

IP Registration in ASEAN Thai Timber Association

by

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July 12, 2012

IP DUE DILIGENCE

Case Study

iPad VS Proview



Case study

The iPad trademark in China

iPad sales

- **2011:** China contributed 16% of Apple's revenues during its fiscal quarter, growing almost three times from a year earlier.
- **2012:** Demand for new iPads in China; unauthorized shops decreased more than for Apple's first two iPads
- ◆ People prefer to smuggle iPads from Hong Kong and America.



Background

In 2000: Proview International had registered the trademark "iPad" in Europe and other areas. Next year, Shenzhen Proview Technology had registered the mark "iPad" in China.

In 2009: Apple purchased the Right of use the mark "iPad" from associated company of Proview International and understood that they completely had the Right to use the mark in China.

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Case study

The iPad trademark in China

In 2010: Apple launched products under the name "iPad".

Apple sued Shenzhen Proview Technology and claimed they already bought the mark from Proview's Taiwan affiliate.

The Court **dismissed** for the reason that Apple bought the Right from Proview International **not** Shenzhen Proview Technology .

In 2011: Proview sued Apple agents and request for sale terminating of Apple's products in china.

Apple sued Proview and requested for compensation and the Right acknowledgement from Proview.

The Court **rejected** Apple's claim

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Case study

The iPad trademark in China

In 2012: Proview claimed that Apple infringed their trademark right.

Settlement

Apple paid USD 60 millions (about THB 1,900 millions) to Proview to settle the dispute over the "iPad" trademark in China.

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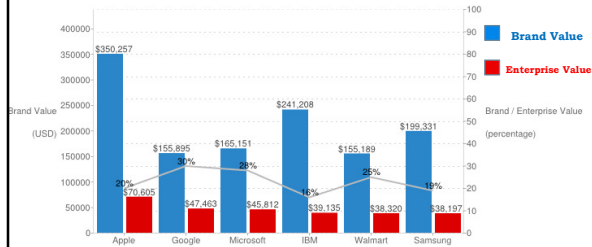
BrandZ™ Top 100 Most Valuable Global Brands 2012

#	Category	Brand	Brand Value 2012 (\$M)	Brand Contribution Index	Brand Momentum Index	% Brand Value Change 2012 vs 2011	Rank Change
1	Technology		182,951	4	10	19%	0
2	Technology		115,985	4	5	15%	1
3	Technology		107,857	4	5	-3%	-1
4	Fast Food		95,188	4	8	17%	0
5	Technology		76,651	4	8	-2%	0
6	Soft Drinks		74,286	5	7	1%	0
7	Tobacco		73,612	3	7	9%	1
8	Telecoms		68,870	3	5	-1%	-1
9	Telecoms		49,151	3	7	15%	4
10	Telecoms		47,041	4	9	-18%	-1

Source: Brandz.com

Brand comparison report

Brand Value / Enterprise Value* (as percentage)

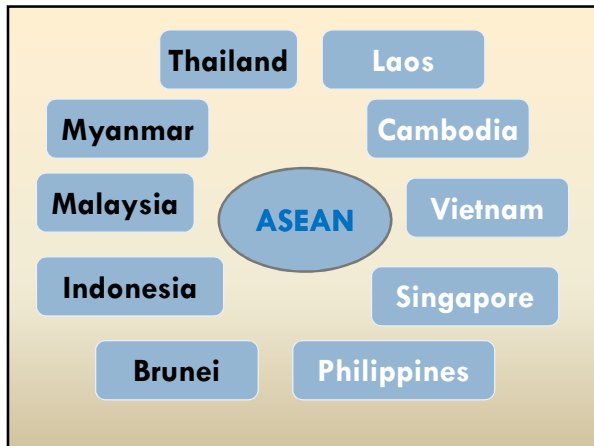


* For banks, enterprise value is substituted with market cap.

Source: Brandirectory.com

Agenda

- IP registration in ASEAN
- Sample on enforcement in ASEAN



IP registration in ASEAN

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IP protection in ASEAN

Country	Trademark	Patent	Design	Copyright
Thailand	✓	✓	✓	✓
Laos	✓	✓	✓	✓
Myanmar	?			?
Vietnam	✓	✓	✓	✓
Malaysia	✓	✓	✓	✓
Indonesia	✓	✓	✓	✓
Brunei	✓	✓	✓	✓
Cambodia	✓	✓	✓	✓
Singapore	✓	✓	✓	✓
Philippines	✓	✓	✓	✓

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Concurrent Protection of IP



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Considerations for trademark registration of healthcare and cosmetic products

□ List of goods

- **Class 19:** wood for making household utensils; wood paneling; wood paving; wood pulp board; semi-worked wood; worked timber; building cardboard; and building materials
- **Class 20:** furniture fittings; office furniture; furniture shelves; chairs; shelves; and cabinets
- **Class 35:** retail and wholesale services; the bringing together for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods

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MALAYSIA



Trademark registration in Malaysia

- First to Use Principle
- Registration of a trade mark is important, to obtain exclusive rights for the purpose of exploitation and commencing infringement actions. However, registration is not compulsory.
- The registration procedure lasts around 24-36 months.

Trademark registration in Malaysia

- The validity period of a registered trademark is 10 years, counted from the filing date, and it is renewable for periods of 10 years thereafter.
- It is possible to file an intent-to-use application in Malaysia.
- The minimum period of use to avoid a non-use cancellation action is 3 years.

Malaysia Notes

- A common-law country
- Series mark is possible
- Single-class filing
- Using British English eg. tyre v. tire



Trademark registration in Indonesia

- First to File System
- The registration procedure lasts 2 years from the filing date.
- Protection lasts 10 years from the application filing date.
- The trademark renewal may be done within 12 months before expiry. There is no grace period allowed for the renewal.

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Non-Use Cancellation in Indonesia

- Non-use for **3 consecutive years** use would make the registration vulnerable to cancellation.

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Indonesia Notes

- Single-class country
- Number one of trademark squatting
- Cancellation on bad faith is really difficult
- Additional fees from the 3rd description of goods

BRUNEI



Trademark registration in Brunei

- First to Use System
- An application in Brunei may be filed on the basis of intent to use, or actual use of the marks, without submitting evidence of use or non-use.

Trademark registration in Brunei

- The registration procedure lasts around 1-2 years
- Protection lasts 10 years from the registration date, and renewable for periods of 10 years thereafter.

Non-Use Cancellation

- The registration of a trademark may be revoked if:
 - within the period of **5 years** following the date of completion of the registration procedure, it has not been put to genuine use in Brunei Darussalam, by the proprietor, or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for such non-use.
 - such use has been suspended for an uninterrupted period of **5 years**, and there are no proper reasons for such non-use.

PHILIPPINES



Trademark registration in the Philippines

- ❑ First to Use System
- ❑ The registration procedure lasts around 18 -24 months

Trademark registration in the Philippines

- ❑ Trademark registrations shall be in force for 10 years, and may be renewed for periods of 10 years.
- ❑ To maintain a trademark registration, the following must be submitted:
 - Declaration of Actual Use and proof of use within **3 years** from the date of filing the application.
 - Declaration of Actual Use and proof of use within **1 year** from the 5th anniversary of the date of the registration of your mark.

Philippines Notes

- ❑ A website page is by far accepted for the purpose of filing of the DAU
- ❑ Filing of application is encouraged even with the possible conflicting trademarks
- ❑ Customs measures is available



Trademark registration in Singapore

- First to Use
- The registration procedure lasts around 8-9 months.
- The registration of a trademark is valid for 10 years from the date of application, and is renewable for a period of every 10 years thereafter.

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Non-Use Cancellation

- The registration of a trade mark may be revoked on any of the following grounds:
 - without valid reasons, the owner of the registered mark has not commenced use of the mark within a period of **5 years** after the completion of the registration procedure;
 - without valid reasons, the use of the mark was suspended for an uninterrupted period of **5 years**.

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Singapore Notes

- ❑ Series mark is acceptable
- ❑ A registration in commonwealth country is useful in case of both absolute ground and relative grounds for refusal
- ❑ Madrid Protocol member



Trademark registration in Vietnam

- ❑ First to File Principle
- ❑ An application can be filed based on "intention to use"
- ❑ The registration procedure lasts around 24 months
- ❑ The registration of a trademark is valid for 10 years from the filing date, and is renewable for a period of every 10 years thereafter.

Non-Use Cancellation

- The registration of a trademark may be revoked provided that:
The trademark has not been used for **5 consecutive years**, without any justifiable reason.

Vietnam Notes

- A multiple-class country
- Additional fees applied for descriptions of goods beyond the 6th description
- Custom measure is available

CAMBODIA



Trademark registration in Cambodia

- First to file system
- Duration for the procedure:
 - It usually takes 5-6 months from the filing date to obtain a Trademark Registration Certificate
- Period of registration:
 - The term of protection of a trademark is 10 years from the date of filing (or from the priority date, if any) and is renewable for a period of every 10 years thereafter.

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Non-Use Cancellation

- At the end of each period of **5 years** from the date of registration, an Affidavit of Use, in the case where the mark has been used in Cambodia, or an Affidavit of Non-Use, if the mark has not been used in Cambodia, is required to be lodged with the Cambodian Trademark Office.
- If no Affidavit of Use/Non-Use is lodged, the trademark cancellation will be vulnerable to cancellation subject to a request by a third party.

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Cambodia Notes

- Single-class system
- Disclaimer is acceptable
- No specimens are necessary when filing Affidavit of Use/ Non-Use

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Trademark registration in LAOS

- ❑ First to file system
- ❑ The registration procedure lasts around 5-6 months.
- ❑ Registration Period:
The validity period of a registered trademark is 10 years, counted from the registration date.
- ❑ Renewal:
A renewal application must be filed before the expiry of protection. However, a grace period of six months is allowed after the expiry of the protection.

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Non-Use Cancellation

- ❑ If the owner does not use his registered trademark, or gives consent to use it, during a period of **5 consecutive years**, the exclusive use of the owner shall lapse, unless it is shown that special circumstances prevented the use of such trademark

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Trademark registration in Myanmar

- ❑ In the absence of a specific trademark law, trademarks/service marks are registered by means of Declaration of Ownership at the Registration Office, followed by publication of Trademark Cautionary Notices.
- ❑ The registration procedure lasts around 1 months
- ❑ The registration and publication is renewable/ re-published in every **3 years**.

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What is the role of a Trademark Cautionary Notice in Myanmar?

- ❑ The objective of publishing a cautionary notice in is to keep reminding the public of the ownership of the Trademark & Service mark, and thereby ward off a potential infringer or any imitations. In addition, it also puts weight/adds legitimacy in respect to the ownership of a Trademark & Service mark, in the case of litigation in court.
- ❑ However, it is not compulsory, nor is it stipulated by any law. However, it is an established practice in Myanmar. Additionally, such publication also has trade advertising and commercial value.

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Trademark Watch Services



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Copycats



Blueberry

BlackBerry

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Beerlao

Beerlao (Original)

The applied mark in Thailand



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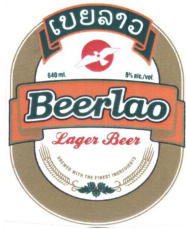
5151

Beerlao

Beerlao (Original)



The applied mark in Thailand



Trademark Watch Services

- ❑ Trademark watch services are designed to alert subscribers to potentially conflicting trademark applications, as they are published for opposition purpose in official gazettes throughout the world.
- ❑ The costs are charged on a yearly basis.
- ❑ A word mark and a device will be monitored and counted separately.

Benefits of Trademark Watch Services

- ❑ Prevent the registration of new trademarks, which are identical to, or very similar to, trade marks that may infringe a company's existing trade marks, or registered trademarks.
- ❑ It is always easiest to deal with such a situation before the latter party starts to build up their rights.

Case study on Racha Chooros

- [Laos-Video-Racha Chooros-Luang prabang.mpg](#)

Final thoughts for business

- IP as value-added tools
- Incoming IPRs/ Incoming applications
- No IP Harmonization
- Paradigm change

Thank you for your attention!

Questions...





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