

Enforcing your IP Rights in ASEAN

INTRODUCTION

Intellectual Property Rights (IPR) are important to companies, and help to protect and enhance the value of their business. Great ideas, properly protected and effectively exploited, help companies compete more successfully both in home markets and overseas.

Registering and owning IPR is just one part of a successful business journey. Companies need to be able to protect their rights too. Protecting your intellectual property makes it easier to take legal action against anyone who steals or copies it.

When others seek to imitate IP by unlawful or unauthorised means, it becomes necessary to enforce such IP rights.

This factsheet provides an overview of IP enforcement in ASEAN and provides top tips for businesses to consider when enforcing their IP rights.

FACTORS TO CONSIDER

When considering how to enforce your IP rights in ASEAN it is advisable to discuss strategy and approach with an IP attorney or other IP professionals.

It is important to consider costs of enforcement, whilst maintaining flexibility of approach and considering various options.

1. Who should take action?

Responsibility for enforcing IPR sits with the IP owner. However, with increased geographical reach of brands, doing this alone is not always practical, especially for SMEs. It can be unrealistic and costly for only the IP owner to handle the enforcement action. However the enforcement burden and expense can be shared with other parties.

Use local licensees:

Authorising and including local licensees can be a practical and effective route. Licensees have a vested interest for genuine branded products to flourish, and have better knowledge of the local market and of local laws. Such motivation and insight provides good background information on the best way to deal with and manage enforcement action in individual markets.

Use a local subsidiary:

Empowering a local subsidiary or undertaking joint action with a local party gives the IP owner control. Enforcement rights should be granted through a contract which is a right that can be easily given or taken away by the IP owner.

2. How to enforce?

There are several options open to an IP owner when enforcing their rights. When it comes to enforcing your rights, there are some overarching decisions that IP owners should consider.

Firstly, IP owners should consider which laws they want to pursue action under. It is possible to seek recourse through applicable IP laws but also under other laws, for example contract law. This is of course best left to legal advisers to recommend.

Secondly, the IP owner should also balance the legal expense against what can realistically be recovered from the infringer to see if enforcement action is worth pursuing. Some infringers in ASEAN may prefer not to contest any claims and instead disperse their assets pending the hearing date.

SPECIFIC ACTIONS

An Initial Warning letter:

Sometimes, this alone can achieve the desired end result. It may sound surprising, but a simple cease-and-desist letter can be enough to persuade the infringer to stop.

Alternative Remedies through existing IP laws:

In Singapore the Copyright Act allows owners of copyrighted material whose copyright has been infringed, to issue a take-down notice to Internet Service Providers, who may respond by removing or disabling access to the infringing material.

In Malaysia, an owner of a registered trade mark may apply for a Trade Description Order under the Trade Descriptions Act and seek the assistance of the Ministry of Domestic Trade, Cooperative and Consumerism of the Malaysian Government to conduct a raid against the suspected infringer.

The Copyright Tribunal in Singapore resolves disputes between licensors and licensees, and can decide the amount IP owners of music, film, sound recordings or even written copyrighted materials can charge for the use of their copyrighted material.

Finally, the IP Owner can always rely on the local Police force to assist in the enforcement. For instance, the Intellectual Property Rights Branch of the Singapore Police Force regularly helps IP owners conduct raids on infringing material.

Court action: The last resort:

Legal proceedings in court to enforce IPR should remain a last resort. Pursuing an action in court does not always provide the best solution or the desired outcome.

But if this is the chosen route, then IP Owners should consider these key tips.



#1

Prepare your finances.

Court action can be expensive and litigation requires sufficient financing.

#2

Prepare your evidence.

Court proceedings require sufficient and convincing evidence of the infringing activity. This is especially so in cases involving the infringement of patents, in which expert evidence is almost inevitably required because of the underlying technology of the patented invention.

#3

Use the assistance of a trusted local party.

One should not underestimate the usefulness of assistance from a local party. IP owners can only start court action in the country where the infringement occurred. Ideally this should be the same location where assets of the infringer are located, and most of the time this is usually the case. However if the thought of pursuing in a foreign jurisdiction is daunting, then the assistance of a trusted local party, as mentioned above, may prove to be useful.

#4

Be aware of counter-claims.

In most infringement actions, there is always the risk of the infringer launching a counter-claim in order to invalidate the IP right.

CONCLUSION

Be prepared! IP owners should do research on the merits of all the available options before taking any enforcement action, bearing in mind the risks and consequences of their choice.



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