

## Trade mark protection in South East Asia (ASEAN)

ASEAN is a region of rapidly developing economies. For companies who wish to enter the Asian and ASEAN markets, whether for product manufacture or sales of products and services, the most effective strategy is to file key marks very early.

South East Asia is a complex region with many and varied laws and processes, which can seem daunting. The following table identifies the key variations between the countries respecting first to file jurisdictions or recognition of trade mark rights resulting from use, enforcement, and timeframes to examination.

| Country     | First-to-file System | Member of Madrid Protocol for International Registrations | Approximate Time to Examination | Enforcement Proceeding                                 |
|-------------|----------------------|---|---------------------------------|--|
| Indonesia   | Yes                  | Yes   | 12 months                       | Infringement for registered marks                      |
| Malaysia    | No                   | No  | 8 months                        | Infringement and passing off                           |
| Philippines | No                   | Yes   | 8 months                        | Infringement and passing off                           |
| Singapore   | No                   | Yes   | 6 months                        | Infringement, consumer protection laws and passing off |
| Thailand    | Yes                  | Yes   | 12 months                       | Infringement for registered marks                      |
| Vietnam     | Yes                  | Yes   | 16 months                       | Infringement for registered marks                      |

FB Rice has a wealth of knowledge and experience for protection of trade marks in Asia and the ASEAN region. Together with first class associates on the ground in each country, we take the headache out of obtaining trade mark protection, streamline the complex processes and ensure the best possible registration outcomes.

*“FB Rice is well equipped for the ever-increasing globalisation of IP rights. It understands the way in which issues can extend across international borders and the importance of a watertight worldwide strategy... The outwardlooking Joanne Martin knows the ins and outs of the trademark filing process in China, South Korea and across the Association of Southeast Asian Nations as well as anyone. She is a discerning portfolio manager who lets nothing escape her eagle eye.”*

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If you have any questions or instructions please contact any member of the [Trade Marks team](#), or email [TradeMarks@fbrice.com.au](mailto:TradeMarks@fbrice.com.au).

## Indonesia

### 1. Commercial opportunities

Indonesia is the largest economy in the region and is a member of the G20 major economies. It has a population of approximately 250 million, more than half of which is under the age of 30. Commercial opportunities are vast, and a trademark registration offers a competitive advantage - the exclusive right to use that trade mark, and to prohibit third parties from doing so. Indonesia joined the ASEAN-Australia-New Zealand Free Trade Area (AANZFTA) Treaty in 2012 which has paved the way for international arbitration and for ease of intellectual property management.

### 2. First-to-file system

Indonesia is a first-to-file country. Therefore prior use of a mark does not establish rights, and filing dates are critical. If a mark is not registered in Indonesia, a third party can legitimately adopt and register it.

### 3. Faster process

As a party to the Madrid Protocol, Indonesia can be designated for filings under the International Registrations process which facilitates faster prosecution and registration, to around 18 months from filing to registration, in the absence of any objections.

### 4. Absence of effective unfair competition laws

As a first-to-file jurisdiction, trade mark registration provides enforcement rights against infringers, and it is possible to put together effective enforcement strategies combining options that include investigations, warning letters, criminal raid actions, and publicity measures to supplement infringement actions.

## Malaysia

### 1. Commercial opportunities

Malaysia is a key trading country in the region with a population of over 31 million. It has one of the best economic records in the ASEAN region, and is the third largest economy behind Indonesia and Thailand. The country is well on its way to meeting its VISION 2020 goals towards becoming a high income developed economy, with sustainable long term economic growth.

### 2. First-to-file system

Malaysia is not a first-to-file system and the first user has prevailing rights. However, registration provides strong and effective enforceable rights in an action for infringement and allows for certain criminal action against infringers.

### 3. Fast registration process

For an application which does not encounter any serious obstacles, a registration is likely to be achieved within 10 to 15 months from filing.

### 4. Effective enforcement laws

As Malaysia recognises trade mark rights resulting from use of a mark in Malaysia, both infringement and passing off actions are available for trade mark owners and provide effective enforcement tools.

## Philippines

### 1. Commercial opportunities

The Philippines has a population of over 106 million people. It is a newly industrialised country which is transitioning from an agricultural to a services and manufacturing economy. It is the 34th largest economy in the world with growing industries which include semiconductors, electronics, transport equipment and petroleum products. It is a founding and active member of ASEAN to promote economic development amongst the members.

### 2. Not a First-to-file system

The Philippines is not a 'first-to-file' system and the first user has prevailing rights. However, registration provides strong and effective enforceable rights in an action for infringement.

### 3. Efficient registration process

If an application meets official requirements and is not opposed, it is likely to be registered between 6 to 12 months of the filing date.

### 4. Common law and registered trade mark rights

Common law trade mark rights are recognised in The Philippines, however reinforcement of an unregistered mark is difficult. Having a registered trade mark provides strong and cost effective enforcement rights against infringers.

## Singapore

### 1. Commercial opportunities

With a population of over 5.7 million people, Singapore is one of the most densely populated countries in the world. It has emerged as a leader in financial, trade and wealth management for the ASEAN region, as well as a global hub for transshipment, oil and gas refining, and currency and commodity trading.

### 2. Common law and registered trade mark rights

Common law trade mark rights are recognised in Singapore through actions for passing off or infringement of well-known marks. However, registered trade mark rights make it easier to bring an infringement claim or to oppose a conflicting trade mark application.

### 3. Efficient and predictable registration process

As a party to the Madrid Protocol, Singapore can be designated for international registrations. If no objections are raised by the examiner and there are no oppositions, a registration will likely be obtained in 6 to 12 months. Additionally, the Intellectual Property Office of Singapore maintains a list of acceptable goods/services, which makes for easier drafting of specifications.

### 4. Effective enforcement laws

Singapore has a comprehensive set of statutory provisions on the protection of trade mark rights which draw inspiration from the UK/EU regime. Of particular relevance are the border enforcement measures, given that Singapore's port is one of the busiest in the world. Singapore also has a well respected judiciary that regularly decides trade mark disputes.

## Thailand

### 1. Commercial opportunities

Thailand is located in the heart of Southeast Asia and has a population of over 68 million people. In 2014, the government announced an agenda for economic reform which includes reduction in the cost of doing business, tackling corruption, better infrastructure and logistics, and the development of a digital economy. These reforms are aimed to improve the private sector, trade, and overseas investment.

### 2. First-to-file system

Thailand is a first-to-file jurisdiction. Even though it is possible to cancel a registered trade mark on grounds that another party has better rights within 5 years from the registration date or on grounds of bad faith registration, it is a very time-consuming process and much more costly than registering the trade mark. Trade mark registration provides prima facie evidence of ownership and validity.

### 3. Ease of enforcement

Trade mark registration is the most cost-effective way to ensure legal exclusivity for use of the mark for goods and services. Registration provides access to the most cost effective and speedy process for challenging infringement.

### 4. Absence of cost effective unfair competition laws

While it is possible to enforce unregistered trade marks on grounds of passing off, enforcement of an unregistered mark is much more difficult.

## Vietnam

### 1. Commercial opportunities

Vietnam's population is close to 100 million. The country is seeing rapid economic growth and is in a transition to an outwardly focussed, industrialised, market based economy. It has long term potential due to its young, increasingly wealthy population and as an importer of high quality products including agricultural and industrial equipment.

### 2. First-to-file system

Registration of trademarks in Vietnam is a critically important step for trade mark owners as the system is essentially a first-to-file country.

### 3. The trade mark registration process

The registration process is substantially harmonised with processes in other ASEAN countries and an application which does not encounter any objections is likely to be registered within 28 months of filing.

### 4. Absence of effective unfair competition laws

Consumer law and anti-competition law do not provide strong enforcement rights which will protect unregistered trade marks for which reason trade mark registration is recommended.