
 Criminal enforcement
 Border measures
 Others: _____

48. What are the criteria for infringement?

- Literal infringement
 Infringement under the doctrine of equivalents
 Use of the patent without permission of patent owner
 Others:
 Making, importing, offering for sale, selling or using a patented product or products obtained directly by means of a patented process; stocking such products for the purpose of offering for sale, selling or using; and/or using a patented process. However, note that very recently there has been judicial consideration of the expanded infringement test pronounced by the UK Supreme Court in *Eli Lilly and Company v Actavis UK Limited and others* [2017] UKSC 48. Arguably, the criteria for infringement in Malaysia may have gravitated towards the doctrine of equivalents.

49. Is there a statute of limitations for filing a suit for patent infringement?

- Yes No

If yes, what is the time period?

5 years from the particular instance of infringement being claimed against.

50. What are the remedies available for an infringement action?

- Damages
 Injunction
 Destruction of the infringing goods
 Others:
 Delivery Up of Infringing Goods

51. What are the actions taken by such authorities?

- Conduct a raid
 Seize the infringing goods
 Impose a fine
 Others: Not Applicable

52. Is there an authority or ministry responsible for the enforcement of patent rights?

Yes No

If yes, please state:

Peculiarities

53. Are there any peculiarities in the system of protection for patents in Malaysia of which it is important for clients to be aware?

None.

Myanmar

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About The Firm

Tilleke & Gibbins is a leading Southeast Asian regional law firm with over 150 lawyers and consultants practising in Bangkok, Hanoi, Ho Chi Minh City, Jakarta, Phnom Penh, Vientiane and Yangon.

Our firm represents the top investors and the high-growth companies that drive economic expansion in Asia in the key areas of commercial transactions and mergers and acquisitions, dispute resolution and litigation, and intellectual property.

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Foreword

Since the end of absolute military rule in 2011, and the subsequent election of Aung San Suu Kyi's National League for Democracy in November 2015, Myanmar has begun a process of opening to the outside world and promoting international trade. This has resulted in rapid economic growth, which requires legal modernisation to be sustainable. Steady legal reform has, therefore, been evident over the last few years, including firm government commitment to modernising the intellectual property regime, and there is no sign of this legislative drive slowing down.

However, modernising the entire legal system of a country that has been isolated for more than half a century is no mean feat, and progress has sometimes been understandably (if frustratingly) slow. In respect of intellectual property, draft laws were produced in 2015 which provided for protection of industrial designs, patents, trademarks, and copyrights, but as of December 2017, they are still not in force.

That isn't to say that the process has stalled, however. With the government demonstrably working to construct a legal system attractive to foreign investors, it is merely a matter of time before the draft intellectual property laws come into force in one form or another. Optimistically, the implementation of these laws may even pave the way for accession to international treaties, although any such development is unlikely to occur soon.

In the meantime, with a legal system based on a century-old British colonial code (of which a substantial portion remains in force), Myanmar already has a basic framework for the protection of some intellectual property rights, including trademarks and patents, and those looking to invest in the country need to familiarise themselves with it in order to ensure adequate protection.

Trademarks

Trademark Rights and Protection in Myanmar

General

1. What is the system for trademark protection in Myanmar?

- Registration Common law
 Co-existing rights under registration and common law

Currently, the registration of trademarks is done via a trademark recordal system. In the absence of an enacted trademarks act, Direction 13 of the Registration Act No. 16 of 1908 allows trademarks to be recorded with the Office of Registration of Deeds in the form of a Declaration of Ownership. This is expected to change upon the enactment of a new trademark act. The latest trademarks bill was issued for public consultation in July 2017 and was submitted to the Upper House of the Parliament by the Union Minister of Education in January 2018.

2. Does first to use or first to register have prior rights in Myanmar?

- First to use First to register

The trademarks bill which is currently pending consideration by the legislative committee adopts a first to register system.

3. Is Myanmar a member of the Madrid Union and the Paris Convention?

- Madrid System Paris Convention

Neither.

4. If Myanmar is a member of Madrid Union is it a party to the Agreement or the Protocol and are there any peculiarities in relation to the implementation of the Madrid System for international registration in Myanmar?

Not applicable.

Trade Mark Registration

A. Registration System

5. What are the benefits of registering a trade mark in Myanmar?

- Prevails over common law rights
 It is the only form of protection available for trademarks
 Entitles the proprietor to bring an infringement action
 Others:
 Entitles the proprietor to file criminal and administrative complaints with authorities such as the Myanmar Police Force and the Myanmar Customs Department.

6. Is it possible to obtain registration for the following types of marks under the registration system in Myanmar?

There are no specific legal provisions governing the types of marks that can be registered in Myanmar. In practice, the protection accorded to the proprietor is as per the visual representation provided in the Declaration of Ownership filed.

a. Service marks

- Yes No

b. Defensive marks

- Yes No

If yes, what are the requirements?

However, non-use of a mark will put it at risk of a cancellation action.

c. Collective marks

- Yes No

If yes, what are the requirements?

No specific requirements.

d. Certification marks

- Yes No
If yes, what are the requirements?
 No specific requirements.

e. Well-known marks

(i.e. registration of a mark as a well-known mark and not an ordinary trademark)

- Yes No
If yes, what are the requirements?
 There is no specific legislation that governs well-known marks and an applicant cannot file a specific application for a well-known mark. Nonetheless, in Criminal Regular Case No. 380/2014 U Zayar Lwin, Mitsubishi Electric Corporation & PME Co., Ltd. vs. U Hla Myint, the Pabedan Township Court in Yangon, Myanmar considered factors, such as degree of recognition by the relevant members of the public in Myanmar; the duration, extent, and geographical area of the use of the mark; the amount of registrations/applications made of the mark; and an assessment of the value associated with the mark in Myanmar and in other countries, when assessing whether or not a mark is regarded as being well known.

f. Series marks

- Yes No
If yes, what are the requirements?
 No specific requirements.

g. Marks in different language or characters other than Roman characters

- Yes No
If yes, what are the requirements?
 No specific requirements, including any requirements to provide translation or transliteration.

h. Non-traditional marks: Sound marks

- Yes No
If yes, what are the requirements?

i. Non-traditional marks: Smell marks

- Yes No
If yes, what are the requirements?

j. Non-traditional marks: Position marks

- Yes No
If yes, what are the requirements?

k. Non-traditional marks: Colour marks

(i.e. registration of a single colour or a combination of colours)

- Yes No
If yes, what are the requirements?

l. Non-traditional marks: Shape or three-dimensional marks

- Yes No
If yes, what are the requirements?
 No specific requirements.

m. Others: _____**7. Is it possible to claim a colour limitation?**

- Yes No
If yes, what are the requirements?
 There are no specific rules governing colour limitations. However, the registry takes the view that the registration of a mark in colour automatically indicates a colour limitation.

8. What is the official name of the trademark office in Myanmar?

The Office of Registration of Deeds

B. Trade Mark Filing**9. What are the documents and information required for filing a trade mark application in Myanmar?**

- Name and address of the applicant
 Representation of the trade mark
 Goods and services and the class(es) for which the trade mark is to be registered
 Certificate of Incorporation (if the applicant is a company)

- Statutory Declaration
- Power of Attorney
- Others:

The Statutory Declaration (Declaration of Ownership) needs to be executed before a Notary Public; whereas the Power of Attorney must be notarised and legalised at the Embassy of Myanmar in the country of origin / incorporation of the applicant.

10. Can a trade mark application be based on intent to use in Myanmar?

- Yes
- No

If yes, please specify any conditions:

No specific requirements. However, non-use of a mark will put it at risk of a cancellation action.

11. Is priority claim allowed in Myanmar?

- Yes
- No

If yes, what are the requirements?

Priority claims are done via a statement of priority inserted into the Declaration of Ownership. A simple copy of the priority document should be attached to the application. There are no specific rules governing priority claims, therefore both partial priority and multiple priority claims are allowed. There are also no deadlines for priority claims.

12. Are multi-class applications permitted in Myanmar?

- Yes
- No

If yes, is there a maximum number of classes that can be applied for?

There is no limit on the number of classes permitted for each application.

13. Does Myanmar adopt the Nice Classification for specification of goods and services?

- Yes
- No

If yes, please specify the edition:

No specific requirements. Applicants are advised to follow the latest edition.

14. Are there any specific requirements in relation to the classification of goods and services in Myanmar?

a. Must the specification of goods and services be limited to items from the list of goods and services under the Nice Classification only?

- Yes
- No

b. Can the class heading be included in the specification?

- Yes
 - No
 - Subject to conditions
- Please specify:*
-

c. Are there sub-classes of goods and services applied by the trademark office in Myanmar?

- Yes
- No

If yes, please elaborate:

d. Others: Not applicable.

C. Trade Mark Examination

15. What marks, signs, representations, emblems or words are specifically prohibited from registration in Myanmar?

- Signs contrary to morality or public order
- Signs of such a nature as to deceive the public

- Signs benefiting protection from other international convention (e.g. Red Cross, Olympic symbols)

- Signs protected by national laws (e.g. royal emblems)

- Others:

Direction 13 of the Registration Act No. 16 of 1908 states that registration of trademarks should be refused in the following circumstances:

- (a) Where the trademark is likely to be objectionable on moral or legal grounds;
- (b) Where the trademark is likely to hurt the religious susceptibilities of any class of citizens of Myanmar;

- (c) Where the Declaration of Ownership of the trademark lends itself to be used as an instrument of fraud or is obscure;
- (d) Where the trademark is a colourable imitation of a currency note; or
- (e) Where the trademark bears the image of the late General Aung San.

16. Is there substantive examination of trademarks?

- Yes No

If yes, what are the grounds?

- Absolute grounds
- Relative grounds

- Others:

Trademarks are merely reviewed by the registrar at the time of filing to ensure that they do not contravene Direction 13 of the Registration Act No. 16 of 1908. The review is done based on the absolute grounds of refusal laid down in Direction 13, and marks which contravene these provisions will not be accepted for filing.

17. Is substantive examination conducted before or after publication of a trademark for opposition by third parties?

- Before publication After publication

Not applicable. In any event, trademarks are not published for opposition by third parties before they are registered.

18. What are the absolute grounds for refusal?

- Mark consists of a non-invented word(s)
- Mark has direct reference to the character or quality of the goods or services
- Mark is not distinctive
- Mark consists of a geographical name
- Mark consists of a surname
- Mark consists of letters of the alphabet
- Mark consists of numerals
- Mark consists of geometric shapes
- Others:

The grounds of refusal laid down in Direction 13 of the Registration Act No. 16 of 1908 are as follows: mark is likely to be objectionable on moral or legal grounds; mark is likely to hurt the religious

susceptibilities of any class of citizens of Myanmar; mark is filed via a Declaration of Ownership which lends itself to be used as an instrument of fraud or is obscure; mark is a colourable imitation of a currency note; mark bears the image of the late General Aung San.

19. What are the relative grounds for refusal?

- There is a prior application for registration or registration for an identical or confusingly similar mark in relation to the same goods or services as the subject mark
- There is a prior application for registration or registration for an identical or confusingly similar mark in relation to similar goods or services (although in different class) as the subject mark
- Well known mark: There is a wellknown mark which is identical or so nearly resembling the subject mark for the same goods or services as the subject mark
- Well known mark: There is an earlier registered mark which is well known for different goods or services and use of the subject mark would indicate a connection between goods or services covered by the subject mark with the proprietor of the well known mark
- Others:

Not applicable. Marks are not examined on relative grounds for refusal.

20. Is there a right of appeal?

- Yes No

If yes, please describe:

D. Publication and Opposition

21. Is there an opposition procedure upon publication?

- Yes No

There is no opposition procedure. Publication is optional, and is done via cautionary notices published in local newspapers after the registration of the mark. It is not an official publication by the registry / government gazette.

22. How long is the opposition term once the trade mark application is published in Myanmar?

Not applicable. There is no opposition procedure.

23. Is the opposition term extendible?

Yes No Others:

Not applicable. There is no opposition procedure.

24. Who may initiate opposition proceedings?

- Any person
 Anyone with a legitimate interest
 Any competent authorities

Others:

Not applicable. There is no opposition procedure. An aggrieved party / interested party who wishes to challenge the validity of a registered trademark will need to file a trademark cancellation action in court.

25. What are the usual grounds for opposition?

- Prior use of a mark which is identical or confusingly similar to the opposed mark
 Prior registration of a mark which is identical or confusingly similar to the opposed mark
 Bad faith in application for registration of the opposed mark
 Applicant is not the rightful proprietor of the opposed mark
 If the opposed mark is identical with or so nearly resembles the Opponent's mark which is well-known in Myanmar for the same goods or services
 If the opposed mark is identical with or so nearly resembles the Opponent's mark which is well-known and registered in Myanmar for goods or services not the same as those claimed in the opposed mark; provided that the use of the opposed mark in relation to the goods or services claimed would indicate a connection between those goods or services and the proprietor of the well-known mark, and the interests of the proprietor of the well-known mark are likely to be damaged by

such use

- Opposed mark lacks distinctiveness
 Lack of intention to use the opposed mark
 Opposed mark consists of false geographical indication
 Use of opposed mark likely to cause confusion or deception
 Others:
 Not applicable. There is no opposition procedure.

E. Timeline

26. What is the time period from application to registration for a straightforward trademark application in Myanmar?

- Between 6 months - 12 months
 Between 12 months - 18 months
 18 months above
 Others:
 Between 1 month – 2 months.

27. Is there any process for accelerated/expedited examination of trade mark applications?

- Yes No
If yes, what are the requirements?
-

Maintenance of Trademark Registration

A. Renewal

28. Is there a mechanism to renew a trade mark registration in Myanmar?

- Yes No
If yes, how long is the validity of the renewal?

3 years. However, this is not a statutory requirement, and the registry is not in the practice of cancelling or removing trademarks from the register on the grounds of late or non-renewal. Trademarks can be renewed by filing a Declaration of Renewal of Ownership, by publishing a cautionary notice in the newspaper, or by both methods.

29. Is late renewal of a trade mark registration permissible in Myanmar?

- Yes No

If yes, what are the conditions?

There are no specific conditions. The 3-year renewal deadline is not stipulated by statute, so in practice, trademark proprietors can file renewals at any time.

30. Are there any provisions to restore a lapsed registration?

- Yes No

If yes, what are the conditions:

Not applicable, as the registration of trademarks does not lapse.

B. Use Requirement

31. Does evidence of use need to be submitted to the trademark office at any time in order to maintain an application for registration or a registration of a trademark in Myanmar?

- Yes No

If yes, what are the requirements?

C. Rectification/Cancellation

32. Are rectification or cancellation proceedings available in Myanmar?

- Yes No

If yes, what is the forum?

Trademark rectification / cancellation proceedings must be filed in court.

33. What are the grounds for rectification or cancellation proceedings?

- Any entry made in the Register without sufficient cause
- Any entry wrongfully remaining in the Register
- Non-use of the mark

- Others:

Registration made in bad faith.

There are no legal provisions stating the grounds for rectification / cancellation proceedings. The plaintiff in such proceedings must furnish evidence to substantiate its claim.

34. When would a presumption of validity arise in relation to a trademark registration?

- [] years from date certificate of registration issued/date of application

- No such presumption

In practice, the Declaration of Ownership serves as prima facie evidence of ownership of a trademark.

35. When are the grounds for rectification or cancellation proceedings assessed?

- At the time of filing of the application
- At the time of issuance of the certificate of registration

- At the time of the application for rectification or cancellation proceedings

- Others:

There are no legal provisions or court precedents which clarify the current stance on the grounds for rectification / cancellation proceedings and the time of assessment of such grounds. This may differ based on the court in which a case is heard before.

36. When is a trade mark registration vulnerable to cancellation on grounds of non-use?

- [] years from the deemed date of registration

- [3] years from the date of certificate issuance

- Others: _____

- Not applicable

There are no related legal provisions concerning the limitation of time for a cancellation action, but it is customary understanding that marks should be used within three years from the date of registration / intent to use such mark should be shown within three years from the date of registration. The Limitation Act 1909

sets a limitation period of three years for the initiation of an action “for compensation for infringing copyright or any other exclusive privilege”, calculated from the date of infringement. Section 15 of the Merchandise Marks Act also provides that for infringement of a trademark, no prosecution shall commence after the expiration of three years after the commission of the offence, or one year after the first discovery thereof by the prosecutor, whichever expiration happens first.

37. Who bears the burden of proof in a non-use cancellation action?

- Applicant for cancellation
- Defendant / Respondent (trademark owner)

The law on this is unclear, given the lack of judicial precedents and statutory guidance. The burden of proof typically lies on the party bringing the action (applicant / plaintiff), but the defendant / respondent in such actions will also need to show that the mark has been used to negate such claims.

38. If the answer to the above is the Applicant, what are the examples of evidence which can be relied on to support an application for cancellation for non-use?

- Full market survey conducted by an independent or professional surveyor of an appropriate sample size
- Simple market survey or enquiries in the trade
- Declaration from the applicant for cancellation
- Others:
There is no known judicial guidance on this.

D. Assignment, Transmission and Licensing

39. Are there any mechanisms to record assignment of a trade mark in Myanmar?

- Yes
- No

If yes, what are the requirements?

The following documents need to be furnished at the Office of Registration of Deeds:

- (a) A notarised Declaration of Assignment / Deed of Assignment with a nominal monetary consideration of USD 10 per trademark, executed by both the assignor and assignee;
- (b) A notarised and legalised Power of Attorney of the assignor; and
- (c) A notarised and legalised Power of Attorney of the assignee.

40. Are there different requirements for recording assignment with or without the goodwill of the business?

- Yes
- No

If yes, what are the requirements?

In both situations, it is common to publish a cautionary notice in local newspapers after the completion of the recordal of assignment.

41. Are there any mechanisms to record transmission of a trade mark in Myanmar, for example transmission by way of merger?

- Yes
- No

If yes, what are the requirements?

The substantive requirements are the same, i.e. notarised and legalised Powers of Attorney of parties involved need to be furnished; and a notarised copy of the relevant declaration stipulating the contents of the transmission (e.g. Declaration of Merger) should be filed as well.

42. Are trade mark licensees required to record themselves with the Registrar?

- Mandatory
- Recommended
- No

Note however that under the current trademark bill, the recordal of trademark licences would be mandatory.

E. Change of Particulars

43. Should any change in the name or address of the proprietor on record of a registered trademark be updated on the register?

- Yes No

If yes, what are the requirements?

The following documents should be furnished at the Office of Registration of Deeds:

- (a) A notarised Declaration of Change of Name and/or Address;
 (b) A notarised and legalised Power of Attorney.

44. Is it possible to change the representation of a registered trademark?

- Yes No

If yes, what are the requirements?

There are no statutory provisions governing this. Based on present practice of the Office of Registration of Deeds, the representation of a registered trademark can be amended if the changes represented on the declaration are not deemed substantive by the filing officer. However, the validity of such declarations have not been tested by court.

45. Is it possible to correct and rectify any errors on the Register?

- Yes No

If yes, what are the requirements?

The following documents should be furnished at the Office of Registration of Deeds:

- (a) A notarised Declaration of Ownership reflecting the correct information;
 (b) A notarised and legalised Power of Attorney.

Enforcement

46. What are the available enforcement methods in Myanmar?

- Civil enforcement
 ⊙ Infringement action
 ⊙ Passing off
 Criminal enforcement

- Border or other administrative enforcement measures

47. What are the requirements to bring an action for infringement of trademark?

- Valid registration of the trademark
 Unauthorised use by a 3rd party in the course of trade of a mark which is
 ⊙ identical to the registered trademark
 ⊙ so nearly resembling the registered mark as is likely to cause confusion
 ⊙ in relation to the goods or services for which the proprietor's mark is registered
 ⊙ in relation to goods or services which are similar to the goods or services for which the proprietor's mark is registered though not the same
If yes, what are the criteria?

48. For a trademark infringement action, is it necessary to establish

- Actual confusion?
 Likelihood of confusion?

49. For a trademark infringement action, is it necessary to establish damage or loss to the proprietor of the trademark?

- Yes No Others
If yes, what are the requirements?
 To establish likelihood of damage or loss.

50. Is there a period of limitation for filing a suit for trademark infringement?

- Yes No
If yes, what is the time period?
 3 years, in accordance with the Limitation Act 1909 and the Merchandise Marks Act.

51. What are the remedies available for an infringement action?

- Damages or account of profits
 Injunction
 Delivery and/or destruction of the infringing goods
 Others: _____

52. Is it possible to claim for 'passing off' in Myanmar?

- Yes No

Theoretically possible, if plaintiff is able to furnish proof of actual and prior use of the trademark, and fulfil the 3 requirements for a passing off claim (goodwill, misrepresentation and damage). In practice, however, it is difficult to substantiate a claim solely on passing off without a trademark registration. Courts may be reluctant to hear cases where the plaintiff has not recorded a Declaration of Ownership of the contested trademark or where a trademark cautionary notice has not previously been published.

53. If yes, what are the criteria to establish 'passing off'?

- That the proprietor has goodwill and reputation in the trademark

a. Must the goodwill and reputation subsist in Myanmar i.e. goodwill and reputation outside Myanmar will not be taken into consideration?

- Yes No

Goodwill and reputation outside of Myanmar will be considered by the court, but emphasis is given to goodwill and reputation in the country.

b. Must there be actual use or business presence in Myanmar?

- Yes No

Actual use is required, physical business presence is not required.

c. What is the usual form of evidence used to establish such goodwill and reputation?

Evidence of sale of the relevant products/services in the country; receipts and invoices; advertisements and cautionary notices, etc.

- That there is misrepresentation caused to members of the public

a. Is it necessary to establish actual confusion or is likelihood of confusion sufficient?

- Actual confusion
 Likelihood of confusion

b. What is the usual form of evidence used to establish such misrepresentation?

Consumer surveys; oral evidence; any evidence of actual confusion.

- That there are damage/likelihood of damage

a. Is it necessary to establish actual damages or is likelihood of damage sufficient?

- Actual damage
 Likelihood of damage

b. What is the usual form of evidence used to establish such damage or likelihood of damage?

Any evidence of actual damage; courts may be ready to infer likelihood of damage if misrepresentation (actual/likelihood of confusion) is proven.

- Others: _____

54. Are there other forms of actions or claims that can be brought by a trademark owner against an infringer or unauthorised user?

- Unfair competition Others:
The Competition Law 2015 came into force on 24 February 2017. However, the competition commission has yet to be established, and regulations have not been issued yet.

55. What are the elements that need to be established to bring the claim(s) above?

No guidance available yet, as the Competition Law 2015 only came into force this year.

56. Can a trade mark owner lodge a complaint to any administrative authorities on counterfeit trade mark goods?

- Yes No

If yes, please state the authority:

Myanmar Police Force, Myanmar Customs Department.

57. What are the actions that can be taken by such authorities?

- Conduct a raid
 Seize the infringing goods
 Impose a fine
 Refer for criminal prosecution
 Others: _____

58. Are border measures available to restrict the importation of counterfeit trademark goods?

- Yes No

If yes, what are the measures?

Trademark proprietors can file a customs recordal to record their registered trademarks with the Myanmar Customs Department. Upon the arrival of suspected counterfeit goods, the officers will detain these goods for verification.

59. Do these border measures apply for counterfeit goods of unregistered trademarks?

- Yes No
 Not applicable, there are no rights for unregistered trademarks in Myanmar

60. Is there an authority or ministry responsible for the enforcement of trademark rights?

- Yes No

If yes, please state:

Myanmar Police Force, Myanmar Customs Department. The proposed ministry to supervise intellectual property matters in Myanmar is the Ministry of Education.

Peculiarities

61. Are there any peculiarities not mentioned above in the system of protection for trademarks in Myanmar of which it is important for clients to be aware?

For the recordal of trademarks:

- (a) Although reference is made to intellectual property rights in the Constitution, there is no law that governs or lays down the framework for the registration of trademarks in Myanmar yet. A trademark recordal process has been established under Direction 13 of the Registration Act No. 16 of 1908, which allows trademarks to be recorded in the form of a Declaration of Ownership of Trademark under Section 18(f) of the Registration Act.
- (b) Pursuant to the recordal of trademarks, it is customary practice to publish cautionary notice in local newspaper to inform members of the trade and public of one's rights over a trademark.
- (c) For the maintenance of marks, it is recommended for renewals to be done once every three years, from the date of registration of the mark. Renewals are done by filing a Declaration of Renewal of Ownership, by publishing a cautionary notice, or both.
- (d) There is no trademark opposition procedure. Interested parties will need to file a trade-mark cancellation action in court.

For the enforcement of trademarks:

In the absence of a trademarks act, reference needs to be made to various pieces of archaic legislation when seeking to enforce trademark rights. For example, the Myanmar Penal Code of 1860 (India Act XLV) contains provisions relating to the definition of a trademark and sections dealing with trademark infringement. Reference is also made to the Code of Criminal Procedure when dealing with cases of trademark infringement. Section 54 of the Specific Relief Act 1877 allows courts to grant perpetual injunctions for trademark matters. The archaic Merchandise Marks Act 1889, which is based on the now repealed Indian Merchandise Marks Act 1889, also contains

provisions concerning remedies against trademark infringement and the use of false trade descriptions. The Sea Customs Act No. 8 of 1878 prohibits the importation of counterfeit goods.

Patents

Patent Rights and Protection in Myanmar

General

At present, it is not possible to file patent applications in Myanmar. In July 2017, officers at the Office of Registration of Deeds (ORD) verbally informed visitors that the ORD has stopped accepting any and all Declarations of Ownership relating to patents with immediate effect. No official announcements, notifications or directives have been issued to date, so the exact situation remains rather unclear. Based on our inquiries with the officers, it appears that this is a transitional period for the government officers while we await the enactment of the new patents act. The latest patents bill was issued for public consultation at the end of July 2017 and was submitted to the Upper House of the Parliament by the Union Minister of Education in January 2018. However, there is currently no indication of when the bill will be enacted into law.

1. What is the system for patent protection?

- Examination system
 Non-examination system

2. Is Myanmar a member of the Patent Cooperation Treaty (PCT)?

- Yes No

3. Is Myanmar a member of the Paris Convention?

- Yes No

Patent Registration

A. Registration System

4. What kinds of patent protection are available?

- Inventions Utility models
 Others: _____

5. What kinds of subject matter are excluded from patent protection?

- Methods of medical treatment or diagnosis
 Computer programs
 Business methods
 Others: _____

B. Patent Filing

6. What are the documents and information required for filing a patent application?

- Name and address of the applicant
 Name and address of the inventor
 Specification
 Abstract
 Power of Attorney
 Deed of Assignment
 Others: _____

7. Is there a fee for extra claims?

- Yes No

If yes, please describe:

8. Does Myanmar require obtaining a foreign filing license before filing a foreign patent application?

- Yes No

If yes, please describe:

B.1 Patent Specification

9. In which language must a patent specification be?

- English Other:

10. Is it possible to file an application first with an English specification, and then later submit its translation in the official language?

- Yes No Not Applicable

B.2 Publication, Amendment and Divisional Application**11. Is it possible to request a deferment of publication?**

-
- Yes
-
- No

If yes, please describe:
_____**12. Is it possible to request an early publication?**

-
- Yes
-
- No

If yes, please describe:
_____**13. Does the applicant have a provisional right upon the publication of an application?**

-
- Yes
-
- No

If yes, please describe:
_____**14. When is it possible to file a voluntary amendment to specification?**

-
- At the time of entry into the national phase (for PCT application)
-
-
- At any time during prosecution
-
-
- At the time of requesting examination
-
-
- Other:
-
- _____

15. When is it possible to voluntarily file a divisional application?

-
- At any time during prosecution
-
-
- At the time of granting a patent
-
-
- Other:
-
- _____

16. Is it possible to file a divisional application based on a previous pending divisional application if the parent application has already been granted a patent?

-
- Yes
-
- No

C. Examination**17. Is there a requirement to submit certain information on corresponding applications, or prior art known to the applicant?**

-
- Yes
-
- No

If yes, please describe:
_____**18. Is there a grace period (exception to novelty)?**

-
- Yes
-
- No

If yes, please describe:
_____**19. Is it required to file a request for substantive examination?**

-
- Yes
-
- No

If yes, what are the requirements?
_____**20. Can a third party file a request for substantive examination?**

-
- Yes
-
- No

21. Is there a right of appeal?

-
- Yes
-
- No

If yes, please describe briefly:
_____**22. Are multiple dependent claims admissible?**

-
- Yes
-
- No

D. Opposition**23. Is there an opposition procedure upon publication?**

-
- Yes
-
- No

24. How long is the opposition term once the application is published?

-
- 2 months
-
- 3 months

 Prior to the grant Other: _____

25. Who may initiate opposition proceedings?

- Any person
 Anyone with a legitimate interest
 Any competent authorities
 Others: _____

E. Timeline**26. What is the time period from application to grant for a straightforward application?**

- Between 2 - 3 years
 Between 3 - 4 years
 Other: 4 - 5 years

27. Is there any process for accelerated examination of application?

- Yes No
If yes, what are the requirements?

Maintenance of Patent**A. Annuity****28. To maintain the validity of patent, is it required to pay an annuity in Myanmar?**

- Yes No

29. Is late payment of annuity permissible?

- Yes No
If yes, what are the requirements?

30. Is government annuity fixed for each year?

- Yes No
If yes, what is the base for calculation of annuity?

31. Can annuity be paid once for all years or once for several years?

- Yes No

32. Is power of attorney required for annuity payment?

- Yes No

33. Are there any provisions to restore a lapsed patent?

- Yes No
If yes, what are the requirements?

34. Is patent term extension available in Myanmar?

- Yes No
If yes, what are the conditions?

B. Compulsory Licence**35. Is a compulsory licence available in Myanmar?**

- Yes No
If yes, what are the requirements?

36. Can a request for termination of compulsory licence be filed?

- Yes No
If yes, what are the requirements?

C. Use Requirement**37. Does the patentee need to submit evidence of obligation of use to the Patent Office in order to maintain a patent in Myanmar?**

- Yes No
If yes, please describe:

38. Is a compulsory licence granted based on failing to perform an obligation to use?

- Yes No
If yes, please describe:

D. Cancellation**39. Are termination or cancellation proceedings available in Myanmar?**

- Yes No

If yes, what are the grounds?

40. What is the time limit for termination or cancellation?

- 3 years 5 years
 Whole Other: _____
protection
term of patent

E. Assignment, Transmission and Licensing**41. Are there any mechanisms to record assignment of a patent in Myanmar?**

- Yes No

If yes, what are the requirements?

Pursuant to the halt in accepting declarations relating to patents, the ORD has also stopped accepting recordals for the Declarations of Assignment of existing registered patents.

42. Are there any mechanisms to record transmission of a patent in Myanmar, for example, transmission by way of merger?

- Yes No

If yes, what are the requirements?

Pursuant to the halt in accepting declarations relating to patents, the ORD has also stopped accepting recordals for the Declarations of Merger related to existing registered patents.

43. Are patent licensees required to record themselves with the Patent Office?

- Yes No

If yes, what are the requirements?

F. Change of Details**44. Are there any mechanisms to record change of name or address of the patent proprietor?**

- Yes No

If yes, what are the requirements?

Pursuant to the halt in accepting declarations relating to patents, the ORD has also stopped accepting recordals for the Declarations of Change of Name and/or Address related to existing registered patents.

45. Is it possible to amend a granted patent?

- Yes No

If yes, what are the requirements?

46. Is it possible to correct and rectify any errors on the patent?

- Yes No

If yes, what are the requirements?

Enforcement**47. What are the available enforcement methods in Myanmar?**

- Civil enforcement
 Administrative enforcement
 Criminal enforcement
 Border measures
 Others: _____

48. What are the criteria for infringement?

- Literal infringement
 Infringement under the doctrine of equivalents
 Use of the patent without permission of patent owner
 Others:

49. Is there a statute of limitations for filing a suit for patent infringement?

- Yes No

If yes, what is the time period?

50. What are the remedies available for an infringement action?

- Damages
- Injunction
- Destruction of the infringing goods
- Others: _____

51. What are the actions taken by such authorities?

- Conduct a raid
- Seize the infringing goods
- Impose a fine
- Others: _____

52. Is there an authority or ministry responsible for the enforcement of patent rights?

- Yes No

If yes, please state:

Peculiarities

53. Are there any peculiarities in the system of protection for patents in Myanmar of which it is important for clients to be aware?

- (a) Although reference is made to intellectual property rights in the Constitution, there is no law that governs or lays down the framework for the registration or enforcement of patents in Myanmar yet. Previously, patent owners were able to record Declarations of Ownership of patents at the Office of Registration of Deeds (ORD) (although Direction 13 of the Registration Act No. 16 of 1908 only refers to the records of trademarks).
- (b) In July 2017, officers at the ORD verbally informed visitors that the ORD has stopped accepting any and all Declarations of Ownership relating to patents with immediate effect, as part of a transitional period for the government officers while the country awaits the enactment of the new patents act. The latest patents bill was issued at the end of July 2017 and is currently being considered by the legislative committee. However, there is currently no indication of when the bill will be enacted into law.

Philippines

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About The Firm

From a modest commercial law practice in downtown Manila at the turn of the 20th century, today we are one of the largest and most highly regarded law firms in the Philippines with a full offering of legal services, including advice and representation in banking and finance, capital market and securities, energy and infrastructure, immigration, intellectual property, labor and employment, litigation and arbitration, real estate and natural resources, taxation, and technology, media, and telecommunications.



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We are composed of more than 90 lawyers – all of whom speak English fluently and a good number of whom have received training and graduate degrees from universities abroad. Our lawyers are also active officers and members of business and civic associations in the Philippines and around the world.

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Foreword

The Intellectual Property Code of the Philippines (“IP Code”; Republic Act No. 8293), which took effect on 1 January 1998, is the omnibus law dealing with the protection of intellectual property rights, namely, patents, copyright, trademark, as well as trade secrets and technological know-how.

The IP Code superseded the Patent Act (Republic Act No. 165) and Trademark Act (Republic Act No. 166) which were effective since 1947 as well as the provisions of the Revised Penal Code (Act No. 3815) on the criminal offenses of unfair competition and various trademark violations.

The IP Code introduced substantial changes to the Philippines’ intellectual property legal framework. With respect to trademarks, in lieu of an actual use system, the IP Code introduced a hybrid system of registration which allows the filing of a trademark application without prior use of the mark, provided that there will be actual use of the mark in commerce within three years from the filing of the application. With respect to patents, in lieu of a first-to-invent system, the IP Code adopted a first-to-file rule which reckons the priority of invention upon the filing of a patent application. This law essentially incorporated the commitments of the Philippines under the Paris Convention, Berne Convention, and the TRIPS Agreement.

The IP Code administered by the Intellectual Property Office of the Philippines (“IPO”), which is the repository for trademarks and patents filed in the Philippines. It has original jurisdiction over administrative complaints concerning intellectual property rights where the total claim for damages does not exceed PHP 200,000. The IPO also exclusively hears opposition and cancellation suits.

Civil and criminal suits for infringement and unfair competition may also be independently filed with the regular courts. The Bureau of Customs, Optical Media Board, National Bureau of Investigation, and Department of Trade and Industry also assist the IPO in enforcement efforts.

Subsequent to the enactment of the IP Code, there have been other laws that were passed for the recognition and protection of intellectual property rights, such as the Act for the Protection of Layout Designs of Integrated Circuits (Republic Act No. 9150), New Plant Varieties Protection Act (Republic Act No. 9168), Optical Media Act (Republic Act No. 9239), and the Universally Accessible Cheaper and Quality Medicines Act of 2008 (Republic Act No. 9502). In 2013, several provisions of the IP Code on copyright were amended by the Republic Act No. 10372, by providing for vicarious liability in the case of copyright infringement.

Trademarks

Trademark Rights and Protection in Philippines

General

1. What is the system for trademark protection in Philippines?

- Registration Common law
 Co-existing rights under registration and common law

2. Does first to use or first to register have prior rights in Philippines?

- First to use First to register

3. Is Philippines a member of the Madrid Union and the Paris Convention?

- Madrid System Paris Convention

4. If Philippines is a member of Madrid Union is it a party to the Agreement or the Protocol and are there any peculiarities in relation to the implementation of the Madrid System for international registration in Philippines?

The Philippines acceded to the Protocol through an instrument of accession accompanied by the following declarations:

- (a) In accordance with Article 5(2)(d) of the Madrid Protocol (1989), under Article 5(2)(b) of the Protocol, the time limit of one year to exercise the right to notify a refusal of protection referred to in Article 5(2)(a) thereof is replaced by 18 months and under Article 5(2)(c) of the said Protocol, when a refusal of protection may result from an opposition to the granting of protection, such refusal may be notified to the International Bureau after the expiry of the 18-month time limit;

- (b) In accordance with Article 8(7)(a) of the Madrid Protocol (1989), the Republic of the Philippines, in connection with each international registration in which it is mentioned under Article 3ter of the said Protocol, and in connection with the renewal of any such international registration, wants to receive instead of a share in the revenue produced by the supplementary and complementary fees, an individual fee; and
- (c) In accordance with Article 14(5) of the Madrid Protocol (1989), the protection resulting from any international registration effected under this Protocol before the date of entry into force of this Protocol with respect to the Republic of the Philippines cannot be extended to it.

Trade Mark Registration

A. Registration System

5. What are the benefits of registering a trade mark in Philippines?

- Prevails over common law rights
 It is the only form of protection available for trademarks
 Entitles the proprietor to bring an infringement action
 Others:
 Registration of a trademark serves as prima facie evidence of the registrant's ownership of the trademark. A person challenging the registration has the burden to prove that the registrant is not the true owner of the trademark.

6. Is it possible to obtain registration for the following types of marks under the registration system in Philippines?

a. Service marks

- Yes No

b. Defensive marks

Yes No

If yes, what are the requirements?

c. Collective marks

Yes No

If yes, what are the requirements?

In the application for registration of a collective mark:

- (a) The mark shall be designated as a collective mark;
- (b) A copy of the agreement, if any, governing the use of the collective mark shall be submitted;
- (c) The registered owner of the collective mark shall notify the Director of the Intellectual Property Office of any changes made in respect of the agreement.

d. Certification mark

Yes No

If yes, what are the requirements?

e. Well-known marks

(i.e. registration of a mark as a well-known mark and not an ordinary trademark)

Yes No

If yes, what are the requirements?

A mark is considered well-known if it is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered in the Philippines. Furthermore, in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark.

f. Series marks

Yes No

If yes, what are the requirements?

g. Marks in different language or characters other than Roman characters

Yes No

If yes, what are the requirements?

A transliteration or translation of the mark must be included in the application.

h. Non-traditional marks: Sound marks

Yes No

If yes, what are the requirements?

i. Non-traditional marks: Smell marks

Yes No

If yes, what are the requirements?

j. Non-traditional marks: Position marks

Yes No

If yes, what are the requirements?

k. Non-traditional marks: Colour marks

(i.e. registration of a single colour or a combination of colours)

Yes No

If yes, what are the requirements?

l. Non-traditional marks: Shape or three-dimensional marks

Yes No

If yes, what are the requirements?

Limited only to stamped or marked container of goods. A reproduction of the three-dimensional mark and a statement that the mark is a three-dimensional mark must be included in the application.

m. Others: _____

7. Is it possible to claim a colour limitation?

- Yes No

If yes, what are the requirements?

If an applicant wishes to claim a color as a distinctive feature of a trademark, a statement to that effect as well as the name or names of the color or colors claimed and an indication, in respect of each color, of the principal parts of the mark which are in that color must be included in the application.

8. What is the official name of the trademark office in Philippines?

The Intellectual Property Office of the Philippines.

B. Trade Mark Filing**9. What are the documents and information required for filing a trade mark application in Philippines?**

- Name and address of the applicant
- Representation of the trade mark
- Goods and services and the class(es) for which the trade mark is to be registered
- Certificate of Incorporation (if the applicant is a company)
- Statutory Declaration
- Power of Attorney
- Others:
 - (a) Nationality/domicile and business residence of the applicant.
 - (b) Appointment of an agent or representative, if the applicant is not domiciled in the Philippines.
 - (c) Sworn statement that the applicant is a small entity if such be the fact.

10. Can a trade mark application be based on intent to use in Philippines?

- Yes No

If yes, please specify any conditions:

To maintain registration of the trademark, proof of use through a Declaration of Actual Use (DAU) must be filed within 3 years from the filing date of the trademark application. A DAU must also be filed within 1 year from the 5th anniversary of the registration of the trademark and within 1 year from the renewal of the registration.

11. Is priority claim allowed in Philippines?

- Yes No

If yes, what are the requirements?

Partial priority claim.

A declaration claiming priority of an earlier application, together with an indication of:

- (a) The name of the state with whose national Office the earlier application was filed or if filed with an Office other than a national Office, the name of that Office;
- (b) The date on which the earlier application was filed; and
- (c) Where available, the application number of the earlier application; must be included in the application.

12. Are multi-class applications permitted in Philippines?

- Yes No

If yes, is there a maximum number of classes that can be applied for?

There is no maximum number of classes prescribed for each application.

13. Does Philippines adopt the Nice Classification for specification of goods and services?

- Yes No

If yes, please specify the edition:

11th Edition

14. Are there any specific requirements in relation to the classification of goods and services in Philippines?**a. Must the specification of goods and services be limited to items from the list of goods and services under the Nice Classification only?**

- Yes No

Goods or services which are not specifically listed under the Nice Classification list may be included but the applicant must indicate the class under the Nice Classification to which such goods or services belong.

b. Can the class heading be included in the specification?

- Yes No Subject to conditions
Please specify:

c. Are there sub-classes of goods and services applied by the trademark office in Philippines?

- Yes No

If yes, please elaborate:

d. Others:

C. Trade Mark Examination**15. What marks, signs, representations, emblems or words are specifically prohibited from registration in Philippines?**

- Signs contrary to morality or public order
- Signs of such a nature as to deceive the public
- Signs benefiting protection from other international convention (e.g. Red Cross, Olympic symbols)
- Signs protected by national laws (e.g. royal emblems)
- Others:
 - (a) Marks consisting of a name, portrait, signature identifying a particular living individual except by his written consent;
 - (b) Marks consisting of the name, signature, or portrait of a deceased President of the Philippines, during the life of his widow, if any, except by written consent of the widow;
 - (c) Marks identical with a registered mark or a mark with an earlier filing date belonging to a different proprietor in respect of:
 - (i) The same goods or services or
 - (ii) Closely related goods or services

- (d) Marks identical with or confusingly similar to, or constitutes a translation of mark which is considered by the competent authority in the Philippines to be well-known internationally and in the Philippines;
- (e) Marks consisting exclusively of signs that are generic for the goods or services that they seek to identify;
- (f) Marks consisting exclusively of signs or indications that have become customary or usual to designate the goods or services in everyday language or in bona fide and established trade practice;
- (g) Marks consisting exclusively of signs or indications that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time or production of the goods or rendering of the services, or other characteristics of the goods or services
- (h) Marks consisting of shapes that may be necessitated by technical factors or by the nature of the goods themselves or factors that affect their intrinsic value;
- (i) Marks consisting of color alone, unless defined by a given form.

16. Is there substantive examination of trademarks?

- Yes No

If yes, what are the grounds?

- Absolute grounds
- Relative grounds

Others: _____

17. Is substantive examination conducted before or after publication of a trademark for opposition by third parties?

- Before publication After publication

18. What are the absolute grounds for refusal?

- Mark consists of a non-invented word(s)
- Mark has direct reference to the character or quality of the goods or services
- Mark is not distinctive
- Mark consists of a geographical name
- Mark consists of a surname
- Mark consists of letters of the alphabet
- Mark consists of numerals
- Mark consists of geometric shapes
- Others:
The configuration of the mark is among those specifically prohibited by law from registration (see answer to question no. 15).

19. What are the relative grounds for refusal?

- There is a prior application for registration or registration for an identical or confusingly similar mark in relation to the same goods or services as the subject mark
- There is a prior application for registration or registration for an identical or confusingly similar mark in relation to similar goods or services (although in different class) as the subject mark
- Well known mark: There is a well known mark which is identical or so nearly resembling the subject mark for the same goods or services as the subject mark
- Well known mark: There is an earlier registered mark which is well known for different goods or services and use of the subject mark would indicate a connection between goods or services covered by the subject mark with the proprietor of the well known mark
- Others:
The configuration of the mark is among those specifically prohibited by law from registration (see answer to question no. 15).

20. Is there a right of appeal?

- Yes No

If yes, please describe:

Upon notice of the refusal, the applicant has a period of 4 months in which to reply or amend his application, which shall then be re-examined by the examiner. Upon final refusal by the examiner, the applicant may, within 2 months from notice of the final refusal and without extension, elevate his application to the Director of the Bureau of Legal Affairs by way of an Appellant's brief. If the decision of the Director of the Bureau of Legal Affairs is unfavorable, a motion for reconsideration may be filed within 15 days from receipt of the decision. The decision or order of the Director of the Bureau of Legal Affairs may also be elevated to the Director General of the Intellectual Property Office of the Philippines by way of a Notice of Appeal within 15 days from receipt of the decision. If the decision of the Director General is unfavorable, no motion for reconsideration may be filed. Instead, the application may be elevated to the Court of Appeals, and thereafter, to the Supreme Court.

D. Publication and Opposition

21. Is there an opposition procedure upon publication?

- Yes No

22. How long is the opposition term once the trade mark application is published in Philippines?

[1] month

23. Is the opposition term extendible?

- Yes, for [3] months

No

Others: _____

24. Who may initiate opposition proceedings?

Any person

Anyone with a legitimate interest

Any competent authorities

Others: _____

25. What are the usual grounds for opposition?

- Prior use of a mark which is identical or confusingly similar to the opposed mark
- Prior registration of a mark which is identical or confusingly similar to the opposed mark
- Bad faith in application for registration of the opposed mark
- Applicant is not the rightful proprietor of the opposed mark
- If the opposed mark is identical with or so nearly resembles the Opponent's mark which is well-known in Philippines for the same goods or services
- If the opposed mark is identical with or so nearly resembles the Opponent's mark which is well-known and registered in Philippines for goods or services not the same as those claimed in the opposed mark; provided that the use of the opposed mark in relation to the goods or services claimed would indicate a connection between those goods or services and the proprietor of the well-known mark, and the interests of the proprietor of the well-known mark are likely to be damaged by such use
- Opposed mark lacks distinctiveness
- Lack of intention to use the opposed mark
- Opposed mark consists of false geographical indication
- Use of opposed mark likely to cause confusion or deception
- Others: _____

E. Timeline

26. What is the time period from application to registration for a straightforward trademark application in Philippines?

- Between 6 months - 12 months
- Between 12 months - 18 months
- 18 months above

27. Is there any process for accelerated/expedited examination of trade mark applications?

- Yes No

If yes, what are the requirements?

Maintenance of Trademark Registration

A. Renewal

28. Is there a mechanism to renew a trade mark registration in Philippines?

- Yes No

If yes, how long is the validity of the renewal?

10 years.

29. Is late renewal of a trademark registration permissible in Philippines?

- Yes No

If yes, what are the conditions?

A request for renewal may be filed within 6 months after the expiration of the registration and with payment of an additional fee.

30. Are there any provisions to restore a lapsed registration?

- Yes No

If yes, what are the requirements?

B. Use Requirement

31. Does evidence of use need to be submitted to the trademark office at any time in order to maintain an application for registration or a registration of a trademark in Philippines?

- Yes No

If yes, what are the requirements?

A Declaration of Actual Use (DAU) must be filed within 3 years from the filing date of the trademark application. A DAU must also be filed within 1 year from the 5th anniversary of the registration of the trademark and within 1 year from the renewal of the registration.

The DAU is made under oath and must contain the list of goods where the mark is attached, the name or names and the exact location or locations of the outlet or outlets where the products are being sold or where the services are being rendered and state the facts of actual use of the trademark in the Philippines and the nature of such use. At least 5 labels or pictures showing the use of the mark shall be submitted as part of the DAU.

C. Rectification/Cancellation

32. Are rectification or cancellation proceedings available in Philippines?

- Yes No

If yes, what is the forum?

Cancellation proceedings are initiated by filing a Petition for Cancellation with the Bureau of Legal Affairs of the Intellectual Property Office of the Philippines.

33. What are the grounds for rectification or cancellation proceedings?

- Any entry made in the Register without sufficient cause
- Any entry wrongfully remaining in the Register
- Non-use of the mark
- Others:
The mark becomes the generic name for the goods or services for which it is registered.
The mark is being used by or with the permission of the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.

34. When would a presumption of validity arise in relation to a trademark registration?

- [5] years from date certificate of registration issued/date of application
- No such presumption

In the Philippines, a registered trademark may no longer be cancelled after five (5) years from the date of the registration of the trademark except on certain grounds (i.e. abandonment, fraud, etc.).

35. When are the grounds for rectification or cancellation proceedings assessed?

- At the time of filing of the application
- At the time of issuance of the certificate of registration
- At the time of the application for rectification or cancellation proceedings
- Others:
Cancellation proceedings may be initiated only upon registration of the trademark. For grounds existing during the application for registration, opposition is the proper remedy. Grounds that exist upon the issuance of the certificate of registration or at the time of cancellation proceedings may be assailed through cancellation.

36. When is a trade mark registration vulnerable to cancellation on grounds of non-use?

- [] years from the deemed date of registration
- [] years from the date of certificate issuance
- Not applicable
- Others:
If the registered owner of the mark without legitimate reason fails to use the mark within the Philippines, or to cause it to be used in the Philippines by virtue of a license during an uninterrupted period of 3 years or longer.

37. Who bears the burden of proof in a non-use cancellation action?

- Applicant for cancellation
- Defendant / Respondent (trademark owner)

38. If the answer to the above is the Applicant, what are the examples of evidence which can be relied on to support an application for cancellation for non-use?

- Full market survey conducted by an independent or professional surveyor of an appropriate sample size
- Simple market survey or enquiries in the trade
- Declaration from the applicant for cancellation
- Others: _____

D. Assignment, Transmission and Licensing

39. Are there any mechanisms to record assignment of a trade mark in Philippines?

- Yes No

If yes, what are the requirements?

- (a) A notarised document stating the assignment of the trademark and signed by the contracting parties; and
- (b) Payment of the prescribed fee.

40. Are there different requirements for recording assignment with or without the goodwill of the business?

- Yes No

If yes, what are the requirements?

41. Are there any mechanisms to record transmission of a trade mark in Philippines, for example transmission by way of merger?

- Yes No

If yes, what are the requirements?

The deed of merger will suffice as proof of the assignment of the trademark.

42. Are trade mark licensees required to record themselves with the Registrar?

- Mandatory Recommended No

The license contract shall be applied for clearance with the Documentation Information and Technology Transfer Bureau of the Intellectual Property Office of the Philippines and shall be recorded only upon certification that the contract does not have an adverse effect on competition and trade and that it contains the mandatory provisions as required by the Intellectual Property Code (Section 88).

E. Change of Particulars

43. Should any change in the name or address of the proprietor on record of a registered trademark be updated on the register?

- Yes No

If yes, what are the requirements?

44. Is it possible to change the representation of a registered trademark?

- Yes No

If yes, what are the requirements?

45. Is it possible to correct and rectify any errors on the Register?

- Yes No

If yes, what are the requirements?

- (a) The correction does not require republication of the mark.
- (b) Submission of an application for correction made under oath and specifying the mistake for which correction is sought, the manner in which it arose, and stating that the mistake occurred in good faith.
- (c) Payment of the prescribed fee.

Enforcement

46. What are the available enforcement methods in Philippines?

- Civil enforcement
 - Infringement action
 - Passing off
- Criminal enforcement
- Border or other administrative enforcement measures

47. What are the requirements to bring an action for infringement of trademark?

- Valid registration of the trademark
- Unauthorised use by a 3rd party in the course of trade of a mark which is
 - identical to the registered trademark
 - so nearly resembling the registered mark as is likely to cause confusion
 - in relation to the goods or services for which the proprietor's mark is registered
 - in relation to goods or services which are similar to the goods or services for which the proprietor's mark is registered though not the same

If yes, what are the criteria?
Infringement may occur in relation to non-competing goods or services if such goods or services are so related to each other that it can reasonably be assumed that they originate from one manufacturer or provider.

48. For a trademark infringement action, is it necessary to establish

- Actual confusion?
- Likelihood of confusion?

49. For a trademark infringement action, is it necessary to establish damage or loss to the proprietor of the trademark?

- Yes No Others

If yes, what are the requirements?

50. Is there a period of limitation for filing a suit for trade mark infringement?

- Yes No

If yes, what is the time period?

51. What are the remedies available for an infringement action?

- Damages or account of profits
- Injunction
- Delivery and/or destruction of the infringing goods
- Others:
 - Impounding of infringing goods by the court.
 - Disposal of infringing goods outside the channels of commerce.
 - Prohibition of importation of the infringing goods.

52. Is it possible to claim for 'passing off' in Philippines?

- Yes No

53. If yes, what are the criteria to establish 'passing off'?

- That the proprietor has goodwill and reputation in the trademark

a. Must the goodwill and reputation subsist in Philippines i.e. goodwill and reputation outside Philippines will not be taken into consideration?

- Yes No

b. Must there be actual use or business presence in Philippines?

- Yes No

c. What is the usual form of evidence used to establish such goodwill and reputation?

Company, trademark registration, and brand history; awards and recognitions received by the trademark and brand; value of goodwill as reflected in the financial statements.

- That there is misrepresentation caused to members of the public

a. Is it necessary to establish actual confusion or is likelihood of confusion sufficient?

- Actual confusion
 Likelihood of confusion

b. What is the usual form of evidence used to establish such misrepresentation?

Comparison of the original goods with the infringing goods.

- That there are damage/likelihood of damage

a. Is it necessary to establish actual damages or is likelihood of damage sufficient?

- Actual damage
 Likelihood of damage

b. What is the usual form of evidence used to establish such damage or likelihood of damage?

- Others:

Where the infringer intends to deceive the public and defraud a competitor, the intent to deceive and defraud may be inferred from the similarity of the infringing goods with the original goods.

54. Are there other forms of actions or claims that can be brought by a trademark owner against an infringer or unauthorised user?

- Unfair competition Others: _____

55. What are the elements that need to be established to bring the claim(s) above?

- (a) Confusing similarity in the general appearance of the goods; and
 (b) Intent to deceive the public and defraud a competitor.

56. Can a trade mark owner lodge a complaint to any administrative authorities on counterfeit trade mark goods?

- Yes No

If yes, please state the authority:

The National Bureau of Investigation

57. What are the actions that can be taken by such authorities?

- Conduct a raid
 Seize the infringing goods
 Impose a fine
 Refer for criminal prosecution
 Others: _____

58. Are border measures available to restrict the importation of counterfeit trademark goods?

- Yes No

If yes, what are the measures?

- (a) Issuance of alert or hold orders for suspect goods; and
 (b) Seizure and detention.

59. Do these border measures apply for counterfeit goods of unregistered trademarks?

- Yes No

Not applicable, there are no rights for unregistered trademarks in Philippines

60. Is there an authority or ministry responsible for the enforcement of trademark rights?

- Yes No

If yes, please state:

The Intellectual Property Office of the Philippines.

Peculiarities

61. Are there any peculiarities not mentioned above in the system of protection for trademarks in Philippines of which it is important for clients to be aware?

None.

Patents

Patent Rights and Protection in Philippines

General

1. What is the system for patent protection?

- Examination system
 Non-examination system

2. Is the Philippines a member of the Patent Cooperation Treaty (PCT)?

- Yes No

3. Is the Philippines a member of the Paris Convention?

- Yes No

Patent Registration

A. Registration System

4. What kinds of patent protection are available?

- Inventions Utility models
 Others:
 Industrial Designs; Layout of Integrated Circuits

5. What kinds of subject matter are excluded from patent protection?

- Methods of medical treatment or diagnosis
 Computer programs
 Business methods
 Others:
 Discoveries, scientific methods, mathematical methods. In the case of medicines, the mere discovery of a new form or new property of a known substance which does not result in the enhancement of the known efficacy of that substance, or the mere discovery of any new property or new use for a known substance, or the mere use of a known process unless such known process results in a new product that employs at least one new reactant; schemes, rules and methods for performing mental acts,

playing games; aesthetic creations; plant varieties, animal breeds, as well as the essential biological processes that produce animals and plants, except microorganisms; anything contrary to public order or morality.

B. Patent Filing

6. What are the documents and information required for filing a patent application?

- Name and address of the applicant
 Name and address of the inventor
 Specification
 Abstract
 Power of Attorney (to be legalised if executed abroad)
 Deed of Assignment (to be legalised if executed abroad)
 Others:
 Title and description of the invention; drawings necessary for the understanding of the invention; name and address of the representative or resident agent, if any; signature of the applicant, representative, or resident agent; if with a claim for convention priority, file number, country of origin, date of filing in the country where the application was first filed.

7. Is there a fee for extra claims?

- Yes No

If yes, please describe:

In excess of five claims, there is an additional fee of PHP 360 (approx. USD 7) per claim.

8. Does the Philippines require obtaining a foreign filing license before filing a foreign patent application?

- Yes No

If yes, please describe:

B.1 Patent Specification**9. In which language must a patent specification be?**

- English Other: _____

10. Is it possible to file an application first with an English specification, and then later submit its translation in the official language?

- Yes No
English language application is sufficient.

B.2 Publication, Amendment and Divisional Application**11. Is it possible to request a deferment of publication?**

- Yes No

If yes, please describe:

Deferment of publication is charged at PHP 1,000 (approx. USD 20).

12. Is it possible to request an early publication?

- Yes No

If yes, please describe:

The application may be published before eighteen (18) months but not earlier than six (6) months from the filing date, provided that:

- (a) a written request for an early publication is filed;
- (b) the applicant attaches a waiver on the confidentiality disclosures of the application, under oath;
- (c) the applicant agrees to have the application published without a search report; and
- (d) full payment has been made of the early publication fees.

13. Does the applicant have a provisional right upon the publication of an application?

- Yes No

If yes, please describe:

The applicant shall have all the rights of a patentee under Philippines patent law against any person who, without his authorization, exercises any of the rights in relation to the invention claimed in the published application, as if a patent has been granted for that invention; provided, that the said person had:

- (a) actual knowledge that the invention that he was using the subject matter of a published application; or
- (b) received a written notice that the invention that he was using was the subject matter of a published application being identified in the said notice by its serial number; provided, that the action may not be filed until after the grant of a patent on the published application and within four (4) years from the commission of the acts complained of.

14. When is it possible to file a voluntary amendment to specification?

- At the time of entry into the national phase (for PCT application)
- At any time during prosecution
- At the time of requesting examination
- Other: _____

15. When is it possible to voluntarily file a divisional application?

- At any time during prosecution
- At the time of granting a patent
- Other:
At any time before the parent application is withdrawn or patented

16. Is it possible to file a divisional application based on a previous pending divisional application if the parent application has already been granted a patent?

- Yes No

C. Examination

17. Is there a requirement to submit certain information on corresponding applications, or prior art known to the applicant?

- Yes No
If yes, please describe:

18. Is there a grace period (exception to novelty)?

- Yes No
If yes, please describe:

19. Is it required to file a request for substantive examination?

- Yes No
If yes, what are the requirements?

A written request for substantive examination together with the full payment of the corresponding fee shall be filed within six (6) months from the date of publication of a patent application. Failure of the applicant to file a request for substantive examination and pay the corresponding fees within the prescribed period shall result in the withdrawal of the application.

20. Can a third party file a request for substantive examination?

- Yes No

21. Is there a right of appeal?

- Yes No
If yes, please describe:

22. Are multiple dependent claims admissible?

- Yes No

A multiple dependent claim shall not serve as a basis for any other multiple dependent claims.

D. Opposition

23. Is there an opposition procedure upon publication?

- Yes No

Within six (6) months from the date of publication of the application or the request for substantive examination filed by the applicant, whichever comes later, any person may present observations in writing concerning the patentability of the invention including matters pertaining to novelty, inventive step, and industrial applicability while citing relevant prior art.

24. How long is the opposition term once the application is published?

- 2 months 3 months
 Prior to the grant Other: Six (6) months

25. Who may initiate opposition proceedings?

- Any person
 Anyone with a legitimate interest
 Any competent authorities
 Other: _____

E. Timeline

26. What is the time period from application to grant for a straightforward application?

- Between 2 - 3 years
 Between 3 - 4 years
 Other: _____

27. Is there any process for accelerated examination of application?

- Yes No
If yes, what are the requirements?

There are different sets of rules for the Patent Prosecution Highway Program between the Philippines Intellectual Property Office and the Japan Patent Office, United States Patent and Trademark Office, Korean Intellectual Property Office, and European Patent Office, respectively.

Maintenance of Patent

A. Annuity

28. To maintain the validity of patent, is it required to pay an annuity in the Philippines?

- Yes No

29. Is late payment of annuity permissible?

- Yes No

If yes, what are the requirements?

The first annual fee on patent shall be due and payable on the expiration of four (4) years from the date the application is published or from the international publication date, in case of PCT national entry phase applications, and on each subsequent anniversary of such date. Payment may be made within three (3) months before the due date.

30. Is government annuity fixed for each year?

- Yes No

If yes, what is the base for calculation of annuity?

The amount of the annuity is fixed, starting at PHP 3,240 (approx. USD 65) on the fifth year and PHP 65,160 (approx. USD 1,300) on the 20th year.

31. Can annuity be paid once for all years or once for several years?

- Yes No

32. Is power of attorney required for annuity payment?

- Yes No

33. Are there any provisions to restore a lapsed patent?

- Yes No

If yes, what are the requirements?

34. Is patent term extension available in the Philippines?

- Yes No

If yes, what are the requirements?

B. Compulsory Licence

35. Is a compulsory licence available in the Philippines?

- Yes No

If yes, what are the requirements?

The grounds for a compulsory licence are the following:

- (a) National emergency or other circumstances of extreme urgency; or
- (b) Where the public interest, in particular, national security, nutrition, health or the development of other vital sectors of the national economy as determined by the appropriate agency of the Government, so requires; or
- (c) Where a judicial or administrative body has determined that the manner of exploitation by the owner of the patent or his licensee is anti-competitive; or
- (d) In case of public non-commercial use of the patent by the patentee, without satisfactory reason; or
- (e) If the patented invention is not being worked in the Philippines on a commercial scale, although capable of being worked, without satisfactory reason: Provided, That the importation of the patented article shall constitute working or using the patent; and
- (f) Where the demand for patented drugs and medicines is not being met to an adequate extent and on reasonable terms, as determined by the Secretary of the Department of Health

36. Can a request for termination of compulsory licence be filed?

- Yes No

If yes, what are the requirements?

Only the patentee may request that the compulsory licence be cancelled because either the ground for the grant of the compulsory licence no longer exists and is unlikely to recur, or the licensee has neither begun to supply the domestic market nor made serious preparation therefor; or the licensee has not complied with the prescribed terms of the license. The licensee may also surrender the compulsory licence by a written declaration.

C. Use Requirement

37. Does the patentee need to submit evidence of obligation of use to the Patent Office in order to maintain a patent in the Philippines?

- Yes No

If yes, please describe:

38. Is a compulsory licence granted based on failing to perform an obligation to use?

- Yes No

If yes, please describe:

There is no duration threshold for non-use.

D. Cancellation

39. Are termination or cancellation proceedings available in the Philippines?

- Yes No

If yes, what are the grounds?

- That what is claimed as the invention is not new or patentable; or
- That the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by any person skilled in the art; or
- That the patent is contrary to public order or morality.

40. What is the time limit for termination or cancellation?

- 3 years 5 years
 Whole protection term of patent Other

E. Assignment, Transmission and Licensing

41. Are there any mechanisms to record assignment of a patent in the Philippines?

- Yes No

If yes, what are the requirements?

To be acceptable for recording, the assignment:

- Must be in writing and if in a language other than English or Filipino, the document must be accompanied by an English translation;
- Must be acknowledged before a notary public, or other officer authorised to administer oaths and perform other notarial acts, and be certified under the hand and official seal of the said notary or other officer;
- Must be accompanied by an appointment of a resident agent, if the assignee is not domiciled in the Philippines;
- So that there can be no mistake as to the patent or application intended, must identify the letters patent involved by number, and date, name of the patentee, and title of the invention as set forth in the patent; in the case of an application for patent, the application number and the filing date of the application should be stated, giving also the name of the applicant, and title of the invention, set forth in the application, but if an assignment is executed concurrently with or subsequent to the execution of the application but before the application is filed, or before its application number is ascertained, it should adequately identify the application by date of execution, name of the applicant, and title of the invention; and
- Must be accompanied by the required recordal and publication fees.

42. Are there any mechanisms to record transmission of a patent in the Philippines, for example, transmission by way of merger?

- Yes No

If yes, what are the requirements?

The requirements and procedure are the same as for the recordal of an assignment.

43. Are patent licensees required to record themselves with the Patent Office?

- Yes No

If yes, what are the requirements?

F. Change of Details

44. Are there any mechanisms to record change of name or address of the patent proprietor?

- Yes No

Please see answers to questions on assignment and transmission of rights.

45. Is it possible to amend a granted patent?

- Yes No

If yes, what are the requirements?

The owner of the patent shall have the right to request the Intellectual Property Office to make changes in the patent in order to:

- Limit the extent of the protection conferred by it;
- Correct obvious mistakes or to correct clerical errors; and
- Correct mistakes or errors, other than obvious mistakes or clerical errors; Provided, that where the change would result in broadening of the extent of the protection conferred by the patent, no request may be made after the expiration of two (2) years from the grant of a patent and the change shall not affect the rights of any third party which has relied on the patent, as published.

46. Is it possible to correct and rectify any errors on the patent?

- Yes No

If yes, what are the requirements?

Upon written petition, in duplicate, of the patentee or assignee of record, and upon tender to the Intellectual Property Office of the copy of the patent issued to the patentee, the Director shall have the power to correct, without fee, any mistake in a patent incurred through the fault of the IPO when clearly disclosed by the records thereof, to make the patent conform to the records.

Meanwhile, on request of any interested person and payment of the prescribed fee, the IPO shall also correct any mistake in the patent of a formal and clerical nature, not incurred through the fault of the IPO.

Enforcement

47. What are the available enforcement methods in the Philippines?

- Civil enforcement
 Administrative enforcement
 Criminal enforcement
 Border measures
 Others: _____

48. What are the criteria for infringement?

- Literal infringement
 Infringement under the doctrine of equivalents
 Use of the patent without permission of patent owner
 Others: _____

49. Is there a statute of limitations for filing a suit for patent infringement?

- Yes No

If yes, what is the time period?

Three (3) years from the commission of the offense for criminal suits; Four (4) years for civil and administrative suits

50. What are the remedies available for an infringement action?

- Damages
- Injunction
- Destruction of the infringing goods
- Others:
Attorney's fees and other expenses of litigation

51. What are the actions taken by such authorities?

- Conduct a raid
- Seize the infringing goods
- Impose a fine
- Others:
Order the substitution of the patentee or, at the option of the true inventor, cancel the patent

52. Is there an authority or ministry responsible for the enforcement of patent rights?

- Yes No

If yes, please state:

Intellectual Property Office of the Philippines; Bureau of Trade Regulation and Consumer Protection of the Department of Trade and Industry; Bureau of Customs; the Judicial Courts

Peculiarities

53. Are there any peculiarities in the system of protection for patents in the Philippines of which it is important for clients to be aware?

There is a Philippine Plant Variety Act of 2002 which allows protected holders the right to authorize the production or reproduction, selling, marketing, or exporting plant varieties. There is also a law, Republic Act No. 9150, protecting lay-out designs, or topographies, of integrated circuits.

The Intellectual Property Office of the Philippines encourages parties to a patent infringement or similar suits to use the available alternative dispute resolution mechanisms offered.

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About The Firm

Rajah & Tann Singapore is a prominent full service law firm in Singapore and one of the largest in South East Asia. Over the years, our firm has been at the leading edge of law in Asia, having worked on many of the biggest and highest profile cases in the region. We have a vast pool of talented and well regarded lawyers dedicated to delivering the very highest standards of service across all the firm's practice areas.

Rajah & Tann Singapore has formed strategic alliances with leading local firms across South East Asia. This has led to the launch of Rajah & Tann Asia in 2014, a network of over 600 lawyers in ten countries in Asia with the reach and resources to deliver legal services to clients in China, Cambodia, Indonesia, Lao PDR, Malaysia, Myanmar, Philippines, Singapore, Thailand and Vietnam. Rajah & Tann Asia's geographical reach also includes Singapore-based regional desks focusing on Japan and South Asia. Individually, each firm in the network is fully qualified to advise and practise the laws of its respective jurisdiction. Collectively, the firms are able to provide integrated and seamless legal service in South East Asia and China. Further, as the Singapore member firm of the Lex Mundi network, Rajah & Tann Singapore is able to offer its clients access to global legal support in over 100 countries.



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Foreword

Singapore has one of ASEAN's strongest intellectual property ("IP") regimes. Since 2013, the Singapore government has been executing its IP Hub Master Plan, a ten-year road map for making the small island nation the preeminent locale for developing, registering and defending IP. In 2016, we were ranked fourth in the world and top in Asia for having the best IP protection by the World Economic Forum's Global Competitiveness Index.

Not only are our local IP laws constantly being updated to be in line with international best practices, Singapore has also acceded to various key international IP conventions, namely the Madrid Protocol, the Patent Cooperation Treaty, the WIPO Copyright Treaty, the Nice Agreement concerning the International Classification of Goods and Services, the Berne Convention for the Protection of Literary and Artistic Works, the TRIPS Agreement, to name a few. Further, Singapore's IP registration regime is known for its efficiency and user-friendliness. For example, a Trade Mark application in Singapore takes 6-8 months from filing to completion, which is around one third the amount of time needed for most other jurisdictions, while a Registered Design application takes only around 4 months from filing to completion. Additionally, the documents and information required for the applications are straightforward relative to other jurisdictions.

The continued success of Singapore's IP infrastructure is a reflection of the relentless efforts put in by key stakeholders to ensure that Singapore remains an attractive jurisdiction in which IP can be created, properly protected, and commercially exploited. Rajah and Tann Singapore LLP, Singapore's largest full-services legal firm boasting more than 300 lawyers, is consistently ranked among the leading IP practices in Singapore. Our dedicated team of IP lawyers combine cutting edge legal expertise with in-depth understanding of the industries in which our clients operate, to provide value-added and comprehensive services of the highest quality, in both contentious and non-contentious aspects of IP law.

Trademarks

Trademark Rights and Protection in Singapore

General

1. What is the system for trademark protection in Singapore?

- Registration Common law
 Co-existing rights under registration and common law

2. Does first to use or first to register have prior rights in Singapore?

- First to use First to register

3. Is Singapore a member of the Madrid Union and the Paris Convention?

- Madrid System Paris Convention

4. If Singapore is a member of Madrid Union is it a party to the Agreement or the Protocol and are there any peculiarities in relation to the implementation of the Madrid System for international registration in Singapore?

Madrid Protocol

Trade Mark Registration

A. Registration System

5. What are the benefits of registering a trade mark in Singapore?

- Prevails over common law rights
 It is the only form of protection available for trademarks
 Entitles the proprietor to bring an infringement action (for trademarks)
 Others: _____

6. Is it possible to obtain registration for the following types of marks under the registration system in Singapore?

a. Service marks

- Yes No
 Marks registered for services (and not goods) are registrable. However, they are referred as trade marks instead of service marks.

b. Defensive marks

- Yes No

c. Collective marks

- Yes No

If yes, what are the requirements?

A collective mark is a sign used, or intended to be used, in relation to goods or services dealt with or provided in the course of trade by members of an association to distinguish those goods or services from goods or services so dealt with or provided by persons who are not members of the association.

d. Certification marks

- Yes No

If yes, what are the requirements?

A certification mark is a sign used, or intended to be used, to distinguish goods or services:

- (a) dealt with or provided in the course of trade; and
- (b) certified by the proprietor of the certification mark in relation to origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics, from other goods or services dealt with or provided in the course of trade but not so certified.

e. Well-known marks

(i.e. registration of a mark as a well-known mark and not an ordinary trademark)

- Yes No

If yes, what are the requirements?

"well known trade mark" means

- (a) Any registered trade mark that is well known in Singapore; or
- (b) Any unregistered trade mark that is well known in Singapore and that belongs to a person who is a national of a Convention country; or is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country, whether or not that person carries on business, or has any goodwill, in Singapore.

In determining whether a trade mark is well known in Singapore, it shall be relevant to take into account any matter from which it may be inferred that the trade mark is well known, including such of the following matters as may be relevant (non-exhaustive):

- (a) The degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore;
- (b) The duration, extent and geographical area of:
- (i) Any use of the trade mark; or
- (ii) Any promotion of the trade mark, including any advertising of, any publicity given to, or any presentation at any fair or exhibition of, the goods or services to which the trade mark is applied;
- (c) Any registration or application for the registration of the trade mark in any country or territory in which the trade mark is used or recognised, and the duration of such registration or application;
- (d) Any successful enforcement of any right in the trade mark in any country or territory, and the extent to which the trade mark was recognised as well known by the competent authorities of that country or territory;
- (e) Any value associated with the trade mark.

Well known marks may be registered as a trade mark. However, well-known marks need not be registered to be protected.

f. Series marks

- Yes No

If yes, what are the requirements?

A number of trade marks which resemble each other as to their material particulars and which differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.

g. Marks in different language or characters other than Roman characters

- Yes No

If yes, what are the requirements?

For non-English words such as Chinese or Japanese characters, there is a requirement to provide translation/transliteration. For English or non-English invented words, there is a requirement to provide derivation of the mark (i.e. how the word was coined).

h. Non-traditional marks: Sound marks

- Yes No

If yes, what are the requirements?

You can represent it graphically using musical notation (i.e. staves divided into measures, showing clefs, musical notes, etc.). In the course of examination, further information may be required by the examiner, e.g. a recording of the sound.

i. Non-traditional marks: Smell marks

- Yes No

If yes, what are the requirements?

j. Non-traditional marks: Position marks

- Yes No

If yes, what are the requirements?

k. Non-traditional marks: Colour marks

(i.e. registration of a single colour or a combination of colours)

- Yes No

Where the trade mark consists solely of colour(s), a sample of the colour(s), in the form of a graphical representation, is required to be lodged with the application. In

addition, the Registrar recommends that the applicant includes on the application form, a designation from an internationally recognised identification code where the colour or shade exists in the coding system. There are a number of colour code identification systems in existence e.g. Pantone®, RAL and Focoltone®. It is not an exhaustive list and it is the choice of the applicant to decide which system to use.

I. Non-traditional marks: Shape or three-dimensional marks

- Yes No

Shape marks are registrable unless they consist exclusively of the shape which results from the nature of the goods themselves, the shape of goods which is necessary to obtain a technical result, or the shape which gives substantial value to the goods. (S7(3) of the Trade Marks Act)

A shape mark should be represented by a picture, or pictures, and words which describe the subject matter of the proposed registration as shown in the picture(s). A mere description of the shape would not be sufficiently precise to meet the graphical representation requirement.

m. Others: _____

7. Is it possible to claim a colour limitation?

- Yes No

When you register a mark in colour, you have to indicate that protection of the mark is limited to the colours shown in the representation of the application form.

8. What is the official name of the trademark office in Singapore?

Intellectual Property Office of Singapore

B. Trade Mark Filing

9. What are the documents and information required for filing a trade mark application in Singapore?

- Name and address of the applicant
 Representation of the trade mark

- Goods and services and the class(es) for which the trade mark is to be registered
 Certificate of Incorporation (if the applicant is a company)
 Statutory Declaration
 Power of Attorney
 Others:
 Translation and transliteration of the mark if it consists of a foreign word/ characters, derivation of the mark if it consists of a non-English word, country of incorporation of the applicant if applicant is a company.

10. Can a trade mark application be based on intent to use in Singapore?

- Yes No

If yes, please specify any conditions:

11. Is priority claim allowed in Singapore?

- Yes No

If yes, what are the requirements?

Both partial priority and multiple priority are available. Requirement to state the date of the earlier application in a Paris Convention country (must be within 6 months of Singapore application).

12. Are multi-class applications permitted in Singapore?

- Yes No

If yes, is there a maximum number of classes that can be applied for?

No maximum number of classes

13. Does Singapore adopt the Nice Classification for specification of goods and services?

- Yes No

If yes, please specify the edition:

11th Edition

14. Are there any specific requirements in relation to the classification of goods and services in Singapore?

- a. Must the specification of goods and services be limited to items from the list of goods and services under the Nice Classification only?

- Yes No

b. Can the class heading be included in the specification?

- Yes No Subject to conditions
Please specify:

Claims for class headings or parts of class headings are acceptable, save for "personal and social services rendered by others to meet the needs of individuals", which appears in the heading of Class 45. The item "personal and social services rendered by others to meet the needs of individuals", is deemed to be insufficiently clear and precise as it does not provide a clear indication of what services are covered. It simply states that it is a form of personal and social services and such services cover a wide range of activities performed by different service providers in different market sectors, and require varying levels of knowledge and skill sets. An objection under Rule 19(2)(b) (ii) of the Rules will be raised against such an item.

c. Are there sub-classes of goods and services applied by the trademark office in Singapore?

- Yes No

d. Others: _____

C. Trade Mark Examination

15. What marks, signs, representations, emblems or words are specifically prohibited from registration in Singapore?

- Signs contrary to morality or public order
- Signs of such a nature as to deceive the public
- Signs benefiting protection from other international convention (e.g. Red Cross, Olympic symbols)
- Signs protected by national laws (e.g. royal emblems)
- Others:
Sign the use of which is prohibited in Singapore by any written law or rule of law.

16. Is there substantive examination of trademarks?

- Yes No

If yes, what are the grounds?:

- Absolute grounds
- Relative grounds

Others: _____

17. Is substantive examination conducted before or after publication of a trademark for opposition by third parties?

- Before publication After publication

18. What are the absolute grounds for refusal?

- Mark consists of a non-invented word(s)
- Mark has direct reference to the character or quality of the goods or services
- Mark is not distinctive
- Mark consists of a geographical name
- Mark consists of a surname
- Mark consists of letters of the alphabet
- Mark consists of numerals
- Mark consists of geometric shapes
- Others:

Marks consisting exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services.

Marks which are shape marks, where the shape results from the nature of goods themselves, the shape is necessary to obtain a technical result, or the shape gives substantial value to the goods.

Marks which consist exclusively of sign or indications which have become customary in the current language or in the bona fide and established practices of the trade.

Mark is contrary to public policy or morality, or is of such a nature to deceive the public (e.g. as to the nature quality or geographical origin of the goods/ services.)

Marks the application of which is done in bad faith.

National emblems of Convention Countries, as well as certain international organisations (such as armorial bearings, flags or other emblems)

19. What are the relative grounds for refusal?

- There is a prior application for registration or registration for an identical or confusingly similar mark in relation to the same goods or services as the subject mark
- There is a prior application for registration or registration for an identical or confusingly similar mark in relation to similar goods or services (although in different class) as the subject mark
- Well known mark: There is a well known mark which is identical or so nearly resembling the subject mark for the same goods or services as the subject mark
- Well known mark: There is an earlier registered mark which is well known for different goods or services and use of the subject mark would indicate a connection between goods or services covered by the subject mark with the proprietor of the well known mark
- Others: _____

20. Is there a right of appeal?

- Yes No
If yes, please describe:

D. Publication and Opposition

21. Is there an opposition procedure upon publication?

- Yes No

22. How long is the opposition term once the trade mark application is published in Singapore?

[2] months

23. Is the opposition term extendible?

- Yes, usually for another 2 months
- No
- Others: _____

24. Who may initiate opposition proceedings?

- Any person
- Anyone with a legitimate interest
- Any competent authorities
- Others: _____

25. What are the usual grounds for opposition?

- Prior use of a mark which is identical or confusingly similar to the opposed mark
- Prior registration of a mark which is identical or confusingly similar to the opposed mark
- Bad faith in application for registration of the opposed mark
- Applicant is not the rightful proprietor of the opposed mark
- If the opposed mark is identical with or so nearly resembles the Opponent's mark which is well-known in Singapore for the same goods or services
- If the opposed mark is identical with or so nearly resembles the Opponent's mark which is well-known and registered in Singapore for goods or services not the same as those claimed in the opposed mark; provided that the use of the opposed mark in relation to the goods or services claimed would indicate a connection between those goods or services and the proprietor of the well-known mark, and the interests of the proprietor of the well-known mark are likely to be damaged by such use
- Opposed mark lacks distinctiveness
- Lack of intention to use the opposed mark
- Opposed mark consists of false geographical indication
- Use of opposed mark likely to cause confusion or deception
- Others:
The above are the usual grounds but not exhaustive of all the legal grounds for opposition.

E. Timeline**26. What is the time period from application to registration for a straightforward trademark application in Singapore?**

- Between 6 months - 12 months
 Between 12 months - 18 months
 18 months above

27. Is there any process for accelerated/expedited examination of trade mark applications?

- Yes No
If yes, what are the requirements?
-

Maintenance of Trademark Registration**A. Renewal****28. Is there a mechanism to renew a trade mark registration in Singapore?**

- Yes No
If yes, how long is the validity of the renewal?
 10 years

29. Is late renewal of a trade mark registration permissible in Singapore?

- Yes No
If yes, what are the conditions?

If renewal is late, the request for such renewal must in any event be made not later than 6 months after the date of expiry of the registration. Late fee payable, on top of renewal fee, if renewal request is made after the date of expiry.

30. Are there any provisions to restore a lapsed registration?

- Yes No
If yes, what are the conditions:

An application for the restoration of the mark which has been removed from the register shall be filed within 6 months from the date of the removal.

B. Use Requirement**31. Does evidence of use need to be submitted to the trademark office at any time in order to maintain an application for registration or a registration of a trademark in Singapore?**

- Yes No
If yes, what are the requirements?
-

C. Rectification/Cancellation**32. Are rectification or cancellation proceedings available in Singapore?**

- Yes No
If yes, what is the forum?
 The correct forum is the IPOS or the Court.

33. What are the grounds for rectification or cancellation proceedings?

- Any entry made in the Register without sufficient cause
 Any entry wrongfully remaining in the Register
 Non-use of the mark
 Others:
 Non-use is the only ground for "Revocation". "Cancellation" is different from "Revocation", and refers to the proprietor cancelling a registered trade mark in respect of some or all of the goods or services for which it is registered at any time.

As for marks that are wrongly entered or wrongly remaining, the applicable process is "Rectification or Correction". When an application is made for rectification or correction of the register, there is no consideration on whether the mark was distinctive.

34. When would a presumption of validity arise in relation to a trademark registration?

- [] years from date certificate of registration issued/date of application
 No such presumption

35. When are the grounds for rectification or cancellation proceedings assessed?

- At the time of filing of the application
 At the time of issuance of the certificate of registration
 At the time of the application for rectification or cancellation proceedings
 Others: _____

36. When is a trade mark registration vulnerable to cancellation on grounds of non-use?

- [] years from the deemed date of registration
 [5] years from the date of certificate issuance
 Not applicable
 Others: _____

37. Who bears the burden of proof in a non-use cancellation action?

- Applicant for cancellation
 Defendant / Respondent (trademark owner)

38. If the answer to the above is the Applicant, what are the examples of evidence which can be relied on to support an application for cancellation for non-use?

- Full market survey conducted by an independent or professional surveyor of an appropriate sample size
 Simple market survey or enquiries in the trade
 Declaration from the applicant for cancellation
 Others: _____

D. Assignment, Transmission and Licensing

39. Are there any mechanisms to record assignment of a trade mark in Singapore?

- Yes No
If yes, what are the requirements?
 File form CM8, copy of assignment agreement, information about assignee.

40. Are there different requirements for recording assignment with or without the goodwill of the business?

- Yes No
If yes, what are the requirements?

41. Are there any mechanisms to record transmission of a trade mark in Singapore, for example transmission by way of merger?

- Yes No
If yes, what are the requirements?

42. Are trade mark licensees required to record themselves with the Registrar?

- Mandatory Recommended No
If yes, what are the requirements?
 A copy of the license and related information. A license is ineffective as against a third party acquiring a conflicting interest in or under the registered trade mark if the third party is ignorant of the transaction. Therefore, the license should be recorded on the register. The licensor or licensee can be the one to record this on the Register.

E. Change of Particulars

43. Should any change in the name or address of the proprietor on record of a registered trademark be updated on the register?

- Yes No
If yes, what are the requirements?
 File Form CM2.

44. Is it possible to change the representation of a registered trade mark?

- Yes No
If yes, what are the requirements?

45. Is it possible to correct and rectify any errors on the Register?

- Yes No

If yes, what are the requirements?

Under Section 25, the applicant has to put in a written request to the Registrar for an amendment of the application/notice/document (as the case may be), on the basis that: (a) the correction of a clerical error or an obvious mistake or (b) the Registrar is of the opinion that it is fair and reasonable in all the circumstances of the case to do so.

is likely to damage the interests of the proprietor; or if the proprietor's trademark is well-known to the public at large in Singapore, the use by the 3rd party of the identical or similar mark would cause dilution in an unfair manner of the distinctive character of the proprietor's trade mark, or would take unfair advantage of the distinctive character of the proprietor's trade mark.

*Kindly note that the remedy awarded under this ground is an injunction.

If yes, what are the criteria:

Enforcement

46. What are the available enforcement methods in Singapore?

- Civil enforcement
- Infringement action
 - Passing off
- Criminal enforcement
- Border or other administrative enforcement measures

47. What are the requirements to bring an action for infringement of trademark?

- Valid registration of the trademark
- Unauthorised use by a 3rd party in the course of trade of a mark which is
- Identical to a registered trademark in relation to goods or services that are identical with those for which the earlier trade mark is registered or
 - Identical or similar to a registered trademark in relation to goods or services identical or similar to those for which the earlier trademark is registered, where there is a likelihood of confusion.
 - Identical to or similar to a well-known trademark, whether or not such a mark has been registered in Singapore*, either:
 - in relation to identical or similar goods or services, where the use is likely to cause confusion, or
 - in relation to any goods or services, where the use of the mark would indicate a connection between those goods or services and the proprietor of the earlier mark, and

48. For a trademark infringement action, is it necessary to establish

- Actual confusion?
- Likelihood of confusion?

49. For a trademark infringement action, is it necessary to establish damage or loss to the proprietor of the trademark?

- Yes No Others

If yes, what are the requirements?

50. Is there a period of limitation for filing a suit for trade mark infringement?

- Yes No

If yes, what is the time period?

6 years from the date from which the infringement occurred.

51. What are the remedies available for an infringement action?

- Damages or account of profits
- Injunction
- Delivery and/or destruction of the infringing goods
- Others:
Statutory damages

52. Is it possible to claim for ‘passing off’ in Singapore?

- Yes No

53. If yes, what are the criteria to establish ‘passing off’?

- That the proprietor has goodwill and reputation in the trademark

a. Must the goodwill and reputation subsist in Singapore i.e. goodwill and reputation outside Singapore will not be taken into consideration?

- Yes No

b. Must there be actual use or business presence in Singapore?

- Yes No

c. What is the usual form of evidence used to establish such goodwill and reputation?

Surveys, commercial details about the proprietor’s business (like market size, sales) etc.

- That there is misrepresentation caused to members of the public

a. Is it necessary to establish actual confusion or is likelihood of confusion sufficient?

- Actual confusion
 Likelihood of confusion

b. What is the usual form of evidence used to establish such misrepresentation?

Survey

- That there are damage/likelihood of damage

a. Is it necessary to establish actual damages or is likelihood of damage sufficient?

- Actual damage
 Likelihood of damage

b. What is the usual form of evidence used to establish such damage or likelihood of damage?

Loss of sales which can be shown by proprietor’s sales records.

- Others: _____

54. Are there other forms of actions or claims that can be brought by a trademark owner against an infringer or unauthorised user?

- Unfair competition Others: No

55. What are the elements that need to be established to bring the claim(s) above?

Not Applicable.

56. Can a trade mark owner lodge a complaint to any administrative authorities on counterfeit trade mark goods?

- Yes No

If yes, please state the authority:
Police, Director General of Customs.

57. What are the actions that can be taken by such authorities?

- Conduct a raid
 Seize the infringing goods
 Impose a fine
 Refer for criminal prosecution
 Others: _____

58. Are border measures available to restrict the importation of counterfeit trademark goods?

- Yes No

If yes, what are the measures?
Seizure of goods, and which may eventually either be retained or disposed of by the

Director General of Customs.

59. Do these border measures apply for counterfeit goods of unregistered trademarks?

- Yes No
 Not applicable, there are no rights for unregistered trademarks in Singapore

60. Is there an authority or ministry responsible for the enforcement of trademark rights?

- Yes No

If yes, please state:

Seizure and raids may be carried out by Immigration and Checkpoint Authority of Singapore or Intellectual Property Rights Branch of Criminal Investigation Department as the case may be.

Peculiarities

61. Are there any peculiarities not mentioned above in the system of protection for trademarks in Singapore of which it is important for clients to be aware?

None.

Patents

Patent Rights and Protection in Singapore

General

1. What is the system for patent protection?

- Examination system
 Non-examination system

2. Is Singapore a member of the Patent Cooperation Treaty (PCT)?

- Yes No

3. Is Singapore a member of the Paris Convention?

- Yes No

- Power of Attorney
 Deed of Assignment
 Others: Drawings

7. Is there a fee for extra claims?

- Yes No

If yes, please describe:

8. Does Singapore require obtaining a foreign filing license before filing a foreign patent application?

- Yes No

If yes, please describe:

A person resident in Singapore is required to obtain written authorisation from the Registrar of Patents for an invention, before he files or causes to be filed outside Singapore an application for a patent for that invention.

Patent Registration

A. Registration System

4. What kinds of patent protection are available?

- Inventions Utility models
 Others: _____

5. What kinds of subject matter are excluded from patent protection?

- Methods of medical treatment or diagnosis
 Computer programs
 Business methods
 Others:
 Invention that is generally expected to encourage offensive, immoral or anti-social behaviour will not be published or patented.

B. Patent Filing

6. What are the documents and information required for filing a patent application?

- Name and address of the applicant
 Name and address of the inventor
 Specification
 Abstract

B.1 Patent Specification

9. In which language must a patent specification be?

- English Other: _____

10. Is it possible to file an application first with an English specification, and then later submit its translation in the official language?

Not applicable

B.2 Publication, Amendment and Divisional Application

11. Is it possible to request a deferment of publication?

- Yes No

If yes, please describe:

12. Is it possible to request an early publication?

- Yes No

If yes, please describe:

File Form 9 and pay official fees of S\$50.00 to request for early publication.

13. Does the applicant have a provisional right upon the publication of an application?

- Yes No

If yes, please describe briefly:

After the patent is granted, the applicant is generally able to enforce the patent from the date of publication.

14. When is it possible to file a voluntary amendment to specification?

- At the time of entry into the national phase (for PCT application)
 At any time during prosecution
 At the time of requesting examination
 Other: _____

15. When is it possible to voluntarily file a divisional application?

- At any time during prosecution
 At the time of granting a patent
 Other: _____

16. Is it possible to file a divisional application based on a previous pending divisional application if the parent application has already been granted a patent?

- Yes No

C. Examination**17. Is there a requirement to submit certain information on corresponding applications, or prior art known to the applicant?**

- Yes No

If yes, please describe:

18. Is there a grace period (exception to novelty)?

- Yes No

If yes, please describe:

The disclosure of the invention shall be disregarded for the period of 12 months immediately preceding the date of filing in a number of limited circumstances. One example is if such disclosure was due to a breach of confidence.

19. Is it required to file a request for substantive examination?

- Yes No

If yes, what are the requirements?

There are currently 4 routes available and the deadlines vary between 13 to 54 months.

20. Can a third party file a request for substantive examination?

- Yes No

If yes, please describe:

There is a proposed new process for the submission of third party observations that has not been implemented.

21. Is there a right of appeal?

- Yes No

If yes, please describe:

If the registrar issues a Notice of Intention to Refuse, the applicant can request for an Examination Review 2 months from the Notice.

22. Are multiple dependent claims admissible?

- Yes No

D. Opposition**23. Is there an opposition procedure upon publication?**

- Yes No

If yes, please describe:

There is a proposed new process for the submission of third party observations that has not been implemented.

24. How long is the opposition term once the application is published?

- 2 months 3 months
 Prior to the grant Others: Not Applicable

25. Who may initiate opposition proceedings?

- Any person
 Anyone with a legitimate interest
 Any competent authorities
 Other: Not Applicable

E. Timeline**26. What is the time period from application to grant for a straightforward application?**

- Between 2 - 3 years
 Between 3 - 4 years
 Other: Between 2-4 years

27. Is there any process for accelerated examination of application?

- Yes No

If yes, what are the requirements?

Expedited examination is only available under the Global Patent Prosecution Highway (GPPH) if the patent in Singapore relies on applications made to offices under the GPPH. The requirements are:

- (a) The application filed in Singapore must be corresponding to the application relied upon sharing the same earliest date (whether priority date or filing date).
 (b) The examination results relied upon for acceleration must be one from the PPH/ GPPH partnering IP office.
 (c) All claims in the Singapore application have to sufficiently correspond to one or more claims found allowable / patentable by the partnering IP office.

Maintenance of Patent**A. Annuity****28. To maintain the validity of patent, is it required to pay an annuity in Singapore?**

- Yes No

29. Is late payment of annuity permissible?

- Yes No

If yes, what are the requirements?

If during the period of 6 months immediately following the end of the prescribed period the renewal fee and any prescribed additional fee are paid, the patent shall be treated for the purposes of this Act as if it had never expired.

30. Is government annuity fixed for each year?

- Yes No

If yes, what is the base for calculation of annuity? This is prescribed by the Intellectual Property Office of Singapore:

	<u>Renewal Fee</u>	<u>Fee (SGD)</u>
(a)	For each year of renewal in respect of the 5th, 6th or 7th year of the patent	70
(b)	For each year of renewal in respect of the 8th, 9th or 10th year of the patent	185
(c)	For each year of renewal in respect of the 11th, 12th or 13th year of the patent	260
(d)	For each year of renewal in respect of the 14th, 15th or 16th year of the patent	335
(e)	For each year of renewal in respect of the 17th, 18th or 19th year of the patent	410
(f)	For renewal of the 20th year of the patent	485
(g)	For each year of renewal after the 20th year of the patent	600

31. Can annuity be paid once for all years or once for several years?

- Yes No

32. Is power of attorney required for annuity payment?

- Yes No

33. Are there any provisions to restore a lapsed patent?

- Yes No

If yes, what are the requirements?

A patent can be restored within 30 months from the day the patent ceases to have effect on payment of a prescribed fee.

34. Is patent term extension available in Singapore?

- Yes No

If yes, what are the conditions?

Extensions are only allowed if one of the reasons below can be shown:

- (a) There was an unreasonable delay by the Registrar in granting the patent
- (b) There was an unreasonable delay caused by a foreign patent office in the issuance of the patent relating to a corresponding application and the foreign patent office has extended the term of the corresponding patent on the basis of such delay
- (c) There was unreasonable curtailment of the opportunity to exploit the patent caused by the process of obtaining marketing approval for a pharmaceutical product, being the first pharmaceutical product to obtain marketing approval which uses a substance (which is included as part of the patent) as an active ingredient; and the term of the patent has not previously been extended on this ground.

B. Compulsory Licence**35. Is a compulsory licence available in Singapore?**

- Yes No

If yes, what are the requirements?

An application may be made for a licence on the ground that such a grant is necessary to remedy an anti-competitive practice.

36. Can a request for termination of compulsory licence be filed?

- Yes No

If yes, what are the requirements?

Any compulsory licence granted may, on the application of any interested party, be terminated by the court where the court is satisfied that the ground upon which the licence was granted has ceased to exist and is unlikely to recur.

C. Use Requirement**37. Does the patentee need to submit evidence of obligation of use to the Patent Office in order to maintain a patent in Singapore?**

- Yes No

If yes, please describe:

38. Is a compulsory licence granted based on failing to perform an obligation to use?

- Yes No

If yes, please describe:

D. Cancellation**39. Are termination or cancellation proceedings available in Singapore?**

- Yes No

If yes, what are the grounds?

The Registrar has the power to revoke patents on the following grounds:

- (a) The invention is not a patentable invention.

- (b) The patent was granted to a person who was not entitled to be granted that patent.
- (c) The specification of the patent does not disclose the invention clearly and completely for it to be performed by a person skilled in the art.
- (d) The matter disclosed in the specification of the patent extends beyond that disclosed in the application for the patent, as filed.
- (e) An amendment or correction has been made to the specification of the patent or the application of the patent which should not have been allowed.
- (f) The patent was obtained fraudulently, on any misrepresentation, or on any non-disclosure of any prescribed material information, whether or not the person under a duty to provide the information knew or ought reasonably to have known of such information or the inaccuracy.,
- (g) The patent is one of 2 or more patents for the same invention having the same priority date and filed by the same party or his successor in title.

40. What is the time limit for termination or cancellation?

- 3 years 5 years
- Whole protection term of patent Other: _____

E. Assignment, Transmission and Licensing

41. Are there any mechanisms to record assignment of a patent in Singapore?

- Yes No
- If yes, the requirements:*
A copy of the assignment and information on the assignee.

42. Are there any mechanisms to record transmission of a patent in Singapore, for example, transmission by way of merger?

- Yes No
- If yes, what are the requirements?*

43. Are patent licensees required to record themselves with the Patent Office?

- Yes No

If yes, what are the requirements?

However, it is recommended that patent licensors or licensees record the licence with the Patent Office.

F. Change of Details

44. Are there any mechanisms to record change of name or address of the patent proprietor?

- Yes No

If yes, what are the requirements?

An electronic form will have to be submitted to record the change.

45. Is it possible to amend a granted patent?

- Yes No

If yes, what are the requirements?

No amendment of an application for a patent shall be allowed if it results in the application disclosing any matter extending beyond that disclosed in the application as filed. The registrar will also consider:

- (a) Whether relevant matters are sufficiently disclosed
- (b) Whether there was any unreasonable delay in seeking amendments
- (c) Whether the patentee has gained an unfair advantage obtained by delaying amendments which are known to be needed.

46. Is it possible to correct and rectify any errors on the patent?

- Yes No

If yes, what are the requirements?

The Registrar may, correct any error of translation or transcription, clerical error or mistake in any specification of a patent or application for a patent or any document filed in connection with a patent or such an application. The proprietor is required to submit Form CM4 detailing the correction. If the request for correction relates to a specification, the page number and the document of the replacement text/figure and the text/figure to be replaced. The proprietor

will also have to explain why the correction sought is obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction.

Enforcement

47. What are the available enforcement methods in Singapore?

- Civil enforcement
- Administrative enforcement
- Criminal enforcement
- Border measures
- Others: _____

48. What are the criteria for infringement?

- Literal infringement
- Infringement under the doctrine of equivalents
- Use of the patent without permission of patent owner
- Others:

A person infringes a patent for an invention if, but only if, while the patent is in force, he does the following without the consent of the proprietor of the patent:

 - (a) Where the invention is a product, he makes, disposes of, offers to dispose of, uses or imports the product or keeps it whether for disposal or otherwise;
 - (b) Where the invention is a process, he uses the process or he offers it for use in Singapore when he knows, or it is obvious to a reasonable person in the circumstances, that its use without the consent of the proprietor would be an infringement of the patent;
 - (c) Where the invention is a process, he disposes of, offers to dispose of, uses or imports any product obtained directly by means of that process or keeps any such product whether for disposal or otherwise.

49. Is there a statute of limitations for filing a suit for patent infringement?

- Yes
- No

If yes, what is the time period?

6 years from the date on which the cause of action accrued.

50. What are the remedies available for an infringement action?

- Damages
- Injunction
- Destruction of the infringing goods
- Others:
 - (a) Order to deliver up;
 - (b) Account of profits obtained by the infringer from the infringement;
 - (c) Declaration that the patent is valid and has been infringed.

51. What are the actions taken by such authorities?

- Conduct a raid
- Seize the infringing goods
- Impose a fine
- Others: _____

52. Is there an authority or ministry responsible for the enforcement of patent rights?

- Yes
- No

If yes, please state:

Seizure and raids may be carried out by Immigration and Checkpoint Authority of Singapore or Intellectual Property Rights Branch of Criminal Investigation Department as the case may be.

Peculiarities

53. Are there any peculiarities in the system of protection for patents in Singapore of which it is important for clients to be aware?

None.

Thailand

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Foreword

Thailand's intellectual property regime has undergone significant development over the years, with an active intellectual property market driven by both domestic and international companies and the law firms that represent them. Thailand's legislative framework supports the full range of intellectual property work, from registration and enforcement, to commercialisation, to litigation.

Trademarks and patents in Thailand are legally protected by a system of registration, while copyright protection is automatically granted for eligible work. The Department of Intellectual Property, Ministry of Commerce, is the main government agency responsible for the protection and enforcement of intellectual property rights, while a specialized court, the Central Intellectual Property and International Trade (IP&IT) Court, adjudicates intellectual property disputes that may arise.

As Thailand becomes increasingly focused on cross-border investments, utilizing new technologies and innovation to boost economic growth, and developing key industries, both the Thai government and the private sector have recognised the need to update the country's intellectual property regime to meet emerging opportunities and challenges.

In addition to occasional amendments to the Trademark Act, the Patent Act, and other primary legislation, ministerial regulations are regularly introduced to provide important updates to the country's intellectual property regime.

Internal improvements are also being driven within relevant government agencies, with a notable example being the Department of Intellectual Property's efforts to boost its Patent Office manpower in 2016 and 2017, in order to resolve the issue of long periods of pendency for patent registration in the country.

Thailand has also put substantial efforts into harmonization of its intellectual property systems with international practices, and has become a party to several important treaties over the years, including the World Trade Organization Agreement on Trade-Related Aspects of Intellectual Property Rights, the WIPO Paris Convention for the Protection of Industrial Property, the Patent Cooperation Treaty and most recently, the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol).

In summary, trademark and patent protection is in a fairly well developed state in Thailand, and enjoy continual and strong support by the Thai government, whether through amended or new legislation, improvements to relevant government agencies, or active participation in regional and international treaties and agreements.

Trademarks

Trademark Rights and Protection in Thailand

General

1. What is the system for trademark protection in Thailand?

- Registration Common law
 Co-existing rights under registration and common law

2. Does first to use or first to register have prior rights in Thailand?

- First to use First to register

3. Is Thailand a member of the Madrid Union and the Paris Convention?

- Madrid System Paris Convention

4. If Thailand is a member of Madrid Union is it a party to the Agreement or the Protocol and are there any peculiarities in relation to the implementation of the Madrid System for international registration in Thailand?

Thailand is a party to the Madrid Protocol. When Thailand acceded to the Madrid Protocol on November 7, 2017, it made declarations under Articles 5(2)(b) and (c) of the Protocol (extension of the refusal period to 18 months and beyond (for oppositions)), Article 8(7)(a) (individual fees) and Rule 20bis(6) (b) of the Common Regulations (recording of licenses in the International Register has no effect in Thailand).

Trade Mark Registration

A. Registration System

5. What are the benefits of registering a trade mark in Thailand?

- Prevails over common law rights
 It is the only form of protection available for trademarks

- Entitles the proprietor to bring an infringement action

Others: _____

6. Is it possible to obtain registration for the following types of marks under the registration system in Thailand?

a. Service marks

- Yes No

b. Defensive marks

- Yes No

If yes, what are the requirements?

There are no special requirements for registering a defensive mark. A defensive mark can be registered in Thailand under the normal registration procedures. However, a defensive mark could be cancelled based on non-use if it can be proved that at the time of registration, the trademark owner had no bona fide intention to use the trademark with the goods/services for which it was registered, and in fact there was no bona fide use of the trademark with such goods/services, or there was no bona fide use of the trademark with the goods/services for which it was registered during the period of three years prior to the request for cancellation.

c. Collective marks

- Yes No

If yes, what are the requirements?

The requirements for filing a collective mark are:

- Notarised Power of Attorney, including a list of members who will use the collective mark;
- Name and address of the applicant;
- List of members and their addresses, and notarised documents verifying the relationship between the applicant and the members;
- Regulations of the use of collective mark (notarization is required);
- Evidence of use of the collective mark,

namely, documents demonstrating the use of the collective mark worldwide such as photos of packaging, details of the export of the products, labels and product packaging samples used in the origin country and in other countries by the members (notarization is required).

d. Certification marks

- Yes No

If yes, what are the requirements?

The requirements for filing a certification mark are:

- (a) Submit a copy of the regulations on the use of the certification mark together with the application for registration; and
- (b) Demonstrate that the applicant is well qualified to certify the merits of the goods or services according to the regulations stated in (a). The regulations mentioned in (a) must specify the origin, composition, manufacturing process, quality and other characteristics of the goods or services to be certified, including the rules, procedures and conditions imposed on the granting of a license to use the certification mark.

e. Well-known marks

(i.e. registration of a mark as a well-known mark and not an ordinary trademark)

- Yes No

If yes, what are the requirements?

Unfortunately, the recordation system for well-known marks in Thailand has been cancelled.

f. Series marks

- Yes No

If yes, what are the requirements?

g. Marks in different language or characters other than Roman characters

- Yes No

If yes, what are the requirements?

Marks may be filed in any languages or characters. An application for a mark in a language other than the Thai language or in characters other than Thai characters must

include a translation and pronunciation of the mark. Nonetheless, the Registrar may check the translation and pronunciation by himself/herself and make his/her own determination regarding the same.

h. Non-traditional marks: Sound marks

- Yes No

If yes, what are the requirements?

According to the Ministerial Regulations, if the applied-for mark is a sound or contains a sound, the applicant shall provide a clear description of that sound and submit a clear recording of the sound that is being applied for. The applicant may also provide musical notations, sonograms, or other materials that represent the features of such trademark.

i. Non-traditional marks: Smell marks

- Yes No

If yes, what are the requirements?

j. Non-traditional marks: Position marks

- Yes No

If yes, what are the requirements?

k. Non-traditional marks: Colour marks

(i.e. registration of a single colour or a combination of colours)

- Yes No

If yes, what are the requirements?

There are no specific requirements, but a combination of colours needs to be presented in a special manner so that it is considered to be distinctive. In view of this, a single colour is unlikely to be registrable under the current practice.

l. Non-traditional marks: Shape or three-dimensional marks

- Yes No

If yes, what are the requirements?

The 3D mark must show a configuration of an object expressing width, length, depth, and perspective views and the mark must be clearly different from other kinds of marks.

m. Others: _____

7. Is it possible to claim a colour limitation?

- Yes No

If yes, what are the requirements?

The Trademark Act states that a trademark registered without a limitation of color shall be deemed to be registered for all colors.

Under the current practice, the Trademark Office deems a mark that is filed in colour to be indicative of a colour limitation.

8. What is the official name of the trademark office in Thailand?

The Trademark Office, under the regulation of the Department of Intellectual Property, Ministry of Commerce.

B. Trade Mark Filing

9. What are the documents and information required for filing a trade mark application in Thailand?

- Name and address of the applicant
 Representation of the trade mark
 Goods and services and the class(es) for which the trade mark is to be registered
 Certificate of Incorporation (if the applicant is a company)
 Statutory Declaration
 Power of Attorney
 Others:

Foreign applicants are not required to submit a Certificate of Incorporation, while Thai companies must submit such Certificate. If used, a Power of Attorney needs to be notarised by a Notary Public. Legalization is not required.

10. Can a trade mark application be based on intent to use in Thailand?

- Yes No

If yes, please specify any conditions:

The applicant is not required to specify whether the mark is in use or is intended to be used.

11. Is priority claim allowed in Thailand?

- Yes No

If yes, what are the requirements?

The following documents are required:

- (a) A certified copy of the priority trademark application. The copy must be certified by a person with the authority to approve trade-mark registrations in the priority country.
 (b) A statement certifying that the priority application has neither been rejected by the Registrar nor withdrawn or abandoned by the applicant.

Both partial priority and multiple priority claims are allowed.

12. Are multi-class applications permitted in Thailand?

- Yes No

If yes, is there a maximum number of classes that can be applied for?

There is no maximum number of classes prescribed for each application.

13. Does Thailand adopt the Nice Classification for specification of goods and services?

- Yes No

If yes, please specify the edition:

The Trademark Office has adopted the 11th edition of the Nice Classification. However, the Trademark Registrar can use his/her own discretion in determining the acceptability of descriptions of goods and services.

14. Are there any specific requirements in relation to the classification of goods and services in Thailand?

a. Must the specification of goods and services be limited to items from the list of goods and services under the Nice Classification only?

- Yes No

b. Can the class heading be included in the specification?

- Yes No Subject to conditions

Please specify:

The Trademark Office has generated its own list of acceptable descriptions of goods/services adopted from the Nice Classification together with the Trademark Registrars' determinations. Normally, the descriptions in the class headings are too broad for registration in Thailand, but if the descriptions are in the above list, they will be accepted.

c. Are there sub-classes of goods and services applied by the trademark office in Thailand?

- Yes No

If yes, please elaborate:

d. Others:

C. Trade Mark Examination**15. What marks, signs, representations, emblems or words are specifically prohibited from registration in Thailand?**

- Signs contrary to morality or public order
- Signs of such a nature as to deceive the public
- Signs benefiting protection from other international convention (e.g. Red Cross, Olympic symbols)
- Signs protected by national laws (e.g. royal emblems)
- Others:
 - (a) State arms or crests, royal seals, official seals, Chakkri emblems, emblems and insignia of the royal orders and decorations, seals of office, seals of ministries, bureaus, departments or provinces
 - (b) National flags of Thailand, royal standard flags or official flags
 - (c) Royal names, royal monograms, abbreviations of royal names or royal monograms
 - (d) Representations of the King, Queen or Heir to the Throne

- (e) Names, words, terms or emblems signifying the King, Queen or Heir to the Throne or members of the royal family
- (f) National emblems and flags of foreign states, emblems and flags of international organizations, emblems of head of foreign states, official emblems and quality control and certification of foreign states or international organizations, names and monograms of foreign states or international organizations, unless permission is given by the competent officer of the foreign state or international organization
- (g) Official emblems and emblems of the Red Cross or appellations "Red Cross" or "Geneva Cross"
- (h) A mark identical with or similar to a medal, diploma or certificate or any other mark awarded at a trade exhibition or competition held by the Thai government or a Thai government agency for public enterprise, or any other government organ of Thailand, or a foreign government or international organization unless such medal, diploma, certificate or mark has been actually awarded to the applicant for goods and is used in combination with the trademark
 - (i) Any mark, which is contrary to public order, morality or public policy
 - (j) A mark registered or not, which is identical with a well-known mark as prescribed by the Ministerial Notifications, or so similar thereto that the public might be confused as to the owner or origin of the goods
 - (k) Geographical indications protected under the law on geographical indications
 - (l) Other trademarks prescribed by the Ministerial Notifications (e.g. marks that are identical or similar to International Nonproprietary Name (INN), or marks or descriptive phrases that may mislead the public as to the type of goods or services or origin or ownership of the goods or services).

16. Is there substantive examination of trademarks?

- Yes No

If yes, what are the grounds?

- Absolute grounds
- Relative grounds

- Others: _____

For marks consisting of a group of letters and numerals, the letters and numerals must be sufficiently stylized in order to be registrable.

For marks consisting of geometric shapes, the shapes must not consist of characteristics of the goods, must not be the figures or shapes necessary for the technical operation of the goods, and must not add value to the goods.

17. Is substantive examination conducted before or after publication of a trademark for opposition by third parties?

- Before publication After publication

18. What are the absolute grounds for refusal?

- Mark consists of a non-invented word(s)
- Mark has direct reference to the character or quality of the goods or services
- Mark is not distinctive
- Mark consists of a geographical name
- Mark consists of a surname
- Mark consists of letters of the alphabet
- Mark consists of numerals
- Mark consists of geometric shapes
- Others:

For a mark consisting of a surname, said surname must not be an ordinary signification. If it is an ordinary signification the mark must be sufficiently stylized in order to be registrable. Currently, the Trademark Office interprets this to be the surnames of famous persons, such as surnames of leaders or persons who created reputation or benefits in scientific, literary or other fields in Thailand, surnames of leaders in the past and present for which Thailand has an ambassadorial relationship, surnames of religious leaders, surnames of historically important persons in Thailand and abroad in each field, and surnames of the persons who received well-known local and international awards, such as the Nobel Prize.

19. What are the relative grounds for refusal?

- There is a prior application for registration or registration for an identical or confusingly similar mark in relation to the same goods or services as the subject mark
- There is a prior application for registration or registration for an identical or confusingly similar mark in relation to similar goods or services (although in different class) as the subject mark
- Well known mark: There is a well known mark which is identical or so nearly resembling the subject mark for the same goods or services as the subject mark
- Well known mark: There is an earlier registered mark which is well known for different goods or services and use of the subject mark would indicate a connection between goods or services covered by the subject mark with the proprietor of the well known mark
- Others: _____

20. Is there a right of appeal?

- Yes No

If yes, please describe:

The applicant of a rejected mark has the right to appeal the Registrar's refusal with the Board of Trademarks by filing an appeal petition arguing against the grounds of rejection along with evidence in support of said arguments. The appeal petition shall be filed within 60 days of receipt of the Registrar's refusal. No extension of time is permitted.

If the applicant does not agree with the Board's decision, it will have the right to bring a civil case to the Intellectual Property and International Trade Court (IP&IT Court) in an attempt to overcome the Board's decision within 90 days of receipt of the decision. The deadline is not extendable.

The judgment of the IP&IT Court can be appealed further to the Court of Appeal for Specialized Cases within 30 days from the reading of the judgement. The deadline is not extendable.

In civil cases, judgments of the Specialized Appeal Court will be deemed final. However, any party who disagrees with a judgment may ask the Supreme Court for permission to appeal the decision further within 30 days from the reading of the judgement. The Supreme Court may grant permission if it finds that there is an issue(s) in the appeal that sets out a significant matter worthy of clarification.

D. Publication and Opposition

21. Is there an opposition procedure upon publication?

Yes No

22. How long is the opposition term once the trade mark application is published in Thailand?

[2] months

23. Is the opposition term extendible?

Yes No Others: _____

24. Who may initiate opposition proceedings?

Any person
 Anyone with a legitimate interest
 Any competent authorities
 Others: _____

25. What are the usual grounds for opposition?

- Prior use of a mark which is identical or confusingly similar to the opposed mark
- Prior registration of a mark which is identical or confusingly similar to the opposed mark
- Bad faith in application for registration of the opposed mark
- Applicant is not the rightful proprietor of the opposed mark
- If the opposed mark is identical with or so nearly resembles the Opponent's mark which is well-known in Thailand for the same goods or services
- If the opposed mark is identical with or so nearly resembles the Opponent's mark which is well-known and registered in Thailand for goods or services not the same as those claimed in the opposed mark; provided that the use of the opposed mark in relation to the goods or services claimed would indicate a connection between those goods or services and the proprietor of the well-known mark, and the interests of the proprietor of the well-known mark are likely to be damaged by such use
- Opposed mark lacks distinctiveness
- Lack of intention to use the opposed mark
- Opposed mark consists of false geographical indication
- Use of opposed mark likely to cause confusion or deception
- Others: _____

E. Timeline

26. What is the time period from application to registration for a straightforward trademark application in Thailand?

- Between 6 months - 12 months
- Between 12 months - 18 months
- 18 months above

27. Is there any process for accelerated/expedited examination of trade mark applications?

Yes No
If yes, what are the requirements?

Maintenance of Trademark Registration

A. Renewal

28. Is there a mechanism to renew a trade mark registration in Thailand?

- Yes No

If yes, how long is the validity of the renewal?

10 years from the date of expiration of the original registration, or from the date of the last renewal of registration.

29. Is late renewal of a trade mark registration permissible in Thailand?

- Yes No

If yes, what are the conditions?

The applicant may renew its trademark registration within a grace period of six months from the expiry date with a 20% surcharge on the government fee.

30. Are there any provisions to restore a lapsed registration?

- Yes No

If yes, what are the conditions?

B. Use Requirement

31. Does evidence of use need to be submitted to the trademark office at any time in order to maintain an application for registration or a registration of a trademark in Thailand?

- Yes No

If yes, what are the requirements?

C. Rectification/Cancellation

32. Are rectification or cancellation proceedings available in Thailand?

- Yes No

If yes, what is the forum?

A mark that was wrongly entered in the Register by a third party can be rectified (i.e. cancelled) by filing a cancellation petition

based on one or more of the grounds described in the response to Question No. 33. Cancellation proceedings can be filed with the prescribed authorities (the Board of Trademarks or the IP&IT Court), depending on the grounds of the cancellation petition.

33. What are the grounds for rectification or cancellation proceedings?

- Any entry made in the Register without sufficient cause
- Any entry wrongfully remaining in the Register
- Non-use of the mark
- Others:
- An interested person or the Registrar may petition the Board to order the cancellation of any trademark if it appears that at the time of registration the trademark:
- Was not distinctive
 - Contained or consisted of a prohibitory characteristic under the Thai Trademark Act;
 - Was identical with a trademark registered by another person for goods of the same class or of different class with the same character;
 - Was so similar to a trademark registered by another person that the public might be confused or misled as to the owner or origin of the goods for goods of the same class or of different class with the same character.

Any person who is of the opinion that any trademark is contrary to public order or good morality or to public policy may petition the Board to cancel the trademark registration.

Any interested person or the Registrar may petition the court to cancel a registered trademark by showing that, at the time of filing the legal action the trademark had become common to the trade for certain kinds or classes of goods to the extent that to the trade or in the public eye the trademark had lost its meaning as a trademark.

Within five years from the date of the Registrar's order to register a trademark, any interested person may petition the

court to cancel a trademark registration by showing that he has better rights in the trademark than the person registered as its owner.

If the petitioner can prove that he has better rights for only some of the goods of the class in which the mark has been registered, the court shall restrict the registration to the goods that the petitioner cannot prove that he has better rights than the trademark owner.

34. When would a presumption of validity arise in relation to a trademark registration?

- [] years from date certificate of registration issued/date of application
 No such presumption

35. When are the grounds for rectification or cancellation proceedings assessed?

- At the time of filing of the application
 At the time of issuance of the certificate of registration
 At the time of the application for rectification or cancellation proceedings
 Others: _____

36. When is a trade mark registration vulnerable to cancellation on grounds of non-use?

- [] years from the deemed date of registration
 [] years from the date of certificate issuance
 Others:
 Any interested person or the Registrar may petition the Board to cancel a trademark registration if it is proved at the time of registration or during the three years prior to the petition for cancellation that there was no bona fide use of the trademark for the goods for which it was registered.
 Not applicable

37. Who bears the burden of proof in a non-use cancellation action?

- Applicant for cancellation
 Defendant / Respondent (trademark owner)

38. If the answer to the above is the Applicant, what are the examples of evidence which can be relied on to support an application for cancellation for non-use?

- Full market survey conducted by an independent or professional surveyor of an appropriate sample size
 Simple market survey or enquiries in the trade
 Declaration from the applicant for cancellation
 Others:
 There are no specific guidelines for the examples of evidence that can be relied on to support a non-use cancellation. A full market survey is generally recommended and it should be submitted along with any other available evidence showing the non-use of the mark. One example of evidence that can be submitted is a letter from a government office showing that there has not been any recordation and/or registration of products that are subject to regulatory approval.

D. Assignment, Transmission and Licensing

39. Are there any mechanisms to record assignment of a trade mark in Thailand?

- Yes No

If yes, what are the requirements?

The required documents are as follows:

- (a) An original signed and notarised Deed of Assignment by the Assignor and the Assignee. The signatures of the Assignor and the Assignee must be notarised by a Notary Public in the respective country. Legalization is not required.
 (b) The Deed of Assignment with a nominal monetary consideration of USD 10 per trademark, executed by both the Assignor and the Assignee is acceptable. However, the amount of consideration is not necessary.

- (c) An original signed and notarised Power of Attorney in the name of the Assignor. The signature of the Assignor's representative must be notarised by a Notary Public in the respective country. Legalization is not required.
- (d) An original signed and notarised Power of Attorney in the name of the Assignee. The signature of the Assignee's representative must be notarised by a Notary Public in the respective country. Legalization is not required.
- (e) The most recent original Certificate of Trademark Registration. If the original Certificate of Trademark Registration cannot be located, it is possible to obtain a replacement Certificate from the Trademark Office.

40. Are there different requirements for recording assignment with or without the goodwill of the business?

- Yes No
If yes, what are the requirements?

41. Are there any mechanisms to record transmission of a trade mark in Thailand, for example transmission by way of merger?

- Yes No
If yes, what are the requirements?

The required documents for Recordal of Merger are as follows:

- (a) An original signed and notarised Power of Attorney in the name of the new owner's name. The signature of their representative must be notarised by a Notary Public in the respective country (a Notary Public in a third party country is not acceptable.) Legalization is not required.
- (b) An original signed and notarised Power of Attorney in the name of the registered owner's name. The signature of their representative must be notarised by a Notary Public in the respective country (a Notary Public in a third party country is not acceptable.) Legalization is not required.
- (c) Original Certificate of Merger, as issued by the responsible governmental authority in the applicant's country, such as the

Commercial Registrar, or the Chamber of Commerce. A copy of such certificate is also acceptable, but it must be certified as a true copy by a Notary Public in the respective country. Legalization is not required. If the Certificate of Merger is not in English, we will also require an English translation. The English translation does not need to be notarised.

- (d) The most recent original Certificate of Trademark Registration. If the original Certificate of Trademark Registration cannot be located, it is possible to obtain a replacement Certificate from the Trademark Office.

NOTE: A Declaration is not acceptable.

42. Are trade mark licensees required to record themselves with the Registrar?

- Mandatory Recommended No
If yes, what are the requirements?

The documents required to file an application for registration of a license agreement are as follows:

- (a) Original notarised license agreement executed by the authorised directors of the licensor and licensee; and
- (b) Certificates evidencing registration of the marks.

A license agreement must contain, at the very least, the following particulars:

- (a) The terms and conditions of the agreement between the owner of the registered mark and the authorised licensee, under which conditions the former must actually be able to control the quality of the goods manufactured or services rendered by the latter;
- (b) Details of the licensed marks, i.e. their current application/ registration numbers and classifications;
- (c) The goods or services for which the licensed marks are used;
- (d) Whether the authorised licensee has the exclusive right to use the mark or whether the owner of the mark can license other parties to use the mark; and
- (e) Other particulars, e.g., specific terms, duration of the agreement, etc.

E. Change of Particulars

43. Should any change in the name or address of the proprietor on record of a registered trademark be updated on the register?

- Yes No

If yes, what are the requirements?

The documents required for a Change of Name and Change of Address are as follows:

- (a) An original signed and notarised Power of Attorney in the name of the new owner's name. The signature of their representative must be notarised by a Notary Public in the respective country (a Notary Public in a third party country is not acceptable.) Legalization is not required.
- (b) Original Certificate of Change of Name, as issued by the responsible governmental authority in the applicant's country, such as the Commercial Registrar, or the Chamber of Commerce. A copy of such certificate is also acceptable, but it must be certified as a true copy by a Notary Public in the respective country. Legalization is not required. If the Certificate of Change of Name is not in English, an English translation is required. The English translation does not need to be notarised.

NOTE: A Declaration is not acceptable.

Document required for a Change of Address alone:

- (a) An original signed and notarised Power of Attorney in the name of the applicant including their new address. The signature of their representative must be notarised by a Notary Public in the respective country. Legalization is not required.

44. Is it possible to change the representation of a registered trademark?

- Yes No

If yes, what are the requirements?

45. Is it possible to correct and rectify any errors on the Register?

- Yes No

If yes, what are the requirements?

The owner of a registered trademark may request the Registrar to amend any of the following particulars of registration:

- (a) The specification of goods/services by way of canceling some items;
- (b) The name, nationality, address and occupation of the owner of the trademark and his agent, if any;
- (c) The office or address for communication by the Registrar; and
- (d) Other particulars as may be prescribed in the Ministerial Regulations (cancelling of local representative, or change of nationality, address or occupation of the licensee.

The required documents for the above amendments include applications for such amendment and the documents showing such change.

Enforcement

46. What are the available enforcement methods in Thailand?

- Civil enforcement
- ⊙ Infringement action
 - ⊙ Passing off
- Criminal enforcement
- Border or other administrative enforcement measures

Trademark owners have the option of pursuing civil litigation and/or criminal action when taking action against trademark infringement. Trademark owners may also employ border control measures as a pre-emptive action to seize infringing goods crossing the borders of Thailand. In addition to these formal actions, trademark owners may also choose informal action such as sending cease-and-desist letters to infringers and trying to negotiate with them.

47. What are the requirements to bring an action for infringement of trademark?

- Valid registration of the trademark
- Unauthorised use by a 3rd party in the course of trade of a mark which is
 - identical to the registered trademark
 - so nearly resembling the registered mark as is likely to cause confusion
 - in relation to the goods or services for which the proprietor's mark is registered
 - in relation to goods or services which are similar to the goods or services for which the proprietor's mark is registered though not the same

If yes, what are the criteria?

If the trademark owner has registered his/her trademark with certain products in Thailand, the trademark owner can bring action for infringement of a trademark against a third party who uses a mark in the course of their trade which is identical to the registered trademark or an imitation of the registered trademark in relation to the goods or services for which the proprietor's mark is registered. Even if the trademark is not registered with the infringing goods, the trademark owner can still take action against such infringement by relying on the Penal Code of Thailand.

48. For a trademark infringement action, is it necessary to establish

- Actual confusion?
- Likelihood of confusion?

49. For a trademark infringement action, is it necessary to establish damage or loss to the proprietor of the trademark?

- Yes
- No
- Others

If yes, what are the requirements?

For a civil suit claiming trademark infringement, the trademark owner would have to prove the actual loss and/or actual damages to the court.

50. Is there a period of limitation for filing a suit for trade mark infringement?

- Yes
- No

If yes, what is the time period?

For a civil suit, the claim for damages arising from a wrongful act is barred by the prescription after one year from the day when the wrongful act and the person bound to make compensation became known to the injured person, or 10 years from the day when the wrongful act was committed.

For a criminal suit, the period of limitation will depend on the penalties of each offences. The trademark owner would have to file a criminal suit within 10 years from the date of the commission of the offence of forgery or imitation of trademarks.

51. What are the remedies available for an infringement action?

- Damages or account of profits
- Injunction
- Delivery and/or destruction of the infringing goods
- Others:
 - (a) Public apology
 - (b) Lawyer's fees (for civil cases)
 - (c) Removal of a domain name
 - (d) Withdrawal of a trademark registration
 - (e) Fines and imprisonment (for criminal cases)

52. Is it possible to claim for 'passing off' in Thailand?

- Yes
- No

'Passing off' in Thailand can be claimed based on Section 46 paragraph 2 of the Trademark Act and Section 420 of the Civil and Commercial Code.

53. If yes, what are the criteria to establish 'passing off'?

- That the proprietor has goodwill and reputation in the trademark

a. Must the goodwill and reputation subsist in Thailand i.e. goodwill and reputation outside Thailand will not be taken into consideration?

- Yes No

b. Must there be actual use or business presence in Thailand?

- Yes No

c. What is the usual form of evidence used to establish such goodwill and reputation?

The evidence of use in Thailand and other countries, such as the actual use of the trademarks on the products or for services, history of the marks, advertisement, marketing materials, sales figures, importation documents, etc.

- That there is misrepresentation caused to members of the public

a. Is it necessary to establish actual confusion or is likelihood of confusion sufficient?

- Actual confusion
 Likelihood of confusion

b. What is the usual form of evidence used to establish such misrepresentation?

Comparison of the two trademarks similarity, consumers' statements and perceptions, surrounding evidences of use, third-party consumer surveys, etc.

- That there are damage/likelihood of damage

a. Is it necessary to establish actual damages or is likelihood of damage sufficient?

- Actual damage
 Likelihood of damage

b. What is the usual form of evidence used to establish such damage or likelihood of damage?

Sales figures, comparison of the sale figures before and after the infringing marks are available in the country, etc.

- Others: _____

54. Are there other forms of actions or claims that can be brought by a trademark owner against an infringer or unauthorised user?

- Unfair competition Others:
There is no unfair competition law in Thailand. However, the trademark owner of a foreign registered trademark can take criminal actions against the goods bearing such marks according to the Thai Penal Code.

55. What are the elements that need to be established to bring the claim(s) above?

The brand owner would have to provide the certificate of foreign registered trademarks and submit them to the enforcement authorities. The brand owner would also have to consult with the enforcement officers first to learn whether they would accept the case.

56. Can a trade mark owner lodge a complaint to any administrative authorities on counterfeit trade mark goods?

- Yes No

If yes, please state the authority:

57. What are the actions that can be taken by such authorities?

- Conduct a raid
 Seize the infringing goods
 Impose a fine
 Refer for criminal prosecution
 Others: Not applicable

58. Are border measures available to restrict the importation of counterfeit trademark goods?

- Yes No

If yes, what are the measures?

Ex-officio actions are available. Customs officers would monitor and inspect the incoming and outgoing goods at the border. If suspected counterfeit goods at the border, they would contact the brand owner or legal representative to confirm whether the seized goods found are counterfeit. If the goods are confirmed to be counterfeit, the case will be forwarded for the consideration of the legal department of the Customs Department. Once the case is finalized, the seized goods will be later destroyed and a fine and/or imprisonment will be imposed on the importer/exporter.

59. Do these border measures apply for counterfeit goods of unregistered trademarks?

- Yes No
 Not applicable, there are no rights for unregistered trademarks in Thailand

But those trademarks would have to be registered in other countries and are included in the list sent to the Customs Department by the Trademark Registrar, according to the Notification of the Ministry of Commerce Governing Exportation and Importation of Goods B.E. 2530 (1987).

60. Is there an authority or ministry responsible for the enforcement of trademark rights?

- Yes No

If yes, please state:

The Department of Intellectual Property (DIP) has set up a special division named "Prevention and Suppression of IPRs Infringement Division" to help with coordinating between IP owners, enforcement bodies, and other related government agencies.

Peculiarities

61. Are there any peculiarities not mentioned above in the system of protection for trademarks in Thailand of which it is important for clients to be aware?

Regarding enforcement of trademark rights:

- (a) Preliminary injunctions are available in Thailand.
 (b) Parallel importation is legitimate in Thailand.

Patents

Patent Rights and Protection in Thailand

General

1. What is the system for patent protection?

- Examination system
- Non-examination system

2. Is Thailand a member of the Patent Cooperation Treaty (PCT)?

- Yes
- No

3. Is Thailand a member of the Paris Convention?

- Yes
- No

Patent Registration

A. Registration System

4. What kinds of patent protection are available?

- Inventions
- Utility models
- Others:

Apart from patents/utility models (or so-called petty patents), patent protection is also available for designs, which include the ornamental aspects or aesthetics of an article, including features pertaining to a design's shape, configuration, or pattern. Thailand adopts the "first to file" patent system. To obtain design patent protection in Thailand, the design must be new and must also be capable of industrial application. The subject matter seeking protection must be kept as confidential as possible until an application is filed with the Thai Patent Office. In accordance with Thai patent law, a design patent application must contain one design only. If the drawings consist of different designs or embodiments, then each embodiment must be filed as a separate application. Furthermore, partial design is not protected under the Thai patent law.

As regards invention, a patent may be granted for an invention, and protection is provided for 20 years when three conditions are satisfied, which are (1) novelty, (2) an inventive step, and (3) industrial applicability. For utility models (or petty patents), the requirements are only for novelty and industrial application, and an inventive step is not required. Utility models provide protection of 10 years, shorter than for invention patents.

Invention without an inventive step can be protected under a utility model. However, it is not possible for the applicant to obtain both a patent and a petty patent for the same invention. The applicants in either case can change the type of right applied for, from a petty patent to a patent and vice versa.

5. What kinds of subject matter are excluded from patent protection?

- Methods of medical treatment or diagnosis
- Computer programs
- Business methods
- Others:

Invention related to the following matters are not protected as per the Thai Patent Act, Section 9: (i) microorganisms that naturally exist and their components, animals, plants, or extracts from animals or plants; (ii) scientific and mathematical rules and theories; (iii) an invention contrary to public order or morality, public health, or welfare. Business methods are also not protected, as they do not possess technical features that could be considered to be a patentable invention.

B. Patent Filing

6. What are the documents and information required for filing a patent application?

- Name and address of the applicant
- Name and address of the inventor
- Specification
- Abstract
- Power of Attorney

Notarization is required. Legalization is not required unless the applicant is Taiwanese. A notarised Power of Attorney can be filed within 90 days from the date of filing the patent application. This deadline is non-extendable.

- Deed of Assignment
For PCT applications: The Deed of Assignment is only required when the applicant in the Thailand national phase is different from the applicant in the international phase. Neither notarization nor legalization is required. Furthermore, a certified copy of the first-filed assignment, with an original executed Deed of Acceptance of Assignment, can be filed in lieu of the Deed of Assignment. The documents and their Thai translation should be filed together with the application. An extension of the 90-day period is allowable for late filing of said documents.
- Others:

(a) Certified copies of priority documents, if claiming priority. These documents must be submitted to the Thai Patent Office within 16 months from its first filing date but before publication of the Thai application. A request for an extension to submit the priority documents is not available;

(b) An English specification of the invention, including claims, abstract, drawings (if any), and sequence listing (if any). The Thai translation of the English specification must be filed within 90 days from the date of filing the application. This deadline is non-extendable.

7. Is there a fee for extra claims?

- Yes No

8. Does Thailand require obtaining a foreign filing license before filing a foreign patent application?

- Yes No

If yes, please describe:

B.1 Patent Specification

9. In which language must a patent specification be?

- English Other: Thai

10. Is it possible to file an application first with an English specification, and then later submit its translation in the official language?

- Yes No

The Thai translation of English specification must be filed with the Thai Patent Office within 90 days from the date of filing the application. This deadline is non-extendable.

B.2 Publication, Amendment and Divisional Application

11. Is it possible to request a deferment of publication?

- Yes No

If yes, please describe:

It is possible to defer publication of the application. Thai law is silent on how long the deferment can be granted and does not specify how many times a request for a delay in publication can be filed. Therefore, the applicant can request a delay in publication for as long as desired. The applicant should inform their local legal representative of the publication date desired.

12. Is it possible to request an early publication?

- Yes No

If yes, please describe:

13. Does the applicant have a provisional right upon the publication of an application?

- Yes No

If yes, please describe:

Provisional protection commences upon publication of the application. When the pending application has already been published in the Thai patent journal, and the infringing party is aware of the patent application or has been informed thereof in writing, a complaint or compensation may be claimed for infringement retrospectively to the publication date.

14. When is it possible to file a voluntary amendment to specification?

- At the time of entry into the national phase (for PCT application)
 At any time during prosecution
 At the time of requesting examination
 Other:

Amendments to a pending patent application may be made during prosecution but before the granting of the patent. However, an amendment requested after the date of publication can only be done with the approval of the Director General of the Department of Intellectual Property. In either case, no amendment is allowed if it broadens the scope of the application, as originally filed, or if it would add essential elements to the invention.

15. When is it possible to voluntarily file a divisional application?

- At any time during prosecution
 At the time of granting a patent
 Other:

According to the Thai Patent Office's regulations, a voluntary divisional application cannot be filed. Filing a divisional application is only possible upon the instructions of the Patent Examiner. This generally occurs at the substantive examination stage when the Examiner rejects the unity of the invention and instructs the applicant to file a divisional application.

16. Is it possible to file a divisional application based on a previous pending divisional application if the parent application has already been granted a patent?

- Yes No

C. Examination

17. Is there a requirement to submit certain information on corresponding applications, or prior art known to the applicant?

- Yes No

If yes, please describe:

In Thailand, there is no requirement to submit or disclose prejudicial prior arts documents to the Examiner at the Patent Office. However, the Examiner is entitled to request any documents from the applicant, and the applicant must comply with such request within the prescribed time. Failure to do so would result in the application being deemed abandoned. If a patent application claims priority to an earlier-filed application in any foreign country, an examination report of the earlier-filed foreign application is required to be submitted to the Department of Intellectual Property.

18. Is there a grace period (exception to novelty)?

- Yes No

If yes, please describe:

In Thailand, the relevant laws concerning grace periods are provided in Sections 6 and 19 of the Thai Patent Act B.E. 2522 (A.D. 1979), as amended by Patent Act (No. 2) B.E. 2535 (A.D. 1992), and Patent Act (No. 3) B.E. 2542 (A.D. 1999).

According to Section 6(2) of the Thai Patent Act, an invention is not new if it was described in a document or printed publication, displayed, or otherwise disclosed to the public in Thailand or in a foreign country before the date of the application for a patent in Thailand.

However, exceptions are provided in the last paragraph of Section 6 of the Thai Patent Act, which states that the following types of disclosures are not deemed to be disclosures:

- (i) disclosure of unlawfully obtained subject matter of the invention;
- (ii) disclosure of the subject matter of the invention by the inventor; and
- (iii) display of the inventor's work at an international exhibition or an official exhibition, whether in Thailand or in a foreign country, within 12 months before the application for a patent in Thailand.

19. Is it required to file a request for substantive examination?

- Yes No

If yes, what are the requirements?

The applicant must file a request for substantive examination of the application upon publication of the application. The deadline to file the request is within 5 years from the publication date.

20. Can a third party file a request for substantive examination?

- Yes No

21. Is there a right of appeal?

- Yes No

If yes, please describe:

In the case where the applicant or the opposing party is dissatisfied with the Director General's decision, either party can file an appeal with the Board of Patents within 60 days from the receipt of the Director General's notice.

22. Are multiple dependent claims admissible?

- Yes No

D. Opposition

23. Is there an opposition procedure upon publication?

- Yes No

24. How long is the opposition term once the application is published?

- 2 months 3 months
 Prior to the grant Other:

Upon publication of the application, an opposition can only be filed within 90 days from the publication date.

25. Who may initiate opposition proceedings?

- Any person
 Anyone with a legitimate interest
 Any competent authorities
 Others: _____

E. Timeline

26. What is the time period from application to grant for a straightforward application?

- Between 2 - 3 years
 Between 3 - 4 years
 Other:

The average time period from filing an application to the granting of the patent is 4–5 years, provided that all the requirements for the patentability of the invention are fulfilled and no opposition is filed.

27. Is there any process for accelerated examination of application?

- Yes No

If yes, what are the requirements?

It is possible to request an accelerated examination process for patent applications by using examination results via the Patent Prosecution Highway (PPH) or the ASEAN Patent Examination Co-operation (ASPEC) Program.

Patent Prosecution Highway (PPH)
 A Thai application eligible to enter the PPH Pilot Program can use examination results of the Japanese Patent Office (JPO) to conduct patent examination. The Thai application must claim priority to the corresponding Japanese application. In addition, a request to participate in the PPH must be filed at the DIP either on or after the filing of the 'request for a substantive

examination,' but prior to the first Office Action being issued.

Upon filing a request for a substantive examination under the PPH Pilot Program, the first Office Action is expected to be issued approximately six months from the request date.

ASEAN Patent Examination Co-operation (ASPEC) Program

At the time of requesting substantive examination, the applicant may file a petition to prosecute the application under ASPEC and to submit a corresponding foreign patent granted by one of the ASEAN member countries participating in the program. It is anticipated that the average processing time for examination will be six months.

Maintenance of Patent

A. Annuity

28. To maintain the validity of patent, is it required to pay an annuity in Thailand?

Yes No

29. Is late payment of annuity permissible?

Yes No

If yes, what are the requirements?

For ordinary annuities, payment must be made within 60 days from the due date, i.e. each anniversary date of the filing date. Also, late payment is allowed within 120 days (with an applicable 30% surcharge) and is calculated from the date following the deadline of the initial 60-day period.

30. Is government annuity fixed for each year?

Yes No

If yes, what is the base for calculation of annuity?

The government annuity is fixed for each annuity year, with the annuity increasing for each passing year.

31. Can annuity be paid once for all years or once for several years?

Yes No

The entire amount of the annuities can be paid in one lump sum. The amount of the annuity will be reduced if you pay the 5th to 20th annuity fees at the same time. We quote Section 44 for your reference.

"The patentee may at one time pay in advance the entire amount of annual fees in lieu of yearly payments.

In case the annuity has been paid in advance but subsequently the annuity rate changes, or the patentee surrenders his patent, or there is a revocation of the patent, then the patentee shall not be required to pay the insufficient amount to cover the new rate nor shall he be entitled to any refund therefrom."

32. Is power of attorney required for annuity payment?

Yes No

33. Are there any provisions to restore a lapsed patent?

Yes No

If yes, what are the requirements?

If the patentee fails to pay the patent annuity fee, a restoration of rights may be requested by paying the fee within 60 days. According to Section 43 of the Thai Patent Act, if the annual fee and late fee are not paid by the deadline, the Director General will submit a report to the Board of Patents to revoke the patent. The patentee may file a petition to the Board, within 60 days of receiving such notice of revocation, to request an extension. If the Board rejects the request for an extension, the patentee can file an Appeal to the Central Intellectual Property and International Trade Court within 60 days from the receipt of the notification. Otherwise, the Board's decision is final.

34. Is patent term extension available in Thailand?

- Yes No

If yes, what are the conditions?

The term of a patent cannot be extended.

it is sold at an unreasonably high price or does not meet the public demand for no appropriate reason.” (emphasis added)

Section 51

“In order to carry out any service for public consumption or which is of vital importance to the defense of the country, or the preservation or acquisition of natural resources or environment or to prevent or alleviate a severe shortage of food or medicines or other consumer goods and foodstuffs, or for the sake of other public interests, ministries, bureaus and departments of the government, themselves or through others, may exploit any invention under any patent under Section 36. In so doing, the ministries, bureaus or departments shall pay a royalty to the patentee or exclusive licensee under Section 48, paragraph 2, and shall inform the patentee in writing without delay. This shall not be subject to the provisions of Sections 46, 47 and 47bis.

B. Compulsory Licence

35. Is a compulsory licence available in Thailand?

- Yes No

If yes, what are the requirements?

Thai patent law provides the possibility for issuing a compulsory licence in the three following situations:

- (a) Non-working or inadequate working of patents so as to meet the local demand for the patented products;
- (b) Unreasonable obstruction, including outright refusal, of licensing negotiations; and
- (c) Uses for public interests.

The relevant Thai laws for compulsory licences are under Sections 46 and 51.

Section 46

“At any time after the expiration of three years from the grant of a patent, or four years from the date of application, whichever is later, any person may apply to the Director-General for a license, if it appears at the time when such application is filed that the patent holder has not applied their rights as follows:

- (i) There is no production of the patents product or application of the patented process in the country without any appropriate reason; or
- (ii) There is no product produced under the patent or under the patented process for sale in any domestic market or, if there is, it is sold at an unreasonably high price or does not meet the public demand for no appropriate reason.”
- (iii) There is no production of the patents product or application of the patented process in the country without any appropriate reason; or
- (iv) There is no product produced under the patent or under the patented process for sale in any domestic market or, if there is,

In the circumstances under the above paragraph, the ministry or bureau or department shall submit its offer setting forth the amount of royalty and conditions for the exploitation to the Director-General. The royalty rate shall be as agreed upon by the ministry or bureau or department and the patentee or his exclusive licensee, the provisions of Section 50 shall apply *mutatis mutandis*.” (emphasis added)

36. Can a request for termination of compulsory licence be filed?

- Yes No

If yes, what are the requirements?

C. Use Requirement

37. Does the patentee need to submit evidence of obligation of use to the Patent Office in order to maintain a patent in Thailand?

- Yes No

If yes, please describe:

At any time after the expiration of three years from the granting of the patent, or from four years from the date of application,

whichever is later, any person may apply to the Director General for a license, if it appears that at the time when such application is filed, the patent holder has not applied its rights as follows:

- (a) There is no production of the patented products or application of the patented process in the country without any appropriate reason; and
- (b) There is no product produced under the patent or under the patented process for sale in any domestic market, or, if there is, it is sold at an unreasonably high price or does not meet the public demand for no appropriate reason.

In any case, the applicant for a license must show that he has made an effort to obtain a license from the patent holder by proposing conditions and royalties reasonable under the circumstances, although no agreement could be reached within a reasonable period.

38. Is a compulsory licence granted based on failing to perform an obligation to use?

Yes No

If yes, please describe:

Please be advised that non-use of the patented invention within the country is regarded as an abuse and will subject said patent to a compulsory licence. The grace period of non-use has been amended by the Patent Act B.E. 2535 (1992). The new provision, in line with Art.5A(4) of the Paris Convention, provides that any interested person may apply for a compulsory licence after the expiration of three years from the date the patent is issued, or four years from the filing date, whichever period expires later. According to Section 46 of the Thai Patent Act, "At any time after the expiration of three years from the grant of a patent, or four years from the date of application, whichever is later, any person may apply to the Director General for a license." The term starts immediately after filing a patent application. In practice, the three-year window starting from the date of the granting of the patent generally applies because it

always expires later, due to the delay in patents being granted in a timely manner, which is a result of the necessarily prior examination with respect to the requirements of patentability.

The law considers a patent not being used in two particular circumstances. First, the failure to use arises when a patented product has not been produced or the patented process has not been applied for manufacture in Thailand. Secondly, a compulsory licence can be granted when the demand in the Thai market is not fulfilled. This refers to situations when the patentee refuses to sell the products protected by the patent in the Thai market in sufficient quantities, or when such products are sold at excessive prices.

However, the law provides for an exemption for non-use. The patent holder may justify his inaction based on "legitimate reasons". For example, he may refer to extraordinary situations such as 'force majeure' circumstances. According to Section 46, if it appears at the time when such application is filed that the patentee has not applied his lawful rights:

- (a) The patented product has not been produced or the patented process has not been applied in the country, without any legitimate reason; or
- (b) That no product produced under the patent is sold in any domestic market, or that such a product is sold but at unreasonably high prices or does not meet the public demand, without any legitimate reason.

Whether submitting an application under (a) or (b), the license applicant must show that he has made an effort to obtain a license from the patentee having proposed conditions and remuneration reasonably sufficient under the circumstances but being unable to reach an agreement within a reasonable period.

D. Cancellation

39. Are termination or cancellation proceedings available in Thailand?

- Yes No

If yes, what are the grounds?

Cancellation of a patent is possible at any time for any invention, which at the time of filing was not new, did not involve an inventive step, is not capable of industrial application, is not protected by the Patent Act, or was applied for by someone without the right to apply for a Thai patent. A petition to cancel an invalid patent may be submitted to the IP & IT Court by any person who has an interest in the patent or by the public prosecutor.

40. What is the time limit for termination or cancellation?

- 3 years 5 years
 Whole Other: _____
 protection
 term of patent

E. Assignment, Transmission and Licensing

41. Are there any mechanisms to record assignment of a patent in Thailand?

- Yes No

If yes, what are the requirements?

The following documents are required for Recordal of Assignment:

- An original, notarised Power of Attorney of the latest applicant; and
- An executed Deed of Assignment or notarised true copy of the Deed of Assignment document. Legalization is not required.

42. Are there any mechanisms to record transmission of a patent in Thailand, for example, transmission by way of merger?

- Yes No

If yes, what are the requirements?

The recordation of transmission of a patent, for example, by means of merger, requires the recordation of the merger. In order to satisfy the official filing requirements, the

following documents are required:

- A notarised Power of Attorney, executed by an authorised person on behalf of the new applicant; and
- The original Certificate of Merger, issued by the relevant government authority, or a copy thereof, which has been certified as a true copy by a Notary Public. Legalization is not required.

43. Are patent licensees required to record themselves with the Patent Office?

- Yes No

If yes, what are the requirements?

There is no requirement for patent licensees to record their existence with the Thai Patent Office. However, the law requires patent licenses to be registered with the Thai Patent Office. To be eligible for registration of a patent license agreement, a written License Agreement is required and is regarded as a contract under the Civil and Commercial Code. The general principles of freedom of contract applies. Parties to an agreement are free to stipulate among themselves the covenants of the agreement to be entered into. However, there are some limitations within which the parties must operate. These are:

- Certain formalities that must be met in order to conclude a legally binding agreement; and
- Restraint of trade.

It is compulsory by law for the patentee to record the Patent License Agreement in accordance with the Thai Patent Act. A license agreement relating to an invention or a design patent shall not be enforceable unless it has been made in writing and registered with the Department of Intellectual Property (DIP). The main objective of the law in requiring registration of the licensee agreement is to regulate the terms and conditions associated with licensing.

To enable us to file an application for registration of a Patent License Agreement on your behalf, we would require the following documents:

- A notarised Power of Attorney from the licensor;
- A notarised Power of Attorney from

- the licensee;
- (c) The original Patent License Agreement-notarised by a Notary Public; and
- (d) The Thai translation of the Power of Attorney, Notarial Acknowledgement, and License Agreement, which we can prepare on your behalf.

F. Change of Details

44. Are there any mechanisms to record change of name or address of the patent proprietor?

- Yes No

If yes, what are the requirements?

To proceed with recordation of change of name or address of the patent proprietor, the following documents are required:

- (a) A notarised Power of Attorney indicating the new name or new address; and
- (b) The original or certified copy of the Certificate of Change of Name or Address issued by the responsible government authority.

45. Is it possible to amend a granted patent?

- Yes No

If yes, what are the requirements?

46. Is it possible to correct and rectify any errors on the patent?

- Yes No

If yes, what are the requirements?

Yes, the patent owner may request the Thai Patent Office to correct and rectify any errors of the patent. The request must be in writing. The patentee must pay a required fee for the correction, if the error is due to the patentee's fault.

To request the Thai Patent Office to correct a patent, the following documents are required:

- (a) An explanation for the correction; and
- (b) The original patent.

Enforcement

47. What are the available enforcement methods in Thailand?

- Civil enforcement
- Administrative enforcement
- Criminal enforcement
- Border measures
- Others: _____

48. What are the criteria for infringement?

- Literal infringement
- Infringement under the doctrine of equivalents
- Use of the patent without permission of patent owner
- Others: _____

49. Is there a statute of limitations for filing a suit for patent infringement?

- Yes No

If yes, what is the time period?

As the Patent Act does not prescribe the statute of limitations for filing a civil action for damages based on the grounds of patent infringement, the tort provision under the Civil Code is applicable. To summarize, the statute of limitations for the patent owner to file a civil lawsuit against the infringer for damages is one year from the date that the owner knows of the infringement and of the person who committed such infringement, or ten years from the date of the infringement. It should, however, be noted that the tort provision also prescribes that if the act of infringement is also deemed a criminal offence and the statute of limitations for filing a criminal lawsuit for such offense against the infringer is longer than the statute of limitations for a civil case, the longer period under the criminal case will be also applicable for the civil case. Therefore, determination of the applicable period governed by the statute of limitations for filing a civil lawsuit for damages is made on a case-by-case basis. Nonetheless, as a precaution, the patent owner should consider the statute of limitations for filing a civil action to claim damages from the infringer to be within one year, as mentioned above.

50. What are the remedies available for an infringement action?

- Damages
- Injunction
- Destruction of the infringing goods
- Others:

Both criminal and civil remedies are available for patent infringement, and different enforcement tracks may be followed either simultaneously or consecutively.

If a patent owner pursues a civil action against an infringer, the patent owner's ability to obtain relief will depend on the remedies claimed in its pleadings and as introduced during the proceedings. If the patent owner prevails in a civil action, the patent owner could obtain a permanent injunction enjoining the infringer from further engaging in the infringing activities. Section 77bis of the Thai Patent Act allows the patent owner to apply for an injunction, the issuance of which will not curtail the patent owner's right to claim damages against the infringer. However, pursuant to Section 142 of the Thai Civil Procedure Code, the Court judgment or order cannot go beyond the claims in the proceedings. Therefore, the patent owner, as the plaintiff, must carefully state the type and scope of the permanent injunction requested from the Court.

In addition, the patent owner can seek damages for losses suffered as a result of the infringement, pursuant to Section 77ter of the Thai Patent Act, which states that where a patentee's right has been violated, the Court has the power to order the violator to pay compensation for damages to the patentee in such amount that the Court considers appropriate, taking into consideration the seriousness of the damages, as well as the loss of benefits and necessary expenses incurred in enforcing the rights of the patentee.

Despite the availability of damages awards, the amount of compensation awarded by the Court tends to be small and often not sufficient for the patent owner to recoup economic losses caused by the infringement and the litigation

costs. This is due to the fact that the Court generally awards only actual proven damages, meaning the actual amount of damages suffered as a direct result of the infringing activities. In light of the difficulties concerning proof of actual damages, the amount of damages awarded is often limited.

In addition to damages and injunctive relief, the Court may also order the destruction of goods that are found to infringe a patent.

Also, if a criminal action is brought against the infringer instead of or in addition to a civil action, criminal penalties would also be applicable. Section 85 of the Thai Patent Act provides criminal penalties for patent infringement in Thailand, which may include fines up to THB 400,000 and/or imprisonment up to two years.

51. What are the actions taken by such authorities?

- Conduct a raid
- Seize the infringing goods
- Impose a fine
- Others:

When faced with infringement, the patent owner may pursue civil preliminary relief to immediately stop the infringing activity. These include an *ex parte preliminary injunction* and an *Anton Piller order* for search and seizure of evidence of infringement.

Preliminary injunction: A preliminary injunction can be applied for prior to the filing of a lawsuit against the infringer. The patent owner must be able to provide the Court with proof of ownership of the patent, evidence of infringement, and sufficient reasons/justifications for the preliminary injunction requested, such as irreparable harm that cannot be addressed by monetary compensation or any other form of indemnity. The Court's decision on the issuance of preliminary injunction will take into account the nature and extent of damages both parties may incur if the injunction is granted (and vice versa) and the difficulty of enforcing the

judgment against the alleged infringer.

Anton Piller order: In addition, the patent owner may seek an *Anton Piller* order to seize the evidence of infringement, provided that an emergency situation exists. An *Anton Piller* order is designed to preserve evidence of infringement for the time when a lawsuit is later launched by the patent owner. To support a motion for an *Anton Piller* order, the patent owner must be able to show that an emergency situation exists, and, if the other party or third party involved is notified beforehand, the evidence of infringement will be damaged, lost, destroyed, or otherwise difficult to be adduced at a later stage.

(b) Translation issues for patents in Thailand are an important emerging issue in litigation. Specifically, translation issues can come into play in litigation and could provide the infringer with a means to invalidate the concerned patents.

(c) The applicants in either case can change the types of rights applied for, from petty patent to patent, and vice versa. This must be done prior to the registration of the invention and the issuance of the petty patent or before the publication of the patent application. An invention patent application can seek patent protection for an unlimited number of claims. However, a petty patent application can seek patent protection for no more than 10 claims.

52. Is there an authority or ministry responsible for the enforcement of patent rights?

Yes No

If yes, please state:

Generally, the following Thai administrative authorities will assert jurisdiction over patent infringement: the Patent Office; Department of Intellectual Property; the Ministry of Justice, the Customs Department; Ministry of Finance; the Department of Special Investigations, the IP & IT Court, public prosecutors, the Royal Thai Police.

Peculiarities

53. Are there any peculiarities in the system of protection for patents in Thailand of which it is important for clients to be aware?

(a) The Patent Prosecution Highway Program (PPH) between Thailand and Japan, which began in January 1, 2014, shows the practical effects of its implementation with regard to increased acceleration of examinations. Therefore, it is highly recommended that an applicant participate in this program if their application is eligible for a PPH request.

Vietnam

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Foreword

Since the introduction of rudimentary intellectual protection provisions in the 1980s, IP protection has been one of the fastest growing areas of law in Vietnam, highlighted by the issuance of the first Law on Intellectual Property in 2005 (amended in 2009) and its various guiding regulations.

To integrate into the world's economy, Vietnam has also put substantial effort into harmonizing its IP systems with international practice, and is now a member of several important treaties, including the Paris Convention for the Protection of Industrial Property, the Patent Cooperation Treaty, the Madrid Agreement and Protocol, and the World Trade Organization Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), to name a few.

In Vietnam, patents and trademarks can be registered with the National Office of Intellectual Property (NOIP), a subordinate of the Ministry of Science and Technology (MOST), which is the administrative state agency responsible for patents, trademarks, and other industrial property objects. The NOIP recently launched an e-filing system, a milestone for IP procedure, which is expected to increase the number of filings and help SMEs.

Over the last few years, lawmakers and government authorities have been more active and Vietnam has shown strong improvement in almost every IP sector. Circular No. 01/2007/TT-BKH-CN, an important legal document in the IP area in Vietnam, was recently amended for the fourth time and will take effect on January 15, 2018. The amendments clarify certain issues and generally push Vietnam's IP law closer to international practice as well as provide practical changes. They also, in some cases, create more stringent requirements for IP owners.

Overall, Vietnam is on the uptrend in putting effort into enhancing its legal systems and human resources to better protect IP rights and meet regional and international standards. It is expected that the changes will contribute to an increase in the pace of science and technology development in Vietnam, and the country's general socio-economic development as well.

Trademarks

Trademark Rights and Protection in Vietnam

General

1. What is the system for trademark protection in Vietnam?

- Registration Common law
 Co-existing rights under registration and common law

2. Does first to use or first to register have prior rights in Vietnam?

- First to use First to register

3. Is Vietnam a member of the Madrid Union and the Paris Convention?

- Madrid System Paris Convention

4. If Vietnam is a member of Madrid Union is it a party to the Agreement or the Protocol and are there any peculiarities in relation to the implementation of the Madrid System for international registration in Vietnam?

Vietnam is a member of both the Madrid Agreement and the Madrid Protocol. There are no peculiarities in relation to the implementation of the Madrid System for international registration in Vietnam.

Trade Mark Registration

A. Registration System

5. What are the benefits of registering a trade mark in Vietnam?

- Prevails over common law rights
 It is the only form of protection available for trademarks
 Entitles the proprietor to bring an infringement action

Others:

Vietnam adopts the first-to-file rule. Registering a trademark in Vietnam will give the owner exclusive rights to use, assign, or license the registered trademark, and to prevent unauthorised use and registration of identical/similar trademarks by other parties.

6. Is it possible to obtain registration for the following types of marks under the registration system in Vietnam?

a. Service marks

- Yes No

Service marks are not specifically mentioned in the law but are protected as normal trademarks.

b. Defensive marks

- Yes No

If yes, what are the requirements?

c. Collective marks

- Yes No

If yes, what are the requirements?

To file a trademark application for a collective mark, the applicant should provide the NOIP with

- (a) An application form having the name and address of the applicant, a representation of the trademark with description thereof, and the goods and services and class(es) for which the trademark is to be registered.
 (b) Power of Attorney if the application is filed by an IP representative. Neither legalization nor notarization is required for the Power of Attorney.
 (c) Rules on the use of the collective mark.

- (d) Explanation of particular characteristics and quality of the product bearing the mark (if the applied-for mark is a collective mark used for a product with unique characteristics).
- (e) Map showing the indicated territory (if the applied-for mark is a collective mark containing geographical area of a product).
- (f) The documents executed by the provincial People's Committee permitting the use of the name of geographical area if the collective mark containing name of geographical area.
- (g) Required fees for filing application.

d. Certification marks

- Yes No
If yes, what are the requirements?

To file a trademark application for a certification mark, the applicant should provide the NOIP with:

- (a) An application form having the name and address of the applicant, a representation of the trademark with description thereof, and the goods and services and class(es) for which the trademark is to be registered.
- (b) Power of Attorney if the application is filed by an IP representative. Neither legalization nor notarization is required for the Power of Attorney.
- (c) Rules on the use of the certification mark.
- (d) Explanation of particular characteristics and quality of the product bearing the mark (if the applied-for mark is a certification mark used to certify quality of a product).
- (e) Map showing the indicated territory (if the applied-for mark is a certification mark containing geographical area of a product).
- (f) The documents executed by the provincial People's Committee permitting the use of the name of geographical area if the certification mark containing name of geographical area.
- (g) Required fees for filing application.

e. Well-known marks

(i.e. registration of a mark as a well-known mark and not an ordinary trademark)

- Yes No
If yes, what are the requirements?
-

f. Series marks

- Yes No
If yes, what are the requirements?
-

g. Marks in different language or characters other than Roman characters

- Yes No
If yes, what are the requirements?

Under Article 74.2(a) of Vietnam IP Law stipulates that "a mark shall not be considered distinctive if it consists of signs falling under one of the following cases: simple devices and geometric figures; numerals, letters, or words of uncommon languages, except for signs having been widely used and recognised as a mark".

Therefore, a trademark would not be inherently registrable if this language is considered an uncommon language in Vietnam, such as Chinese, Japanese, Thai, etc

h. Non-traditional marks: Sound marks

- Yes No
If yes, what are the requirements?
-

i. Non-traditional marks: Smell marks

- Yes No
If yes, what are the requirements?
-

j. Non-traditional marks: Position marks

- Yes No
If yes, what are the requirements?

There are no regulations on position marks in Vietnam's IP law. In practice, position marks are protected as normal marks and with the same requirements for filing as normal marks.

k. Non-traditional marks: Colour marks

(i.e. registration of a single colour or a combination of colours)

- Yes No

If yes, what are the requirements?

Color, *per se*, is not registrable in Vietnam under domestic law. However, the TRIPS Agreement, to which Vietnam is a member, requests that color combinations should be protected, provided that these marks are distinctive. The requirements for filing color marks are the same as for normal marks.

l. Non-traditional marks: Shape or three-dimensional marks

- Yes No

If yes, what are the requirements?

Applications for three-dimensional marks are filed and treated the same as two-dimensional trademarks with the additional requirement that clear pictures or drawings of the perspective view of the three-dimensional mark must be submitted with the application.

The National Office of Intellectual Property is very strict in examining the distinctiveness of three-dimensional marks that are related to the shape of the designated goods or their packages. Generally, if the shape can be recognised as no more than the shape of the designated goods, the shape cannot be registered as a three-dimensional trademark unless it has acquired distinctiveness through long and extensive use.

m. Others: _____

7. Is it possible to claim a colour limitation?

- Yes No

If yes, what are the requirements?

The law is silent on color limitation. In practice, when applying for a mark, the applicant needs to indicate whether the mark is in black-and-white or in color. If the mark is in color, the colors should be listed. Under the law, the scope of protection of a trademark is determined according to the scope of protection stated in the trademark registration. As such, trademarks filed in black-and-white will be protected in black-and-white as filed. Trademarks filed in color will be protected

in the colors as filed. The protection of a black-and-white trademark is limited to the protection of contents of the trademark (word/figurative element), while the protection of a color trademark covers both the contents of the trademark (word/figurative elements) and color combinations.

However, for the purpose of maintaining the registration, a black-and-white version may render more flexibility for the trademark owner, as use of the mark in color may be accepted as use of the registered mark in black-and-white. However if the mark is registered in color, use of the black-and-white version, or use of the mark in different colors, may not be accepted as use of the registered mark in the registered color.

8. What is the official name of the trademark office in Vietnam?

National Office of Intellectual Property

B. Trade Mark Filing**9. What are the documents and information required for filing a trade mark application in Vietnam?**

- Name and address of the applicant
 Representation of the trade mark
 Goods and services and the class(es) for which the trade mark is to be registered
 Certificate of Incorporation (if the applicant is a company)
 Statutory Declaration
 Power of Attorney
 Others:

To file a trademark application, the applicant should provide the NOIP with (a) an application form having the name and address of the applicant, a representation of the trademark with description thereof, and the goods and services and class(es) for which the trademark is to be registered, (b) Power of Attorney if the application is filed by an IP representative, and (c) required fees for filing application. Neither legalization nor notarization is required for the Power of Attorney. Certified documents evidencing the basis for enjoying a priority right are required if the applicant claims a priority date.

10. Can a trade mark application be based on intent to use in Vietnam?

- Yes No

If yes, please specify any conditions:

A trademark application can be based on intent to use in Vietnam. No documents are required for that purpose.

11. Is priority claim allowed in Vietnam?

- Yes No

If yes, what are the requirements?

Yes, the applicant can claim priority for a period of 6 months under the Paris Convention. Partial priority and/or multiple priority claims are allowed. For priority claims to be accepted, the applicant should provide the NOIP with certified copies of the first application that serves as the basis for the priority claims.

12. Are multi-class applications permitted in Vietnam?

- Yes No

If yes, is there a maximum number of classes that can be applied for?

There is no limitation on the number of classes prescribed for each application.

13. Does Vietnam adopt the Nice Classification for specification of goods and services?

- Yes No

If yes, please specify the edition:

While Vietnam is not an official member of the Nice Agreement, the country applies the Nice Classification system in practice. Since 1 October 2017, the Nice 11th Edition has been applied.

14. Are there any specific requirements in relation to the classification of goods and services in Vietnam?

a. Must the specification of goods and services be limited to items from the list of goods and services under the Nice Classification only?

- Yes No

b. Can the class heading be included in the specification?

- Yes No Subject to conditions

Please specify:

In practice, the goods and services bearing the trademark must be appropriately classified in accordance with the Nice Classification. The goods and services do not need to exactly match those listed in the Nice Classification, but they should be specific enough for classification purposes. Claiming the class heading is acceptable with some classes, but not all classes. It is not required to prove use of or intent to use the goods claimed at the time of filing the trademark application in Vietnam.

c. Are there sub-classes of goods and services applied by the trademark office in Vietnam?

- Yes No

If yes, please elaborate:

d. Others, please specify:**C. Trade Mark Examination****15. What marks, signs, representations, emblems or words are specifically prohibited from registration in Vietnam?**

- Signs contrary to morality or public order
- Signs of such a nature as to deceive the public
- Signs benefiting protection from other international convention (e.g. Red Cross, Olympic symbols)
- Signs protected by national laws (e.g. royal emblems)
- Others:

16. Is there substantive examination of trademarks?

- Yes No

If yes, what are the grounds?

- Absolute grounds
- Relative grounds

Others: _____

17. Is substantive examination conducted before or after publication of a trademark for opposition by third parties?

- Before publication After publication

18. What are the absolute grounds for refusal?

- Mark consists of a non-invented word(s)
- Mark has direct reference to the character or quality of the goods or services
- Mark is not distinctive
- Mark consists of a geographical name
- Mark consists of a surname
- Mark consists of letters of the alphabet
- Mark consists of numerals
- Mark consists of geometric shapes
- Others:

In addition to answers above, a trademark may be refused on the following absolute grounds:

- (a) It consists of a sign describing the legal status or field of business of the subject business entity (this “subject business entity” in most cases means the applicant);
- (b) It consists of a sign which is misleading or which causes confusion or deceives consumers as to the origin, properties, intended utilities, quality, value or other characteristics of goods or services;
- (c) It consists of a sign which is identical or confusingly similar to real names, aliases, pseudonyms or images of leaders, national heroes or famous personalities of Vietnam or foreign countries;
- (d) It consists of a sign which is identical or confusingly similar to an emblem, flag, armorial bearing or full or abbreviated name of a state agency, political organization, socio-political

organization, socio-political-professional organization, social organization or socio-professional organization of Vietnam and international organizations, unless permitted by such agencies or organizations;

- (e) It consists of a sign which is identical or confusingly similar to certification seals, check seals or warranty seals of international organizations which require that their signs must not be used, unless such seals are registered as certification marks by those organizations; or
- (f) It consists of a sign which is contrary to social ethics and public order, or prejudicial to national defense and security.

19. What are the relative grounds for refusal?

- There is a prior application for registration or registration for an identical or confusingly similar mark in relation to the same goods or services as the subject mark
- There is a prior application for registration or registration for an identical or confusingly similar mark in relation to similar goods or services (although in different class) as the subject mark
- Well known mark: There is a well known mark which is identical or so nearly resembling the subject mark for the same goods or services as the subject mark
- Well known mark: There is an earlier registered mark which is well known for different goods or services and use of the subject mark would indicate a connection between goods or services covered by the subject mark with the proprietor of the well known mark
- Others:

A trademark may be refused on the following relative grounds:

- (a) It is a sign which is identical or confusingly similar to another entity's mark which has been widely used and recognised (but has not attained “well known” status) for similar or identical goods or services prior to the filing date or the priority date;

- (b) It is a sign which is identical or similar to a trade name being used by another entity if the use of such sign is likely to cause confusion to consumers as to the source of goods or services or
- (c) It is a sign which is identical to or insignificantly different from another person's industrial design having been protected on the basis of an industrial design registration application with a filing date or priority date earlier than that of the trademark application.

20. Is there a right of appeal?

- Yes No

If yes, please describe:

There are two levels of appeal. The first appeal must be filed with the National Office of Intellectual Property within 90 days from the date of the contested decision. The second appeal should be filed with the Minister of Science and Technology within 30 days from the date of the decision on settlement of the first appeal. No extension of time for filing appeals is available.

D. Publication and Opposition

21. Is there an opposition procedure upon publication?

- Yes No

Vietnam's IP law has a procedure for opposition against a trademark application after it is published in Vietnam.

22. How long is the opposition term once the trade mark application is published in Vietnam?

There is no specific term for opposition. The opposition can be filed after a trademark application is published and before the trademark matures into registration.

23. Is the opposition term extendible?

- Yes No Others: _____

24. Who may initiate opposition proceedings?

- Any person
 Anyone with a legitimate interest
 Any competent authorities
 Others: _____

25. What are the usual grounds for opposition?

- Prior use of a mark which is identical or confusingly similar to the opposed mark
 Prior registration of a mark which is identical or confusingly similar to the opposed mark
 Bad faith in application for registration of the opposed mark
 Applicant is not the rightful proprietor of the opposed mark
 If the opposed mark is identical with or so nearly resembles the Opponent's mark which is well-known in Vietnam for the same goods or services
 If the opposed mark is identical with or so nearly resembles the Opponent's mark which is well-known and registered in Vietnam for goods or services not the same as those claimed in the opposed mark; provided that the use of the opposed mark in relation to the goods or services claimed would indicate a connection between those goods or services and the proprietor of the well-known mark, and the interests of the proprietor of the well-known mark are likely to be damaged by such use
 Opposed mark lacks distinctiveness
 Lack of intention to use the opposed mark
 Opposed mark consists of false geographical indication
 Use of opposed mark likely to cause confusion or deception
 Others: _____

E. Timeline

26. What is the time period from application to registration for a straightforward trademark application in Vietnam?

- Between 6 months - 12 months
 Between 12 months - 18 months
 18 months above

Under Vietnam's IP law, the time period from application to registration for a straightforward application is 12 months. In practice, this time period is often prolonged to 18-20 months.

27. Is there any process for accelerated/expedited examination of trade mark applications?

- Yes No

If yes, what are the requirements?

Maintenance of Trademark Registration

A. Renewal

28. Is there a mechanism to renew a trade mark registration in Vietnam?

- Yes No

If yes, how long is the validity of the renewal?

A trademark registration is valid in Vietnam for 10 years from the filing date and can be renewed an unlimited number of times for a period of 10 years each.

29. Is late renewal of a trade mark registration permissible in Vietnam?

- Yes No

If yes, what are the conditions?

Late renewal within no more than six months after the expiry date of a trademark registration is possible on the condition that the trademark owner pays an extension fee plus 10% for each month of delayed filing.

30. Are there any provisions to restore a lapsed registration?

- Yes No

If yes, what are the conditions?

B. Use Requirement

31. Does evidence of use need to be submitted to the trademark office at any time in order to maintain an application for registration or a registration of a trademark in Vietnam?

- Yes No

If yes, what are the requirements?

C. Rectification/Cancellation

32. Are rectification or cancellation proceedings available in Vietnam?

- Yes No

If yes, what is the forum?

The rectification or cancellation shall be submitted to the National Office of Intellectual Property of Vietnam.

33. What are the grounds for rectification or cancellation proceedings?

- Any entry made in the Register without sufficient cause
 Any entry wrongfully remaining in the Register
 Non-use of the mark
 Others:

A trademark registration can be subject to cancellation proceedings in Vietnam if:

- (a) Its owner has not paid the due fees for the maintenance or renewal as prescribed;
- (b) Its owner has declared its relinquishment of the trademark registration;
- (c) Its owner no longer exists or is no longer engaged in business, without leaving a lawful successor;

- (d) The mark has not been used by its owner or a licensee of the owner without justifiable reasons for a term of 5 consecutive years prior to a request for termination of validity, except where the use has commenced or resumed at least 3 months before the request for termination;
- (e) The owner of a collective mark fails to supervise or ineffectively supervises the implementation of the rules on using collective marks;
- (f) The owner of a certification mark violates the rules on using certification marks or fails to supervise or ineffectively supervises the implementation of such rules;
- (g) The geographical conditions attributable to the reputation, quality or characteristics of the product bearing a geographical indication have changed resulting in a loss of the reputation, quality or characteristics of the product.
- (h) The applicant neither had, nor had been assigned, the right to register the mark;
- (i) The trade mark failed to satisfy the protection conditions (absolute and relative grounds) at the granting date of the protection title. Note that if a trade-mark would have failed the absolute grounds for being non-distinctive but has subsequently acquired distinctive character; this would be sufficient to defend against an invalidation attack.

34. When would a presumption of validity arise in relation to a trademark registration?

- [] years from date certificate of registration issued/date of application
- No such presumption

The validity of a trademark registration arise from the issuance date of trademark registration.

35. When are the grounds for rectification or cancellation proceedings assessed?

- At the time of filing of the application
- At the time of issuance of the certificate of registration

- At the time of the application for rectification or cancellation proceedings
- Others:

In Vietnam, there are two proceedings to challenge the validity of a registration: termination proceedings and invalidation proceedings. In termination proceedings, the validity of a registration will be ceased at the time of the decision on termination. In invalidation proceedings, the registration is considered to have never been valid.

As such, the grounds for rectification (invalidation) proceedings are assessed at the time of issuance of the certificate of registration. The grounds for cancellation (termination) proceedings are assessed at the time of the application for cancellation.

36. When is a trade mark registration vulnerable to cancellation on grounds of non-use?

- [] years from the deemed date of registration
- [5] years from the date of certificate issuance
- Not applicable
- Others: _____

37. Who bears the burden of proof in a non-use cancellation action?

- Applicant for cancellation
- Defendant / Respondent (trademark owner)

In a non-use cancellation action in Vietnam, the applicant bears the burden of proving the non-use status of the contested mark. If the burden is met, the burden of proving use or legitimate excuses for non-use will shift to the trademark owner.

38. If the answer to the above is the Applicant, what are the examples of evidence which can be relied on to support an application for cancellation for non-use?

- Full market survey conducted by an independent or professional surveyor of an appropriate sample size

- Simple market survey or enquiries in the trade
- Declaration from the applicant for cancellation
- Others:
In Vietnam, to be accepted by the National Office of Intellectual Property as evidence showing the non-use status of the contested mark, the applicant for cancellation must obtain a market survey result collected and certified by a competent authority in Vietnam.

D. Assignment, Transmission and Licensing

39. Are there any mechanisms to record assignment of a trade mark in Vietnam?

- Yes No

If yes, what are the requirements?

Recording the assignment of a trademark is possible in Vietnam. An Assignment Agreement must be recorded with the NOIP to be legally effective and enforceable. The following are the documents required for the filing of a trademark assignment in Vietnam:

- (a) Original Power of Attorney duly executed by the assignee. No notarization or legalization is required if the assignment is filed through an IP representative.
- (b) Two originals of the deed of assignment duly signed by both the assignor and assignee, or two certified copies thereof.
- (c) Original Certificate of Trademark Registration for the endorsement of assignment particulars.

40. Are there different requirements for recording assignment with or without the goodwill of the business?

- Yes No

If yes, what are the requirements?

Vietnam's IP law is silent on the requirement for recording assignment with or without the goodwill of the business.

41. Are there any mechanisms to record transmission of a trade mark in Vietnam, for example transmission by way of merger?

- Yes No

If yes, what are the requirements?

It is possible to record the transmission of a trademark in Vietnam by way of, e.g., merger or acquisition. The recordal of such transmission will be considered as recordal of a change of name and address of the trademark owner. For the purpose of such recordal, the following documents are required: (i) original Power of Attorney from the owner in its new name/address (neither notarization nor legalization is required); (ii) original or certified copy of document attesting to the change; and (iii) original Certificate of Trademark Registration.

42. Are trade mark licensees required to record themselves with the Registrar?

- Mandatory Recommended No
If yes, what are the requirements?

Trademark licensees are not required to record themselves, and a trademark license contract is valid as agreed upon by the involved parties under Vietnam's IP law. However, such contract is only legally effective to a third party if it is registered.

Filing for registration of a trademark license agreement in Vietnam requires: (i) an original Power of Attorney duly executed by the licensor or licensee (no notarization or legalization is required) and (ii) two originals of the license agreement duly signed by both the licensor and licensee, or two certified copies thereof.

E. Change of Particulars

43. Should any change in the name or address of the proprietor on record of a registered trademark be updated on the register?

- Yes No

If yes, what are the requirements?

A change of name or address of the trademark proprietor is possible in Vietnam. For recordal of a change of the owner's name and address, the following documents are required:

- (a) Original Power of Attorney from the owner in its new name/address (neither notarization nor legalization is required);

- (b) original or certified copy of document attesting to the change; and
 (c) Original Certificate of Trademark Registration.

44. Is it possible to change the representation of a registered trademark?

- Yes No

If yes, what are the requirements?

It is possible to change the representation of a registered trademark in Vietnam with the conditions that the proposed changed mark will not alter the distinctive character of the trademark.

To change the representation of a registered trade mark, the applicant should provide the NOIP with:

- (a) An application form having the name and address of the applicant, a representation of the trademark with description thereof,
 (b) Power of Attorney if the application is filed by an IP representative, and
 (c) Required fees for filing application.
 Neither legalization nor notarization is required for the Power of Attorney.

45. Is it possible to correct and rectify any errors on the Register?

- Yes No

If yes, what are the requirements?

The owner of a trademark may request the NOIP to correct and rectify any errors on the Register. The request must be in writing. The trademark owner must pay a required fee for the correction if the error is due to its fault. If the error is caused by the NOIP, the trademark owner is not required to pay the fee.

Enforcement

46. What are the available enforcement methods in Vietnam?

- Civil enforcement
 ◦ Infringement action
 ◦ Passing off
 Criminal enforcement
 Border or other administrative enforcement measures

Vietnam law is silent on “passing off” enforcement. In practice, “passing off” is treated as unfair competition.

Trademark owners have the option of pursuing administrative action, civil litigation and/ or criminal action when taking action against trademark infringement. Trademark owners may also employ border control measures as a pre-emptive action to seize infringing goods crossing the borders of Vietnam. In addition to these formal actions, trademark owners may also choose informal action such as sending cease-and-desist letters to infringers.

47. What are the requirements to bring an action for infringement of trademark?

- Valid registration of the trademark
 Unauthorised use by a 3rd party in the course of trade of a mark which is
 ◦ identical to the registered trademark
 ◦ so nearly resembling the registered mark as is likely to cause confusion
 ◦ in relation to the goods or services for which the proprietor’s mark is registered
 ◦ in relation to goods or services which are similar to the goods or services for which the proprietor’s mark is registered though not the same
If yes, what are the criteria?

48. For a trademark infringement action, is it necessary to establish

- Actual confusion?
 Likelihood of confusion?

49. For a trademark infringement action, is it necessary to establish damage or loss to the proprietor of the trademark?

- Yes No Others
If yes, what are the requirements?

50. Is there a period of limitation for filing a suit for trade mark infringement?

- Yes No

If yes, what is the time period?

The statute of limitations for filing cases relating to trademark disputes and other types of IP disputes is 2 or 3 years from the date on which the trademark owner becomes aware that his/her legitimate rights and interests are infringed, depending on the nature of the case. Also, disputes over ownership rights are exempted from limitation periods.

51. What are the remedies available for an infringement action?

- Damages or account of profits
 Injunction
 Delivery and/or destruction of the infringing goods
 Others:

Remedies in administrative cases may include the following:

- (a) Primary sanctions, which include either a warning or a fine up to VND 500 million (about USD 22,000);
 (b) Additional sanctions, which include, *inter alia*, confiscation and/or destruction of infringing goods as well as means for producing the infringing goods; suspension of business license; and
 (c) Remedial measures, which include, *inter alia*, removal of infringing elements, and, withdrawal of domain name.

Meanwhile, the following remedies are available in civil proceedings:

- (a) Compulsory cessation of the infringing act;
 (b) Compulsory public retraction of the false information on the ownership of the IP assets which have been published, and an apology;
 (c) Compulsory compensation for damages, etc.

In addition, attorney's fees may be awarded in civil proceedings.

Further, remedies are also available in criminal proceedings. However, criminal charges are applicable to trademark counterfeiting only and do not apply to other types of trademark infringement. These remedies include, *inter alia*:

- (a) A monetary fine up to VND 1 billion (USD 44,000) and
 (b) Imprisonment for up to 3 years.

52. Is it possible to claim for 'passing off' in Vietnam?

- Yes No

In principle, there is no 'passing off' theory under Vietnamese law. However, in the absence of trademark registration, it is still possible to claim protection for unregistered trademarks and/or trade dress under the well-known trademark charge or unfair competition charge.

53. If yes, what are the criteria to establish 'passing off'?

- That the proprietor has goodwill and reputation in the trademark

a. Must the goodwill and reputation subsist in Vietnam i.e. goodwill and reputation outside Vietnam will not be taken into consideration?

- Yes No

b. Must there be actual use or business presence in Vietnam?

- Yes No

c. What is the usual form of evidence used to establish such goodwill and reputation?

To establish goodwill and reputation, the following evidence should be collected:

- (a) Turnover from the sale or supply of the goods and/or services bearing the trademark or the volume of the goods sold both in Vietnam and on a global scale;
 (b) Period of continuous use of the trademark in Vietnam;

- (c) Widespread goodwill of the goods and services bearing the trademark such as awards and prizes won in Vietnam;
- (d) Value of the trademark in assignment, licensing, and investment capital contribution;
- (e) Territorial extent of circulation of the goods and services bearing the trademark;
- (f) Number of Vietnamese consumers who are aware of the trademark;
- (g) Amount of money spent on trade promotion of the goods and services with the trademark; and
- (h) Social activities in Vietnam that the trademark holder takes part in, etc.

That there is misrepresentation caused to members of the public

a. Is it necessary to establish actual confusion or is likelihood of confusion sufficient?

- Actual confusion
- Likelihood of confusion

b. What is the usual form of evidence used to establish such misrepresentation?

As there is a lack of precedent, there is no clear guidance under the Vietnam regulations as to the evidence used to establish misrepresentation in Vietnam.

That there are damage/likelihood of damage

a. Is it necessary to establish actual damages or is likelihood of damage sufficient?

- Actual damage
- Likelihood of damage

b. What is the usual form of evidence used to establish such damage or likelihood of damage?

Not applicable

Others: _____

54. Are there other forms of actions or claims that can be brought by a trademark owner against an infringer or unauthorised user?

Unfair competition Others: _____

55. What are the elements that need to be established to bring the claim(s) above?

To accuse the infringer of unfair competition under the IP Law, we must establish that:

- (a) The unregistered trademark has become a trade indication; and
- (b) The use of the infringing element confuses the buying public as to the relationships and the origins of the products.

To prove the former condition, we must attest to the wide use of the unregistered trademark prior to the market entry of the offender's products in Vietnam. To satisfy the first condition, we should collect the following information/documents:

- (a) Turnover (globally and in Vietnam) from the sale or supply of the goods bearing the unregistered trademark or the volume of the goods sold;
- (b) Period of continuous use of the unregistered trademark in Vietnam;
- (c) Widespread goodwill of the unregistered trademark such as awards and prizes won;
- (d) Value of the unregistered trademark in assignment, licensing, and investment capital contribution;
- (e) Territorial extent of circulation of the unregistered trademark in Vietnam;
- (f) Number of Vietnamese consumers who are aware of the products and/or the unregistered trademark, a survey indicating the number is best;
- (g) Amount of money spent on trade promotion of the unregistered trademark; and
- (h) Social activities in Vietnam that the IP holder takes part in, etc.

To satisfy the second condition, we must establish that:

- (a) The unregistered trademark is unique; and

- (b) The unregistered trademark is similar to the infringing element.

56. Can a trade mark owner lodge a complaint to any administrative authorities on counterfeit trademark goods?

- Yes No

If yes, please state the authority:

Generally, the following administrative authorities will assert jurisdiction over trademark infringement: Market Surveillance Agency; Economic Police; Inspectorate of Science and Technology; Customs. In addition, a trademark owner can also submit its complaint to the competent court.

57. What are the actions that can be taken by such authorities?

- Conduct a raid
 Seize the infringing goods
 Impose a fine
 Refer for criminal prosecution
 Others:

After conducting a raid into the infringer's premises/place of business, the administrative authorities may impose the following actions on the infringer:

- (a) Primary sanctions, which are monetary fines;
 (b) Additional sanctions, which include, *inter alia*, confiscation and/or destruction of infringing goods as well as means for producing the infringing goods; suspension of business license; and
 (c) Remedial measures, which include, *inter alia*, removal of infringing elements, withdrawal of domain name and/or company name containing infringing elements; compulsory distribution or use of infringing goods as well as means primarily used to produce the infringing goods for non-commercial purposes provided that such distribution and use does not influence the exploitability of the rights of the trademark holder; recall of infringing goods on the market, and recovery of illegal profits from the infringement to the State budget.

- If the case otherwise goes to civil court, the court may take the following actions:
- (a) Compulsory cessation of the infringing act;
 (b) Compulsory public retraction of the false information on the ownership of the IP assets which have been published, and an apology;
 (c) Compulsory performance of civil obligations (a task under which the obligors must transfer an object, transfer rights, pay money or return valuable papers, perform other tasks, or refrain from doing certain tasks in the interest of the obligees);
 (d) Compulsory compensation for damages; and
 (e) Compulsory destruction of infringing goods or distribution of them for non-commercial purposes without prejudice to the rights of the trademark holder;

In addition, attorney's fees may be recovered in civil proceedings.

As to criminal court, in addition to imposing monetary fines on the infringer, the court may also imprison the infringer for up to 3 years.

58. Are border measures available to restrict the importation of counterfeit trademark goods?

- Yes No

If yes, what are the measures?

A trademark owner can seek customs recordal for his/her trademark. Upon the success of customs recordal, Customs will begin monitoring for infringing goods on a nationwide basis. Upon detecting suspected infringing goods, Customs will temporarily suspend the clearance of the goods and notify the trademark owner via its representative. The sanctions which Customs may impose include monetary fines and orders for destruction of the infringing elements of the goods in question.

59. Do these border measures apply for counterfeit goods of unregistered trademarks?

- Yes No
 Not applicable, there are no rights for unregistered trademarks in Vietnam

60. Is there an authority or ministry responsible for the enforcement of trademark rights?

- Yes No

If yes, please state:

Generally, the following administrative authorities will assert jurisdiction over trademark infringement: Market Surveillance Agency; Economic Police; Inspectorate of Science and Technology; Customs. In addition, a trademark owner can also submit its complaint to the competent court.

Peculiarities

61. Are there any peculiarities not mentioned above in the system of protection for trademarks in Vietnam of which it is important for clients to be aware?

Regarding establishment of trademark rights:

- (a) As mentioned above, Vietnam adopts the first-to-file priority system. As such, it is advisable to immediately register your trademark with the NOIP as soon as you decide to launch your business in Vietnam. Such trademark registrations would serve as *prima facie* evidence of ownership and priority rights, which ensures a better chance of success if enforcement actions need to be taken.
- (b) Since the fee for filing a trademark application depends on the number of goods or services in a class, care should be taken in choosing the appropriate number of goods or services to ensure protection for the trademark while at the same time balancing this need against the costs which would be incurred by claiming broadly.

- (c) Also, it is worth noting that Vietnamese laws and regulations do not provide an exact deadline within which to file a trademark opposition. The law simply states that an opposition shall be made during the substantive examination period and before grant of registration. Normally, it takes between 9-15 months from publication to grant but practice has shown instances of quicker grants of registration in the past. Therefore, oppositions should be filed as soon as possible as it is difficult to estimate the exact time when the substantive examination will be completed.

Regarding enforcement of trademark rights:

- (a) Most trademark holders opt for administrative measures because:
- (i) Administrative measures are relatively swift, generally taking between 1 to 5 months;
 - (ii) Administrative measures are more cost-efficient than civil action; and
 - (iii) Administrative enforcement bodies are more experienced in IP cases and typically have superior IP legal knowledge compared to other bodies such as courts.
- (b) Infringers may seek invalidation of the trademark in question in an effort to hinder and prolong legal actions, including administrative measures and civil action. In contrast to civil proceedings, the invalidation counter-attack may not slow administrative enforcement. The reason for this is that under Decree 99/2013/ND-CP, if the trademark holder can confirm the validity of the trademark under oath, the enforcement bodies may continue to move forward with the case rather than stay the proceedings. However; unlike administrative measures, under civil action, it is more likely that the court will suspend the proceedings pending the resolution of the invalidation request by NOIP.
- (c) Damages awards in Vietnam are typically low, as clear proof of damages is required.

-
- (d) If the trademark owner is a foreign entity, it bears an onerous burden in terms of the formality of the documentation which is required to be submitted to the court. Broadly speaking, all documentation must be legalised. The statement of claims must be signed and sealed directly by the trademark owner. The formalities which are required when preparing and submitting documentation can result in significant delays in the progress of civil proceedings.
- (e) Due to a lack of clear precedent in favor of preliminary injunctions, the court may prefer, on the balance of convenience, not to allow a preliminary injunction.

Patents

Patent Rights and Protection in Vietnam

General

1. What is the system for patent protection?

- Examination system
 Non-examination system

2. Is Vietnam a member of the Patent Cooperation Treaty (PCT)?

- Yes No

3. Is Vietnam a member of the Paris Convention?

- Yes No

Patent Registration

A. Registration System

4. What kinds of patent protection are available?

- Inventions Utility models
 Others:

In addition to patents/utility solutions, Vietnam also protects innovations (in the form of an Innovation Certificate), defined as technical, managerial, or operational solutions, or solutions for the application of a technical advance (collectively referred to as "solutions" below), which may be recognised as such by a company or organization if fully satisfying the following conditions:

- (a) It is novel within the establishment;
 (b) It has been applied or experimentally applied at the establishment and is capable of bringing about practical benefits; and
 (c) It is not a solution which:
 (i) Has been published or applied contrary to public order or social ethics; or
 (ii) Was protected under the intellectual property law at the time of recognition.

In addition, please note that "utility model" is called "utility solution" in Vietnam. The fields covered by patents for invention and patents for utility solution are the same, and the application documents for the two kinds of matters are also the same. The requirements for invention are (1) novelty all over the world, (2) inventive step and (3) industrial applicability. The requirements for utility solution are novelty and industrial applicability, but an inventive step is not required; the utility solution just must not be ordinary knowledge. The period of protection is 20 years for patents for invention and 10 years for patents for utility solution. During prosecution, a patent application for invention may be converted into a patent application for utility solution and vice versa.

5. What kinds of subject matter are excluded from patent protection?

- Methods of medical treatment or diagnosis
 Computer programs
 Business methods
 Others:

Discoveries and scientific theories; mathematical methods; schemes, plans, rules, or methods for performing mental acts, training domestic animals, or playing games; presentations of information; solutions of aesthetic characteristics only; plant and animal varieties (these are protected by other non-patent mechanisms); processes of essentially biological nature for the production of plants and animals other than microbiological processes.

B. Patent Filing

6. What are the documents and information required for filing a patent application?

- Name and address of the applicant
- Name and address of the inventor
- Specification
- Abstract
- Power of Attorney
 - Original is sufficient, notarization or legalization is not required
- Deed of Assignment
 - For PCT applications: Deed of Assignment is only required when the applicant in the Vietnamese national phase is different from the applicant in international phase.

For Paris Convention application:

Deed of Assignment is only required when applicant in Vietnamese application is different from the applicant in priority application. When required, an original Deed of Assignment is sufficient, notarization or legalization is not required

- Others
 - (a) Nationality of the inventor;
 - (b) International Patent Classification (IPC) symbols under the Strasbourg Agreement for Paris Convention application; and
 - (c) Certified copies of the priority applications (for Paris Convention application).

7. Is there a fee for extra claims?

- Yes No

If yes, please describe:

Government fees are calculated based on number of independent claims, not total number of claims. If the claim set contains more than one independent claim, an extra claim fee must be paid for each additional independent claim from the 2nd independent claim including filing (formality examination), substantive examination, and granting stages.

8. Does Vietnam require obtaining a foreign filing license before filing a foreign patent application?

- Yes No

If yes, please describe:

The National Office of Intellectual Property (NOIP) of Vietnam does not issue foreign filing licenses. However, in cases of (1) inventions of Vietnamese organizations and individuals and (2) inventions created in Vietnam, if the owners plan to seek patent protection in Vietnam, the patent application must first be filed in Vietnam before being filed elsewhere. In the six-month period after filing an application in Vietnam, the NOIP will cooperate with other competent authorities to check whether the claimed invention belongs to the category "secret invention." If the invention is determined to be a secret invention, the NOIP will inform the applicant of the same, and such invention should be treated under the regulations for protecting national secrets. Namely, such invention could only be filed in foreign countries having regulations on secret invention protection after obtaining permission from a competent authority. After six months from the filing date, if the invention is not classified as a secret invention, the NOIP will not issue any notification and the applicant can file the invention abroad.

B.1 Patent Specification

9. In which language must a patent specification be?

- English Other: Vietnamese

10. Is it possible to file an application first with an English specification, and then later submit its translation in the official language?

- Yes No

B.2 Publication, Amendment and Divisional Application

11. Is it possible to request a deferment of publication?

- Yes No

If yes, please describe:

12. Is it possible to request an early publication?

- Yes No

If yes, please describe:

The applicant can request early publication. If such request is filed, the patent application will be published within two months from the date of request, or from the date of issuance of a Decision on acceptance of application as valid application after formality examination, depending on which date is later.

13. Does the applicant have a provisional right upon the publication of an application?

- Yes No

If yes, please describe:

In Vietnam, before an invention/utility model is granted, the intellectual property rights (IPR) owner has a provisional right to the invention/utility model. Particularly, the IPR owner could send a warning letter informing the filing date and publication date in the Industrial Property Gazette and ask the user to terminate the use of the invention/utility model. If the user continues using such invention/utility model, then as soon as a patent for invention/utility model is granted, the owner of the patent shall have the right to request the user to pay compensation equivalent to the price for licensing of such invention/utility model within the corresponding scope and duration of use.

14. When is it possible to file a voluntary amendment to specification?

- At the time of entry into the national phase (for PCT application)
 At any time during prosecution
 At the time of requesting examination
 Other:

An amendment can be filed any time during prosecution of an application but must be filed before issuance of a Decision on refusal of acceptance of application as a valid application or Decision on grant (grant date) or Decision on refusal to grant patent.

15. When is it possible to voluntarily file a divisional application?

- At any time during prosecution
 At the time of granting a patent
 Other:

One or more divisional application(s) can be filed any time during prosecution of an application but must be filed before issuance of a Decision on refusal of acceptance of application as a valid application or Decision on grant (grant date) or Decision on refusal to grant patent.

16. Is it possible to file a divisional application based on a previous pending divisional application if the parent application has already been granted a patent?

- Yes No

The matter above is not clear from the IP Law and regulations. However, in practice, the NOIP has been accepting divisional applications based on previous divisional applications.

C. Examination

17. Is there a requirement to submit certain information on corresponding applications, or prior art known to the applicant?

- Yes No

If yes, please describe:

Vietnam does not have regulations on "Duty of Disclosure" like some countries.

Therefore, there is no consequence for not complying, whether intentionally or by mistake, in regard to "Duty of Disclosure," like in some countries. However, according to Point 15.2 of Circular 01, the applicant can (proactively or at the request of the NOIP) submit the following documents to assist the substantive examination:

Results of information search or examination of the application filed overseas for the subject matters stated in the application; copies of patents granted for corresponding applications filed overseas; prior art documents of the corresponding application supplied by a competent foreign authority (foreign patent office) to the applicant; and other documents.

In practice, the NOIP will not require the submission of cited (prior art) documents of corresponding foreign applications or foreign patents which are in English and available from the Internet. The NOIP normally requests applicants to submit English translations of granted claims or English translations of full specifications of foreign patents that are not in English, for example, claims or specifications of Chinese, Korean, and Japanese patents, for reference in examination. Currently, only if requested by the NOIP via a notice, the applicant must submit such documents within two months from the date of the notice. In conclusion, there will only be consequences in cases in which the NOIP requests in writing via an office action the submission of reference documents and the applicant does not comply. If the applicant does not submit the documents according to the NOIP's request within the prescribed period indicated in the NOIP's office action, the application for a patent will be refused.

18. Is there a grace period (exception to novelty)?

Yes No

If yes, please describe:

An invention/utility solution shall not be considered to lack novelty if it was publicly disclosed in the following cases, provided that the patent application is filed within six months from the date of disclosure:

- (a) The invention/utility solution was disclosed by another person without permission of the person entitled to file the application;
- (b) The invention/utility solution was disclosed in the form of a scientific presentation by the person entitled to file the application; or
- (c) The invention/utility solution was displayed at a national exhibition of Vietnam or at an official or officially recognised international exhibition by the person entitled to file the application.

19. Is it required to file a request for substantive examination?

Yes No

If yes, what are the requirements?

A request for substantive examination should be filed by the 42-month deadline for invention application or the 36-month deadline for utility solution application, counted from the earliest priority date (or filing date if the application claimed no priority). A six-month grace period is possible if the applicant submits reasons for the late submission and the NOIP considers and agrees with those reasons.

20. Can a third party file a request for substantive examination?

Yes No

21. Is there a right of appeal?

Yes No

If yes, please describe:

Under the regulations, the time limit for filing the first-instance appeal is 90 days from the date the appellant receives or becomes aware of the decision or notification on the processing of his/her industrial property registration application. However, the NOIP normally considers the time limit for filing the first-instance appeal as 90 days beginning on the date of the decision to refuse the patent application.

The time limit for filing the second appeal is 30 days from the expiry date of the term for settlement of the first-instance appeal if by that date the first-instance appeal is not

dealt with, or from the date the appellant receives or becomes aware of the first appeal settlement decision.

22. Are multiple dependent claims admissible?

- Yes No

D. Opposition

23. Is there an opposition procedure upon publication?

- Yes No

24. How long is the opposition term once the application is published?

- 2 months 3 months
 Prior to the grant Other:

25. Who may initiate opposition proceedings?

- Any person
 Anyone with a legitimate interest
 Any competent authorities
 Others: _____

E. Timeline

26. What is the time period from application to grant for a straightforward application?

- Between 2 - 3 years
 Between 3 - 4 years
 Other: _____

27. Is there any process for accelerated examination of application?

- Yes No
If yes, what are the requirements?

Under the regulations, the time limit for issuing examination results is 18 months from the publication date (if a request for examination is filed prior to the publication date) or the filing date of the request for examination (if the request for examination is filed subsequent to the publication date). Because of the NOIP's backlog, examination results are often issued quite late and after

the 18-month time limit.

There are several ways to accelerate examination of patent applications in Vietnam, specifically:

- (a) Filing a PPH (Patent Prosecution Highway) request with patentable claims from the Japan Patent Office (JPO) if the JPO is the first filing office. This procedure will cut the time of normal examination approximately in half (reduced from 18 months to nine months).
- (b) Filing an ASPEC (ASEAN Patent Examination Co-operation) request when there are favorable opinions of applications from other ASPEC members. However, in practice, since patents granted by ASEAN countries are not preferred by the NOIP, this avenue is not practical.
- (c) Formal acceleration: This procedure requires filing a request for accelerated examination to obtain the examination results before the 18-month time limit. In practice, in addition to the request, the applicant needs to receive the approval of the responsible examiner for an accelerated examination on a case-by-case basis. However, in practice, the NOIP normally agrees on acceleration only if the period for examination of application has already reached 12 months.
- (d) Informal acceleration: This is done by submitting favorable examination results for the corresponding patent applications filed in EP, US, JP, CN, KR, etc. Because of the NOIP's backlog, the Vietnamese examiners often rely on the examination outcomes issued by large patent offices, such as the EPO, USPTO, JPO, SIPO, etc., on the corresponding applications when examining Vietnamese applications. This is the most useful approach to avoid excessive delay in the examination.

Maintenance of Patent

A. Annuity

28. To maintain the validity of patent, is it required to pay an annuity in Vietnam?

- Yes No

29. Is late payment of annuity permissible?

- Yes No

If yes, what are the requirements?

The late payment should be made no more than six months from the due date. There are no conditions for late payment, except a late payment charge must be paid.

30. Is government annuity fixed for each year?

- Yes No

If yes, what is the base for calculation of annuity?

Government annuity is calculated for each year and based on number of independent claim(s).

31. Can annuity be paid once for all years or once for several years?

- Yes No

From the regulations, to maintain the patent, the patent owner must pay annuities within six months of the deadline. However, in practice, the NOIP has accepted payment once for all years or once for several years.

32. Is power of attorney required for annuity payment?

- Yes No

33. Are there any provisions to restore a lapsed patent?

- Yes No

If yes, what are the requirements?

34. Is patent term extension available in Vietnam?

- Yes No

If yes, what are the conditions?

Currently, Patent Term Extension or Supplemental Protection Certificates (PTE/SPC) are not available in Vietnam. Vietnam is a member of the Trans-Pacific Partnership Agreement ("TPP"). In the TPP, Article 18.46 and Article 18.48 under the current version relate to patent term adjustment for unreasonable granting authority delays and

for unreasonable curtailment. Based on the decision of the United States to withdraw from the Agreement, the TPP may not come into force; however, the Agreement could still move forward in some form with the remaining member countries, and patent term adjustment could be introduced.

In addition, Vietnam and the EU have concluded negotiations on the EU-Vietnam Free Trade Agreement ("EVFTA"), which is expected to come into force in 2018. Under the current version, Article 8.3 of EVFTA provides extension for patent terms. Vietnam is considering amending the current IP Law in 2018 to be in line with EVFTA. However, it is not known which options (Item 1 or 2 of Article 8.3 of EVFTA) Vietnam will choose.

B. Compulsory Licence**35. Is a compulsory licence available in Vietnam?**

- Yes No

If yes, what are the requirements?

Compulsory licences are available in Vietnam under Article 145 of the IP Law, which is in compliance with the TRIPS Agreement. There are three general situations in which compulsory licences may be granted, including (i) for dependent inventions, (ii) for reasons of public interest, and (iii) for failure to work the invention to meet a number of public and national demands. Moreover, if a third party fails to negotiate a license with reasonable terms and conditions, a compulsory licence may be granted.

The grounds for granting a compulsory licence are based on Article 145.1 of the IP Law:

Article 145.1: In the following circumstances, the right to use an invention shall be transferred to another organization or individual to use by a decision of a state competent authority as provided for in Article 147.1 of this Law without having to obtain permission from the patent holder:

- (a) Where such use of invention is for public non-commercial use, for meeting needs of national defense, security, disease prevention, treatment, nutrition for people

- and for other national emergencies;
- (b) Where the patentee or the licensee of the patent under an exclusive license agreement fails to fulfill the obligation of using such invention (to manufacture the protected product or to apply the protected process to satisfy the needs of national defense, security, disease prevention, treatment and nutrition for people or to meet other national emergencies) after the expiration of 4 years from the filing date of patent application and expiration of 3 years from the granting date of patent;
- (c) Where the person who wants to use the invention fails, in spite of efforts made after a reasonable time for negotiation on adequate price and commercial conditions, to obtain authorization from patent holder;
- (d) Where the patent holder is determined to perform an act of anti-competition prohibited under the Competition Law.

36. Can a request for termination of compulsory licence be filed?

- Yes No

If yes, what are the requirements?

According to Article 145.2 of the IP Law, the patent owner has the right to request termination of a compulsory licence when the bases of compulsory licensing cease to exist and are unlikely to recur, provided that such termination are not prejudicial to the licensee.

C. Use Requirement

37. Does the patentee need to submit evidence of obligation of use to the Patent Office in order to maintain a patent in Vietnam?

- Yes No

If yes, please describe:

In the normal life of a patent, the owner is not required to provide evidence of manufacture and use.

However, according to Article 136 of the IP Law, a patent owner has the obligation to manufacture the protected products or use the protected processes to satisfy the re-

quirements of national defense and security, disease prevention or treatment, nutrition of the people, or to meet other urgent social needs. When said needs or requirements arise, and the owner fails to perform such obligation, the competent authority may license the invention to others without the permission of the owner. Such obligations are considered satisfiable by imported products or products manufactured by licensees (according to Article 23.2 of Decree No. 103/2006/ND-CP).

38. Is a compulsory licence granted based on failing to perform an obligation to use?

- Yes No

If yes, please describe:

Please see Question 35 above: after the expiration of 4 years from the filing date of patent application and expiration of 3 years from the granting date of patent.

D. Cancellation

39. Are termination or cancellation proceedings available in Vietnam?

- Yes No

If yes, what are the grounds?

Termination: According to Article 95 of the IP Law, a patent can be terminated on the following grounds:

- (a) Its owner has not paid the due fees for the maintenance or renewal as prescribed;
- (b) Its owner has declared its relinquishment of the rights conferred by the patent; or
- (c) Its owner no longer exists

Cancellation (invalidation): According to Article 96 of the IP Law, a patent can be canceled/invalidated on the following grounds:

- (a) The invention in the patent did not meet the patentability requirements at the time of grant; or
- (b) The applicant was neither entitled to file the application nor assigned such right.

A patent can be partially invalidated if certain parts of the patent did not meet the patentability requirements at the time of grant.

Item 1, Chapter VII of the IP Law provides regulations on “patentability requirements” including novelty, inventiveness, and industrial applicability. The non-patentable subject matters are also mentioned in this Item. Therefore, based on our interpretation, the grounds for invalidation of a patent include novelty, inventiveness, industrial applicability and non-patentable subject matters found in claims.

In addition, Article 220.3 of the IP Law prescribes that for patents granted before the effective date of the IP Law (1 July 2006), the grounds for invalidation of patents will be based on the law and regulations at the time of grant for such patents. These grounds are largely similar to the grounds under the current law.

In practice, we have found that a third party may invalidate a patent (granted before the effective date of the IP Law) based on other grounds, such as on the grounds that the amendment of the PCT application goes beyond the content of the priority application. The NOIP, in fact, has not refused such grounds and informed the patent owner so he/she can respond to the third party's invalidation grounds and arguments.

40. What is the time limit for termination or cancellation?

- 3 years 5 years
 Whole Other: _____
 protection
 term of patent

E. Assignment, Transmission and Licensing

41. Are there any mechanisms to record assignment of a patent in Vietnam?

- Yes No
If yes, what are the requirements?
 Yes, recording the assignment of a patent is possible in Vietnam. An Assignment Agreement must be recorded with the NOIP to be legally effective and enforceable. The following are the documents required for the filing of a patent assignment in Vietnam:
 (a) An Assignment Agreement (original or certified copy, and a Vietnamese transla-

tion of the Assignment Agreement must be submitted),

- (b) A power of attorney of the assignee (original is sufficient, no notarization or legalization is required) and
 (c) The original patent.

42. Are there any mechanisms to record transmission of a patent in Vietnam, for example, transmission by way of merger?

- Yes No
If yes, what are the requirements?
 Yes, it is possible to record the transmission of a patent in Vietnam by way of, e.g., merger or acquisition. The recordal of such transmission will be considered as recordal of a change of name and address of the patent owner. For the purpose of such recordal, the following documents are required:
 (a) A document evidencing the change (original with notarization or certified copy, and a Vietnamese translation of the document must be submitted),
 (b) A power of attorney issued by the new owner with the updated name/address (original is sufficient, no notarization or legalization is required) and
 (c) The original patent.

43. Are patent licensees required to record themselves with the Patent Office?

- Yes No
If yes, what are the requirements?
 Patent licensees are not required to record themselves, and a patent license contract is valid as agreed upon by the involved parties under the IP Law. However, such contract is only legally effective to a third party if it is registered with the NOIP.

Filing for registration of a patent license agreement in Vietnam requires: (1) an original Power of Attorney duly executed by the licensor or licensee (original is sufficient, no notarization or legalization is required) and (2) two originals or two certified copies of the license agreement duly signed by both the licensor and licensee.

Please note that a Vietnamese translation of the license agreement must be submitted.

F. Change of Details

44. Are there any mechanisms to record change of name or address of the patent proprietor?

- Yes No

If yes, what are the requirements?

A change of name or address of the patent owner is possible in Vietnam. For recordal of a change of the owner's name and address, the following documents are required:

- (a) A document evidencing the change (original with notarization or certified copy, and a Vietnamese translation of the document must be submitted),
- (b) A power of attorney issued by the new owner with the updated name/address (original is sufficient, no notarization or legalization is required) and
- (c) The original patent.

45. Is it possible to amend a granted patent?

- Yes No

If yes, what are the requirements?

According to Article 97.3 of the IP Law, a patent owner may request a narrower scope of industrial property rights. Item 20.1.b of Circular No. 01/2007/TT-BKHCH further explains the request for narrower scope of protection according to Article 97.3 of the IP Law as follows:

"A request for narrower scope of protection, according to Article 97.3 of the Law on Intellectual Property, may include one of the following contents:

...

- (iii) Request for reducing one or more independent claims or dependent claims of a patent for invention or patent for utility solution.
- (iv) Request for deleting one or more embodiments of design, one or more products in the set of products of a patent for industrial design; request for deleting one or more non-essential appearance-forming features of a design...."

It is not clear from the regulations whether an amendment of a granted patent for invention/utility solution is only permitted

in the case of deleting one or more claims, or if narrowing the scope of one or more of the claims by amending such claim(s) is also acceptable. Recently, the NOIP has interpreted this issue through its explanation on fees for this item and the answer is that, yes, narrowing the scope of one or more of the claims by amending such claim(s) is also acceptable.

To request the NOIP to amend a patent, the following documents are required:

- (a) An explanation for the amendment,
- (b) A power of attorney issued by the patent owner (original is sufficient, no notarization or legalization is required) and
- (c) The original patent.

46. Is it possible to correct and rectify any errors on the patent?

- Yes No

If yes, what are the requirements?

The patent owner may request the NOIP to correct and rectify any errors on the patent. The request must be in writing. The patent owner must pay a required fee for the correction if the error is due to its fault. If the error is caused by the NOIP, the patent owner is not required to pay the fee.

To request the NOIP to correct a patent, the following documents are required:

- (a) An explanation for the correction,
- (b) A power of attorney issued by the patent owner (original is sufficient, no notarization or legalization is required) and
- (c) The original patent.

Enforcement

47. What are the available enforcement methods in Vietnam?

- Civil enforcement
 Administrative enforcement
 Criminal enforcement
 Border measures
 Others: _____

48. What are the criteria for infringement?

- Literal infringement
- Infringement under the doctrine of equivalents
- Use of the patent without permission of patent owner
- Others:
In Vietnam, infringement is found by either literal infringement or infringement under the doctrine of equivalents.

49. Is there a statute of limitations for filing a suit for patent infringement?

- Yes No

If yes, what is the time period?

The statute of limitations for filing cases relating to patent disputes and other types of IP disputes is two or three years from the date on which the patent owner becomes aware that his/her legitimate rights and interests are infringed, depending on the nature of the case. Also, disputes over ownership rights are exempted from limitation periods.

50. What are the remedies available for an infringement action?

- Damages
- Injunction
- Destruction of the infringing goods
- Others:
Remedies in administrative cases may include the following:
 - (a) Primary sanctions, which include either a warning or a fine up to VND 500 million (about USD 22,000);
 - (b) Additional sanctions, which include, inter alia, confiscation and/or destruction of infringing goods as well as means for producing the infringing goods; suspension of business license; and
 - (c) Remedial measures, which include, inter alia, removal of infringing elements, and forcible public correction of errors for acts of giving wrong indications on industrial property rights.

Meanwhile, the following remedies are available in civil proceedings:

- (a) Compulsory cessation of the infringing act;

- (b) Compulsory public retraction of the false information on the ownership of the IP assets which have been published, and an apology;
- (c) Compulsory compensation for damages, etc.

In addition, attorney's fees may be awarded in civil proceedings.

51. What are the actions taken by such authorities?

- Conduct a raid
- Seize the infringing goods
- Impose a fine
- Others:
After conducting a raid into the infringer's premises/place of business, the administrative authorities may impose the following actions on the infringer:
 - (a) Primary sanctions, which are monetary fines;
 - (b) Additional sanctions, which include, inter alia, confiscation and/or destruction of infringing goods as well as means for producing the infringing goods; suspension of business license; and
 - (c) Remedial measures, which include, inter alia, removal of infringing elements; compulsory distribution or use of infringing goods as well as means primarily used to produce the infringing goods for non-commercial purposes provided that such distribution and use does not influence the exploitability of the rights of the patent holder; recall of infringing goods on the market; and recovery of illegal profits from the infringement to the State budget.

If the case otherwise goes to civil court, the court may take the following actions:

- (a) Compulsory cessation of the infringing act;
- (b) Compulsory public retraction of the false information on the ownership of the IP assets which have been published, and an apology;
- (c) Compulsory performance of civil obligations (a task under which the obligors must transfer an object, transfer rights, pay money or return

- valuable papers, perform other tasks, or refrain from doing certain tasks in the interest of the obligees);
- (d) Compulsory compensation for damages; and
- (e) Compulsory destruction of infringing goods or distribution of them for non-commercial purposes without prejudice to the rights of the patent holder.

In addition, attorney's fees may be recovered in civil proceedings.

52. Is there an authority or ministry responsible for the enforcement of patent rights?

- Yes No

If yes, please state:

Generally, the following administrative authorities will assert jurisdiction over patent infringement: Inspectorate of Science and Technology; Customs; Market Surveillance Agency (for certain infringement actions, for example, violations of provisions on indications on protection of industrial property rights). In addition, a patent owner can also submit its complaint to the competent court.

- (c) Conversion of an invention application into utility solution application and vice versa is possible at any time during the prosecution of the parent application but before a decision on grant or decision on refusal to grant a patent is issued. An example for conversion is when the invention application does not meet the inventiveness requirements when the office action is issued. If the period mentioned has passed, it is impossible to convert the application, for example, after issuance of the Decision on the refusal to grant a patent. However, the applicant can file a new utility solution/invention application and this new utility solution/invention application can have the same filing date and priority date as the invention/utility solution application (the filed application).

Peculiarities

53. Are there any peculiarities in the system of protection for patents in Vietnam of which it is important for clients to be aware?

- (a) The Patent Prosecution Highway Program (PPH) between Vietnam and Japan, which began in 1 April 2016, showed practical effect with regard to acceleration of examination. Therefore, if any application is eligible for a PPH request, it is highly recommended to apply for the PPH request.
- (b) Translation issues for patents in Vietnam are an emerging issue of importance in litigation. Specifically, in our experience, the translation issues can come into play in litigation and could equip the infringer with ammunition to invalidate the concerned patents.

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