

ASEAN INTELLECTUAL PROPERTY RIGHTS ENFORCEMENT HANDBOOK



one vision
one identity
one community



UK Government



FINANCIAL SECTOR AND
INTELLECTUAL PROPERTY
PROGRAMME

ROUSE

The Association of Southeast Asian Nations (ASEAN) was established on 8 August 1967. The Member States are Brunei Darussalam, Cambodia, Indonesia, Lao PDR, Malaysia, Myanmar, Philippines, Singapore, Thailand and Viet Nam.

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The manual was developed under the Financial Sector and Intellectual Property (FSIP) programme, a component of the ASEAN Economic Reform Programme funded by the United Kingdom's cross government Prosperity Fund. The Manual was created and coordinated by Rouse & Co International, in conjunction with PwC. The views recommendations and contents of this Manual do not necessarily represent or are not necessarily endorsed by the relevant agencies in ASEAN member states.

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INTRODUCTION

ASEAN seeks to transform itself into an innovative and competitive region through the use of Intellectual Property (IP). IP plays an important role in the conduct of trade and the flow of investment among the ASEAN Member States. The ASEAN member states are increasing their cooperation in IP to provide a firm basis for economic progress and to achieve both the realisation of the ASEAN Economic Community and prosperity among the ASEAN Member States.

The ASEAN IPR Action Plan 2016-2025 is designed to meet the IP goals of the ASEAN Economic Community. It helps ASEAN IP Offices adopt modern business models and practices and brings about a more competitive and productive ASEAN region through the effective exploitation and enforcement of IP. The ASEAN IPR Action Plan 2016-2025, comprises of four strategic goals:

- (i) Strategic Goal 1: A more robust ASEAN IP System is developed by strengthening IP Offices and building IP infrastructures in the region;
- (ii) Strategic Goal 2: Regional IP platforms and infrastructures are developed to contribute to enhancing the ASEAN Economic Community;
- (iii) Strategic Goal 3: An expanded and inclusive ASEAN IP Ecosystem is developed; and
- (iv) Strategic Goal 4: Regional mechanisms to promote asset creation and commercialization, particularly geographical indications and traditional knowledge are enhanced.

Initiative 12 under Strategic Goal 3 focusses on Implementation of a Regional Action Plan on IPR Enforcement. This seeks to improve information awareness activities (including development of information materials) on IP enforcement in the region. This Initiative addresses the lack of IP enforcement information, which affects transparency and prejudices the owners of IP in ASEAN Member States.

This IP enforcement manual seeks to provide all IP owners, IP holders or other interested parties with a clear explanation of the IP enforcement procedures in all 10 ASEAN Member States. The manual was developed under the Financial Sector and Intellectual Property (FSIP) programme, a component of the ASEAN Economic Reform Programme funded by the United Kingdom's cross government Prosperity Fund.

ASEAN Member States have differing legal systems and different procedures for IP enforcement, however, these are all consistent with the provisions in the World Trade Organisation Trade Related Aspects of Intellectual Property Rights Agreement (TRIPS Agreement). The TRIPS Agreement covers many forms of IP; however, the most commonly used IP enforcement procedures are for trademarks and copyrights. The illegal acts that trademark and copyright enforcement procedures cover are commonly called counterfeiting and piracy respectively. Trademark and copyright enforcement procedures generally include criminal, civil, customs and administrative remedies. Set out in this Handbook are the trademark and copyright enforcement procedures for all the 10 ASEAN Member States.

These IP enforcement procedures are up to date as of December 31st, 2019. Users of this Manual should take local legal advice to ensure accuracy.



BRUNEI DARUSSALAM

The manual was developed under the Financial Sector and Intellectual Property (FSIP) programme, a component of the ASEAN Economic Reform Programme funded by the United Kingdom's cross government Prosperity Fund. This Chapter was drafted by Rouse & Co International in cooperation with Ahmad Isa & Partners, Brunei.

IP ENFORCEMENT – BRUNEI DARUSSALAM

1. THE IP ENFORCEMENT SYSTEM

The procedures and rules for IP enforcement are set out in written laws in Brunei such as in the Trade Marks Act (Cap 98) and the Copyright Order, 1999. The common law doctrine of passing off may also apply to Brunei for IP enforcement. Laws of Brunei provide various civil and criminal remedies and enforcement measures.

2. TRADEMARKS AND COPYRIGHT

Trademark

The authority dealing with trademarks is the Brunei Darussalam Intellectual Property office. Trademarks are also protected under the common law doctrine of passing off besides registration under the Trade Marks Act (Cap. 98). Brunei is the 98th Member of the Madrid Protocol (international registration system).

Registration in Brunei is not compulsory prior to use but there are advantages in registering a trademark. If a trademark is registered, the owner acquires statutory and proprietary rights under the enabling legislation which are established and definite in nature. Protection of a registered trademark begins from the date on which the application for registration was filed.

Copyright

The legislation governing the protection of copyright in Brunei is the Copyright Order 1999 and amended in select sections by the Copyright (Amendment) Order 2013. Protection of copyright is automatic thus there is no formal procedure for registration in Brunei. There is no registry or any department in Brunei that accepts registration of copyright. The categories of work that the Copyright Order protects are literary works, dramatic works, musical works, artistic works, films, sound recordings, broadcasts, cable programmes and published editions.

3. CRIMINAL IP ENFORCEMENT

3.1.1 Criminal acts defined in the Trade Marks Act

Trademark infringement occurs when the infringer does any of the act stated under the Trade Marks Act. The relevant provisions considered to be infringements under the Trade Marks Act are:

- Unauthorised use of trademarks in relation to goods [Section 95];
- Falsely representing trademarks as registered [Section 97];
- Counterfeiting trademarks used by another [Section 98];
- Having possession of instruments for counterfeiting any trademark [Section 99];
- Importing or selling goods marked with a counterfeit trademark [Section 100];
- Falsely applying registered trademarks to services [Section 101]; and
- Unauthorised use of trademarks resembling the Royal Arms [Section 102].

3.1.2 Criminal procedure

3.1.2.1. Police

There are laws allowing a registered trademark owner to lodge a police complaint against a counterfeit product. We can lodge a complaint to the Royal Brunei Police Force for the counterfeiting activity and request the police to investigate for the purpose of commencing criminal prosecution. The police may conduct a raid and seize the counterfeit product. The trademark owner's representative will be called to assist the police.

3.1.3 Criminal Penalties under Trade Marks Act

The court may order the following penalties: -

- Under Section 94(6), any person found guilty of unauthorised use of trademark in relation to goods is liable on conviction to imprisonment for a term not exceeding 10 years, a fine or both.
- Under Section 96(3), any person found guilty of making, or causing to be made, a false entry in the register of trademarks is liable on conviction to imprisonment for a term not exceeding 5 years, a fine not exceeding \$50,000.00 or both.
- Under Section 97(1), any person found guilty of falsely representing trademark as registered is liable on conviction to a fine not exceeding \$10,000.00.
- Under Section 98(1), any person found guilty of counterfeiting trademark used by any other person is liable on conviction to imprisonment for a term not exceeding 5 years, a fine not exceeding \$10,000.00 or both.
- Under Section 99, any person found guilty of making or possession of instrument for counterfeiting trademark is liable on conviction to imprisonment for a term not exceeding 5 years, a fine not exceeding \$100,000.00 or both.

The court may also make the following orders under the Trade Mark Act: -

- Under Section 17, order for the erasure of the offending sign from the infringing goods.
- Under Section 18, order for delivery up of any infringing goods, materials or articles that are in the possession, custody or control of the infringer in the course of business.
- When the court makes an order under Section 18, the court may also make an order under Section 21 for the disposal of the infringing goods, or where there are grounds for the order for the disposal of the infringing goods, or where there are grounds for the order for disposal of the infringing goods.

Before making an order for disposal, the court shall consider what other remedies are available that are adequate to compensate the proprietor and to protect his interests.

3.1.4 Defences to trademark infringement

Under Section 94(5), it is a defence for a person charged with an offence of unauthorised use of trademark in relation to goods to show that he believed on reasonable grounds that the use of the sign in the manner in which it was used, or was to be used, was not an infringement of the registered trademark.

3.2 COPYRIGHT

3.2.1 Criminal acts defined in the Copyright Order

Criminal offenses amounting to Copyright and/or Related Rights infringement are laid down under Sections 203, 204, 204A, 204B, 205, 205A, 205B, 207 and 208.

3.2.1.1. Devices designed to circumvent copy-protection

Section 203(2) sets out 4 unlawful acts in relation to devices designed to circumvent copy-protection:

- The manufacture or importation for sale or rental of any device or means specifically designed or adapted to circumvent any device or means intended to prevent or restrict reproduction of a work, sound recording or broadcast, or to impair the quality of any copy thereof;
- The manufacture or importation for sale or rental of any device or means that is susceptible to enable or assist the reception of an encrypted program broadcast or otherwise communicated to the public, including by satellite, by any person not entitled to receive that program;
- Removal or alteration of any electronic rights management information without authority;
- Distribution, importation for distribution, broadcasting, communication or making available to the public, without authority, or a work, performance, sound recording or broadcast, by any person knowing or having reason to believe that electronic rights management information has been removed or altered without authority.

3.2.1.2. Offences involving making or dealing with infringing articles

Section 204 sets out a number of different unlawful acts in relation to making or dealing with infringement articles:

- Making for sale or hire infringing articles.
- Importing infringing articles other than for private and domestic use.
- Communicating the work to the public.
- In the course of business, possessing infringing articles with the intent of infringing.
- In the course of business, selling, letting for hire or exposing infringing articles as such, exhibiting in public or distributing.
- Other than the course of business, distributing to such an extent as to prejudicially affect the owner of the copyright.
- Making an article specifically designed or adapted to make copies of a particular copyright work.

3.2.1.3. Offences involving making and dealing with illicit recordings

Section 205 sets out a number of different offences in relation to making or dealing with illicit recordings:

- Making for sale or hire illicit recordings
- Importing otherwise than for his private and domestic use.
- Making available to the public.
- In the course of a business, possessing, with a view to commit any act infringing the rights conferred by Part III of Copyright Order.
- In the course of business, selling, letting for hire, offering or exposing for sale or hire or distributing.

3.2.1.4 False representation of authority to give consent

Section 207(1) provides that it is an offence for a person to falsely represent that he is authorised by any person to give consent for the purpose of part III of Copyright Order in relation to a performance, unless he believes on reasonable grounds that he is so authorised.

3.2.2 Criminal procedure for copyright crimes

To establish criminal liability for dealing with infringing articles, a person must:

- without the consent of the copyright holder;
- import otherwise than for private or domestic use, make for sale or hire, communicates the work to the public, in the course of business,
- possess with a view to committing any act infringing the copyright, in the course of business distribute to such an extent so as to prejudicially affect the owner of the copyright;
- any article which is, and which he knows or has reason to believe is, an infringing copy of a copyright work.

Public Prosecutor's Fiat

Section 214A allows private prosecution done by a private individual subject to the approval of the Public Prosecutor.

3.2.3 Criminal Penalties for copyright infringement

The court may order the following penalties:

- Under section 203A, any person who is found guilty of an offence relating to devices designed to circumvent copy-protection is liable on conviction to a fine not exceeding \$250,000.00, imprisonment for a term not exceeding 3 years or both, and in respect of a second or subsequent offence, to a fine not exceeding \$500,000.00, imprisonment for a term not exceeding 5 years or both.
- Under section 204 (5) any person who is found guilty of an offence who without the licence of the copyright owner makes for sale or hire; imports otherwise than for his private and domestic use; communicates the work to the public; in the course of a business: (i) possesses with a view to commit any copyright infringement, (ii) sells or lets for hire, offers or exposes for sale or hire, exhibits in public, or distributes; otherwise than in the course of a business distributes as to prejudicially affect the copyright owner is liable on conviction to a fine not exceeding \$10,000.00 for the infringing copy of a or for each infringing copy of a work in respect of which the offence was committed, imprisonment for a term not exceeding 5 years or both, and in respect of a second or subsequent offence, to a fine not exceeding \$20,000.00 for the infringing copy of a work in respect of which the offence was committed, imprisonment for a term not exceeding 10 years or both.
- Under section 204(6), any person found guilty of an offence of making an article specifically designed or adapted for making copies of a particular copyright work or has such article in his possession, is liable on conviction to a fine not exceeding \$20,000.00 for each infringing copy of work in respect of which the offence was committed, imprisonment for a term not exceeding 10 years or both, and in respect of a second or subsequent offence, to a fine not exceeding \$40,000.00 for each infringing copy of a work in respect of which the offence was committed, imprisonment for a term not exceeding 20 years or both.
- Under section 205(5), any person found guilty of an offence for making, importing, possessing etc. of illicit recordings is liable on conviction to a fine not exceeding \$10,000.00 for the infringing copy of a work or for each infringing copy of a work in respect of which the offence was committed, imprisonment for a term not exceeding 5 years or both, and in respect of a second or subsequent offence, to a fine not exceeding \$20,000.00 for the infringing copy of a work or for each infringing copy of a work in respect of which the offence was committed, imprisonment for a term not exceeding 10 years or both

- Under section 205(6), any person found guilty of any other offence against section 205 is liable on conviction to a fine not exceeding \$25,000.00, imprisonment for a term not exceeding 3 years or both.
- Under section 207A, any person guilty of any offence against this Copyright Order is liable on conviction, if no other penalty is provided, to a fine not exceeding \$25,000 imprisonment for a term not exceeding 3 years or both.

3.2.4 Defences/exceptions: Acts not considered as Copyright infringement

The Copyright Order in chapter III provides certain exceptions to infringement. They are, inter alia, the following:

- Research and private study, under section 33 of the Copyright Order.
- Criticism, reviews and news reporting, under section 34 of the Copyright Order.
- Incidental inclusion of copyright material, under section 35 of the Copyright Order
- Educational use such as for the purpose of instruction or examination, anthologies for educational use, performing work in course of activities of educational establishment, recording by educational establishments of broadcasts and cable programmes and reprographic copying by educational establishments of passages from published works, under section 36-40 of the Copyright Order.
- For use in libraries and archives such as copying by librarians or archivists of articles in periodicals and parts of published works under section 41- 48 of the Copyright Order.
- Use for the purpose of public administration of legislative council, judicial proceedings, royal commission and statutory inquiries.
- Use of typeface in ordinary course of printing under section 58-59 of the Copyright Order.
- Transfer of copies of works in electronic form, under section 60 of the Copyright Order.

*The criminal procedure for trademark and copyright infringement is shown by way of a flowchart in Annex 1 of this Chapter.

4. CIVIL IP ENFORCEMENT

4.1 Trademark infringement

4.1.1 Registered Trademark infringement

Section 67 states that in all legal proceedings relating to a registered trademark, the registration of a person as a proprietor is prima facie evidence of the validity of the original registration, and of any assignment or transfer of it.

4.1.2 Well known Trademark infringement

Section 54 gives the proprietor of a trademark who claims protection under the Paris Convention that his trademark is a may apply to restrain by injunction the use in Brunei Darussalam of a trademark which, or the essential part of which, is identical or similar to his trademark, in relation to identical or similar goods or services, where the use is likely to cause confusion.

4.1.3 Surrender of Trademark infringing goods

Under Section 87 provides that where a defendant is sued to surrender goods that use a trademark without authority, the judge may order that the surrender of said goods or value of the goods to be executed after a court's decision. The order is final and binding.

4.1.4 Civil remedies for Trademark infringement

Section 16 entitles only the proprietor of a trademark to bring infringement proceedings. Available remedies are damages, injunction and account of profits.

The court may make the following orders where a person is found to have infringed a registered trademark:

- Order for erasure of an offending sign [Section 17];
- Order for delivery up of the infringing goods to the proprietor of the trademark or such other person as the court may direct [Section 18]; or
- Order for the disposal of infringing goods that were delivered up to such persons [Section 21].

Where the court determine that the infringing goods that were imported were not for private and domestic use, the court shall make an order that the goods be:

- Forfeited, destroyed or otherwise [Section 89(1)]; or
- Sold where more than one person is interested in any infringing goods, and the proceeds divided [Section 89(3)].

4.2 Copyright infringement

Under section 99 of the Copyright Order, an infringement of copyright is actionable by the copyright owner. All such relief by way of damages, injunction, account or profits or otherwise is available to the copyright owner.

4.2.1 Civil remedies for copyright infringement

The remedies available in a copyright infringement are:

- Order for deliver up of the infringing copy or article to the copyright owner or such other person as it may direct [Section 101];
- Seizure and detention of the infringing copies of the work [Section 102];
- Injunctive relief and prohibition of the act, or a disclaimer to disassociate the author or director from the treatment of the work [Section 105(2)]
- Forfeit or deliver the infringing work to the owner or destroy the infringing work [Section 212].

5. CUSTOMS IP BORDER ENFORCEMENT

5.1 Customs authority in Brunei Darussalam

The customs authority in Brunei Darussalam is a government entity named Royal Customs and Excise Department and it is in charge of monitoring all goods entering and leaving Brunei. It is authorised to levy duties on goods imported into the country. Customs levies duties on specific goods at rates prescribed under the Customs Act. Under the trademark laws of Brunei a trade mark owner who suspects that goods to be imported into Brunei are counterfeits, fakes or infringing the owner's trademarks may give notice to the Controller of Customs who shall prevent such identified goods from entering the country by detaining or seizing the goods at the point of entry. Customs registration is available for border control in Brunei. A copy of the registration certificate of trademark is needed. If the mark has been renewed, a copy of the certificate of renewal is needed.

The Customs in Brunei will act only upon receiving notice (Notice requesting detention of goods infringing registered trade \mark) with covering letter from a trademark owner or authorized agent that goods which are infringing his trademark are being imported into the country. A notice shall be in force not longer than 5 years from the date of the notice or if the registration of the trademark will expire within 5 years from the date of the notice, not later than such date of expiry.

The Customs are not positioned to keep a “watch” for possible infringing goods coming into the country. The notice to the Customs must contain sufficient particulars to support the applicant’s request to detain any infringing goods that are coming through the Customs. The Customs will be the one to determine what information / evidence they will require.

5.2 Enforcing Copyright through Customs

There is a provision under the Copyright Order, that is section 109, in which the owner of a copyright, who suspects that goods to be imported into Brunei are copyright infringing, may give notice to the Controller claiming his ownership of the created work and request the customs to treat as prohibited goods infringing copies of the work for a period of not exceeding five (5) years. The customs officers may treat the infringing copies as prohibited goods.

Written notice has to be given by the owner of the copyrighted work to the Controller of Customs to prevent work that infringes copyright from entering Brunei. The owner of the copyright must firstly establish his ownership and provide the details of the infringing works coming into Brunei.

An owner of a copyright may not be entitled to damages against a defendant if the defendant can show that he/she did not know or have reason to believe that he/she had infringed a copyright.

5.3 Infringing copies may be treated as prohibited goods

The owner of a copyright may give notice in writing to the Controller of Customs claiming that he is the copyright owner and requesting for a period specified in the notice to treat as prohibited goods copies of work which are infringing copies for the purposes of the Copyright Order that are or at any time come under customs control.

5.4 Determination whether goods are infringing copies

Upon receipt of a notice and an officer of customs forms the opinion that any goods that have been imported and are under customs control may be infringing copies, the customs officer may conduct such investigation as he considers necessary to establish whether or not the goods appear to be infringing copies.

5.5 Detention of infringing goods

An officer of customs is entitled to detain goods where he has formed an opinion that any goods that have been imported and are under customs control may be goods to which a notice has been given by the copyright owner.

6. ADMINISTRATIVE IP ENFORCEMENT

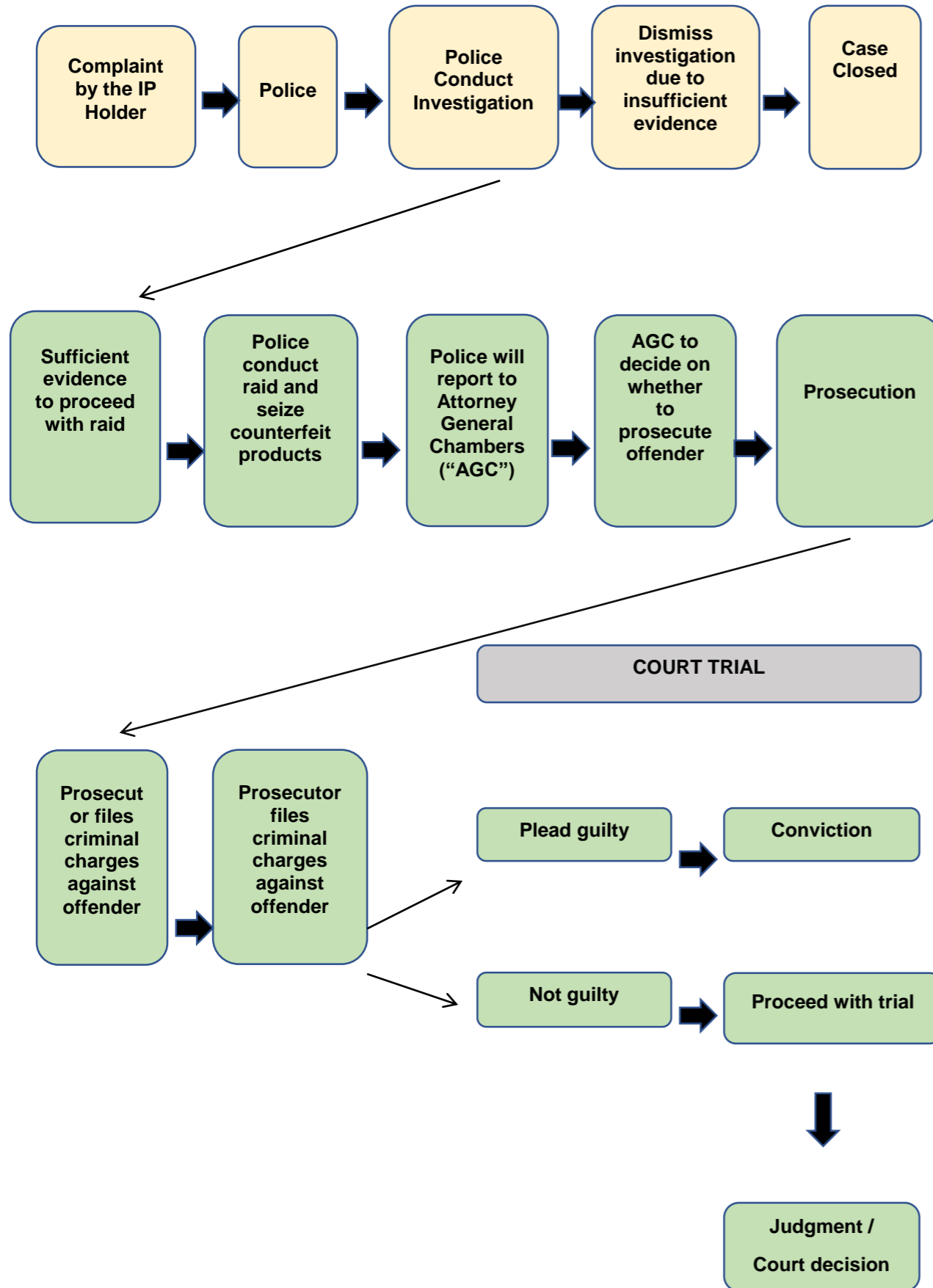
There is no specific enforcement agency in Brunei. Successful prosecution by police and custom controls are minimal.

7. OTHER ENFORCEMENT ISSUES

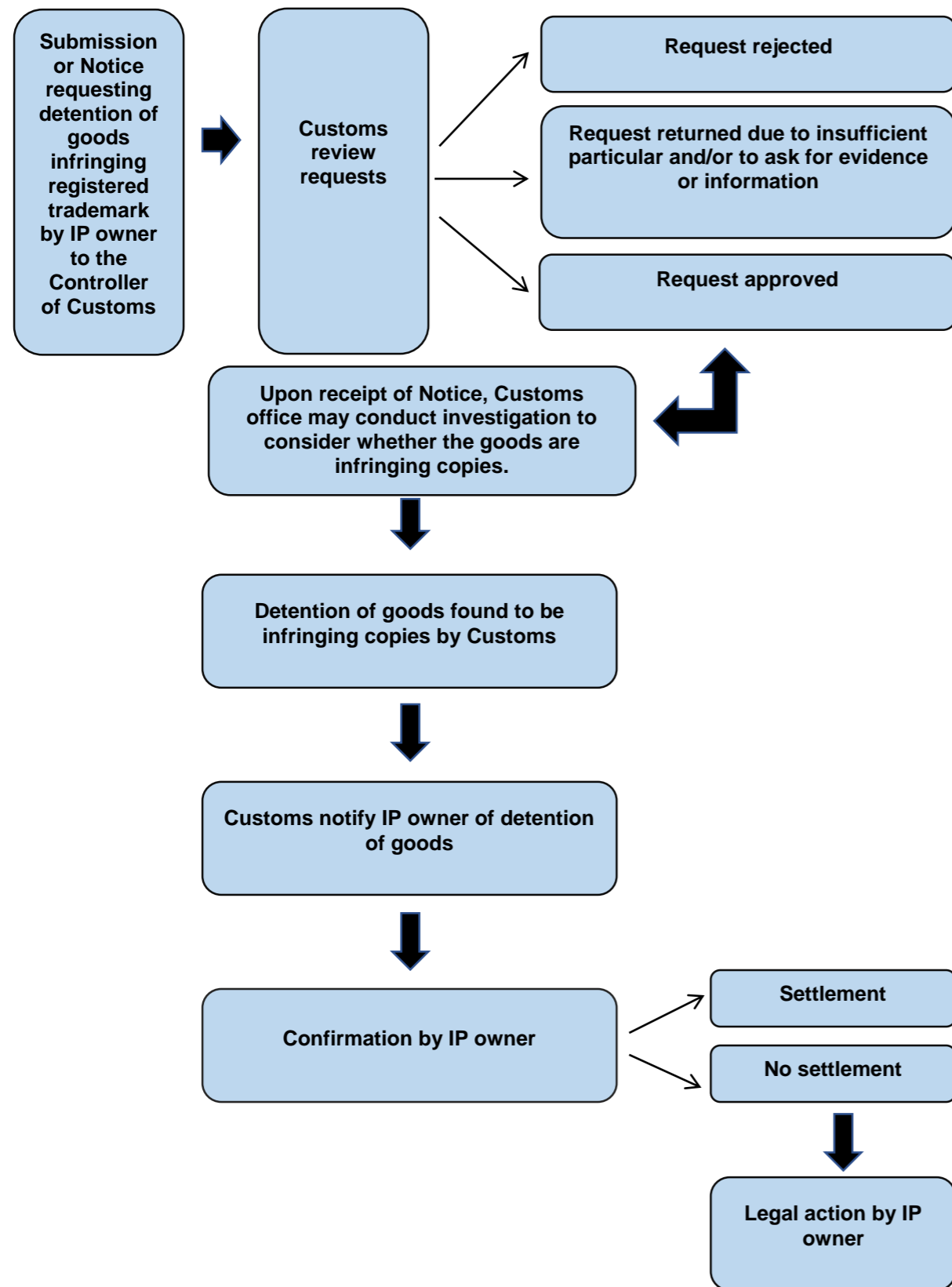
7.1 Warning letters and settlements

There are not many litigated cases of trademark infringement in Brunei as infringers will immediately respond and sign Undertakings to refrain from indulging in further misuse of the trademark. Successful prosecution by the police is really minimal. Similarly, there are not many litigations involving copyright infringement in Brunei.

ANNEX 1: FLOWCHART FOR CRIMINAL PROCEDURE FOR TRADEMARK AND COPYRIGHT INFRINGEMENT



ANNEX 2: FLOWCHART OF CUSTOMS RECORDAL PROCESS FOR TRADEMARK AND/OR COPYRIGHT





CAMBODIA

The manual was developed under the Financial Sector and Intellectual Property (FSIP) programme, a component of the ASEAN Economic Reform Programme funded by the United Kingdom's cross government Prosperity Fund. This Chapter was drafted by Rouse & Co International. The author is Sokunvannary Tep.

IP ENFORCEMENT – CAMBODIA

1. THE IP ENFORCEMENT SYSTEM UNDER TRIPS

Cambodia is a WTO TRIPS member, but it is exempted from obligations under TRIPs until July 2021 being a Least Developed Country.¹

Cambodia is a civil law country therefore, written laws set out all the rules and procedures for IP enforcement. These comprise of:

- Civil remedies, comprising injunctions, damages, other remedies, right of information, right of indemnification to defendants, as well as provisional measures (preliminary injunctions and search and seizure order);
- Border measures; and
- Criminal remedies for trademark and copyright infringements.

This Manual sets out how these apply to counterfeiting (trademark infringements) and piracy (copyright infringement).

2. TRADEMARKS AND COPYRIGHT

Cambodia has a first-to-file trademark system. Accordingly, to be protected and enforceable, trademarks must be registered at the Department of Intellectual Property (DIPR) under the Ministry of Commerce (MOC) to be protected under the Law Concerning Marks, Trade Names and Acts of Unfair Competition (Trademark Law). While unregistered trademarks are not generally protected, there are exceptions to unregistered well-known trademarks in Cambodia. Under the Madrid Protocol, Cambodia accepts applications under the international registration system.

Cambodia is not a member of Berne Convention for the Protection of Literary and Artistic Works. However, Cambodian Law on Copyrights and Related Rights (Copyright Law) protects a wide range of creative works and confers both moral rights and the exclusive economic rights to conduct and control activities in relation to the author or owner's works. Based on the Copyright Law, works are automatically protected and enforceable in Cambodia if they are original and:

- Are works of nationals of Cambodia or of those who have habitual residence in Cambodia (including legal entities headquartered in Cambodia); or
- The work was first published, took place, fixed in Cambodia or transmitted from transmitters in Cambodia; or
- For works of first published abroad, they were brought to be published in Cambodia within 30 days of being first published abroad; or
- Are Work of architect erected in Cambodia, etc.

There is a voluntary recordal and deposit system of copyright works with the Ministry of Culture and Fine Arts (MCFA). The recordal/deposit of work however does not confer legal advantage for enforcement but practically serves the purpose of providing existence to given copyrighted work or for providing a presumption as to the ownership of the copyrighted work.

3. CRIMINAL IP ENFORCEMENT

3.1.1 Criminal Acts defined in the Trademark Law

Trademark infringement occurs when an infringer does any of the acts defined in Articles 24, 25, and 26 of the Trademark Law.

¹ https://www.wto.org/english/tratop_e/trips_e/ta_docs_e/7_1_ipc64_e.pdf

- Article 24: unauthorized use of a mark identical or similar to a registered mark for goods or services identical or similar to those of the registered mark.
- Article 25: unauthorized use of a mark identical with or confusingly similar to a registered well-known mark in Cambodia for identical or similar goods and services to those of the registered well-known mark. In case of dissimilar goods or services, the use must be in such a way that indicates a connection between those goods and services and the owner of the well-known mark and that the interest of the owner of the well-known mark are likely to be damaged by such use.
- Article 26: unauthorized use of a mark identical or confusingly similar to an unregistered well-known mark in Cambodia for identical or similar goods and services to those of the well-known mark.

3.1.2 Criminal Procedure for Trademark Infringement

Article 11 and 27 of Trademark Law states that offences under Articles 24, 25 and 26 constitute complaint-based offences. Trademark owners are required to file a complaint before any action is taken against the infringement. Criminal trademark cases may be filed with Anti-Economic Crime Police Department (Economic Police) or Cambodian Counter Counterfeit Committee (CCCC).

3.1.3 Economic Police or CCCC

According to Rule 5(3) of Prakas on Duty, Obligation, Rights and Structures of Anti-Economic Crime Police Department, Economic Police has duties to monitor and inspect all activities and offences against intellectual property infringement and conduct searches and investigation (in cooperation other authorities and court officials) to collect evidence and initiate court proceeding.

CCCC is a joint take force consisting of 14 ministries.² According to Sub-Decree No. 150, dated 31 October 2014 and Prakas No. 5619 dated, 23rd December 2014, CCCC is mainly tasked with combating all kinds of counterfeit products that area harmful to health and social safety in Cambodia.

3.1.4 Criminal Prosecution of Trademark Crimes

The Trademark Law does not provide a procedure for filing a complaint to courts. Therefore, we refer to Code on Criminal Procedure of Cambodia to deal with criminal prosecution of trademarks. According to Articles 5 and 6 of the Code on Criminal Procedure, a trademark owner may file a complaint as a plaintiff before the investigating judge or prosecutor to initiate the criminal action.

3.1.5 Criminal Penalties for Trademark Infringement

In a criminal trademark case, the court has the authority to award imprisonment and/or monetary fines.

The Trademark Law imposes penalties against trademark infringements as below:

- Under Article 64 of the Trademark Law, any person who counterfeits a trademark registered in Cambodia shall be liable to imprisonment from one to five years and/or a monetary fine of one to twenty million riels.
- Under Article 65 of the Trademark Law, any person who imitates a trademark registered in Cambodia shall be liable to imprisonment from one month to one year and/or a monetary fine of five to ten million riels.
- Under Article 66 of the Trademark Law, any person who purposely imports, sells, offers for sale or has for the purpose of sale of goods bearing a counterfeit mark shall be liable to imprisonment from one to five years and/or a monetary fine of one to twenty million riels. For those who purposely import, sell, offer for sale or has for the purpose of sale of goods bearing

² Ministry of Interior, Ministry of Justice, Ministry of Public Health, Ministry of Industry and Handicraft, Ministry of Information, Ministry of Tourism, Ministry of Education, Youths and Sports, Ministry of Agriculture, Forestry and Fishery, General Commissariat of National Police, General Department of Immigration, National Military Police, General Department of Customs and Excise, General Department of Cambodia Import-Export Inspection and Fraud Suspension (Camcontrol), and Department of Anti Economic Crime Police.

an imitated mark shall be liable to one month to one year and/or a monetary fine of five to ten million riels.

- Under Article 67 of the Trademark Law, any person who repeats the same offence is subject to double fine and imprisonment as stated in Article 64 and 65.

3.1.6 Defences to Trademark Infringement

Article 47 of the Trademark Law provides that counterfeit goods of a non-commercial nature in travellers' personal luggage are excluded from the application of the Trademark Law.

3.2.1 Criminal Acts defined in the Copyright Law

Criminal offences for copyright or related rights infringement are laid down under Article 62, 64 and 65 of the Copyright Law. These are separated into differently defined categories of infringing criminal acts.

3.2.1.1	Economic Rights Infringement	<p>Article 62 defines unlawful acts in relation to copyright and related rights infringement including rights management information and technological circumvention:</p> <ul style="list-style-type: none"> ▪ The production or reproduction for sale or lease of any device or means specifically designed for adapted to circumvent any device or means or intend to restrict the quantity of the reproduction of a work, a phonogram or a broadcast, or to impair the quality of the copies being made; ▪ The production or importation for sale or lease of any device or means that is susceptible to assist the unauthorized person in the reception of an encrypted program, which is broadcasted or otherwise communicated to the public, including broadcasting by satellite. ▪ The suppression or modification, without being permitted by the right-holder, of all information related to the regime of rights presented in electronic form. ▪ The distribution or importation for the purpose of distribution, broadcasting through broadcasting organization, communication to the public or making available to the public, without authorization, of works or performances, of phonogram or broadcast of the broadcasting organization, while knowing that the information related to the regime of rights, presented in electronic form, has been already been suppressed or modified.
3.2.1.2	Collective Management Organization (CMO) offences	<p>Under Article 11 of the Prakas (Declaration) of Collective Management Organization (CMO), any person who uses without permission any type of work of author under the supervision of CMO commits an offense.</p> <p>Article 14 of the Declaration requires that any CMO must obtain approval from MCFA, and such approval may be revoked if any irregularities are found in the conduct of CMO.</p>

3.2.2 Criminal Procedure for Copyright infringement

Article 57 of Copyright Law states that whoever suffers or risks suffering a violation of his/her copyright or related right can file petition to the court. Criminal copyright cases may be filed with Economic Police or CCCC.

3.2.3 Criminal Prosecution of Copyright infringement

Criminal prosecution for copyright is the same as trademarks – please refer to section 3.1.4 above.

3.2.4 Criminal Penalties of Copyright and Related Right infringement

Penalties are provided in Articles 64 and 65 of the Copyright Law and vary depending on the type of offences.

Article 64 imposes penalties for copyright infringement and states that all production, reproduction, or performance, or communication to the public, by whatever means, (of a work) in violation of the author's right, as defined by this law, are offences which must be punished by law. The penalties are as follows:

- Infringement of production or reproduction is punishable by six months to twelve-month imprisonment and/or five to twenty-five million riels fine.
- Importation or exportation of product obtained from the infringed acts of reproduction is punishable by six months to twelve-month imprisonment and/ or two to ten million riels fine.
- Performance or communication to the public is punishable one to three-month imprisonment and/ or one to five million riels fine. In case of having several offenses, punishment will be multiplied by the number of offenses.
- Double punishment of the previous case is applied in case of repeated offense.

Article 65 imposes penalties for related rights infringement as follows:

- Production or reproduction (of a work) without having authorization of the performer or phonogram producer or video producer or broadcasting organization, is punishable by six to twelve-month imprisonment and/or five to twenty-five million riels fine.
- Importation or exportation of phonogram, cassette, or video cassette without authorization of the performer or phonogram producer or video producer or broadcasting organization, is punishable by one to three-month imprisonment and/ or two to ten-million riels fine.
- Broadcasting by broadcasting organization without permission of the performer or phonogram producer or video producer or broadcasting organization, is punishable by one to three-month imprisonment and/or two to ten million riels fine.
- Double punishment is applied in case of a repeated offense.

3.2.5 Defences/exceptions: acts not considered as copyright infringement

Under Articles 23, 24, 25, 28, 29 and 50 of the Copyright Law, the following acts are not considered as copyright infringement:

- The importation of a copy or private reproduction of a published work for personal use. However, this does not extend to the reproduction of a work of architect, reprography of the whole or part of a book, musical work, a database in digital form, computer program (other than a backup copy), all of which would affect legitimate interest of the author or right-holder;
- Private representation made to family or friends.
- The use or reproduction of part or extract of published works for purposes of conservation, research, education – all of which are non-profit;
- Translation related to minority language.
- Analyses or short quotation.
- Broadcasting of press commentary.
- Dissemination of speeches address to public.
- Adaptation of comic or style.

- Reproduction of graphic or plastic work situated in the public which is not subject to subsequent reproduction.
- Reasonable portion of citation of published work with indication of source and/or the author's name.

*The criminal procedure for trademark and copyright infringement is shown by way of a flowchart in Annex 1 of this Chapter.

4. CIVIL IP ENFORCEMENT

The Cambodia judicial system consists of municipal/provincial courts (court of the first instance), appellate court and supreme court. There is no separate commercial or IP court. All civil cases including intellectual property civil disputes fall under the jurisdiction of municipal/provincial courts at the first instance.

An IP case shall be brought to municipal or provincial courts where the defendant resides or is domiciled, or has a registered address, or business or representative office.

4.1 Trademark and copyright civil case rules

Neither the Trademark Law nor Copyright law set out the detailed procedures to file a civil IP lawsuit in the court. The procedure to file a civil lawsuit is laid out under the Code of Civil Procedure and it is beyond the scope of this IP enforcement Manual to cover every kind of civil law procedure that might be possible in an IP case.

Civil IP cases are governed by:

- The law under which the case is filed – the Trademark Law or the Copyright Law; and
- Code of Civil Procedure.

4.2 Trademark Infringement

4.2.1 Registered Trademark Infringement

Based on Articles 11, 27 and 69 of the Trademark Law, the registered trademark owner may file a civil lawsuit with the municipal/provincial court against anyone who unlawfully uses mark that is similar to or identical for similar goods and services and request:

- Injunction, including preliminary injunction and provisional measures;
- Damages; and/or
- Destruction of counterfeit goods.

4.2.2 Well-known Trademark Infringement

Although an unregistered well-known mark is protected against infringement under the Trademark Law, it is not likely that such trademark rights can be enforced against any infringement in absence of registration.

4.3. Copyright Infringement

Copyright disputes can be subject to civil litigation a petition can be filed by the authors or right holders. The basis for a copyright civil court cases include offences as stated in section 3.2.1.1 above.

4.4. Civil IP Remedies in Trademark and Copyright infringement

All civil IP remedies for Trademark and Copyright cases are stated in the Trademark Law and Copyright Laws respectively.

4.4.1 Injunction and Preliminary Injunctions

Article 27 of Trademark Law provides that the Court may grant an injunction to prevent an infringement or an imminent infringement.

Similar to the Trademark Law, Articles 57 of the Copyright Law also allows the complainant to seek an injunction to prevent an infringement or an imminent infringement.

There is no detailed procedure on filing a request for an injunction or preliminary injunction in the Trademark Law and Copyright Law. The Court may refer to relevant provisions to make such request under the Code of Civil Procedure.

4.4.2 Damages

Both the Trademark Law and Copyright Law contain provisions that entitles the winning parties to damages.

The Trademark Law does not contain detailed rules on calculation or payment of damages.

The Copyright Law contains some reference to damages that states whoever suffers or risks to suffer a violation of his/her copyright or related rights can file a petition to court in order to claim for compensation, to redress moral injury, to return the disputed equipment or material, as well as to return any benefits derived from the illegal act.

4.4.3 Other remedies

Under Article 69 of the Trademark Law, the Court may order a temporary suspension or confiscation of goods suspected of being counterfeit and/or destruction of the infringing goods.

Under Article 58 of the Copyright Law, the Court has authority to order the confiscation, destruction of equipment or materials being produced or used or made available in an illegal manner, or of equipment used in the violation, and which are found in the possession of the defendant or are being held by the application of this law.

4.4.4 Right to Information

This refers to judicial orders that the infringer disclose the identity of third persons involved in the copyright and related right infringement. Presently, no provision in Trademark Law or Copyright Law exists.

When specific laws as such are silent and provide no proviso on disclosure of information, then rules on "Examination of Parties" of the Code of Civil Procedure will apply. Parties to the court proceedings are obliged to provide true testimony as required by the court. The refusal to testify without justifiable grounds is subject to a civil fine (Article 140 of Section II of Book II – Proceedings at the Court of First Instance of Code of Civil Procedure).

4.4.5 Indemnification of Defendant

This refers to protecting defendants from abuse by excessively aggressive Plaintiffs.

Both the Trademark Law and the Copyright Law provides two references to indemnification of defendant. Particularly when the complainant is held responsible for the injury caused to the defendant by:

- the execution of the provisional measures and
- the wrongful retention of goods (Article 34 and 41 of the Trademark Law and Article 59 and 63 of the Copyright Law).

4.4.6 Provisional measures

Injunction and preliminary injunction are described in section 4.4.1 above. However, other provisional measures can be made.

Under Articles 29, 35 and 69 of the Trademark Law, the trademark owner may request the court to issue a provisional decision to:

- Preserve relevant evidence with regard to the alleged infringement.
- Suspend clearance of goods suspected of being counterfeit; and/or
- Confiscate suspected infringing goods.

According to Articles 58, 59 and 66 of the Copyright Law, the copyright owner or right holder can request the court to:

- Confiscate equipment or materials being produced or used or made available in an illegal manner in violation and which are found in the possession of the defendant; and/or
- Confiscate subject matters reproduced from the unauthorized reproduction of a work; and/or
- Other measures to ensure the conservation of evidence, etc.

5. E-COMMERCE IP INFRINGEMENT FOR TRADEMARK AND COPYRIGHT

This section sets out the possible violations that relate to online traders as well as online intermediaries (such as ISPs, ecommerce platforms, etc.) at a civil and criminal level.

The Trademark Law and Copyright Law contain no specific provisions on e-commerce/digital infringement.

However, a recently promulgated Law on E-Commerce in Cambodia provides generally that if online intermediaries or e-commerce service providers knew that the content stored on their platforms may involve civil or criminal liabilities, they shall immediately take the following actions:

- Remove the suspected infringing contents and cease offering services in relation to such contents
- Maintain contents as evidence and report to the Ministry of Posts and Telecommunication (MPTC) and other competent authorities about the facts and identity suspected infringers. Upon receipt of the complaint, MPTC may also order online intermediaries or traders to:
 - Remove the infringing content
 - Suspend or cease rendering services to whom the infringing content belongs or
 - Suspend or cease services in relation to online contents.

Cambodia does not have internet or cyber laws.

6. CUSTOMS IP BORDER ENFORCEMENT

Cambodia does not have a customs recordal system in place. However, the IP owner or right holder can file a complaint with the Customs to suspend the suspected goods (for counterfeit goods or physical pirated items) at the border.

Article 35, 37 and 38 of Trademark Law and Article 63 of Copyright Law provide that within 10 working days from receipt of the complaint, the Customs shall confirm if the complaint is accepted, rejected or reserved for further consideration. The Customs may ask the IP owner or right holder to provide security or equivalent assurance to protect importers, exporters or owner of the goods.

6.1 Seizure/Suspension of Goods

According to Article 39 of Trademark Law and Article 63 of Copyright Law, upon accepting the complaint, the Customs shall suspend clearance of suspected goods for the initial period, and any extension thereof which is not more than of 10 working days, the Customs is required to immediately upon accepting the complaint, the Customs shall suspend clearance of suspected goods for the initial period,

and any extension thereof which is not more than of 10 working days, the Customs is required to immediately notify the importer and the applicant of the suspension and the grounds of such suspension.

6.2 Examination of Suspended Goods

According to Article 42 of Trademark Law which is also applicable to Copyright cases, the Customs or other competent authorities may allow IP owners, importers or exporter to examine the goods, and take some samples of the goods for examination, testing and analysing to determine whether the goods are counterfeit/pirated.

6.3 Legal Action/Settlement

According to Article 40 of Trademark Law and Article 63 of Copyright Law, within 10 working days from receipt of the suspension notice, if the court proceedings have not been initiated by the plaintiff, or the duly empowered authority has not taken the provisional measure to extend the suspension of suspected goods, or no settlement is reached between the parties, the Customs will release the goods, provided that all other conditions for importation or exportation have been complied with. The extension period can be made for a further 10 working days in appropriate cases.

*The process for suspension/seizure of suspended goods for trademark and/or copyright is shown in Annex 2 of this Chapter.

7. ADMINISTRATIVE IP ENFORCEMENT

In Cambodia, administrative measures are not obligated by law. In a trademark infringement case, the parties may seek intervention from DIPR. In copyright infringement case, the parties may seek mediation from MCFA.

8. OTHER ENFORCEMENT ISSUES

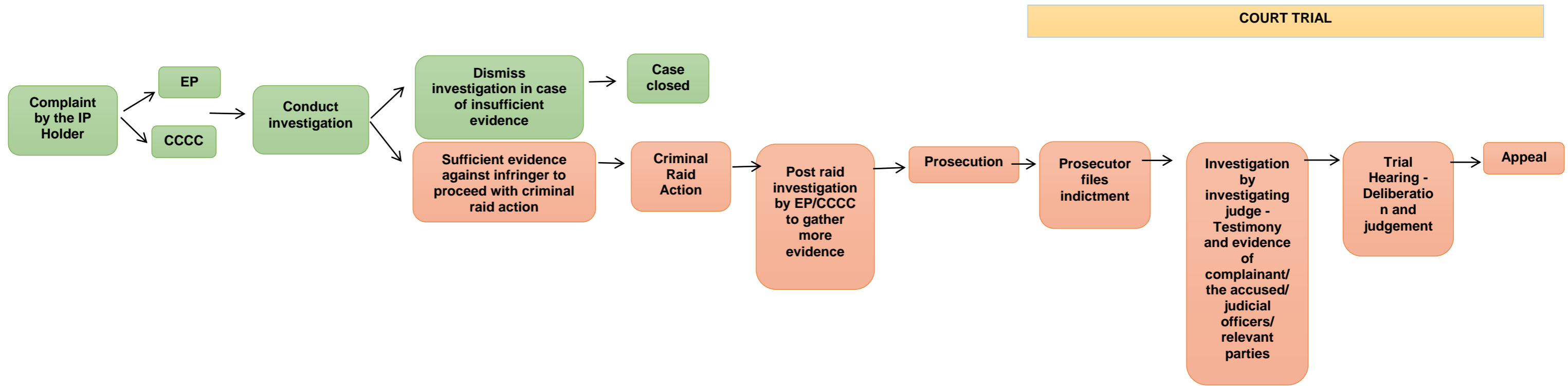
8.1 Alternative Dispute Resolution

Neither the Trademark Law nor the Copyright Law obligates parties to dispute to go through any alternative dispute resolution.

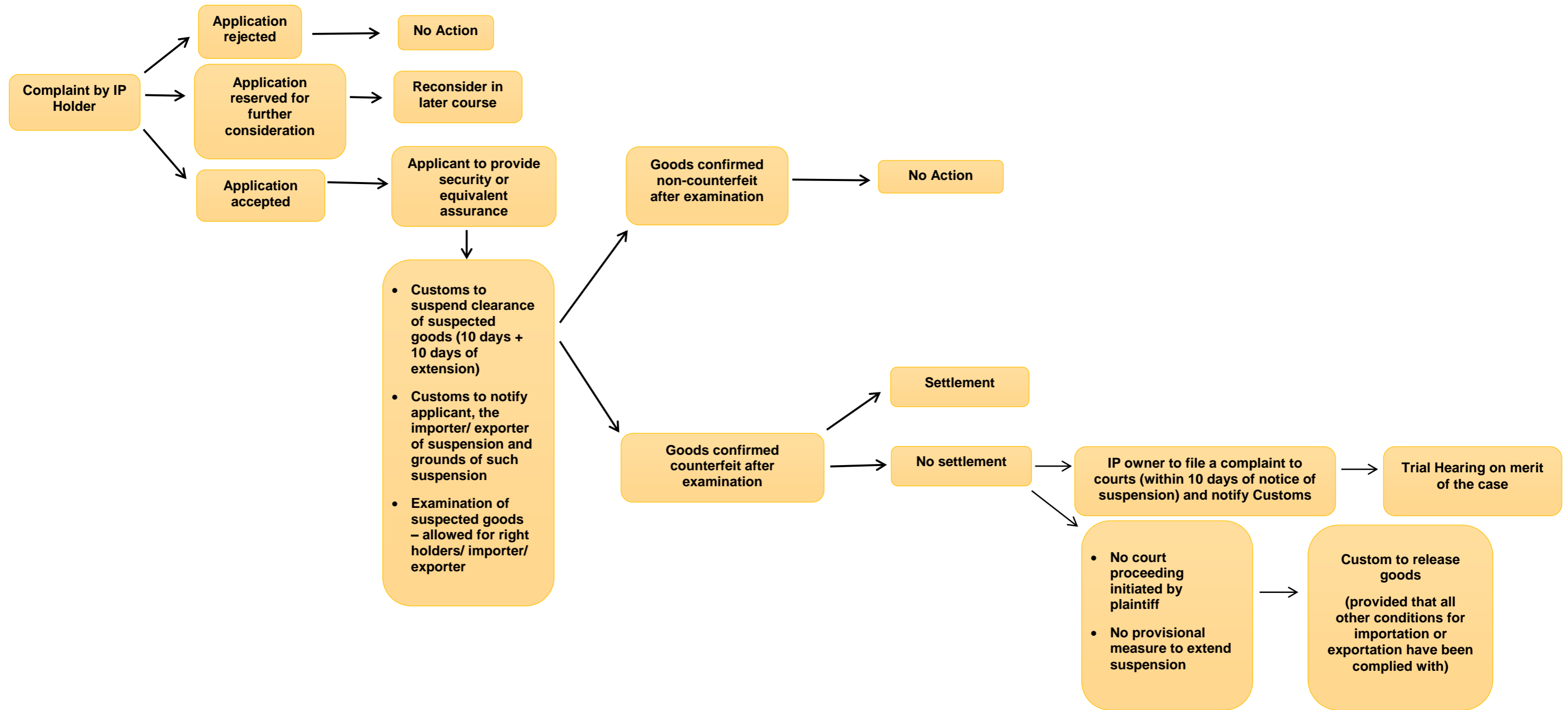
8.2 Warning letters and settlements

Many IP disputes are resolved by issuing a warning letter and the IP owner and the alleged infringer resolve the dispute. A settlement agreement and undertaking can be used to reach a resolution.

ANNEX 1: FLOWCHART FOR CRIMINAL PROCEDURE FOR TRADEMARK AND COPYRIGHTS



ANNEX 2: FLOWCHART ON CUSTOMS PROCESS FOR SUSPENSION/SEIZURE OF SUSPENDED GOODS FOR TRADEMARK AND/OR COPYRIGHT





INDONESIA

The manual was developed under the Financial Sector and Intellectual Property (FSIP) programme, a component of the ASEAN Economic Reform Programme funded by the United Kingdom's cross government Prosperity Fund. This Chapter was drafted by Rouse & Co International. The authors are Nicholas Redfearn and Anushka Arya.

IP ENFORCEMENT – INDONESIA

1. THE IP ENFORCEMENT SYSTEM UNDER TRIPS

Indonesia is a civil law country therefore, written laws set out all the rules and procedures for IP enforcement. As a WTO TRIPs member, Indonesia commits to providing enforcement measures³. These comprise of:

- civil remedies, including judicial procedures, evidence rules, injunctions, damages, other remedies, information to rights holder and right of indemnification to defendants, as well as provisional measures (preliminary injunctions and search and seizure orders);
- Suspension of release by customs authorities' criminal remedies, at least for willful trademark counterfeiting or copyright piracy on a commercial scale

This Manual sets out how these apply to counterfeiting (trademark infringements) and piracy (copyright infringements).

2. TRADEMARKS AND COPYRIGHT

Trademarks must be registered at the Directorate General of Intellectual Property to be protected, under Law No. 20 of 2016 (Trademark Law). There is no protection for unregistered trademarks. Under the Madrid Protocol, Indonesia accepts trademark applications under the international registration system.

Copyright protects a wide range of creative works under the Copyright Law No. 28 of 2014 (Copyright Law). It confers the exclusive economic right to conduct and control those activities in relation to the author or owner's works as well as moral rights. Copyright is protected upon creation of the copyright work. There is a voluntary recordal system for certain copyrights at the Directorate General of Intellectual Property (DGIP), but this confers no legal advantage for enforcement. It may assist practically to have all the copyright data already approved and the copyright data in local bahasa language.

3. CRIMINAL IP ENFORCEMENT

3.1.1 Criminal acts defined in the Trademark law

Trademark infringement occurs when an infringer does any of the acts defined in Article 100 and 102 of the Trademark Law. These broadly cover applying an infringing trademark and selling goods under an infringing trademark.

- Article 100 (1): unlawful use of trademarks, identical (similar in its entirety) to registered trademarks of other parties for goods of the same kind.
- Article 100 (2): unlawful use of trademarks, similar (in principal) to registered trademarks of other parties for goods of the same kind.
- Article 100 (3): an infringer whose goods could threaten human health, the environment, and/or cause death in humans.
- Article 102: trading in goods which are known to be or reasonably suspected to be counterfeit goods.

3.1.2 Criminal procedure for trademark infringement

Article 103 states that criminal offences in Article 100 to Article 102 constitute complaint-based offences. Trademark owners are required to file a complaint before any action is taken against the infringement.

³ Part III of TRIPS - Articles 41-61

Criminal trademark cases may be filed with the Police or DGIP's Civil Service Investigation Office (PPNS)⁴. Trademark owners also have the option to use alternate dispute resolution mechanism such as mediation, negotiation as well as concilitation before decide to proceed to the prosecution phase.

3.1.3 Police and the PPNS

Article 1 (1) and Article 6 of the Criminal Procedure Code defines an Investigator as an official of the National Police or the PPNS, who by law are granted special authority to conduct an investigation.

Article 99 empowers the investigating officers of National Police and the PPNS to investigate criminal offences for trademark infringement. The investigators have authority to:

- conduct examination on the accuracy of the report or information in relation to the criminal acts;
- conduct examination to any person allegedly committing criminal acts;
- request information and evidence from any person in relation to criminal acts;
- conduct examination on bookkeeping, records, and other documents in relation to criminal acts;
- search and conduct examination in places allegedly having evidence, bookkeeping, records, and other documents in relation to the criminal acts;
- confiscate infringing materials and goods as evidence in criminal acts;
- request expert statements in the implementation of their duties to investigate the criminal acts;
- request assistance from relevant institutions to arrest, detent, set a wanted list, and prevent the perpetrator from doing the criminal act; and
- dismiss investigation if there is no sufficient evidence for conviction of the criminal acts in the field of Trademarks.

The PPNS must notify the commencement of investigations to the public prosecutor with a copy to the investigator officers of the National Police. The results of investigation carried out by the PPNS are forwarded to the public prosecutor through the investigating officers of the National Police.

3.1.4 Criminal prosecution of trademark crimes

The Criminal Procedure Code outlines the duties of the investigator which includes:

- Preparing a report on the implementation of measures as intended in article
- The investigator shall hand over the dossier of the case to the public prosecutor

The handing over of the dossier may have several stages. At the first stage the investigator delivers the case dossier to the public prosecutor. If the public prosecutor considers it complete, the investigator transfers responsibility of the suspect and evidence materials to the public prosecutor to file the case in the court. In some cases, the dossier is incomplete so is returned for more investigations. After completion it is to be returned to the public prosecutor to decide whether the dossier has met requirements for transfer to the court.

*The criminal procedure for trademark infringement is shown by way of a flowchart in Annex 1a of this Chapter.

3.1.5 Criminal penalties for trademark infringement

The criminal court judge may order the following penalties. In practice judges may award penalties lower than this in most cases.

- Under Article 100 (1) any person who unlawfully uses trademarks that are identical (similar in its entirety) to registered trademarks of other parties for goods of the same kind shall be sentenced to imprisonment of up to five years and/or fine up to Rp2,000,000,000.

⁴ Penyidik Pegawai Negeri Sipil

- Under Article 100 (2) any person who unlawfully uses trademarks of similar nature (in principal) to registered trademarks of other parties for goods of the same kind shall be sentenced to imprisonment for up to four years and/or fine up to Rp2,000,000,000.
- Under Article 100(3) an infringer per Article 100 (1) and (2) whose goods could threaten human health, the environment, and/or cause death in humans shall be sentenced to imprisonment for a maximum period of ten years and/or a fine of a maximum amount of Rp5,000,000,000.
- Under Article 102 any person trading in goods which are known to be or reasonably suspected to be counterfeit goods shall be sentenced to imprisonment for a maximum period of one year or a fine of a maximum amount of Rp200,000,000.

3.1.6 Defences to trademark infringement

Indonesia's trademark law contains no specific defences. The closest to a defence would be under Article 102, where trading in counterfeit goods requires the prosecutor to prove that the trader knew or reasonably suspected the goods were counterfeit.

3.2.1 Criminal acts defined in the Copyright Law

Criminal offenses for copyright or related rights infringement are laid down under Article 112 to 120 of the Copyright Act. These are separated into differently defined categories of infringing criminal acts.

3.2.1.1	Rights management information and technological circumvention	<p>Article 112 contains two unlawful acts in relation to rights management information and technological circumvention measures for commercial use:</p> <ul style="list-style-type: none"> ▪ Unlawfully removing, changing or damaging copyright management information and copyright electronic information (defined under Article 7(3)) that are owned by the Author and/or ▪ Damaging, destroying, eliminating, or disabling the function of technological protection measures (defined in Article 52) used as a safeguard for the works or related rights products
3.2.1.2	Economic rights infringement	<p>The Copyright Law sets out different criminal offences for each of the different economic rights.</p> <p>Article 113 (1) sets out one criminal offence in relation to the economic rights of the author or the copyright holder:</p> <ul style="list-style-type: none"> ▪ the right to rental

		<p>Article 113 (2) sets out 4 criminal offences in relation to the economic rights of the author or the copyright holder:</p> <ul style="list-style-type: none"> ▪ translation ▪ adaptation, arrangement, or transformation ▪ performance ▪ communication <p>Article 113 (3) sets out 4 criminal offences in relation to the Economic Rights of the Author or the Copyright holder:</p> <ul style="list-style-type: none"> ▪ publication ▪ reproduction ▪ distribution ▪ publication <p>Article 113 (4) sets out an aggravated infringement offence of intentional piracy.</p>
3.2.1.3	Landlord liability- Sale of copyright infringing goods on landlord premises	Article 114 provides a criminal offence for those managing business premises where the owner deliberately and knowingly allows the sale and/or duplication of goods resulting into infringement of copyright and/or related rights in the premises that they manage (as set out in Article 10).
3.2.1.4	Infringement of publicity/advertising rights	Article 115 provides that where persons are portrayed in publicity/advertising images (as set out in Article 12), the commercial use, reproduction, publication, distribution or communication of their image rights for the purposes of advertising or publication in electronic and non-electronic media is an offence.
3.2.1.5	Infringement of Performers rights	Article 116 sets out criminal offences in relation to the economic rights of performers for commercial use:

		<ul style="list-style-type: none"> ▪ Article 116 (1) prohibits unauthorised rental to the public of fixations of performances [(defined in Article 23(2)(e))]. ▪ Article 116 (2) prohibits unauthorised broadcasting or communication of performances, fixation of unfixed performances, or making available of the fixation of performances to the public [defined in Article 23(2) (a) (b) and (f)]. ▪ Article 116 (3) prohibits unauthorised reproduction or fixation of performances [defined in Article 23(2) (c) and (d)]. ▪ Article 116(4) provides an aggravated infringement offence of intentional piracy.
3.2.1.6	Infringement of phonogram/sound recording rights of Producers	<p>Article 117 sets out criminal offences in relation to the economic rights of producers of phonogram/sound recordings for commercial use.</p> <ul style="list-style-type: none"> ▪ Article 117 (1) prohibits unauthorised rental of phonograms [defined in Article 24(2)(c)] ▪ Article 117 (2) prohibits unauthorised reproduction, distribution and making available by wire or wireless to the public [defined in Article 24(2) (a) (b) and (d)] ▪ Article 117(3) provides an aggravated infringement offence of intentional piracy.
3.2.1.7	Infringement of Broadcast rights	<p>Article 118 sets out criminal offences in relation to the economic rights of broadcasters.</p> <ul style="list-style-type: none"> ▪ Article 118 (1) prohibits unauthorised rebroadcasting, communica-

		<p>tion, fixation or reproduction of a broadcast [defined in Article 25(2) (a) (b) (c) and (d)].</p> <ul style="list-style-type: none"> ▪ Article 118 (2) provides an aggravated infringement offence of intentional piracy.
3.2.1.8	Collective Management Organization (CMO) offences	Under Article 119 any unlicensed CMO [(defined in Article 88 (3)] seeking to collect royalties commits an offence.

3.2.2 Criminal procedure for copyright crimes

Article 120 states that criminal offences in Article 112 to Article 119 constitute complaint-based offences. Copyright owners are required to file a complaint before any action is taken against the infringement.

Criminal copyright cases may be filed with the Police or PPNS (at the IP owner's choice). The copyrights owners are obligated to use alternate dispute resolution mechanism such as mediation, negotiation as well as conciliation. They can only proceed to the prosecution phase provided that the alternate dispute resolution mechanism failed.

3.2.3 Police and PPNS

Article 1 (1) and Article 6 of the Criminal Procedure Code defines an investigator as an official of the National Police or the PPNS, who by law are granted special authority to conduct an investigation.

Article 110 of the Copyright Law empowers the investigating officers of National Police and/or the PPNS to investigate criminal offences for copyright infringement. The investigators have authority to conduct:

- verification of the accuracy of the reports or information in relation to criminal offenses;
- examination of persons or legal entities allegedly committing criminal offenses;
- soliciting information and evidence from persons or legal entities in relation to criminal offenses;
- examination of books, records and other documents relating to criminal offenses;
- searching and examination of premises that are alleged contain evidence, bookkeeping, records and other documents relating to criminal offenses;
- confiscation and/or termination of circulation upon the permission of the court of materials and goods resulting from the offenses that may be used as evidence in a criminal case in the field of copyright and related rights in accordance with the Code of Criminal Procedure;
- request expert depositions in performing the tasks of criminal investigations;
- request for assistance from relevant institutions to arrests, detent, set a wanted list, prevent and deter against perpetrators of criminal offenses; and
- termination of the investigation if there is no sufficient evidence of criminal activity.

The PPNS must notify the commencement of investigation to the public prosecutor with a copy to the investigating officers of the National Police. The results of investigation carried out by the PPNS are forwarded to the public prosecutor through the investigating officers of the National Police.

Note: Article 95(4) requires mediation prior to criminal copyright action, with an exception in cases of Piracy.

3.2.4 Criminal Prosecution of copyright infringement crimes

Criminal prosecution for copyright is the same as trademarks – please refer to section 3.1.4 above.

*The criminal procedure copyright infringement is shown by way of a flowchart in Annex 1b of this Chapter.

3.2.5 Criminal Penalties for copyright infringement

The criminal court judge may order the following penalties. In practice judges may award penalties lower than this in most cases.

- Article 112: Any person who unlawfully causes removal of copyrights management information and/or technological circumvention offences shall be sentenced to imprisonment for up to two years and/or a fine up to Rp300,000,000.
- Article 113 economic offences vary depending on the type of offence:
 - Rental offences in Article 113 (1): A person shall be sentenced to imprisonment for up to one year and/or a fine up to Rp100,000,000.
 - Translation, adaptation, arrangement, or transformation, performance or communication offences in Article 113 (2): A person shall be sentenced to imprisonment for up to three years and/or a fine up to Rp500,000,000.
 - Publication, reproduction, distribution or publication offences in Article 113 (3): A person shall be sentenced to imprisonment for up to four years and/or a fine up to Rp1,000,000,000
 - Piracy offences in Article 113 (4): A person shall be sentenced to imprisonment for up to ten years and/or a fine up to Rp4,000,000,000.
 - Article 114 on Landlord offences: A person shall be sentenced to a fine up to Rp100,000,000.
 - Article 115 on Publicity/advertising rights offences: A person shall be sentenced to a fine up to Rp500,000,000.
- Article 116 Performers rights offences vary depending on the type of offence:
 - Rental offences in Article 116 (1): A person shall be sentenced to imprisonment for up to one year and/or a fine up to Rp100,000,000.
 - Broadcasting or Communication and fixation or making available offences in Article 116 (2): A person shall be sentenced to imprisonment for up to three years and/or a fine up to Rp500,000,000.
 - Unauthorised reproduction or fixation offences in Article 116 (3): A person shall be sentenced to imprisonment for up to four years and/or a fine up to Rp1,000,000,000.
 - Piracy offences in Article 116 (4): A person shall be sentenced to imprisonment for up to ten years and/or a fine up to Rp4,000,000,000.
- Article 117 Sound recording rights offences vary depending on the type of offence:
 - Rental offences in Article 117 (1): A person shall be sentenced to imprisonment for up to one year and/or a fine up to Rp100,000,000.
 - Unauthorised reproduction, distribution and making available offences in Article 117 (2): A person shall be sentenced to imprisonment for up to four years and/or a fine up to Rp1,000,000,000.
 - Piracy offences in Article 117 (3): A person shall be sentenced to imprisonment for up to ten years and/or a fine up to Rp4,000,000,000.

- Article 118 Broadcast offences vary depending on the type of offence:
 - Unauthorised rebroadcasting, communication, fixation or reproduction offences in Article 118 (1): A person shall be sentenced to imprisonment for up to four years and/or a fine up to Rp1,000,000,000.
 - Piracy offences in Article 118 (2): A person shall be sentenced to imprisonment for up to ten years and/or a fine up to Rp4,000,000,000.
 - Article 119 on CMO offences: A person shall be sentenced to imprisonment for up to four years and/or a fine up to Rp1,000,000,000.

3.2.6 Defences/exceptions: acts not considered as copyright infringement

Under Article 43 'acts' that are not considered as copyright infringement include:

- Publication, distribution, communication, and/or reproduction of state emblems and national anthem in accordance with their original nature;
- Publication, distribution, communication, and/or reproduction executed by or on behalf of the government in certain circumstances;
- Taking of actual news, either in whole or in part from a news agency, broadcaster, newspaper or other similar sources provided that the source is fully cited;
- Production and distribution of copyrighted content through information technology and communication media for non-commercial use which either provides a benefit to the Author or he expresses no objection.
- Reproduction, publication, and/or distribution of portraits of the president, vice president, former presidents, former vice presidents, national heroes, heads of state institutions, heads of ministries/non-ministerial government agencies, and/or the heads of regions taking into account the dignity and appropriateness thereof.

4. CIVIL IP ENFORCEMENT

Indonesia has a three-tiered civil court system, District Courts at the first level (located in each city/regency), High Court at the appellate level (located in each province), and the Supreme Court (located in Jakarta). Intellectual Property civil disputes such as Trademark and Copyright are under the jurisdiction of Commercial Courts. A Commercial Court which is a special chamber at the first instance level handles matters concerning bankruptcies, bank liquidations and intellectual property.

Currently there are five (5) Commercial Courts in Indonesia, with legal jurisdictions according to President Decree No. 97 of 1999 as follows:

Commercial Court	Province
Central Jakarta	Jakarta Special Region, West Java, Lampung, South Sumatera, West Kalimantan
Surabaya	East Java, South Kalimantan, Central Kalimantan, East Kalimantan, Bali, West Nusa Tenggara, East Nusa Tenggara
Semarang	Central Java and Yogyakarta Special Region
Medan	North Sumatera, Riau, West Sumatera, Bengkulu, Jambi, Aceh Special Region
Makassar (f.k.a. Ujung Pandang)	South Sulawesi, Southeast Sulawesi, Central Sulawesi, North Sulawesi, Maluku, Irian Jaya

IP infringement lawsuits addressed to the Chief Justice of the Commercial Court are heard in the jurisdiction where the defendant resides or is domiciled, except in a case where one of the parties resides outside Indonesia, then the lawsuit is addressed to the Chief Justice of the Commercial Court of Central Jakarta.

4.1 Trademark and copyright infringement civil case rules

4.1.1 Rules for civil IP cases

The Trademark Law and Copyright Law both set out the procedures to file a civil lawsuit in the commercial court. They cover matters such as how to file a case, the timetable, deadlines, decision structure and the appeal procedures.

The Civil Procedure Law⁵ also applies to cases in the Commercial Courts. The Trademark and Copyright Laws are termed 'special laws' so have priority, but where they are silent on an issue, provisions of the Civil Procedure Law apply.

Therefore, Civil cases in Indonesia are governed by three group of rules:

- The law under which the case is filed – the Trademark Law or the Copyright Law.
- The Rules of court as provided under the Civil Procedure Law
- There are Supreme Court regulations which cover certain detailed rules relating to trademark and copyright cases.

4.2 Trademark infringement

4.2.1 Registered trademark infringement

Article 83(1) entitles the registered Trademark owner to file a lawsuit with the Commercial Court against anyone who unlawfully uses a Trademark that is similar to or identical for similar kinds of goods and/or services and request a:

- claim for damages; and/or
- cessation of all acts related to the use of Trademark, including production, distribution, and/or trade in the goods and/or services which use the said Mark without the right thereto.

4.2.2 Well known trademark infringement

In Article 83(2) a special additional right is given to file a lawsuit to the owner of an unregistered well-known trademark based on a court decision.

4.3 Copyright infringement

Copyright disputes can be filed in the commercial court by authors, related rights owners, authors and heirs. The basis for copyright civil court cases includes:

- Infringement of copyright and related rights
- Cases of Piracy
- Cancellation of copyrights recoded with DGIP
- Moral rights violations

Note that cases may also be resolved by arbitration or alternative dispute resolution. All cases must undergo a mediation opportunity during the case.

Article 96 of the Copyright Law entitles a copyright owner to claim damages in the event of loss of Economic Rights of the Author, Copyright holder and/or Related rights holder.

4.4 Civil IP remedies in trademark and copyright cases

This section covers specific IP remedies required by the TRIPs agreement. It is beyond the scope of this IP enforcement Manual to cover every kind of civil law procedure that might be possible in an IP case.

⁵ Hukum Acara Perdata

4.4.1 Injunctions and preliminary injunctions

The Trademark Law contains two provisions. First, under Article 83(1) (b) the trademark owner plaintiff can request cessation of all infringing acts. Second, under Article 84 the trademark owner can seek an injunction to prevent further loss, cease all production, distribution, and/or trade of the goods and/or services of that Mark unlawfully.

The Copyright Law contains 2 provisions. First, under Article 99 (3), a copyrights/related rights holder may request for an interlocutory injunction to cease copyright infringing activities. Second, Article 106 provides for an injunction to prevent further loss to prohibit the act of infringement.

Supreme Court Regulation No. 5 of 2012 on Provisional Decisions set out rules for Preliminary Injunctions and these were adopted into the Copyright Law in 2014 and Trademark Law in 2016. Detailed procedures on filing a request, submitting evidence of IP ownership, details of the infringement, details of the IP owner are provided. The case is assigned to a Judge and should be heard within 4 days (2 days for Head of Commercial Court to assign case to judge, 2 days for assigned judge to decide). There is confidentiality in these proceedings up to the time the provisional decision is issued. Failure to comply with a Provisional Decision can be a criminal offence. After the provisional decision is executed there are *inter partes* hearings at which the evidence is taken and testimony is heard, then the judge may either confirm the provisional decision or revoke it. This must be completed within 30 days.

4.4.2 Damages

Both the Trademark Law and Copyright Law contain provisions entitling the winning parties to damages.

The Trademark Law contains no detailed rules on calculation or payment of damages.

The Copyright Law contains several references to damages. It defines damages as arising from economic loss. Payments must be made within 6 months of the court decision. In some cases it can comprise the income from infringement.

4.4.3 Other remedies

This refers to two remedies, one being disposal of infringing goods outside the channels of commerce and another being the seizure of tools and materials to create infringing goods.

The Trademark Law Article 84 (2) provides that a judge may order that the surrender of infringing goods or the value of the goods.

Under Article 99 (3) of the Copyright Law, a copyright owner can request a decision to seize infringing works and tools to produce them.

4.4.4 Right of Information

This refers to judicial orders, that the infringer disclose the identity of third persons involved in the production and distribution of infringing goods. No specific provisions in the Trademark Law or Copyright Law exist.

4.4.5 Indemnification of Defendant

This refers to protecting defendants from abuse by excessively aggressive Plaintiffs.

The Trademark Law and Copyright Law provide the right to damages and right to claim over the bond furnished by the plaintiff in the event that the interlocutory injunction is discharged following *inter parte* hearing. This is covered in Article 109(5) of the Copyright Law and Article 97(5) of the Trademark Law.

4.4.6 Provisional measures

Preliminary injunctions are described in section 4.4.2 above. However other provisional orders can be made.

Under Article 94 of the Trademark Law, a trademark owner may request a judge of the Commercial Court to issue a provisional decision to:

- prevent alleged import of infringing goods entering the market;
- seize evidence relevant to the trademark infringement;

- secure and prevent the loss of evidence by infringer; and/or
- prohibit the act of infringement to prevent greater damages

Under Article 106 of the Copyright Law, a copyright owner can request a provisional decision to

- prevent alleged import of copyright infringing goods entering the market;
- seize evidence relevant to the copyright infringement;
- secure and prevent the loss of evidence by infringer; and/or
- prohibit the act of infringement to prevent greater damages

Supreme Court Regulation No. 5 of 2012 on Provisional Decisions set out rules for Preliminary Injunctions and these were adopted into the Copyright Law in 2014 and Trademark Law in 2016. Detailed procedures on filing a request, submitting evidence of IP ownership, details of the infringement, details of the IP owner are provided. The case is assigned to a Judge and should be heard within 2 days. There is confidentiality in these proceedings up to the time the provisional decision is issued. Failure to comply with a Provisional Decision can be a criminal offence. After the provisional decision is executed there are *inter partes* hearings at which the evidence and testimony is heard then the judge may either confirm the provisional decision or revoke it. This must be completed within 30 days.

5. E-COMMERCE IP INFRINGEMENT FOR TRADEMARK AND COPYRIGHT

This section sets out the possible violations that relate to traders online, as well as online intermediaries (such as ISPs, ecommerce platforms etc) at a civil or criminal level.

5.1 Trademark violations

The Trademarks Law contains no specific provisions on e-commerce digital infringement. Cases about online trademark infringements by traders may follow the regular criminal or civil provisions. For intermediaries there is no specific trademark law liability.

5.2 Copyright violations

Under the Copyright Law, cases over online copyright infringements by traders may follow the regular criminal or civil provisions. For intermediaries there is no specific copyright law liability.

However, there is a no-fault type site/content blocking system under Articles 55-56 of the Copyright Law. This provides a system for blocking of access to infringing internet content by the Ministry of Communication and Informatics (KOMINFO). It is further regulated by a Joint Regulation of the Ministry of Law and Human Rights and Ministry of Communication and Informatics No. 14 of 2015 / No. 26 of 2015.⁶ Complaints must be reported to the Ministry of Law and Human Rights through the Directorate of Intellectual Property ("DGIP"). With sufficient evidence, the DGIP may recommend KOMINFO to block access to the infringing content. Pursuant to DGIP's recommendations, KOMINFO may block such content that infringes Copyrights and/or Related Rights in the electronic system or render the electronic system services inaccessible.

5.3 Internet law violations by intermediaries

There is a separate internet law regime which includes a notice and takedown and safe harbour system through which IP infringements appearing on internet intermediaries' online systems can be dealt with.

Article 25 of the Electronic, Information and Transactions Law, 2008 as amended in 2016 (EIT Law) states that content created on the internet is protected as Intellectual Property Rights. The Ministry of Communication and Informatics ("MOCI/KOMINFO") Circular Letter No. 5 of 2016 ("Circular") on the Limitations and Responsibilities of Platform Providers and Merchants in E-Commerce Using User-Generated Content Platforms was issued under the EIT law. This provides a safe harbour system for intermediaries who meet the requirements in it. These include ensuring that the intermediary imposes specified terms and conditions for its operation and usage by traders/users. Secondly, intermediaries must take action upon complaints by an IP owner to remove/block infringing content, along with a notice and takedown (and counternotice) system.

⁶[http://www.bentoelgroup.com/group/sites/bat_a4sq96.nsf/vwPagesWebLive/DO9T5K4G/\\$FILE/medMDA7TGDV.pdf?openement](http://www.bentoelgroup.com/group/sites/bat_a4sq96.nsf/vwPagesWebLive/DO9T5K4G/$FILE/medMDA7TGDV.pdf?openement)

6. IP Enforcement by Customs Authorities at the Border

Indonesia has established two mechanisms for IP enforcement by Customs Authorities at the border, judicial and ex-officio. Such mechanisms have already been regulated under Law No. 10 of 1995 as amended by Law No. 17 of 2006 on Customs. In fact, the mechanisms are in place since 1995 and already adopting the Section 4 (special requirements related to border measures) of Part III (Enforcement of Intellectual Property Rights) of the WTO TRIPS.

While IP enforcement by Customs Authorities in the WTO TRIPS only covers copyrights and trademarks, the Government Regulation No. 20 of 2017 made a huge leap by covering enforcement of not only copyrights and trademark, but also other IP rights.

For the Implementation of the Government Regulation, the Supreme Court has enacted Regulation (Peraturan Mahkamah Agung) No.6 of 2019 on Temporary Suspension Order and Ministry of Finance enacted Regulation (Peraturan Menteri Keuangan) No.40 of 2018 on Recordation, Detention, Guarantee, Temporary Suspension, Monitoring and Evaluation for Controlling Import and Export of Goods Suspected of IP Infringement.

Minister of Finance Regulation also covers enforcement of copyrights and trademarks at the border utilizing the new recordation system.

6.1 Recordation process for trademarks and/or copyright

The recordation system is a tool that can be utilized by Customs Authorities in its efforts to enforce IP under ex-officio mechanism. The system contains IP database (copyright and trademark) that are recorded based on the application request and data submitted by IP owner and/or IP holder.

IP owner/holder must provide assistance to the Customs Authority in the recordation application process and focal point that is able to response any queries from Customs Authorities in a swift manner. Therefore, it is important for IP owner/holder to have an established legal entity in Indonesia. In addition to trademark certificates or copyright information and information about the genuine goods, the application must include legal documents relating to the company, authorized importer/exporter information and a statement of liability from the IP owner/holder.

IP owner/holder must also appoint an Examiner who can verify genuine products and who understands distribution and trademarking of such genuine products. Once the application is submitted, Customs will review the application and approve/reject the application within 30 days. The record is valid for one year and is renewable.

6.2 Suspension of Goods

Customs Authority has the right to suspend the release of imported or exported goods suspected of infringing copyright and trademark. Customs will then notify the IP owner/holder of such suspension, the IP owner/holder will need to send confirmation of its decision to either apply to Commercial Court for suspension order or other legal action to Customs within two days.

6.3 Suspension order

Customs Authority has the right to suspend the release of imported or exported goods suspected of infringing copyright and trademark. Customs will then notify the IP owner/holder of such suspension, the IP owner/holder will need to send confirmation of its decision to either apply to Commercial Court for suspension order or other legal action to Customs within two days.

6.4 Examination of suspended goods

After receiving the suspension order, Customs will detain the goods for ten working days. The IP owner/holder and/or its representative must send request for examination schedule to Customs to examine the detained goods which will be attended by all related parties, including the Examiner. The request must be submitted at maximum two working days after Customs received the detention order. If more time is required, the IP owner/holder can apply to for extension of detention to Commercial Court for a maximum of ten working days.

6.5 Legal action/settlement

After the ten working days detention period, should the goods be proven to infringe IP and there be no settlement, the IP owner/holder can take further legal action which could mean either civil or criminal action or settlement.

*The Recordal process for trademarks and/or copyright is shown in Annex 2 of this Chapter.

7. ADMINISTRATIVE IP ENFORCEMENT

Indonesia does not use administrative remedies. Trademark and Copyright infringement is either criminal or civil.

8. OTHER ENFORCEMENT ISSUES

8.1 Alternate Dispute Resolution

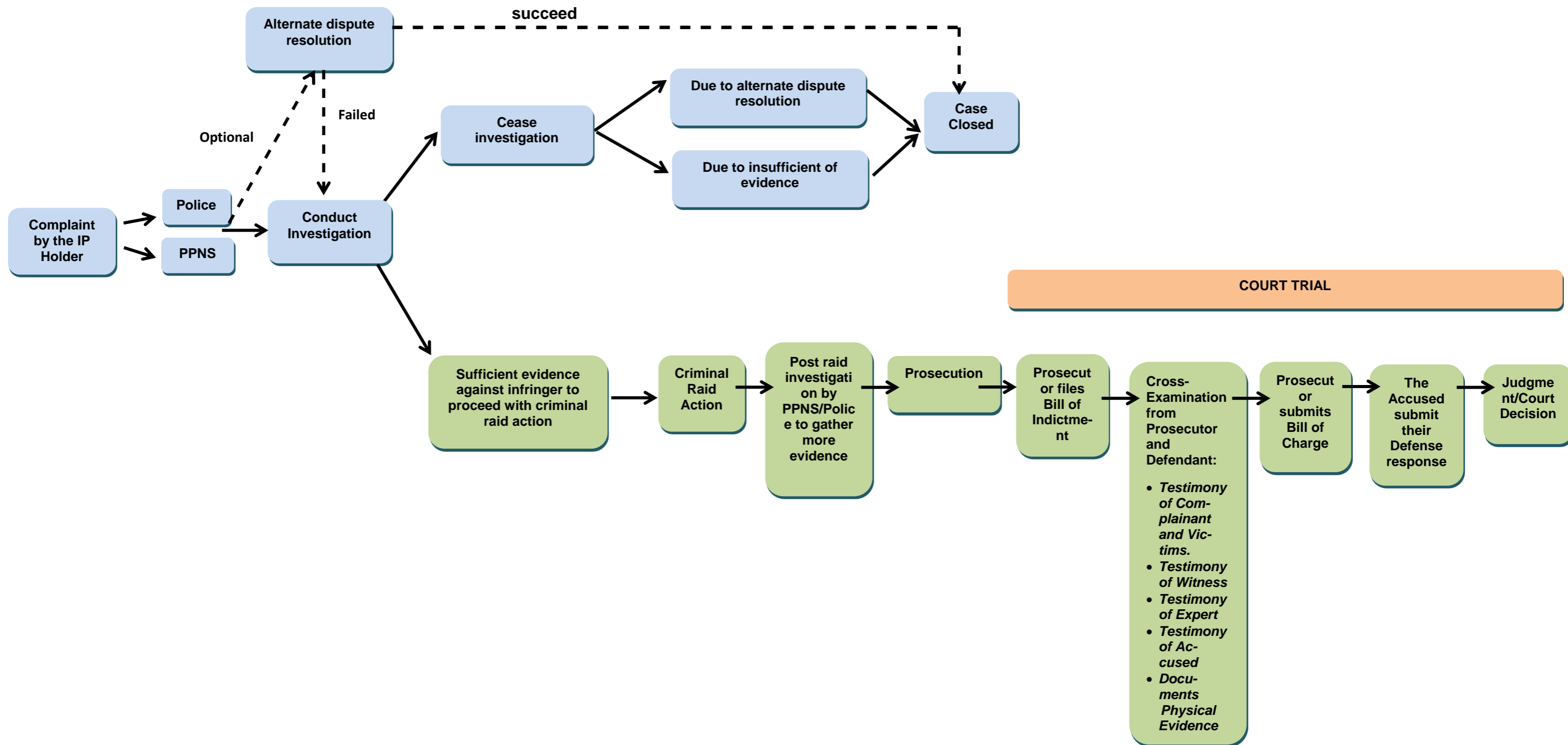
Article 93 of the Trademarks Law allows civil trademark infringement disputes to be settled through an arbitration or an alternative dispute resolution. This is defined in the Elucidation to the trademark law as negotiation, mediation, conciliation, and other means selected by the parties.

Article 95 of the Copyrights Law allows dispute settlement through alternative dispute resolution, arbitration or courts. In addition, where the parties are in Indonesia settlement of disputes through mediation is allowed.

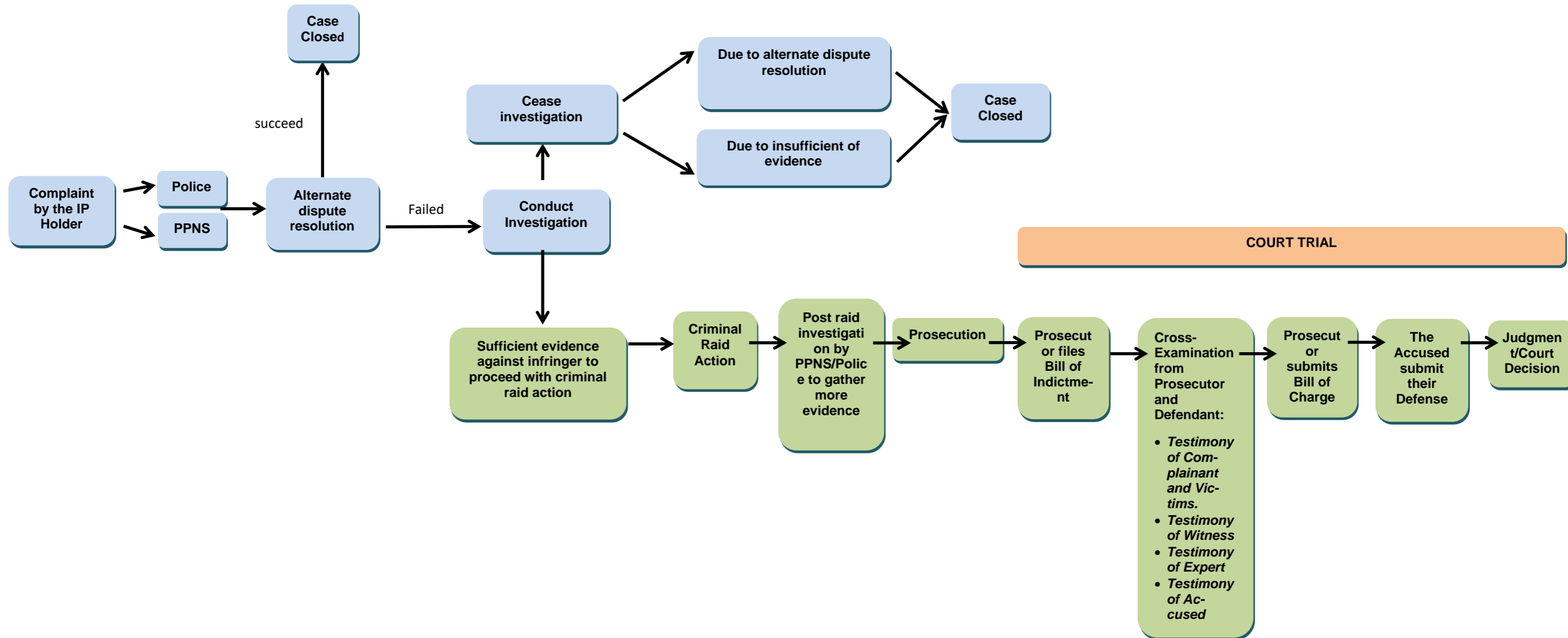
8.2 Warning letters and settlements

Many IP disputes are resolved by issuing a warning letter, and the IP owner and the alleged infringer resolve the dispute. Settlement Agreements and Undertakings can be used to reach a resolution.

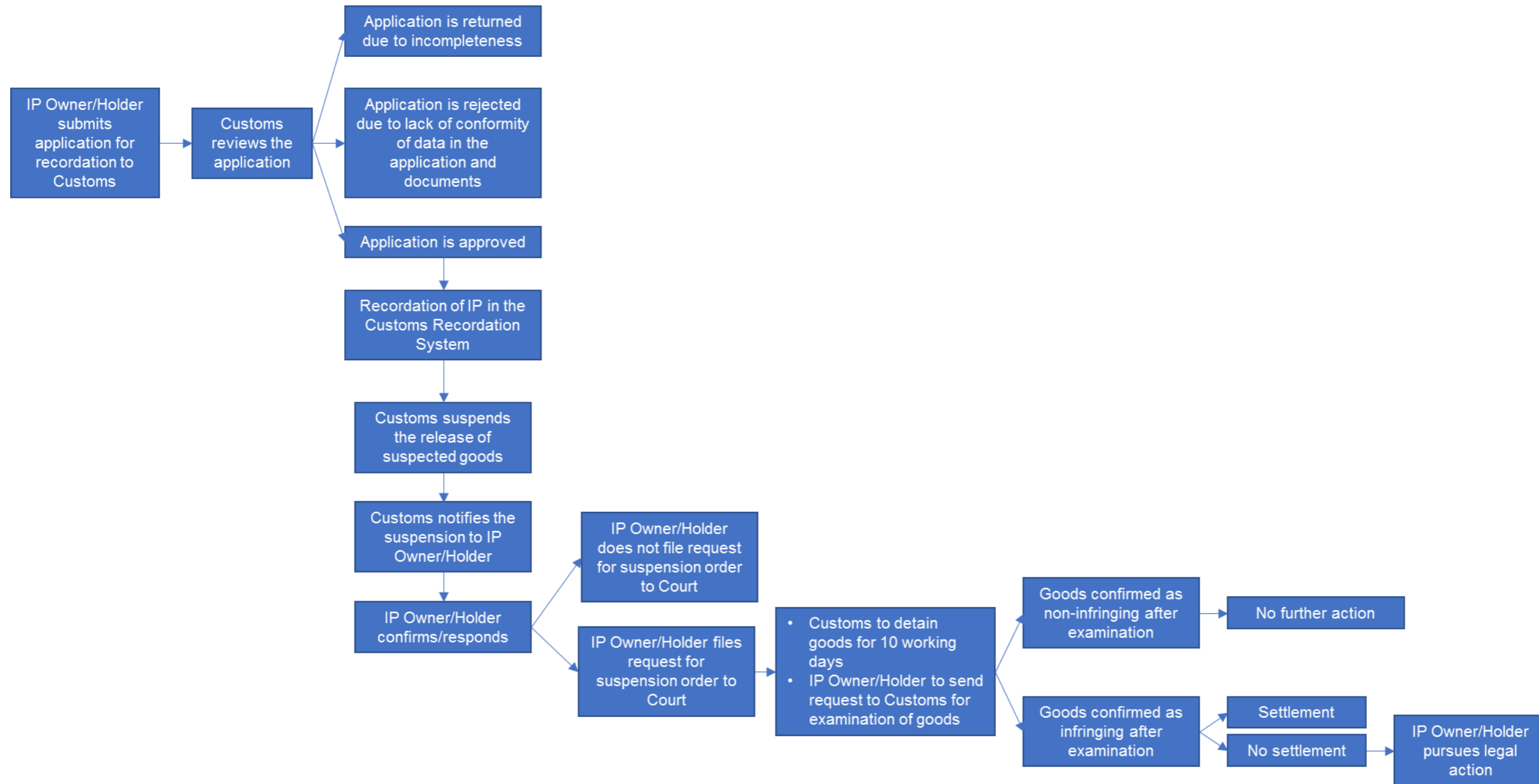
ANNEX 1a: FLOWCHART FOR CRIMINAL PROCEDURE FOR TRADEMARK



ANNEX 1b: FLOWCHART FOR CRIMINAL PROCEDURE FOR COPYRIGHTS



ANNEX 2: FLOWCHART ON CUSTOMS RECORDATION PROCESS FOR TRADEMARKS AND/OR COPYRIGHTS





LAOS

The manual was developed under the Financial Sector and Intellectual Property (FSIP) programme, a component of the ASEAN Economic Reform Programme funded by the United Kingdom's cross government Prosperity Fund. This Chapter was drafted by Rouse & Co International. The authors are Yen Vu, Trung Tran and Khanh Nguyen.

IP ENFORCEMENT – LAOS

1. THE IP ENFORCEMENT SYSTEM UNDER TRIPS

Laos is a civil law country; therefore, written laws set out all the rules and procedures for IP enforcement. As a WTO TRIPs member Laos commits to providing enforcement measures⁷. These comprise:

- civil remedies, comprising judicial procedures, evidence rules, injunctions, damages, other remedies, information to rights holder and rights of indemnifications to defendants, as well as provisional measures (preliminary injunctions and search and seizure orders);
- customs interceptions of infringements;
- criminal remedies, at least for willful trademark counterfeiting or copyright piracy on a commercial scale.

This Manual sets out how these apply to counterfeiting (trademark infringements) and piracy (copyright and related rights infringements).

2. TRADEMARKS AND COPYRIGHT

Laos's Law on Intellectual Property ("**IP Law**") stipulates trademark rights, copyright and related rights, among others, and protection of such rights. The law sets out acts of trademark infringement and copyright/ related rights infringement. IP Law also specify infringing acts that constitute IP offences.

2.1. Rights establishment/registration

Under Article 5.3 of IP Law, trademarks must be registered at the Department of Intellectual Property ("**DIP**"), under Ministry of Science and Technology ("**MOST**") to be protected. Rights to well-known trademarks are established based on trademark use instead of registration (Article 58 of IP Law). Under the Madrid Protocol, Laos accepts applications under the international registration system.

Copyright and related rights are established automatically upon creation and fixation of the works, without registration required (Articles 5.4 and 92 of IP Law). However, holders of registration certificates may use the certificates for evidence when it comes to a dispute or violation. IP Law protects literary, artistic, literacy works and their compilation under copyrights, with the work types specified in Article 92 of IP Law. In addition, performances, phonograms, broadcasts and satellite signals carrying encrypted or unencrypted programs are subject to the protection of related rights, under Article 96 of IP Law.

2.1.1. Trademark infringement

Under Article 58 of IP Law, a trademark owner has the rights to –

- prevent all third parties from using identical or similar signs for goods or services which are identical, similar, or related to those in respect of which the trademark is registered where such use would result in a likelihood of confusion;
- prevent the sales or advertisements of goods bearing the mark or the use of the mark in connection with services, and the importation or importation of goods bearing such a mark; and
- protect their rights against infringements by opting for Court action and invoking the rights to damages.

Accordingly, the above acts conducted without authorization will be considered as violations of industrial property rights, under Article 121 of IP Law.

Under Article 125 of IP Law, 'counterfeit trademark goods' shall mean any goods, including packaging, bearing without authorization a trademark which 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. It shall be a violation to manufacture, sell, offer for sales, advertise or otherwise market, or to import or export counterfeit trademark goods.

⁷ Part III of TRIPS - Articles 41-61

Under Article 148 of IP Law, the intentional infringements as provided in Article 121 of IP Law in relation to violations of industrial property rights⁸ and Article 125 of IP law in relation to trademark counterfeiting, will be considered as criminal offenses.

2.1.2. Copyright and Related Rights

2.1.2.1 Copyright

Copyright owners will have the moral rights⁹ to:

- First disclosure and publication of the works;
- Attribution, including the rights to –
 - claim authorship of the works;
 - have his or her name shown and used in connection with publicity concerning the work;
 - use a pseudonym or to publish the work anonymously;
 - object to any misattribution of the works;
 - object to the use of his or her name in connection with the works that the authors did not create or that has been modified.
- Object to any distortion, mutilation or any other modifications of the works, where such actions would be prejudicial to the author's honour or integrity.

The economic rights¹⁰ generally include –

- Making a collection of such works;
- Reproducing such work in any manner or form (including distribution of copies of such works);
- Translating the works;
- Broadcasting the works;
- Communicating the works to the public by any wire or wireless diffusion on by rebroadcasting;
- Communicating the broadcast of the work to the public by loudspeaker or any other analogous instrument transmitting, by signs, sounds or images.

Accordingly, the above acts conducted without authorization will be generally considered as copyright infringements, under Article 103 of IP Law.

2.1.2.2 Related Rights

Under Article 107 of IP Law, owners the related rights (i.e., performers) will have the moral rights to –

- claim to be identified as the performer of his performances (except where omission is dictated by the manner of the use of the performance); and
- object to any distortion, mutilation or other modification of his performances (that would be prejudicial to their honour and reputation).

Depending on the involvement in the making of the works, relevant stakeholders may have different sets of rights, including –

Performers/ Producers of Phonograms

- For unfixed performances (exclusively for performers):
- the broadcasting and communication to the public of their unfixed performances (except where the performance is already a broadcast performance);

⁸ Under Article 9 of IP Law, industrial property is composed of patents, petty patents, industrial designs, trademarks, trade names, layout-design of integrated circuits, geographical indications and trade secrets.

⁹ Article 101 of IP Law

¹⁰ Article 102 of IP Law

- the fixation of their unfixed performances.
- The direct or indirect reproduction of their performances fixed in phonograms or the phonograms themselves.
- The making available to the public through sale or other transfer of ownership (provided that such right shall not extend to subsequent sales or other transfers of ownership of the original and of the same copy of the fixed performance that has been lawfully sold or otherwise transferred with proper authorization);
- The commercial rental to the public of the original and copies of their performances fixed in phonograms or the phonograms themselves, even after such phonograms have been distributed under authorisation.
- The making available to the public of their performances fixed in phonograms or the phonograms themselves, by wire or wireless means, in such a way that members of the public may access them from a place and at a time individually of their choice.
- The transfer of ownership over performances works or phonograms by contract or inheritance.

Broadcasters and Broadcasting Organizations

- The fixation of their broadcasts.
- The reproduction of fixations of their broadcasts;
- The rebroadcasting by wireless means of their broadcasts.
- The communication to the public of television broadcasts of their broadcasts;
- The transferring to own broadcasts works by contract or inheritance.

Accordingly, the above acts conducted without authorization will be considered as infringements of related rights, under Article 112 of IP Law.

2.1.3 Infringements against copyright and related rights

Under Article 123 of IP Law, the infringements against copyright and related rights includes –

- committing an act of infringement as described in Article 103 or 112 of IP Law (as mentioned above);
- circumventing effective technological measures used by performers or producers of phonograms in connection with the exercise of their rights and that restrict acts, in respect of their performances or phonograms, which are not authorized by the performers or the producers of phonograms concerned or permitted by law;
- performing any of the following acts, knowingly or having reasonable grounds to know that it will lead to an infringement of copyright or related rights:
 - Removing or altering any electronic rights management information without authority;
 - distributing, importing for distribution, broadcasting, communicating or making available to the public, without authority, performances, copies of fixed performances or phonograms knowing that electronic rights management information has been removed or altered without authority.
- recording or disseminating of satellite signal carrying encrypted or unencrypted programs for commercial purposes without the authorization of the lawful distributors.

In addition, under Article 126 of IP Law, pirated copyright goods shall mean any goods:

- made without the consent of the right holder or person duly authorized by the right holder in the country of production;
- made directly or indirectly from an article including the use of any instruments for recording cinematographic works in the movie theatres.

It shall be a violation of IP Law to produce pirated copyright goods, or to, sell, offer for sale, advertise or otherwise market, or to export or import such goods.

3. CRIMINAL IP ENFORCEMENT

There are three main sets of regulations covering criminal IP enforcement in Laos –

- IP Law. This law will define criminal acts involving IP subjects and relevant thresholds for criminality;
- Criminal Procedure Code. This code will be relevant for procedure (within Police, prosecutors and criminal courts) from initiating an investigation against IP infringements to the final verdict against the infringers;
- Penal Code. The code simply mentions relevant IP criminal sanctions and violations.

3.1.1 Criminal acts defined in IP Law

Under Article 148 of IP Law, the criminal offences of IP are intentional violations of

- Article 121 of IP Law in relation to violations of industrial property rights¹¹;
- Article 123 of IP Law in relation to violation of copyright and related rights;
- Article 125 of IP in relation to trademark counterfeits; and
- Article 126 of IP Law in relation to copyright piracy.

Article 121 of IP Law lays out a framework on acts considered as violations of industrial property rights (including trademark rights) while Article 125 of IP Law expressly define 'counterfeit trademark goods' and relevant infringing acts involving the goods. Article 125 of IP Law inherits the spirit of relevant definitions of 'counterfeit trademark goods' from TRIPS.

3.1.2 Criminal procedure

Under Article 167 of IP Law, infringements against intellectual property rights especially counterfeit, deceive, fraud, unfair competition that results in serious damages, produce, sales of counterfeit goods or trademark counterfeiting or infringement of copyrights or related rights and regulations on industrial property protection shall be punished by criminal measures.

Criminal prosecution can be initiated through the Police, who refer the case to a public prosecutor for criminal court action.

3.1.3 Police

Under Article 46 and 47 of Laos Criminal Procedure Law (Criminal Procedure Law), the Police has the rights and duties as below:

- To accept and record complaints regarding offences;
- To immediately report to the public prosecutor regarding offences;
- To issue an order to open investigations, and send a copy of the order to the public prosecutor immediately;
- To proceed to investigate;
- To use coercive measures and release any suspect who was detained, and to report in writing to the public prosecutor;
- To appeal against the orders of lower-level public prosecutors to higher-level public prosecutors;
- Cooperate with other organizations;
- To summarize the investigation and prepare a case file to be submitted to the public prosecutor.

¹¹ Under Article 9 of IP Law, industrial property is composed of patents, petty patents, industrial designs, trademarks, trade names, layout-design of integrated circuits, geographical indications and trade secrets.

3.1.4 Criminal prosecution

The cause of opening an investigation may include a compliant/petition on a criminal offence and proactive discovery of traces of an offence (by the Police or public prosecutor).

In case the individuals or organizations file a petition or complaint to the Police, the Police will have a period¹² of 5 days (in straightforward cases) or 10 days (in complicated cases) to consider it before ordering an investigation, rejecting the complaint or forwarding it to the relevant authorities for further proceedings. For rejection circumstance¹³, the complainant could appeal the rejection in 7 days and the public prosecutor will have 5 days to consider it.

The Police must¹⁴ investigate, summarize the investigation and prepare the case file together with exhibits, and shall send those to the public prosecutor within 3 months. They may also request for extending the investigation period up to 12 months in total.

Under Article 152 of Criminal Procedure Law, the public prosecutor shall study the investigation result within 15 days since the receipt of the case file and inform the Police whether the result of the investigation is complete or not. In case the result of the investigation has proved to be not yet complete, the public prosecutor shall return the dossier of the case to the Police accompanied by instructions for additional investigation (within the timeframe of 2 months under Article 110 of Criminal Procedure Law).

The People's Court will have one month¹⁵ to consider the case since the date it receives such order from the public prosecutor. Upon consideration, the People's Court may decide to

- send the case file back to the public prosecutor for additional investigation or for expanding the scope of the charges and involved individuals; or
- open a hearing.

After the hearing, the People's Court decision must be printed and given to the defendant within 30 days¹⁶ from the date of judgement announcement. The defendant will have 20 days¹⁷ to appeal the Court's decision. The court of appeal will open proceedings of the concerned case within 45 days¹⁸ from the date of having received the case file. After deciding on the case, the People's Court must print and send the decision to the office of judgement enforcement within 10 days¹⁹.

* Please refer to Annex 1 of this Chapter for the flowchart of Criminal Procedure.

3.1.5 Criminal penalties

Under Article 246 of Laos Penal Code, any person who violates the intellectual property, counterfeits, lies, deceives, competes improperly the intellectual property, which damages the other person, shall be

- punished by one year to three years of imprisonment or re-education without deprivation of liberty; and
- fined from 5,000,000 LAK (approx. US\$565) to 20,000,000 LAK (approx. US\$2,260).

3.1.6 Defences to trademark infringement and copyright piracy

- Intent²⁰

As IP crimes should be intentional, the defence is around whether the accused has the intent to infringe the relevant trademark, copyright or related rights.

- Limitations and Exceptions

Infringement of Industrial Property Rights²¹. IP holders may invoke the limitations and exceptions where the unauthorized acts may not constitute infringements. In relation to infringements against industrial

¹² Under Article 90 of Criminal Procedure Law

¹³ Article 93, Criminal Procedure Law

¹⁴ Under 110 of Criminal Procedure Law

¹⁵ Article 165, Criminal Procedure Law

¹⁶ Under 210 of Criminal Procedure Law

¹⁷ Under Article 214 of Criminal Procedure Law

¹⁸ Under Article 216 of Criminal Procedure Law

¹⁹ Under Article 222 of Criminal Procedure Law

²⁰ Under Article 148 of IP Law

²¹ Under Article 121 of IP Law

property rights, where the claimed rights are invalid (due to unsatisfied protection conditions) or the term of protection for those rights has expired, it may not constitute infringements.

Copyright and related rights infringement²². In relation to the fair use defence against the claim of copyright and related rights infringement, the alleged infringers may argue that they are –

- making quotations from a work which has already been lawfully made available to the public, provided that their making is compatible with fair use, and their extent does not exceed that justified by the purpose (including quotations from newspaper articles and periodicals in the form of press summaries);
- utilization, to the extent justified by the purpose, of literary or artistic works by way of illustration in publications, broadcasts or sound or visual recordings for teaching or scientific research, (provided such utilization is compatible with fair practice);
- reproducing, by photography or cinematography, images of works of fine art, photographs, and other artistic works, and works of applied art, provided such works have already been published, publicly displayed, or communicated to the public, where such reproduction is incidental to the photographic or cinematographic work and is not the object of the photographic or cinematographic work;
- Translating literary works into Braille or other characters for visually impaired persons;
- Reproducing a computer program where such reproduction occurs in the ordinary operation of the computer program (providing the use of the computer program is consistent with terms of authorization of the copyright owner);
- Reproducing a work embodied in electronic media for backup or archival storage, or for replacement of a legally acquired work that is lost, destroyed or fails to work.

4. CIVIL IP ENFORCEMENT

Laos has a three-tiered civil court system, court of first instance (District People’s Court and Provincial/ Capital People’s Court for cases exceeding the authorities of the District People’s Court), court of appeal (including the relevant Regional People Court and Provincial/ Capital People’s Court), and Supreme People’s Court (located at Vientiane Capital).

Under Article 49 of Laos Civil Procedure Law, only the provincial and Capital People’s Court have the right consider a commercial case as a court of first instance. Therefore, the infringements against copyright and trademarks can be referred to the Provincial/ Capital People’s Court (where the infringement has occurred or where the asset which forms the basis of the claim is located or where the defendant resides).

Under Article 48 of Civil Procedure Law, cases relating to violations of copyright trademark are decided by the commercial chamber.

4.1 Grounds of actions and civil remedies

Under Article 133 and 135 of IP Law, a plaintiff suffering from an infringement of intellectual property has the right to file a judicial action to the People’s Court.

Under Article 140 of IP Law, the plaintiff may request the People’s Court to order:

- the infringer to desist from an infringement;
- the suspension of Customs procedures;
- the seizure of goods to prevent the entry into the channels of commerce of imported goods that involve the infringement of an intellectual property right, immediately after customs clearance of such goods;
- a declaratory judgment of infringement;
- the infringer to pay damages adequate to compensate;
- the infringer to pay the right holder expenses, which may include appropriate attorney’s fees;

²² Under Article 115 and 116 of IP Law

- that goods that have been found to be infringing, be destroyed or otherwise disposed of in such a manner that such goods will not enter channels of commerce;
- that materials and implements the predominant use of which has been in the creation of the infringing goods be disposed of outside the channels of commerce in such a manner as to minimize the risks of further infringements.

In addition, under Article 144 of IP Law, IP holders may file a complaint requesting the People's Court to order prompt provisional measures to preserve relevant evidence on the alleged infringement and prevent –

- an infringement of any intellectual property right from occurring; and
- the entry into the channels of commerce of goods, including imported goods immediately after customs clearance.

4.2 Right to Information

Article 138 of the IP Law stipulates that where a party in an IP infringement lawsuit can prove that appropriate evidence proving such party's claim is under the control of the other party and is therefore inaccessible, the former party shall have the right to request the court to compel the latter party to provide such evidence.

4.3 Damages

Under Article 141 of the IP Law, the People's Court shall set damage awards in an amount sufficient to compensate the party making the claim for its losses and to deprive the infringer or other violator of any profit from its unlawful act. The People's Court may order recovery of profits and/or payment of damages even where the infringer did not knowingly, or with reasonable grounds to know, engage in infringing activity.

4.4 Indemnification of Defendant

Article 143 of IP Law may request the People's Court to order a party at whose request measures were taken and who has abused enforcement procedures to provide to a party wrongfully enjoined or restrained with compensation including expenses in connection with the legal action, which may include attorney's fees for the injury suffered because of such abuse.

4.5 Civil procedure

Under Article 66 of Civil Procedure Law, the plaintiff may submit a claim to the People's Court, stating the damage suffered, nature of dispute and the involved rights and interests.

The defendant has the rights to admit all or part of the plaintiff's claim. Accordingly, the People's Court may decide without trial, under Article 68 of Civil Procedure Law. When the plaintiff withdraws his/her claim in part, the court shall only consider the part not withdrawn.

Under Article 70 of Civil Procedure Law, for commercial case (including trademark and copyright violations), the proceedings must commence within fifteen days, upon receipt of the claim.

The plaintiff has the rights to appeal the decision of the People's Court of first instance within 20 days from the date of the decision, under Article 98 of Civil Procedure Law. Once the timeframe for appeal or objection has ended, the Court of first instance must submit the appeal to the Court of appeal within 20 days. Since the receipt of the appeal, the Court of appeal will have 60 days²³ to consider it. The Court may summon the litigants to appear in the trial under a similar manner with the Court of first instance and should publish the decision within 30 days from the date of decision.

5. ECOMMERCE IP INFRINGEMENT FOR TRADEMARK AND COPYRIGHT

IP Law contains no specific provisions on e-commerce IP infringement. Laos has Law on Electronic Transactions and Consumer Protection Law, but the law does not yet cover IP enforcement in e-commerce platforms.

²³ Article 99 of Civil Procedure Law.

6. CUSTOMS IP BORDER ENFORCEMENT

6.1 Recordal process for trademarks and/or copyright

Laos allows for Customs recordal. Based on the recordal, the Customs will monitor the goods flowing through the border. The recordal dossier should include relevant registration certificates and documentation to help identify counterfeit/ infringing products, including pictures and general information about the genuine products subject to the recordal and relevant identifications.

6.2 Suspension of goods

Under Article 8 of Instruction on Customs Measures for The Protection of Intellectual Property Rights No. 1970/MOF (Customs Measures Instruction) dated 8 September 2011, the Customs authorities shall, within 3 (three) working days from the receipt of such application, issue an instruction accompanied with the application and supporting documents to the relevant customs officer(s), in order to inspect suspected goods. Otherwise, the Customs shall serve the applicant a written notice with reasons in case of rejection.

If the Customs has found that the suspected goods are infringing goods, it shall immediately order the suspension of such goods and, within 24 hours, serve a written notice of such suspension to both the relevant importer or exporter and the applicant and send a copy of the notice to the Customs Department or relevant regional customs office, under Article 9 of Customs Measures Instruction.

Under Article 12 of Customs Measures Instruction, Customs may maintain the suspension for ten (10) working days; however, the suspension period may continue if the applicant has provided evidence that judicial action has been initiated.

6.3 Court decision

According to Article 11 of Customs Measures Instruction, the applicant must initiate judicial action with the People's Court against the owner of the allegedly infringing goods within ten (10) working days upon receipt of the notice of suspension. Failure to initiate judicial action within the statutory time entitles the customs officer to release the goods immediately (Article 15 of Customs Measures Instruction).

Where a People's Court decision has ruled that the suspended goods are infringing goods, the owner of the goods shall be fined in accordance with the Customs Law. Where the People's Court decision has ruled that the suspended goods are not infringing goods, the customs officer shall apply the security of the applicant to pay for any expenses and damages arising from such suspension in accordance with People's Court decision (Article 14 of Customs Measures Instruction).

6.4 Relevant fees for Customs measures

There is no fee for informing Customs of counterfeit or pirated goods in Laos. However, the applicant must pay a security deposit of LAK 10,000,000 (approximately US\$1,130) prescribed in Article 5 of Customs Measures Instruction.

This deposit serves as assurance for the suspended goods. If the applicant fails to initiate judicial action within the 10 working days, the Customs must immediately release the suspended goods, and the applicant's security deposit will be applied to compensate the owner of the goods for damages suffered (Article 15 of Customs Measures Instruction). The same applies in cases where Court action is initiated, but the People's Court rules that the suspected goods are not infringing goods, the Customs shall apply the security deposit to pay for any expenses and damages arising from the suspension, in accordance with the People's Court decision. (The remainder of the security deposit after such payment shall be returned to the applicant, under Article 14 of Customs Measures Instruction).

*The Customs Recordal process is shown by way of a flowchart in Annex 2 of this Chapter.

7. ADMINISTRATIVE IP ENFORCEMENT

Under Article 127 of IP Law, IP holders may request the administrative authorities to handle dispute resolution. These remedies will focus on the resolution of disputes related to the registration of industrial property rights, new plant varieties, copyright and related rights.

8. OTHER ENFORCEMENT OPTIONS

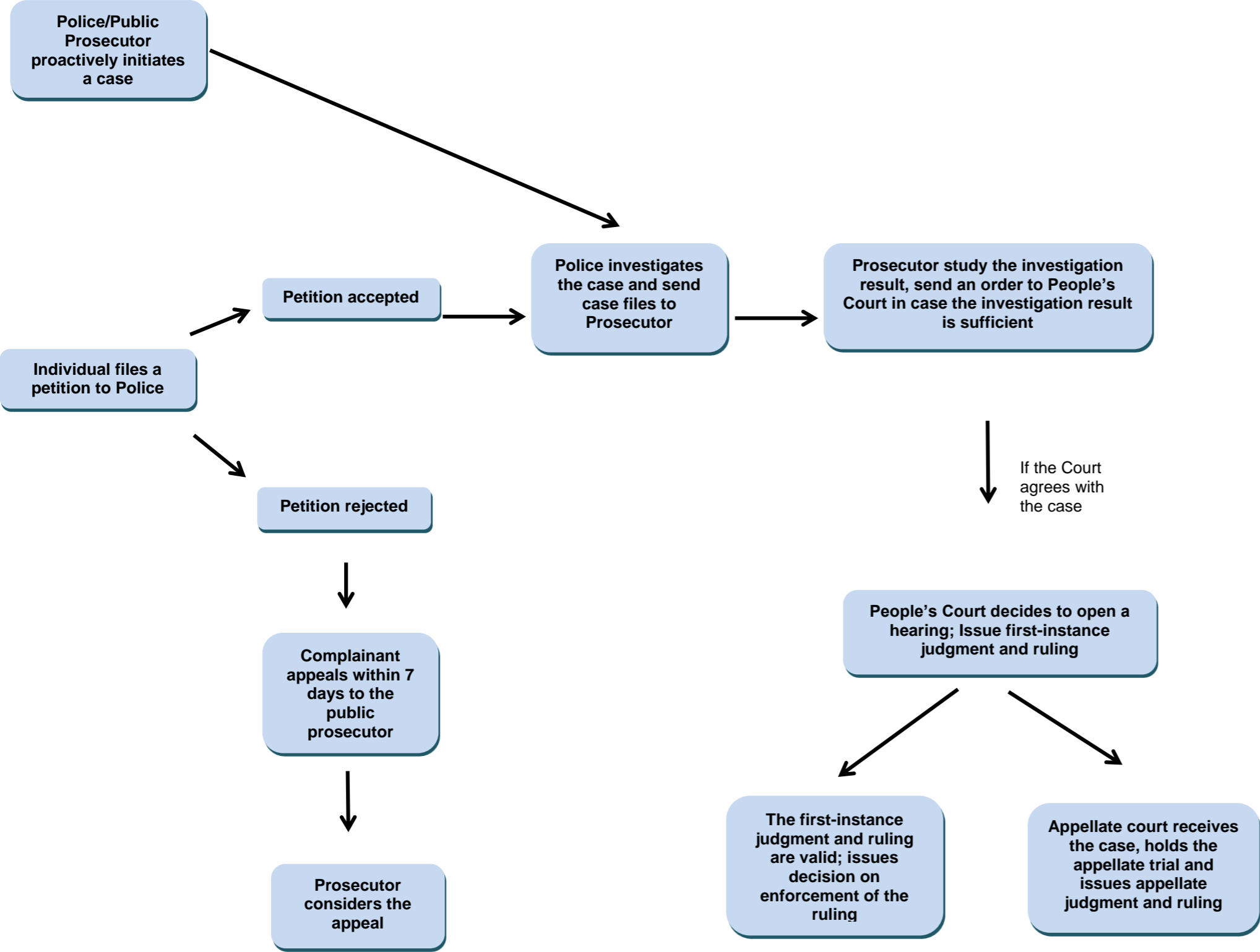
8.1 Alternative Dispute Resolution

Along with the above dispute resolutions, Article 127 of IP Law sets out other alternative resolutions that parties can carry out to settle IP infringement cases. Such resolutions are Reconciliation, Mediation, Remedy through Economic Dispute Resolution Committee, and International dispute settlement.

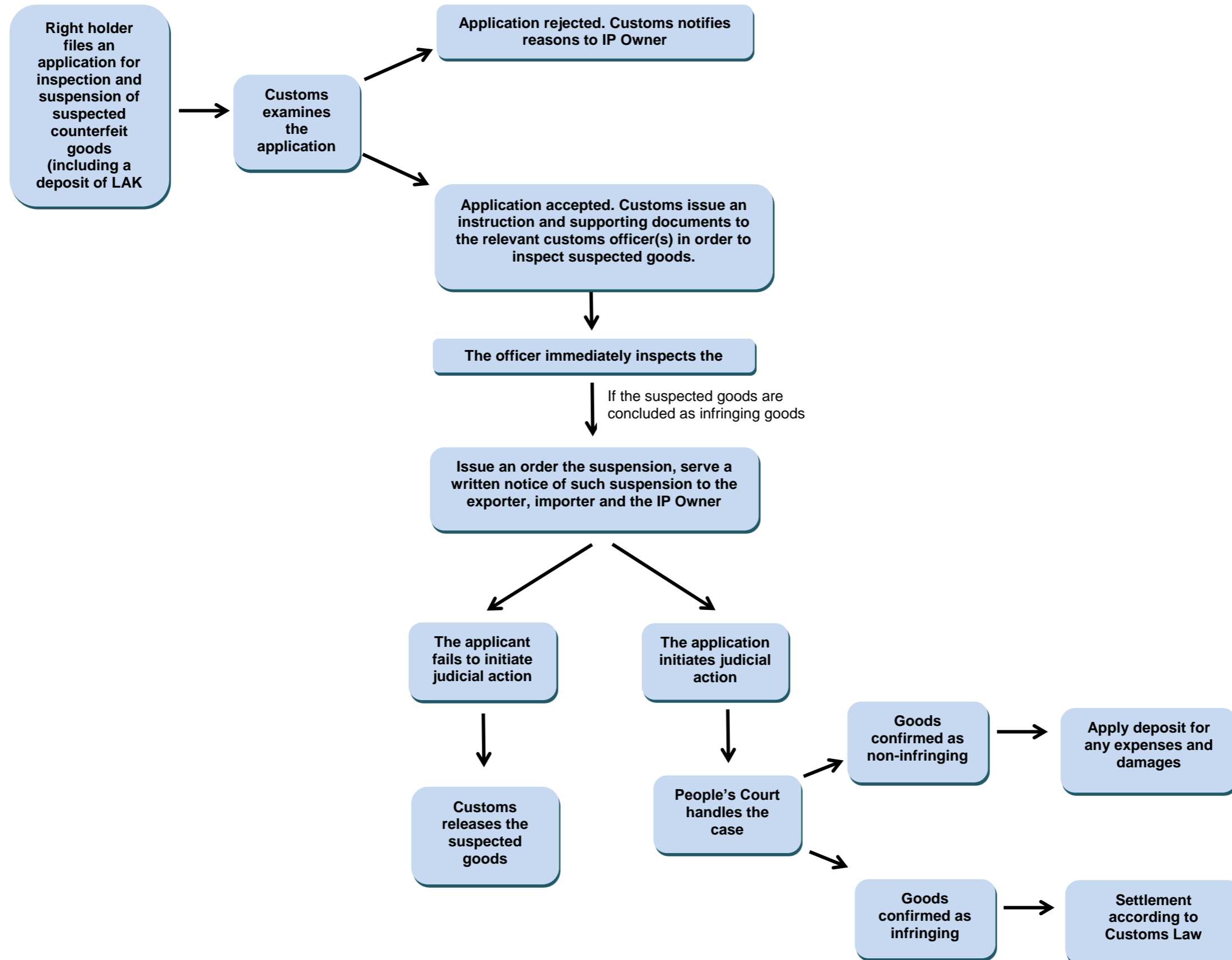
8.2 Warning letters and settlements

Many IP disputes are resolved by issuing a warning letter, and IP owner and the alleged infringer resolve the dispute. Settlement Agreements and Undertakings can be used to reach a resolution.

ANNEX 1: FLOWCHART FOR CRIMINAL PROCEDURE FOR TRADEMARK AND COPYRIGHTS



ANNEX 2: FLOWCHART ON CUSTOMS RECORDAL PROCESS FOR TRADEMARKS AND/OR COPYRIGHT





MALAYSIA

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IP ENFORCEMENT– MALAYSIA

1. THE IP ENFORCEMENT SYSTEM UNDER TRIPS

Malaysia is a common law country. Malaysian laws relating to Intellectual Property (“IP”) are mainly contained in statutes and common laws, and accordingly Malaysia has in place several laws for IP enforcement. As a WTO TRIPs member, Malaysia commits to providing enforcement measures²⁴. These comprise:

- civil remedies, comprising judicial procedures, evidence rules, injunctions, damages, other remedies, information to rights holder and rights of indemnification to defendants, as well as provisional measures (preliminary injunctions and search and seizure orders);
- customs interceptions of infringements or border measures; and
- criminal remedies for willful trademark counterfeiting or copyright piracy on a commercial scale.

This Manual sets out how these apply to counterfeiting (trademark infringements) and piracy (copyright infringements).

2. TRADEMARKS AND COPYRIGHT

Trademarks must be registered with the Intellectual Property Corporation of Malaysia (“MyIPO”) for trademark proprietors to institute actions for trademark infringement under Section 56 of the Trade Marks Act 2019 (“TMA 2019”) which came into force on 27 December 2019, repealing the Trade Marks Act 1976. In Malaysia, the proprietor of an unregistered trademark is not left without remedy in the event that his trademark is violated by a third party. Section 159 of the TMA 2019 expressly preserves the common law rights of unregistered trademark proprietors to institute actions for passing-off. Malaysia has acceded to the Madrid Protocol on 27 September 2019 and the TMA 2019 provides for, amongst others, Malaysia’s accession to the Madrid Protocol.

In Malaysia, copyright protection is provided under the Copyright Act 1987 (“CA 1987”) which covers a wide range of works eligible for copyright including literary works, musical works, artistic works, films, sound recordings, broadcasts, derivative works and published editions of works (“subject matters of copyright”). Under the CA 1987, copyright will subsist in a work if:

- the work is one of the subject matters of copyright;
- the work is original and has been reduced to material form; and
- the author is a qualified person or one of the other qualifying requirements are fulfilled. Although it is not mandatory to record a copyright in Malaysia to subsist, the Copyright (Voluntary Notification) Regulations 2012 which came into operation on 1 June 2012 established a new framework for the voluntary notification of copyright under Malaysian copyright law (“Voluntary Notification”). The Voluntary Notification provides copyright owners with prima facie proof of copyright ownership in their works and this may facilitate the enforcement procedure.

3. CRIMINAL IP ENFORCEMENT

3.1 TRADEMARKS

3.1.1 Criminal acts defined in the TMA 2019 and Trade Descriptions Act 2011 (“TDA 2011”)

With the coming into force of the TMA 2019, various offences relating to counterfeiting involving registered trademarks have now been provided under the TMA 2019. These offences include the following:

- **Counterfeiting a trademark (Section 99 of the TMA 2019)** – Any person who counterfeits a registered trademark by:
 - making a sign identical with or similar to a registered trademark with the intent to deceive;
 - or

²⁴ Part III of TRIPS - Articles 41-61

- falsifying a genuine registered trademark, whether by alteration, addition, effacement, partial removal or otherwise,

without the consent of the registered proprietor of the trademark commits an offence under this section. In a prosecution under this provision, the burden of proving the consent of the registered proprietor of the trademark shall be upon the accused person.

- **Falsely applying a registered trademark to goods or services (Section 100 of the TMA 2019)** – A person falsely applies a registered trademark to goods or services when he applies the trademark or a sign likely to be mistaken for that trademark to the goods or services without the consent of the registered proprietor and in the case of an application to goods, the goods are not the genuine goods of the registered proprietor or licensee of the trademark. A trademark shall be deemed applied to goods or services if it is used in any advertisement or printed matters (such as invoice, catalogues, business letter, price list or other commercial document).
- **Making or possessing of article for committing offence (Section 101 of the TMA 2019)** – Any person who makes an article specifically designed or adapted for making copies of a registered trademark or sign likely to be mistaken for that trademark or has in his possession, custody or control such an article, knowing or having reason to believe that it has been, or is to be, used for, or in the course of, committing an offence against Sections 99 and 100 of the TMA 2019 set out above, commits an offence under this section.
- **Importing or selling, etc., goods with falsely applied trademark (Section 102 of the TMA 2019)**- Any person who imports into Malaysia for the purpose of trade or manufacture; sells or offers or exposes for sale; or has in his possession, custody or control for the purpose of trade or manufacture, any goods to which a registered trademark is falsely applied under Section 100 of the TMA 2019, unless he proves that having taken all reasonable precautions against committing an offence under this section, he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the trademark and on demand made by the Assistant Controller/relevant law enforcement officer, he gave all the information in his knowledge with respect to the persons from whom he obtained the goods, commits an offence under this section. For the purposes of establishing an offence of possession, custody or control of the goods to which a registered trademark is applied is for trade or manufacture, there will be a presumption that by having 3 or more of these goods, that person will be deemed to be in possession for the purpose of trade or manufacture.

With the removal of references to the registered trademarks in the TDA 2011 [as amended by the Trade Descriptions (Amendment) Act 2019]] with the coming into force of the TMA 2019, the provisions of the TDA 2011 will still be relevant to any investigations, trial or proceedings commenced before the TMA 2019 came into force. Further, complaints may still be lodged under the TDA 2011 if the complainant is able to establish that the infringers, in addition to committing offences under the TMA 2019, conducted activities which may amount to offences under the TDA 2011, for instance, by dealing with goods where false trade descriptions have been applied, by making direct or indirect indications relating to the nature or designation of such goods (e.g. false labelling relating to the nature, any physical or technological characteristics, approval by any person or place of manufacture).

3.1.2 Registrar's Verification

Section 112 of the TMA 2019 provides that the Assistant Controller may, upon a complaint by a person, conduct an investigation on any person who has committed or is committing any offence under the TMA 2019.

If the complaint made is in relation to a trademark which is not identical with the registered trademark, any registered proprietor or licensee shall obtain the Registrar's verification in the form as determined by the Registrar together with the payment of the prescribed fee to be submitted to the Assistant Controller. The Registrar's verification shall be prima facie evidence in any proceedings before any court of law.

3.1.3 Criminal procedure for trademark offences

Enforcement actions are initiated by the registered proprietor or person authorised by the registered proprietor lodging a written complaint with the Enforcement Division of the Ministry of Domestic Trade and Consumer Affairs (“MDTCA”) and submitting supporting documents including a Letter of Authorisation (“LOA”) or a Power of Attorney (“POA”) if the complaint is lodged by the representatives, copies of the registration certificates of the relevant trademarks (or printouts from MyIPO), brief preliminary details of the targets and locations and images of suspected counterfeit goods and comparison with the genuine products. TMA 2019 empower the MDTCA officers to conduct investigations

- where they have reasonable grounds to suspect that any offence is or will be committed; or
- upon complaints lodged in relation to counterfeiting activities.

The MDTCA has the wide power to conduct raid actions, seize suspected counterfeit products, seize and retain documents, may direct the targets to allow them to access to records and computerised data and where appropriate and if the circumstances warrant it, to arrest the targets. The MDTCA has the option of compounding the offence (with a payment of monetary fine but no prosecution will be made) or alternatively, to prosecute the offenders in Court. No prosecution for or in relation to any offence under the TMA 2019 shall be instituted without the consent of the Public Prosecutor. The court may issue orders for seized goods to be forfeited and disposed off.

3.1.3.1 Ministry of Domestic Trade and Consumer Affairs (“MDTCA”)

MDTCA (formerly known as Ministry of Domestic Trade, Co-Operatives and Consumerism) was established on 27 October 1990 to promote the growth of ethical domestic trade and protecting consumer interest. MDTCA also formulates policies, strategies and reviews matters pertaining to the development of the domestic trade.

Under the TDA 2011, MDTCA are empowered to exercise the following powers and functions conferred upon them:

- Investigation (Section 30 of the TDA 2011)
- Search and Seizure of goods and documents (Section 40 of the TDA 2011)
- Entry of premises with/without warrant (Sections 40 and 41 of the TDA 2011)
- Arrest (Section 39 of the TDA 2011)
- Compounding of offences (Section 63 of the TDA 2011)

Under the TMA 2019, MDTCA officers are empowered to exercise the following powers and functions conferred upon them:

- Investigation (Section 111 or 112 of the TMA 2019)
- Arrest (Section 119 of the TMA 2019)
- Power to enter premises other than residential premises/dwellings, inspect and seize goods (Section 120 of the TMA 2019)
- Conduct searches without a warrant (Section 122 of the TMA 2019)
- Access recorded information or computerized data (Section 123 of the TMA 2019)
- Compounding of offences (Section 136 of the TMA 2019)

3.1.4 Criminal penalties for Trademark offences

The court may order the following penalties for trademark offences:

- **Counterfeiting a trademark**

Any person who counterfeits a registered trademark under Section 99 of TMA 2019 shall, on conviction, be liable to a fine not exceeding one million ringgit or to imprisonment for a term not exceeding five years or to both.

- **Falsely applying a registered trademark to goods or services**

Any person who falsely applies a registered trademark to goods under Section 100 of the TMA 2019 shall, on conviction, be liable:

- if the person is a body corporate, to a fine not exceeding fifteen thousand ringgit for each of the goods bearing the falsely applied registered trademark, and for a second or subsequent offence, to a fine not exceeding thirty thousand ringgit for each of the goods bearing the falsely applied registered trademark; or
- if the person is not a body corporate, to a fine not exceeding ten thousand ringgit for each of the goods bearing the falsely applied registered trademark or to imprisonment for a term not exceeding three years or to both, and for a second or subsequent offence, to a fine not exceeding twenty thousand ringgit for each of the goods bearing the falsely applied registered trademark, or to imprisonment for a term not exceeding five years or to both; or

Any person who falsely applies a registered trademark to **services** under Section 100 of the TMA 2019 shall, on conviction, be liable:

- if the person is a body corporate, to a fine not exceeding one hundred thousand ringgit; or
- if the person is not a body corporate, to a fine not exceeding seventy thousand ringgit or to imprisonment for a term not exceeding three years or to both

- **Making or possessing of article for committing offence**

Any person who commits this offence under Section 101 of the TMA 2019 shall, on conviction, be liable to a fine not exceeding one million ringgit or to imprisonment for a term not exceeding five years or to both.

- **Importing or selling, etc., goods with falsely applied trademark**

Any person who commits this offence under Section 102 of the TMA 2019 shall, on conviction, be liable:

- if the person is a body corporate, to a fine not exceeding fifteen thousand ringgit for each of the goods with the falsely applied registered trademark, and for a second and subsequent offence, to a fine not exceeding thirty thousand ringgit for each of the goods with the falsely applied registered trademark; or
- if the person is not a body corporate, to a fine not exceeding ten thousand ringgit for each of the goods with the falsely applied registered trademark or to imprisonment for a term not exceeding three years or to both, and for a second or subsequent offence, to a fine not exceeding twenty thousand ringgit for each of the goods with the falsely applied registered trademark, or to imprisonment for a term not exceeding five years or to both.

3.1.5 Defences

Apart from the statutory defences available to infringement claims under the TMA 2019 (for example, a person who uses the registered trademark for non-commercial purpose, for news reporting or news commentary or if the use is expressly or impliedly consented to by the registered proprietor or licensee, there are defences available under the TMA 2019. For offences under Section 102 of the TMA 2019, it

will be a defence if the person can prove that he has taken all reasonable precautions against committing an offence and he had, at the time of the commission of the alleged offence no reason to suspect the genuineness of the trademark.

3.2 COPYRIGHT

3.2.1 Criminal acts defined in the CA 1987

There are two main categories of offences under the CA 1987. The first comprises offences related to copyright infringement or infringing copies while the second covers acts which obstruct or interfere with the enforcement of the CA 1987.

3.2.2 Criminal offences under CA 1987

Section 41 of the CA 1987 provides that if any person who during the subsistence of copyright in a work or performers' right:

- makes for sale or hire any infringing copy; (a)
- sells, lets for hire or by way of trade, exposes or offers for sale or hire any infringing copy;(b)
- distributes infringing copies; (c)
- has in his possession, custody or control, otherwise than for his private and domestic use, any infringing copy; (d)
- by way of trade, exhibits in public any infringing copy;(e)
- imports into Malaysia, otherwise than for his private and domestic use, an infringing copy; (f)
- makes or has in his possession any contrivance used or intended to be used for the purposes of making infringing copies; (g)
- circumvents or causes or authorizes the circumvention of any effective technological measures²⁵; (h)
- manufactures, imports or sells any technology or device for the purpose of the circumvention of technological protection measure; (i)
- removes or alters any electronic rights management information²⁶ without authority; or (j)
- distributes, imports for distribution or communicates to the public, without authority, works or copies of works in respect of which electronic rights management information has been removed or altered without authority; (k)

shall, unless he is able to prove that he had acted in good faith and had no reasonable grounds for supposing that copyright or performers' right may be liable for copyright infringement.

In addition to the above offences, it is also an offence under Section 43A of the CA 1987 for any person to operate an audio-visual recording device in a screening room to record any film in whole or in part. If found guilty, the offender will be liable to a minimum fine of RM10,000 (ten thousand ringgit) and maximum fine of RM100,000 (one hundred thousand ringgit) or to imprisonment for a term not exceeding five years or to both.

3.2.3 Criminal procedure

Enforcement actions are initiated by the copyright owner or its authorised representative lodging a written complaint with the MDTCA (or Police)²⁷ and submitting supporting documents including a LOA or a POA (if the complaint is lodged by the representative), a copy of the certificate of notification of copyright or a Section 42 Statutory Declaration, brief preliminary details of the targets and locations and images

²⁵Technological protection measure is defined to mean any technology, device or component that, in the normal course of its operation, effectively prevents or limits the doing of any act that results in an infringement of the copyright in a work;

²⁶ Rights management information is defined to mean information which identifies the work, the author of the work, the owner of any right in the work, the performer or the terms and conditions of use of the work, any number or codes that represent such information, when any of these items is attached to a copy of a work or appears in connection with the communication of a work to the public.

²⁷ Although empowered to do so, the Police in recent years is hardly involved in enforcement actions under the CA 1987.

of suspected infringing goods and comparison with original goods. The MDTCA has the power to conduct raid actions and seize suspected infringing products from any premises or house provided that a search warrant has been issued. There will be no prosecution for any offence under CA 1987 except:

- with the consent in writing of the Public Prosecutor pursuant to Section 53 of the CA 1987
- to compound or impose a fine for offences with the consent of the public prosecutor pursuant to Section 41A (1) of the CA 1987
- the compound acts as a fine for the acts of infringement, and no further proceedings will be taken against the infringer. Goods seized during raid actions and seizures may be released to the infringer pursuant to Section 41A (2) of the CA 1987

3.2.4 Powers of MDTCA

Power of investigation

Section 50(2) of the CA 1987 provides that in relation to any investigation in respect of any offence under the CA 1987, officers of the Enforcement Division of the MDTCA are entitled to exercise all powers in relation to police investigations as prescribed under the Criminal Procedure Code.

Power to enter, search and seized under a warrant

The power of the court to grant search warrants and the said warrant which authorises entry into premises is conferred by Section 44 of the CA 1987.

Power to enter, search and seized without a warrant

Under Section 44 of the CA 1987, the MDTCA may only conduct a search without a warrant if there are reasonable grounds to believe that by reason of delay in obtaining a search warrant, the infringing copies, contrivance, article, vehicle, book or documents used to commit an offence under the CA 1987 are likely to be removed or destroyed.

Power to compound offences

Under Section 41A of the CA 1987, MDTCA may compound any offence which is prescribed by subsidiary legislation under the CA 1987 as a compoundable offence with the written consent of the Public Prosecutor.

3.2.5 Criminal Penalties

Any person who is guilty of any criminal offence under Section 41 of the CA 1987 stated in paragraph 3.2.2 above shall, on conviction, be liable:

- in the case of an offence under paragraphs 3.2.2 (a) to (f), to a minimum fine of RM2,000 (two thousand ringgit) and a maximum fine RM20,000 (twenty thousand ringgit) for each infringing copy, or to imprisonment for a term not exceeding five years or to both and for any subsequent offence, to a minimum fine of RM4,000 (four thousand ringgit) and maximum fine of RM40,000 (forty thousand ringgit) for each infringing copy or to imprisonment for a term not exceeding ten years or to both;
- in the case of an offence under paragraphs 3.2.2 (g) and (i), to a fine of not less than RM4,000 (four thousand ringgit) and not more than RM40,000 (forty thousand ringgit) for each contrivance in respect of which the offence was committed or to imprisonment for a term not exceeding ten years or to both and for any subsequent offence to a fine of not less than RM8,000 (eight thousand ringgit) and not more than RM80,000 (eighty thousand ringgit) for each contrivance in respect of which the offence was committed or to imprisonment for a term not exceeding twenty years or to both;
- in the case of an offence under paragraphs 3.2.2 (h), (j) and (k), to a fine not exceeding RM250,000 (two hundred and fifty thousand ringgit) or to imprisonment for a term not exceeding five years or to both and for any subsequent offence, to a fine not exceeding RM500,000 (five hundred thousand ringgit) or to imprisonment for a term not exceeding ten years or to both.

Criminal cases taken by the MDCA will be filed at the Sessions Court which has the jurisdiction to impose fines for offences under the CA 1987.

3.2.6 Exceptions/Defences: acts not considered as copyright infringement or offences

Section 13(2) of the CA 1987 provides the following statutory exceptions to the right of control of the copyright owner and accordingly exceptions to infringement actions:

- fair dealing for purposes of research, private study, criticism, review or the reporting of news or current events, provided that it is accompanied by an acknowledgement of the title of the work and its authorship, except that no acknowledgment is required in connection with the reporting of news or current events by means of a sound recording, film or broadcast; (a)
- doing of any act by way of parody, pastiche or caricature; (b)
- inclusion in a film or broadcast of any artistic work situated in a place where it can be viewed by the public; (c)
- reproduction and distribution of copies of any artistic work permanently situated in a place where it can be viewed by the public; (d)
- incidental inclusion of a work in an artistic work, sound recording, film or broadcast; (e)
- inclusion of a work in a broadcast, performance, showing, or playing to the public, collection of literary or musical works, sound recording or film, if such inclusion is made by way of illustration for teaching purposes and is compatible with fair practice, provided that mention is made of the source and of the name of the author which appears on the work used; (f)
- any use of a work for the purpose of an examination by way of setting the questions, communicating the questions to the candidates or answering the questions, provided that a reprographic copy of a musical work shall not be made for use by an examination candidate in performing the work; (g)
- reproduction made in schools, universities or educational institutions of a work included in a broadcast intended for such schools, universities or educational institutions; (h)
- making of a sound recording of a broadcast, or a literary, dramatic or musical work, sound recording or a film included in the broadcast insofar as it consists of sounds if such sound recording of a broadcast is for the private and domestic use of the person by whom the sound recording is made; (i)
- making of a film of a broadcast, or a literary, artistic, dramatic or musical work or a film included in the broadcast insofar as it consists of visual images if such making of a film of the broadcast is for the private and domestic use of the person by whom the film is made; (j)
- making and issuing of copies of any work into a format to cater for the special needs of people who are visually or hearing impaired and the issuing of such copies to the public by non-profit making bodies or institutions and on such terms as the Minister may determine; (k)
- reading or recitation in public or in a broadcast by one person of any reasonable extract from a published literary work if accompanied by sufficient acknowledgement; (l)
- any use made of a work by or under the direction or control of the Government, by the National Archives or any State Archives, by the National Library, or any State library, or by such public libraries and educational, scientific or professional institutions as the Minister may by order prescribe, where such use is in the public interest and is compatible with fair practice and the provisions of any regulations, and no profit is derived therefrom, and no admission fee is charged for the performance, showing or playing, if any, to the public of the work thus used; (m)
- reproduction of any work by or under the direction or control of a broadcasting service where such reproduction or any copies thereof are intended exclusively for a lawful broadcasting and are destroyed before the end of the period of six calendar months immediately following the making of the reproduction or such longer period as may be agreed between the broadcasting service and the owner of the relevant part of the copyright in the work, provided that any

reproduction of a work made under this paragraph may, if it is of exceptional documentary character, be preserved in the archives of the broadcasting service which are hereby designated official archives for the purpose, but subject to the CA 1987, shall not be used for broadcasting or for any other purpose without the consent of the owner of the relevant part of the copyright in the work; (n)

- performance, showing or playing of a work by a non-profit making club or institution where such performance, showing or playing is for charitable or educational purpose and is in a place where no admission fee is charged in respect of such performance, showing or playing; (o)
- any use of a work for the purposes of any judicial proceedings, the proceedings of a royal commission, a legislative body, a statutory or Governmental inquiry, or of any report of any such proceedings, or for the purpose of the giving of professional advice by a legal practitioner; (p)
- making of quotations from a published work if they are compatible with fair practice and their extent does not exceed that justified by the purpose, including quotations from newspaper articles and periodicals in the form of press summaries, provided that mention is made of the source and of the name of the author which appears on the work thus used; (q)
- reproduction by the press, the broadcasting or the showing to the public of articles published in newspapers or periodicals on current topics, if such reproduction, broadcasting or showing has not been expressly reserved, provided that the source is clearly indicated; (r)
- reproduction by the press, the broadcasting or the performance, showing or playing to the public of lectures, addresses and other works of the same nature which are delivered in public if such use is for informatory purposes and has not been expressly reserved; (s)
- commercial rental of computer programs, where the program is not the essential object of the rental; and (t)
- making of a transient and incidental electronic copy of a work made available on a network if the making of such copy is required for the viewing, listening or utilization of the said work. (u)

It is a defence for the target to

- prove that he had acted in good faith and had no reasonable grounds for supposing that copyright would or might be infringed;
- import an infringing copy into Malaysia for his private and domestic use. It should be noted that for the purposes of offences stated in paragraph 3.2.2 (a) to (f) above, any person who has in his possession, custody or control three or more infringing copies of a work in the same form shall, unless the contrary is proved, be presumed to be in possession of or to import such copies otherwise than for private and domestic use.

4. CIVIL IP ENFORCEMENT

Although Malaysia is federally constituted, its judicial system is a single-structured system consisting of superior and subordinate courts. The superior courts are the High Court of Malaya, the High Court of Sabah and Sarawak, the Court of Appeal and the Federal Court. The subordinate courts are the Magistrate Courts and the Sessions Courts. The Federal Court is the highest judicial authority in Malaysia and is the final court of appeal. The IP Court was established in 2007 to focus mainly on IP disputes. Currently, there is an IP High Court in Kuala Lumpur.

Civil litigation for trademark and copyright infringements are to be initiated at the High Courts which have the jurisdiction to hand out injunctions and also an unlimited award of monetary damages.

4.1 Trademark and copyright civil cases

4.1.1 Trademark and well-known mark infringement under the TMA 2019

Section 54(1) of the TMA 2019 provides that a person infringes a registered trademark if he uses a sign which is identical with the trademark in relation to goods or services which are identical with those for which it is registered, in the course of trade, without the consent of the registered proprietor.

Section 54(2) of the TMA 2019 further provides that a person infringes a registered trademark if, without the consent of the proprietor of the trademark, uses in the course of trade a sign that is

- identical with the trademark in relation to similar goods or services;
- similar to the trademark in relation to identical goods or services.

The potential scenarios of infringement covered by the TMA 2019 include:

- A person uses an identical trademark in relation to identical goods or services in the course of trade and without the consent of the registered proprietor. In such situation, the likelihood of confusion will be presumed.
- A person uses an identical trademark in relation to similar goods or services in the course of trade and without the consent of the registered proprietor.
- A person uses a similar trademark in relation to identical goods or services in the course of trade and without the consent of the registered proprietor.
- For the second and third scenarios, the registered proprietor has to establish that such use will result in the likelihood of confusion on the part of the public in order to establish an infringement of his registered trademark.

The TMA 2019 has also stated what would amount to uses of a sign for the purpose of infringement. It includes application to goods or their packaging; offering or exposing the goods for sale, offering or supplying services; importing or exporting goods, use of the sign in advertising and printed matters such as invoices, catalogues, business papers, price lists or other commercial documents.

A well-known trademark is protected under Section 76 of the TMA 2019. A well-known trademark is entitled to protection whether or not the trademark is registered in Malaysia, or an application for the registration of trademark has been made to the Registrar; and whether or not the proprietor of the trademark carries on business or has any goodwill in Malaysia. In determining whether the mark is a well-known mark in Malaysia, the following criteria under regulation 5 of the Trademarks Regulations 2019 ("TMR 2019") will be taken into account:

- the extent of knowledge or recognition of the mark in the relevant sector of the public;
- the duration, extent and geographical area of any use of the trademark;
- the duration, extent and geographical area of any promotion of the trademark, including advertising or publicity and the presentation, at fairs or exhibits, of the goods and services to which the mark applied;
- the duration and place of any registrations, or any application for registration, of the trademark to the extent that they reflect use or recognition of the trademark;
- the record of successful enforcement of rights in the trademark, in particular, the extent to which the trademark was recognised as well known by competent authorities; and
- the value associated with the trademark.

4.1.2 Passing off

Unregistered trademarks may be protected in Malaysia under the common law principle of passing off. The right to pursue such action is expressly preserved by Section 159(2) of the TMA 2019. Although passing off is the only remedy available for proprietors of unregistered trademark, registered proprietors

would likewise be entitled to commence actions for passing off if they are able to satisfy the requisite elements.

In order to succeed in an action for passing-off, the following elements must be satisfied by the claimant or plaintiff:

- that he has sufficient reputation or goodwill in the mark, trademark, get-up or other indicia in question in this country;
- that the actions of the defendant are likely to and/or have actually caused misrepresentations; and
- that he has suffered or is likely to suffer damage or injury to his business or goodwill as a result of the defendant's misrepresentation.

4.1.3 Statutory Defences under the TMA 2019

The statutory defences to a trademark infringement claim, which are as set out in Section 55 of the TMA 2019, are summarised as below:

- Use in good faith by a person of his own or his predecessor's name or the name of his or his predecessor's place of business.
- Use in good faith by a person of a sign to indicate the kind, quality, quantity, intended purposes, value, geographical origin or other characteristics of goods or services; or the time of production of goods or the rendering of services; or uses the trademark to indicate the intended purpose of goods which includes accessories or spare parts or service and such use is in accordance with honest practices in industrial or commercial matters.
- Continuous use in the course of trade from a date before the use of the registered trademark by its proprietor, predecessors or registered user; or the registration date of the trademark, whichever is earlier.
- Use of the registered trademark for a non-commercial purpose, for purposes of news reporting or news commentary.

4.2 Copyright infringement

Section 36(1) of the CA 1987 provides that copyright is infringed by any person who does or causes any other person to do, without the copyright owner's authority, any of the acts restricted by copyright under the CA 1987. Such acts include the reproduction of the work in any material form, the performance, showing or playing to the public, the communication of the work to the public, the distribution of copies to the public by way of sale or other transfer of ownership and the commercial rental of copies of the work to the public.

Pursuant to Section 36(2) of the CA 1987, copyright is infringed by any person who, without the consent or licence of the copyright owner, imports an article into Malaysia for the purpose of selling, letting for hire, or by way of trade, offering or exposing for sale or hire, the article, distributing the article for the purpose of trade or for any other purpose to an extent that it will affect prejudicially the owner of the copyright; or by way of trade, exhibiting the article in public, where he knows or ought reasonably to know that the making of the article was carried out without the consent or licence of the owner of the copyright.

Further, Section 36(3) of the CA 1987 provides that copyright is infringed by any person who circumvents or causes any other person to circumvent any effective technological measures that are used to restrict acts of their works.

Copyright is also infringed by any person who knowingly performs any of the following acts or has reasonable grounds to know that it will induce, enable, facilitate or conceal an infringement of any right:

- The removal or alteration of any electronic rights management information without authority;

- The distribution, importation for distribution or communication to the public, without authority, of works knowing that electronic rights management information has been removed or altered without authority.

4.3 Civil remedies in trademark and copyright cases

Trademarks

In Malaysia, the civil remedies available to the plaintiff in a trademark infringement action include but are not limited to the following:

- an injunction subject to such conditions as the High Court thinks fit which includes to prevent goods that involve the infringement from entering into the channels of commerce;
- damages;
- an account of profits;
- in an action where the infringement involves the use of a counterfeit trademark, the award of such additional damages as the High Court considers appropriate and the Court may also order the seizure or taking into custody of suspected infringing goods, materials or articles relevant to the infringement and the supply of documentary evidence relevant to the infringement.

Copyright

Section 37 of the CA 1987 provides that the copyright owner may be granted the following types of relief:

- an order for injunction;
- damages;
- an account of profits;
- statutory damages of not more than twenty-five thousand ringgit for each work, but not more than five hundred thousand ringgit in the aggregate; or
- any other order as the court deems fit.

4.4 Civil procedures in Trademark and Copyright cases

The civil procedures could be summarised as follows:

- After the filing and service of the Writ of Summons and Statement of Claim, the defendant must enter his appearance within the prescribed 14 days.
- The defendant shall file his defence within 14 days from entering his appearance.
- The plaintiff may file a reply to the defence within 14 days from service of the defence.
- Pleadings are deemed closed 14 days after the filing of the reply by the plaintiff.
- Thereafter, the court will issue directions for pre-trial case management on the conduct of proceedings up to trial.

Generally, the following case management directions are issued, which the parties have to comply with prior to trial:

- A statement of the issues to be tried must be filed.
- A statement of agreed facts must be filed.
- Common documents for trial, which are separated into 3 bundles (Part A - agreed by plaintiff and defendant; Part B - authenticity is not disputed but contents are disputed; and, Part C – both authenticity and contents are disputed), must be filed.
- List of witnesses must be filed.

- Witness statements must be filed and served before the trial.

A case is usually set down for trial within 3 to 8 months from the commencement of proceedings, depending on the availability of the free dates of the High Court. Trial is usually conducted by an examination of witnesses in open court. The witnesses are subject to examination-in-chief, cross-examination and re-examination if need be. On completion of the trial, the High Court will usually provide directions for filing of written submissions and then fixes a date for decision.

Note: Rules of general civil procedure shall be applicable.

4.5 Interlocutory injunction

The principles on which interlocutory injunctions are granted are laid down in the landmark case of *American Cyanamid Co v Ethicon Ltd [1975] AC 396* which have been adopted in Malaysia in various cases. The judge should consider whether:

- There is a bona fide serious issue to be tried.
- The balance of convenience favours the grant of the interlocutory injunction.
- The award of damages at the end of the trial to a successful claimant would not offer adequate relief.

The plaintiff will usually be required to give an undertaking as to damages before the interlocutory injunction is granted which would be called upon if the injunction is granted and the plaintiff fails to sustain the action after full trial. As injunctive relief is equitable in nature, the application must be applied for as soon as the plaintiff becomes aware that his trademark or copyright is infringed. Any inordinate delay in the application may be fatal unless it is justified and adequately explained. Further, in an ex parte application for an interlocutory injunction, full and frank disclosure of all material facts must be made. Any failure to disclose any material fact may be fatal and result in the ex parte injunction being set aside and the plaintiff may be liable for all damages suffered.

5. E-Commerce IP Infringement for Trademark and Copyright

Trademarks

Under Regulation 6 of the TMR 2019 provides that in relation to the use of a sign or trademark on the internet, the Registrar or the Court shall have regard to the provisions of the TMA 2019, the TMR 2019 as well as the Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet adopted at the Thirty-Sixth Series of Meeting of the Assemblies of the Member States of the World Intellectual Property Organisation on 24 September to 3 October 2001.

Copyright

Under Part VIB of the CA 1987, Internet Service Providers (ISP) or intermediaries are exempted from liabilities in 3 main areas, namely transmission, caching and storage provided that the ISP did not initiate or direct the transmission of the electronic copy of the work, the transmission is carried out through an automatic technical process without any selection of the electronic copy of the work; the ISP does not make any modification to the content, it was merely acting as a conduit and it has no knowledge of the infringing activities nor receive any financial benefit directly attributable to the infringement and responds within the time specified to remove access to the infringing copy.

Further, the Consumer Protection (Electronic Trade Transactions) Regulations 2012 (“CP(ETT)R 2012”) provides that online merchants are required to disclose information which include but are not limited to their personal and company (if applicable) details, and descriptions of their goods as specified in the Schedule to the CP(ETT)R 2012 on the online marketplace or website where their business is conducted. It is an offence for any person to disclose or provide information as specified in the Schedule that he knows or has reason to believe is false or misleading.

6. Customs IP Border Enforcement

6.1 TMA 2019

Border measure provisions are provided under Sections 81 to 94 of the TMA 2019 (Part XIII), with specific provisions governing the detention or seizure of counterfeit goods being imported into Malaysia. Under Section 82 of the TMA 2019, the registered proprietor of a registered trademark or the licensee may submit an application to apply for restrictions on the importation of particular counterfeit goods to the Registrar. The application must include very specific details of the shipment, importer, registration number of the vehicle/aircraft/ship and place where the goods would be arriving. Upon receipt of the application, the Registrar shall determine the application and will inform the applicant within a reasonable period whether the application has been approved. The Registrar will immediately take necessary measures to notify the Royal Malaysian Customs Department to prohibit the importation of the goods identified in the notice into Malaysia and seize and detain the identified goods. An approval shall remain in force until the end of 60 days from the approval date.

Based on prima facie evidence, any authorised officer may detain or suspend the release of goods bearing, without authorization, a trademark which is identical with the registered trademark and the goods are identical with the goods of a registered trademark which are to be imported or destined for export. Destined for export has been defined in the TMA 2019 to mean goods which are to be exported from Malaysia to another country through any mode of transportation. It should be noted that the provisions in Part XIII do not apply to small quantities of goods of a non-commercial nature contained in travelers' personal luggage or sent in small consignments. Small quantities means not more than 2 goods.

There is currently no recordal system in place in Malaysia.

6.2 CA 1987

Section 39 of the CA 1987 provides that copyright owners may apply to the Director General of the Intellectual Property Corporation of Malaysia or Copyright Controller to request that the importation of infringing copies into Malaysia be prohibited during a specified period. Once the application is approved, the importation of the infringing copies will be prohibited and liable to seizure and forfeiture. Similarly, due to the onerous requirements of these provisions, they are rarely utilised by copyright owners.

7. Administrative IP Enforcement

In Malaysia, the MDTCA is the main law enforcement authority which carries out the enforcement of intellectual property rights. As mentioned above, complaints can be lodged with the MDTCA for cases in relation to counterfeiting or piracy. The MDTCA has the power to search and seize counterfeit and/or infringing products and prosecute offenders/counterfeiters. These actions are rather expeditious, can be cost-effective and leave a lasting impact on the offenders/counterfeiters. When lodging complaints to the MDTCA, IP rights holders would have to submit documents to prove their proprietorship, brief investigation reports showing the infringing activity and letters of complaints.

Other government agencies which may be involved in the enforcement of IP rights are the Royal Malaysian Customs Department, Royal Malaysia Police and Malaysian Communications and Multimedia Commission (in certain occasions).

8. Other Enforcement issues

8.1 Alternate Dispute Resolution

Arbitrations in Malaysia are governed by the Arbitration Act 2005 ("AA 2005") which is based on the UNCITRAL Model Law on International Commercial Arbitrations. AA 2005 applies to all arbitral proceedings seated in Malaysia. Mediation is also available for parties in dispute. Mediation in Malaysia is governed by the Mediation Act 2012 ("MA 2012"). All disputes may be referred to mediation except for matters specifically excluded in the Schedule to the MA 2012 (for example, any criminal matter). It has become increasingly common for the courts to refer parties to mediation before trial commences. If parties are able to settle the dispute through mediation, the parties may enter a Consent Judgment with the courts or into a Settlement Agreement and withdraw or discontinue their claims before the courts.

8.2 Warning letters and settlements

IP disputes may also be resolved at the outset before commencement of civil actions by issuing cease and desist letters and through negotiations between the IP rights holders and infringers. Settlement terms which infringers usually have to comply with would include but are not limited to signing of Letter of Undertaking (“LOU”) containing the agreed settlement terms, affirmation of statutory declarations stating the details of the suppliers of the counterfeit goods, delivery-up and/or destruction of counterfeit goods and payment of settlement sums. The infringers’ compliance of the demands would constitute resolution of the dispute. If the infringers breach any term in the LOU, the IP rights holders will retain the right to commence civil suits and take further action against the infringers.

In certain situations, warning letters may be issued in lieu of cease and desist letters to serve as educational instruments and deterrence. Such letters would put the recipients on notice that the IP rights holders are aware of the alleged infringers’ infringing acts but rather give them a chance to make amends for their wrongdoings and provide information on how their infringing acts are cheating or endangering consumers and the public. Further, such letters may also be distributed among members of the same trade or industry or they may receive “word on the street” about such warning letters which deter them from venturing into similar counterfeiting activities.

Before the registered proprietor of trademarks embarks on a cease and desist letter program, it is important to consider the provision on groundless threats of infringement proceedings introduced by Section 61 of the TMA 2019. Under this provision, where a person threatens another with proceedings for infringement of a registered trademark other than:

- the application of trademark to goods or material used or intended to be used for labelling or packaging goods (i.e. manufacturer);
- the importation of goods to which, or to the packaging of which, the trademark has been applied (i.e. the importer); or
- the supply of goods under the trademark

any aggrieved person may bring proceedings for relief under this section. The reliefs shall include any of the following:

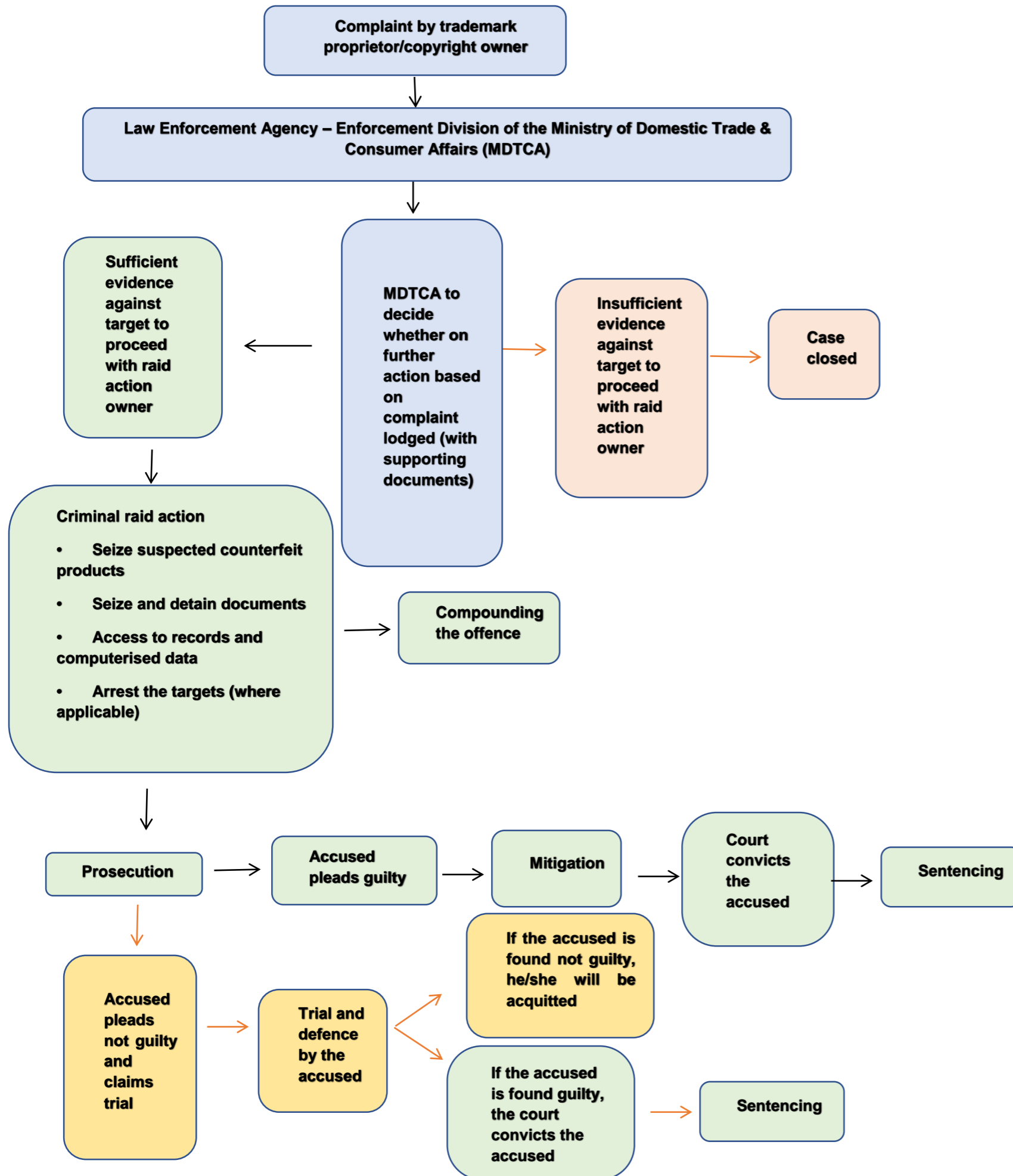
- a declaration that the threats are unjustifiable;
- an injunction against the continuance of the threats; or
- damages in respect of any loss he has sustained by the threats.

Accordingly, the recipient or addressee of the cease and desist letter may be entitled to any of the above reliefs unless the registered proprietor is able to show that the acts in respect of which the proceedings were threatened constitute or if done would constitute an infringement of the registered trademark. The mere notification that a trademark is registered or that an application for registration has been made, shall not constitute a threat of proceedings for the purpose of this provision.

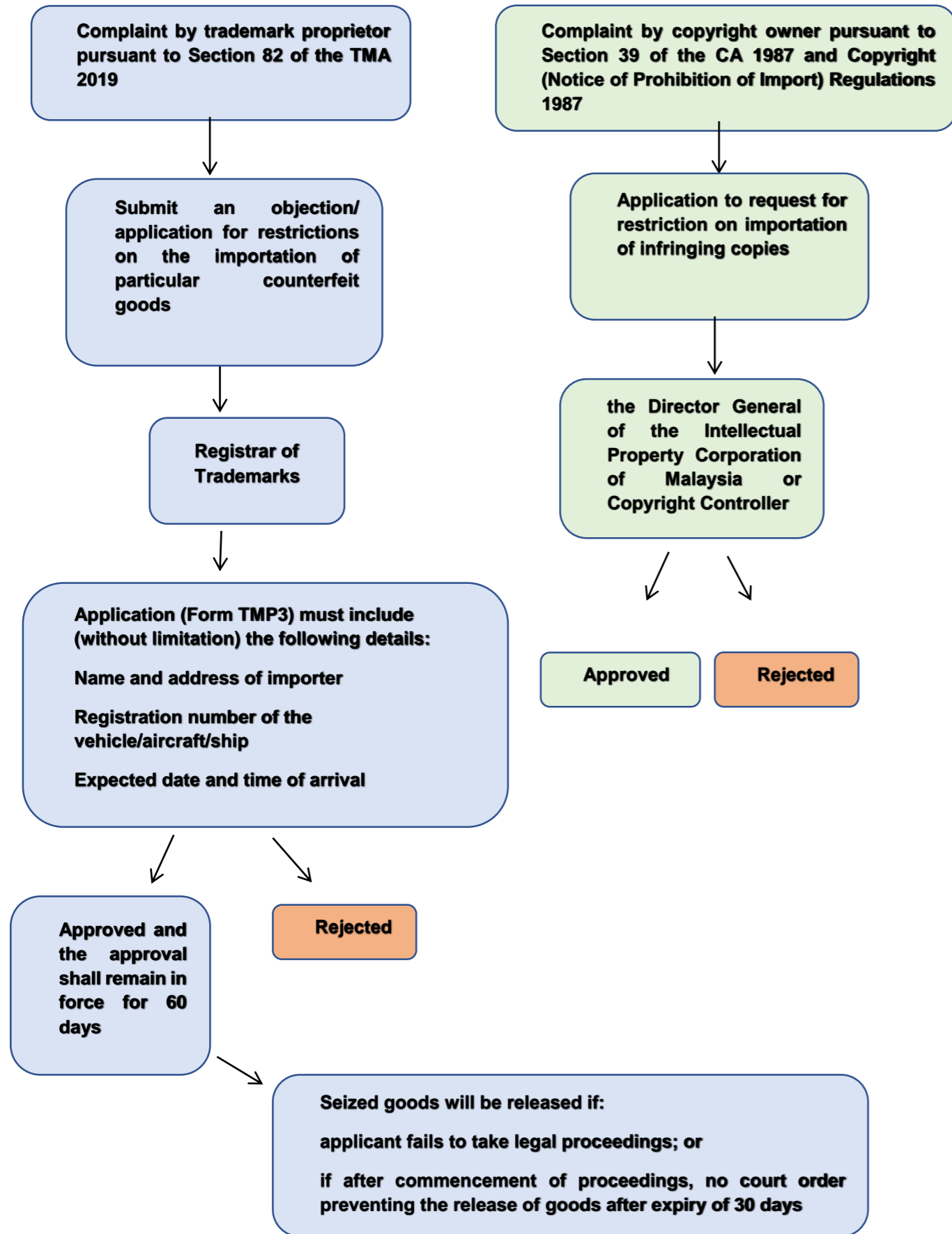
8.3 Publication of Apology Notice

In certain cases, the IP rights holders would be able to secure publication of apology notices by infringers in the local newspapers and/or their social media platforms as one of the settlement terms. For certain brands, such a public acknowledgment by the infringers of their wrongdoings would send a strong message to the market, provide an educational tool as well as creating a deterrent effect for other infringers and in such situation, it would better serve the interest of the IP rights holders.

ANNEX 1: FLOWCHART FOR CRIMINAL PROCEDURE FOR TRADEMARK AND COPYRIGHT



ANNEX 2: FLOWCHART ON CUSTOMS RECORDAL PROCESS FOR TRADEMARKS AND/OR COPYRIGHT





MYANMAR

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IP ENFORCEMENT – MYANMAR

1. THE IP ENFORCEMENT SYSTEM UNDER TRIPS

Myanmar is currently not a signatory to the Paris Convention for the Protection of Industrial Property or any other multilateral trademark treaty. However, in accordance with the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), to which it acceded as part of its entry into the Agreement Establishing The World Trade Organization (WTO), Myanmar is required to implement and comply with Articles 1-12 and 19 of the Paris Convention and the terms of TRIPS by no later than January 1, 2006. This transition period has been extended twice for all LDC members in response to a specific request by the LDC Group. In its decision of 29 November 2005, the TRIPS Council extended the period until 1 July 2013, and on 11 June 2013, it extended this further until 1 July 2021. In order to comply with its obligations, the Government has drafted four IP laws on trademark and geographical indication, patent, design and copyright. The four IP laws all passed in 2019. However, they are still not yet in effect. They all require an implementation date. Most likely, the Trademark Law will be implemented first, followed by the Copyright law and Design Law and then the Patent Law. Geographical Indications provided as a chapter of the Trademark Law should follow.

There is no Myanmar Department of Intellectual Property (MDIP) established yet. There has been speculation that it may be launched on April 26, 2020, World IP Day.

Because of the position of extreme uncertainty about when the IP laws will commence and the IP Office will open, this Chapter of the IP Enforcement Manual should not be relied upon without further advice.

2. TRADEMARKS AND COPYRIGHT

Currently, there is no system for registration of trademarks or for a statutory title to a trademark. Only a recordation system is in place.

The rights of a person to make a claim to ownership of a trademark must be determined in accordance with the principle of common law based on 'first use'. To prove the 'first use' of a trademark in a criminal or civil lawsuit is critical to achieve a better right over a mark. This can be achieved by a publication of a Cautionary Notice and/or a recordal of a Declaration to ownership of the trademark with the Registry of Deeds.

Trademark searches/inspections of the official register of Declarations are not currently permitted. However, because the Cautionary Notices are published in the newspaper, private collections of Cautionary Notices can be searched as a guide to whether a Cautionary Notice for a mark has been published.

The new Trademark Law was passed by the Assembly of the Union on January 30, 2019 following its adoption by the Lower House on December 12, 2018 and the Upper House on February 15, 2018

Among several notable changes, the new law introduces a "first-to-file" system that requires no evidence of prior use or ownership in Myanmar.

The law significantly improves the ability of trademark owners to counter bad-faith trademark squatting and, in cases where infringement is found, provides higher fine amounts, more deterrent imprisonment terms and customs and civil remedies, including temporary and permanent injunctions. In addition, the law introduces the formality examination and substantive examination of applications, oppositions, invalidation and cancellation actions, and envisages establishing a specialized Intellectual Property Court to handle all IP disputes and the possibility for Myanmar to join the Madrid system. The new law also clarifies protection for "well-known" trademarks, provides trademark publication, amendment, withdrawal and renewal procedures, makes available multi-class applications and priority claim. Geographical indications are also protected through registration.

There is no procedure for automatically re-registering marks which are recorded under the current system. Therefore, marks recorded with the Registry of Deeds and Assurance may be re-applied for once

a proposed sunrise period starts in order for the owners of that recorded mark to secure rights under the new Trademark Law.

Copyrights from other countries are not recognized and there are no procedures for registering copyrights in Myanmar. The new Copyright Law was enacted on May 24, 2019, Law No. 15/2019 (Copyright Law). It provides administrative (customs action), civil and criminal remedies against infringers.

3. CRIMINAL IP ENFORCEMENT

Criminal action may be taken under the Myanmar Penal Code, 1860 (Penal Code). For the purposes of the Penal Code and the Merchandise Marks Act, 1889, a trademark is “a mark used for denoting that goods are the manufacture or merchandise of a particular person”.

The benefit of criminal action is that the Merchandise Marks Act’s forfeiture provisions, which also apply to offences under the Penal Code, give significant powers to the court to order the forfeiture of infringing goods, whether or not a conviction is actually secured.

3.1.1 Offences under the Penal Code

Under the Penal Code it is an offence to, among other things “use a false trademark,” unless such act was done innocently, without intent to defraud; including to:

- counterfeit a trademark make or possess any die, plate or other instrument for the purpose of counterfeiting a trademark or possess a trademark for denoting that any goods are the manufacture or merchandise of a person whose manufacture or merchandise they are not;
- sell or possess for sale or any purpose of trade or manufacture any goods to which a counterfeit trademark is affixed or impressed unless it is proven that:
 - having taken all reasonable precautions against committing an offence, there was no reason to suspect the genuineness of the mark;
 - all information known about the person from whom the goods were obtained was given to the prosecutor; and (c) otherwise, the activities in question were done innocently.

A person is deemed to “use a false trademark” if they mark any goods or packaging in a manner reasonably calculated to cause it to be believed that the goods are the manufacture or merchandise of a person of whose manufacture or merchandise they are not.

Relevant provisions of the Penal Code are Article 28, Article 415, Article 480 and Article 486. Article 28 reads:

A person is said to “Counterfeit” who causes one thing to resemble another thing, intending by means of that resemblance to practice deception or knowing it to be likely that deception will there be practiced.

Explanation. 1: It is not essential to counterfeiting that the imitation should be exact.

Explanation. 2: When a person causes one thing to resemble another thing, and the resemblance is such that a person might be deceived thereby, it shall be presumed, until the contrary is proved, that the person so causing the one thing to resemble the other thing intended by means of that resemblance to practice deception or knew it to be likely deception would thereby be practiced;”

Article 415 reads:

“Whoever, by deceiving any person, fraudulently or dishonestly induces the person so deceived to deliver any property to any person, or to consent that any person shall retain any property, or intentionally induces the person so deceived to do or omit to do anything which he would not do or omit if he were not so deceived, and which act or omission causes or is likely to causes damage or harm to that person in body, mind, reputation or property, is said to “cheat.”

Illustration:

A, by putting a counterfeit mark on an article, intentionally deceives Z into a belief that this article was made by a certain celebrated manufacturer, and thus dishonestly induces Z to buy and pay for the article. A cheats.

Article 480 reads:

“Whoever marks any goods or any case, package or other receptacle containing goods, or uses any case, package or other receptacle with any mark thereon, in a manner reasonably calculated to cause it to be believed that the goods so marked, or any goods contained in any such receptacle so marked, are the manufacture or merchandise of a person whose manufacture or merchandise they are not, is said to use a false trademark.”

Article 486 reads:

“Whoever sells, or exposes, or has in possession for sale or any purpose of trade or manufacture, any goods or things with a counterfeit trademark or property mark affixed to or impressed upon the same or to or upon any case, package or other receptacle in which such goods are contained, shall, unless he proves -

- that, having taken all reasonable precautions against committing an offence against this section, he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the mark, and
- that, on demand made by or on behalf of the prosecutor he gave all the information in his power with respect to the person from whom he obtained such goods or things, or
- that otherwise he had acted innocently, be punished with imprisonment of either description for a term which may extend to one year, or with fine, or with both.”

3.1.2 Offences Under the Merchandise Marks Act

Every person who commits any of the following acts is guilty of an offence under the Merchandise Marks Act, unless it can be proven that they acted innocently and without the intent to defraud

- “applies” any “false trade description” to goods or
- sells or exposes or has in possession for sale or for any purpose of trade or manufacture,
- any goods or things to which any false trade description is applied.

The punishment for each of these offences on conviction is imprisonment for up to three months or a fine and, in the case of a second or subsequent conviction, imprisonment for up to one year or a fine or both.

3.1.3 Criminal procedure for trademark infringement

To initiate a criminal enforcement action, the trademark owner must first lodge a police complaint, supported by a compiled dossier of evidence. Pursuant to the police’s investigation, a raid action can be carried out to seize the counterfeit goods.

3.1.4 Police

The Police is the competent authority for conducting raid actions relating to IP disputes.

3.1.5 Criminal prosecution of Trademark crimes

The Penal Code, The Evidence Act, The Penal Procedure Code and the Merchandise Marks Act are the main legal texts which set out the procedures for criminal actions.

3.1.6 Criminal penalties for Trademark infringement

Punishment ranges from a fine to three (3) years imprisonment. Additionally, the court may order the destruction of the seized goods, by drawing upon powers conferred by the Merchandise Marks Act.

The court may order the forfeiture to the court of all goods and things by means of or in relation to which an offence has been committed or, where the accused is not convicted because the contravention was found to be unintentional, would have otherwise been committed.

The offences to which forfeiture apply are:

- use of a false trademark (Sections 480/482 and 487/488 of the Penal Code);
- selling/possessing for sale goods with a counterfeit trademark (Section 486 of the Penal Code);
- applying a false trade description (Section 6 of the Merchandise Marks Act);
- selling/possessing for sale goods to which a false trade description is attached (Section 7 of the Merchandise Marks Act).
- selling, or exposing or having in possession for sale or any purpose of trade or manufacture, any goods or things with a counterfeit (Section 9 of the Merchandise Marks Act)

3.1.7 Defenses to trademark infringement

The Merchandise Marks Act provides that persons charged with falsely applying to goods any trademark or any mark resembling a trademark or making any die, plate or other instrument for the purpose of counterfeiting a trademark (under the Penal Code) or applying to goods any false trade description (under the Merchandise Marks Act) are entitled to be discharged if they can show that they:

- in the ordinary course of business, are employed to apply trademarks or trade descriptions or, as the case may be, to make dies, plates or other instruments to make or be used in making trademarks and, for the case that is the subject of the charge, they were so employed;
- were not interested in the goods by way of profit or commission dependent on their sale;
- took reasonable precautions against committing the offence charged;
- at the time of the commission of the alleged offence, had no reason to suspect the genuineness of the trademark or trade description; and
- gave the prosecutor all the information in their power with respect to the person on whose behalf the trademark or trade description was applied.

3.2.1 Criminal acts defined in the Copyright Law

Myanmar is not a signatory to the Paris Convention for the Protection of Industrial Property, nor is it a signatory to the Berne Convention for the Protection of Literary and Artistic Works.

The Copyright Act 1914 provides and outlines copyright of original literature and dramatic and artistic work if:

- in the case of a published work, the work was first published within Myanmar; and
- in the case of an unpublished work, the author was a citizen of Myanmar or “within” Myanmar when the work was created. Copyright for written work, film, music or software may be difficult for foreign companies to enforce in Myanmar under the current Copyright Act of 1914. Copyrights from other countries are not recognized in Myanmar and there are no procedures for registering foreign copyrights in Myanmar.

According to the Copyright Act 1914, infringement of copyright is actionable in both criminal and civil courts. In Myanmar no specific mechanisms exist for search, seizure and disposal of property relating to copyright. However, the general provisions of the Criminal Procedure Code relating to search, seizure

and disposal of property can be applied. Sections 101 – 103 allow for any search to be made in the presence of at least two witnesses who are respectable inhabitants of the locality and will be required to sign the list to attest to its accuracy.

Punishment with regards to infringement consists of a fine not exceeding Kyats 500 (approximately EUR 0.38), but this is expected to increase. Making or possessing plates for the purpose of producing counterfeit copies shall be punishable with a fine, which is also up to a maximum of Kyats 500 (approximately EUR 0.38). For any subsequent offence the penalty is imprisonment for up to one (1) month or a fine to a maximum of Kyats 1,000 (approximately EUR 0.76), or both.

On 24 May 2019, the Union Parliament of Myanmar passed the Copyright Law (Law No. 15/2019). It will come into force after the President of Myanmar issues a notification to that effect. It repeals and replaces the Copyright Act 1914 and establishes a new copyright protection system with the following major principles:

- Copyright protection subsists in the following works without registration;
- literary and artistic works, performances of performers, phonograms created published by citizens or residents of Myanmar;
- Foreign works will be protected if the original works first published in Myanmar or abroad but subsequently published in Myanmar within 30 days from their first publication date;
- Literary and artistic works include: written, oral, musical, choreographic, architectural, traditional and cultural expressions, lithographical and photographic works, works of print, works of applied art, illustrations, adaptations of works and datasets
- Terms of copyright protection are lifetime of the author + 50 years for literary works and 50 years for works published under a pseudonym, audio-visual works and 25 years works of applied art. Authors of literary and artistic works have a moral right over them throughout his or her lifetime plus an unlimited period of time after his or her death;
- Copyright owners have an exclusive right to reproduce, translate, adapt, arrange, transform, modify, distribute, sell, transfer, assign, license, rent the original or a copy of a copyright work;
- Reproduction of a copyright work without authorization of the rights holder under some circumstances such as reproduction for educational or personal use is allowed provided that it does not impact the rights of copyright owners.

3.2.1.1 Economic rights infringement

Offenses under the new Copyright law include the unauthorized reproduction, communication to the public, distribution of copyright works and related rights matters, the possession of infringing goods for commercial purposes, the importation of infringing items into Myanmar, and more. The minimum penalties stipulated for specified offences are imprisonment not exceeding three years or a fine not exceeding MMK 1 million or both. Repeat offenders may be subject to imprisonment of up to 10 years and a maximum fine of up to MMK 10 million. The unauthorized reproduction of literary and artistic works by libraries for non-commercial purposes will not constitute copyright infringement.

Other statutory defenses to copyright infringement include, among others, use for reporting of news and current events, and reproduction for purposes of research and private study.

Notwithstanding the above, the Copyright Law includes a provision allowing for a two-year transition period from the enforcement of the law, during which copies that were lawfully made for public interest without the authorization of the right owner before the entry into force of this law may be distributed to the public without the permission of the right owner.

3.2.2 Criminal Penalties for copyright infringement

According to Articles 82, 83, 84 and 85 of the Copyright Law 2019, any person who has been convicted of having committed any of the following acts shall be punishable with imprisonment for a term of not

more than 3 years or with fine of not less than 1 million kyats or both:

- for commercial purposes without the permission of the right holder:
 - direct or indirect reproduction, communication to the public and distribution to the public of the protected work under copyright or related right.
 - keeping in possession or trading of goods that have infringed copyright or related right;
 - importing the goods that have infringed copyright or related right into Myanmar;
 - committing any acts prohibited in sections 43 and 44.
- keeping in possession of any materials or equipment which are mainly used in making or to make the goods that have infringed the copyright or the related right.

Any person who has been convicted of having committed any acts in section 82 after the prior conviction for the such offence shall be punishable with imprisonment for a term of from 3 years in minimum to 10 years in maximum and fine of not more than 10 million kyats or with both.

Any person who has been convicted of having committed any of the following acts shall be punishable with imprisonment for a term of not more than 1 year or with fine of not more than 2 million kyats or with both:

- issuing or causing to issue the Copyright or Related right Certificate fraudulently;
- making or causing make a false entry in the register of copyright or in the register of related right dishonestly.

Any person who conspires or abets the committing of any offence contained in this Law shall be liable to the punishment prescribed for such offence.

3.2.3 Defenses/exceptions: acts not considered as copyright infringement

The Copyright Act 2019 provides an extensive list of exemptions to copyright infringement as below:

- Section 24: any person may reproduce parts of literary or artistic work which was already published for his own use without requiring to obtain the permission of the right holder. The reproduction shall be compatible with fair practice, conflict with a normal exploitation of the literary or artistic work and shall not unreasonably prejudice the legitimate interests of the right holder. Provided that such exemption shall not apply to any of the following facts:
 - reproduction of an architectural work of building or other construction;
 - reproduction of the whole or a substantial part of book or notation of musical work;
 - reproduction of the whole or a substantial part of a database in digital form;
 - reproduction of a computer program which is not in conformity with provision in section 30.
- Section 25: the temporary reproduction of a literary or artistic work shall be permitted if all the following conditions are conformed:
 - reproduction is made in the process of a digital transmission of the literary or artistic work or made perceptible the literary or artistic work vividly which is digitally stored; - (a)
 - reproduction is made by a person who is authorized under sub-section (a) above.
- Section 26: a part of literary or artistic work which was made available to the public in accordance with law shall be reproduced as a quotation without the permission of the right holder.

- Section 27: the reproduction which is conformed with the following facts shall be permitted without permission of the author or copyright owner. However, such reproduction is compatible with fair practice and does not exceed the extent justified by the purpose. Moreover, the name of the author and the reference of reproduced literary or artistic work shall be indicated as far as practicable on all such copies:
 - reproduction of any parts of published work or article in newspaper, magazine, journal for teaching purpose; - (a)
 - embodiment of copies made under sub-section (a) into the printed syllabuses and electronic syllabuses to be used in teaching by education organizations. (These electronic syllabuses shall be stored on the secure network which is only accessed by the teachers and the students who are allowed to use such syllabuses) – (b)
 - combined use of the parts of literary or artistic works which are in printed form or in electronic form for the assignment or research papers for the purpose of own personal use or preserving in library by the persons who are to learn such syllabus. – (c)

- Section 28: Any library or archive, not for the purpose of direct or indirect commercial profit, without requiring to obtain the permission of the right holder, may make a single copy of the literary or artistic work by reproduction for the following acts:
 - In case of literary or artistic work, the reproduction shall be part or excerpt of published article, other literature or artistic work, and the purpose of the reproduction is due to the request of any person. Provided that this reproduction is –
 - satisfied by the library or archive that the copy will be used solely for the purposes of study, scholarship or private research;
 - separate reproduction in case they are different from and unrelated with each other.

 - The reproduction shall be made to maintain a copy and, if necessary, to replace a copy, or to replace a copy which has been lost, destroyed or rendered unusable in the permanent collection of another similar library or archive. Provided that this reproduction is –
 - due to valid condition of impossibility to obtain such a copy;
 - separate reproduction in case they are different from and unrelated with each other.

 - For the purpose of copying or maintaining the literary or artistic work, the copies may be made as follows:
 - when the library or archive is collecting for its organization, if the literary or artistic work or its copy is not sufficient, or if it is not available in the market or from the publisher, the necessary parts may be copied or obtained the copy from another library or archive;
 - when the library or archive, despite making attempts, is not able to obtain the permission of the right holder, or when it is not available in the market or from the publisher, literary or artistic works may be copied;
 - the user may use the copies made in accordance with sub-subsection (1) and (2) in the precinct of the library or archive. Moreover, the library or archive may rent such copies to the users for their own use and own learning within its precinct.

 - The libraries may provide their copy of work with each other through post office, fax or secure electronic system. Provided that after the electronic copy file of literary or

artistic work is duplicated on the paper, such electronic copy file shall be deleted at once. Moreover, the received library may provide the duplicated paper for the users who access to such library. Such process of reproducing and providing the copy shall not be performed repeatedly.

- When the literary or artistic work is not available in required language for the users, the library or archive may translate the literary or artistic works which are officially obtained or authorized to use for teaching or research purposes. Such translation shall not be used for other purposes.
- A person or legal entity may translate the literary or artistic works to and from languages used by minority of people for public information, not for commercial purpose.
- Section 29: Notwithstanding the provisions of sub-sections (a), (f) and (g) of section 18²⁸, if it appears the source of literary or artistic works and name of author, and if these facts are referred, the following acts may be made without requiring to obtain the permission of right holder:
 - Reproduction in newspaper or periodical, broadcasting or communication to the public of articles about current political, economic or religious affairs which has already been published in newspaper or periodical, or broadcasts of similar articles. In case the permission is expressly restricted for reproduction, broadcasting or communication to the public in otherwise manner, such reproduction shall not be made.
 - For the purpose of reporting current affairs, the proper reproduction or broadcasting or communication to the public in otherwise manner of short excerpts of a literary or artistic work.
 - Publication in a newspaper, periodical or in otherwise manner, reproduction or broadcasting, communication to the public in otherwise manner of a political speech, a lecture, address, sermon, other similar literary or artistic related fiction or nonfiction speeches for the purpose of providing current information. Provided that such act shall not exceed the extent justified by the purpose and not for commercial purpose.

- Section 30: With respect to the computer program:

Notwithstanding the provisions of sub-sections (a) and (b) of section 18, the lawful owner of a copy of computer program may made reproduction or adaptation of a copy computer program without the permission of the right holder if it is conformed with any of the following facts:

- Applying the computer program to some extent for the purpose of having obtained the computer program;
- Requiring to keep the computer program as record and to replace the copy of computer program which is lawfully owned in the event that the said copy of the computer program is lost, destroyed or rendered unusable;
- reproduction a computer program for a back-up copy for own use.

No adaption of copy or original computer program shall be made for any purpose other than the facts mentioned in sub-section (a). Moreover, any copy or adaptation of computer program shall be destroyed in the event that the right to possess such copy of the computer program is invalid.

²⁸ Section 18...., the author or the copyright owner shall have the exclusive economic right to carry out or to authorize any of the following acts: (a) reproduction; (b) translation, adaptation, arrangement or other transformation or modification; (c) Selling the original or copy, or distributing to the public by assigning ownership in any otherwise manners; Proviso: The author or the copyright owner shall not entitle to the right to distribute original or copy of literary or artistic work which has already been sold or assigned the ownership with his permission in any other countries. (d) rental of original or copy of computer program, audiovisual work, cinematographic work, literary or artistic work embodied in phonogram, database or notation of musical work to the public with fee; Proviso: However, if computer program is not essential thing in rent, it shall not apply to the right to rent with fee. (e) public performance; (f) broadcasting; (g) communication to the public in otherwise manners; (h) collecting the literary or artistic works created by own

- Section 31: Any person, not for the purpose of commercial profit, may import a copy of literary or artistic work without permission of the right holder.
- Section 32: Notwithstanding the provisions of sub-section (a) of section 18, any broadcasting organization may make temporary recording of any literary or artistic work which is authorized for own broadcasting by means of its own facilities. In case of a literary or artistic work with exceptional character, such temporary record may be delivered to the government's archive to maintain.
- Section 33: Notwithstanding the provisions of sub-sections (a), (c), (e) and (g) of section 18, responsible organization shall be permitted, without the permission of the right holder, to make an accessible format of literary or artistic work, performance, phonogram or broadcasts, to receive a copy in such form from other responsible organization which undertakes for the visually impaired person, or to supply these copies of this accessible format to persons with visual impairment by any means, including by non-commercial lending or by communication by wire or wireless means, when all of the following conditions are conformed:- (a)
 - having access legally to such literary or artistic work or its copy by a responsible organization which is desirous of undertaking any activity under sub-section (a);
 - when converting the literary or artistic works to an accessible format, guiding the facts to be included in the accessible format without other amendments, other than making understandable to the beneficiary persons with visual impairment;
 - providing such copies for the exclusive use of beneficiary person with visual impairment;
 - undertaking on a non-profit basis.
- A beneficiary person with visual impairment, or someone acting on his behalf including a primary caretaker or caregiver, may make an accessible format copy of a work for the personal use of the beneficiary person or otherwise may assist the beneficiary person with visual impairment to make and use accessible format copies of work which can be accessed lawfully or of its copy. –(b)
- Responsible organization shall be permitted, without the permission of the right holder, to distribute or make available for the exclusive use of beneficiary persons accessible format copies to a responsible organization in other member country of Marrakesh Treaty relating to facilitate access to published works for persons who are visually impaired. –(c)
- Responsible organization shall be permitted, without the permission of the right holder, to distribute or make available accessible format copies to a beneficiary person with visual impairment in other member country to Marrakesh Treaty relating to facilitate access to published works for persons who are visually impaired. –(d)
- The permission granted under sub-section (c) and (d) may apply, provided that the responsible organization without knowing or having reasonable ground to know that accessible format copy would be used by other person prior to the distribution or making available of accessible format copy. Such act shall be limited to certain special cases, shall not conflict with a normal exploitation of the work and not to unreasonably prejudice the legitimate interests of the right holder. (e)

The criminal procedure for trademark and copyright infringement is shown by way of a flowchart in Annex 1 of this Chapter.

4. CIVIL IP ENFORCEMENT

4.1 Trademark and copyright civil case rules

Civil cases are governed by three groups of rules:

- The law under which the case is filed – the Trademark Law or the Copyright Law;
- The Specific Relief Act, 1877;
- The Evidence Act, 1872; and
- Precedent cases when applicable.

4.2 Trademark infringement

4.2.1 Infringement

A possible cause of action in respect of trademark infringements exists under Sections 42 and 54 of the Specific Relief Act, 1877.

Article 42 reads:

“Any person entitled to any legal character, or to any right as to any property may institute a suit against any person denying, or interested to deny, his title to such character or right, and the Court may in its discretion make therein a declaration that he is so entitled, and the plaintiff need not in such suit ask for any further relief

Article 54 reads:

“..(A) perpetual injunction may be granted to prevent the breach of an obligation existing in favour of the applicant, whether expressly or by implication;”

4.2.2 Passing off

Even though property in a name or mark is not vested in the “registered owner” through registration under statute in Myanmar, the country’s general law does provide that no trader has any right to misrepresent its goods as the goods of somebody else. An action to enforce this principle, namely an action based on passing off, lies where there is a real possibility of damage to some business or trading activity. It is not necessary to prove a fraudulent motive and the “injured party” is entitled to nominal damages if no actual damage is proved. The remedies that may be granted in actions for passing off in Myanmar include both interim and permanent injunctions and an award of damages or an account of profits. Also, in appropriate cases, orders may be made for the delivery up of infringing articles or labels for the destruction or erasure of the offending mark. Where the mark can be erased, the order may be for erasure only.

4.3 Copyright infringement

Copyright disputes can be filed in the Civil or Criminal Courts by authors, related rights owners, authors and heirs.

4.4 Civil IP remedies in trademark and copyright cases

This section covers specific IP remedies required by the TRIPS agreement. It is beyond the scope of this IP enforcement Manual to cover every kind of civil law procedure that might be possible in an IP case.

4.4.1 Rules for Civil IP cases

The new Trademark Law and Copyright Law both set out the procedures to file a civil lawsuit in the IP Court which is yet to be established.

4.4.2 Injunctions and preliminary injunctions

The remedies that may be granted in actions for passing off include both interim and permanent injunctions.

4.4.3 Damages

Myanmar's civil law does provide that no trader has any right to represent its goods as the goods of somebody else. An action to enforce this principle, namely an action based on passing off, lies where there is a real possibility of damages to some business or trading activity. It is not necessary to prove a fraudulent motive or representation, and the "injured party" is entitled to nominal damages if no actual damage is proved.

4.4.4 Other remedies

In appropriate cases, orders may be made for the delivery up of infringing goods for the destruction or removal of the offending mark from the channel of commerce.

4.4.5 Right of Information

No specific provisions in the Trademark Law or Copyright Law exist.

4.4.6 Indemnification of Defendant

This refer to protecting defendants from abuse by excessively aggressive Plaintiffs. The Trademark Law and Copyright Law provide that the Intellectual Property Court may order the rights holder to pay the respondent's appropriate expenses, legal (including reasonable attorneys' fees) or otherwise.

4.4.7 Provisional measures

Preliminary injunctions are described in section 4 above.

5. ECOMMERCE IP INFRINGEMENT FOR TRADEMARK AND COPYRIGHT

This section sets out the possible violations that relate to traders online, as well as online intermediaries (such as ISPs, ecommerce platforms etc.) at a civil or criminal level.

5.1 Trademark violations

The Trademarks Law contains no specific provisions on e-commerce digital infringement.

5.2 Copyright violations

Under the Copyright Law cases over online copyright infringements by traders may follow the regular criminal or civil provisions. For intermediaries there is no specific copyright law liability.

5.3 Internet law violations by intermediaries

A Cyberlaw is being drafted which will address internet law violations. The country's laws which can now be used in cases of defamation or fraud via the internet are the Communications Law 2013 and Electronic Transactions Law 2004 and Computer Science Development law, 1996.

6. CUSTOMS IP BORDER ENFORCEMENT

There is a new recordal system and seizure system for trademark and copyright under the new Trademark Law and Copyright Law.

6.1 Recordal process for trademarks and/or copyright

Currently there is a recordal process of trademarks with the Myanmar Customs. The procedure requires the trademark owner to file a request with the Customs Office with details of the recorded marks in Myanmar, authorized importer(s) in Myanmar. Customs Officers have conducted a couple of customs seizures so far.

The procedure is as follows:

- To record a trademark first before the custom recordal application is filed;
- To appoint local authorized distributor or local legal representative to avoid delay to response the notification from Customs;
- To prepare a comparison of genuine with counterfeit goods or a description of genuine goods;
- To publish a relevant trademark cautionary notice in newspaper before the ad hoc application has been applied;
- No original documents except cover letter are required at the time of filing the application. However, the original documents shall be submitted when the Customs Department informs the applicant to check those documents. Currently, late filing of documents is available in this matter.
- Myanmar Automated Cargo Clearance System (MACCS) has been launched since November 2016 which have a system to prohibit the brands from importation by third party once the ad hoc application has been filed for such brands.

Under the new Trademark Law and Copyright Law, there are new procedures for Customs actions.

After the acceptance of the application with suspected evidence that the goods have infringed the copyright or trademark is imported or being imported or to be imported into the Myanmar, or ex-officio action of the Customs Department, he may apply to the Director General of the Customs Department in accordance with the stipulations to issue the suspension order against the entry of such goods through the trade route.

The Director General of the Customs Department:

- shall notify the applicant whether the application is granted or refused within 30 days from the receipt date of application under section 68(a);
- in case the information is not sufficient to scrutinize the application, shall defer the decision by sending notice to the applicant to enable to submit the additional information within 15 days from the issuance date of notice.;
- when receiving the application, may order the applicant to deposit a guarantee to the Customs Departments in accordance with stipulations;
- if the application is refused, shall declare the reason expressly.

Unless the right holder requested a shorter period, under sub-section (a) shall be effective for a period of 6 months.

If there are sound evidences that the imported goods have infringed the copyright or the related right, the Director General of the Customs Department shall suspend the permission of free entry of such good through trade route and shall inform immediately to the applicant and the importer of such suspension.

Without divulging the confidential information, the Director General of the Customs Department shall permit the applicant and the importer sufficient opportunity to inspect the goods subject to suspension in order to substantiate the applicant's claim that the goods have infringed the copyright or trademark.

If the Director General of the Customs Department has not been informed that action is started to be taken to decide on the merits of the case by the applicant within 15 days after the applicant has been sent the notice of suspension or that the intellectual property court has taken long provisional measures to suspend the release of goods, the goods shall be released. In appropriate cases, this prescribed period may be extended by another 15 days by decision of the Customs authorities before the expiry of the first 15 days.

The prescribed period is 3 days in case of perishable goods.

If the importer, on receipt of the notice of suspension order, is not satisfied with the notification letter for suspension, he may apply to the respective Intellectual Property Court conferred jurisdiction. The Intellectual Property Court shall amend, revoke or approve the suspension period within 30 days from the

date of application for the right to review.

If the Intellectual Property Court determined that the goods have infringed copyrights or related right, the importer is liable to pay the costs for storage to the Customs Department, destruction or disposal of such goods.

If the Intellectual Property Court determined that the goods have not infringed the copyright or the related right, the applicant shall pay the importer the damages in an amount determined by the Intellectual Property Court caused by the wrongful suspension and temporary detention of such goods.

The provisions shall not apply to goods, which have been have infringed copyright or related right, intended for the importer's own personal use for non-commercial purpose, carried in personal luggage or sent on consignments mentioned in rules.

The Director General of the Customs Department, in respect of the goods that have infringed the copyright or related right, may exchange the information and co-operate with the World Customs Organization, Director Generals of the Customs Departments from the other countries and Collective Management Organization of Copyright or Related Right.

*The Recordal process for trademarks and/or copyright is shown in Annex 2 of this Chapter.

7. ADMINISTRATIVE IP ENFORCEMENT

The Consumer Protection Law, 2019. Law No. 9/2019, was enacted on 15 March 2019, entered into force on 15 March 2019. It provides administrative remedies against counterfeiters. However, these remedies known as product label requirement remedies will only enter into force on 15 March 2020.

8. OTHER ENFORCEMENT ISSUES

8.1 Alternate Dispute Resolution

The Trademarks Law allows civil trademark disputes to be settled through an arbitration or an alternative dispute resolution.

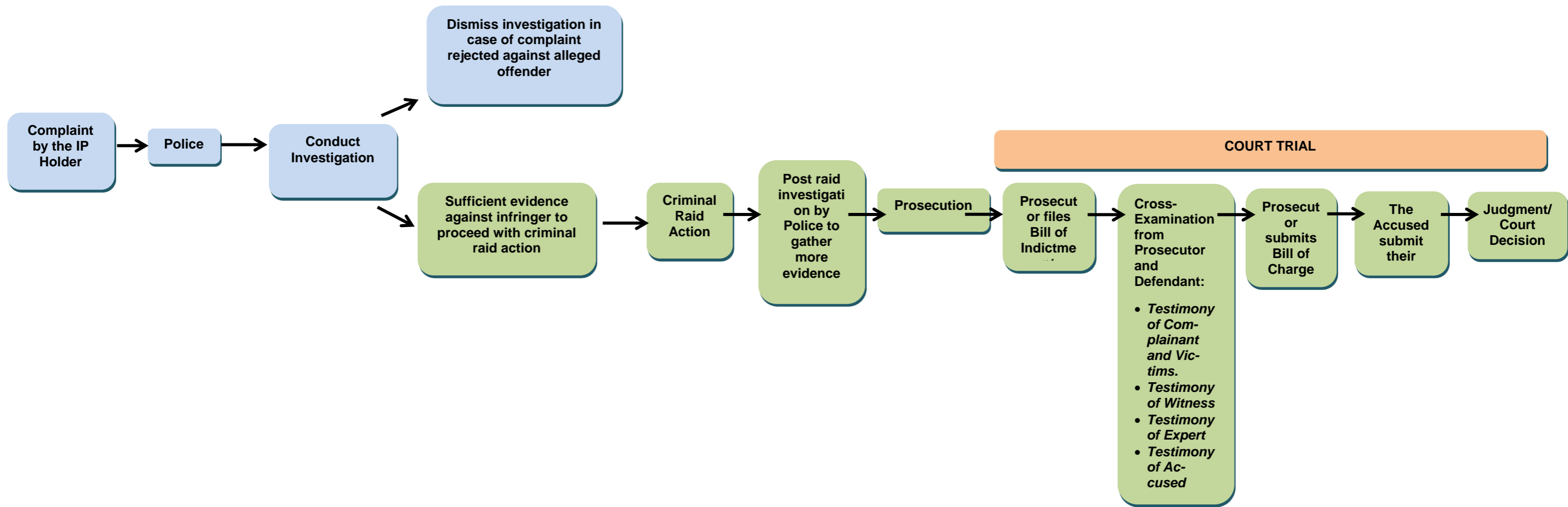
Article 95 of the Copyright Law also allow disputes "arising out among the parties regarding copyright or related right may be settled by amicable negotiation or by arbitration or by litigation. "

IP disputes are also resolved through mediation.

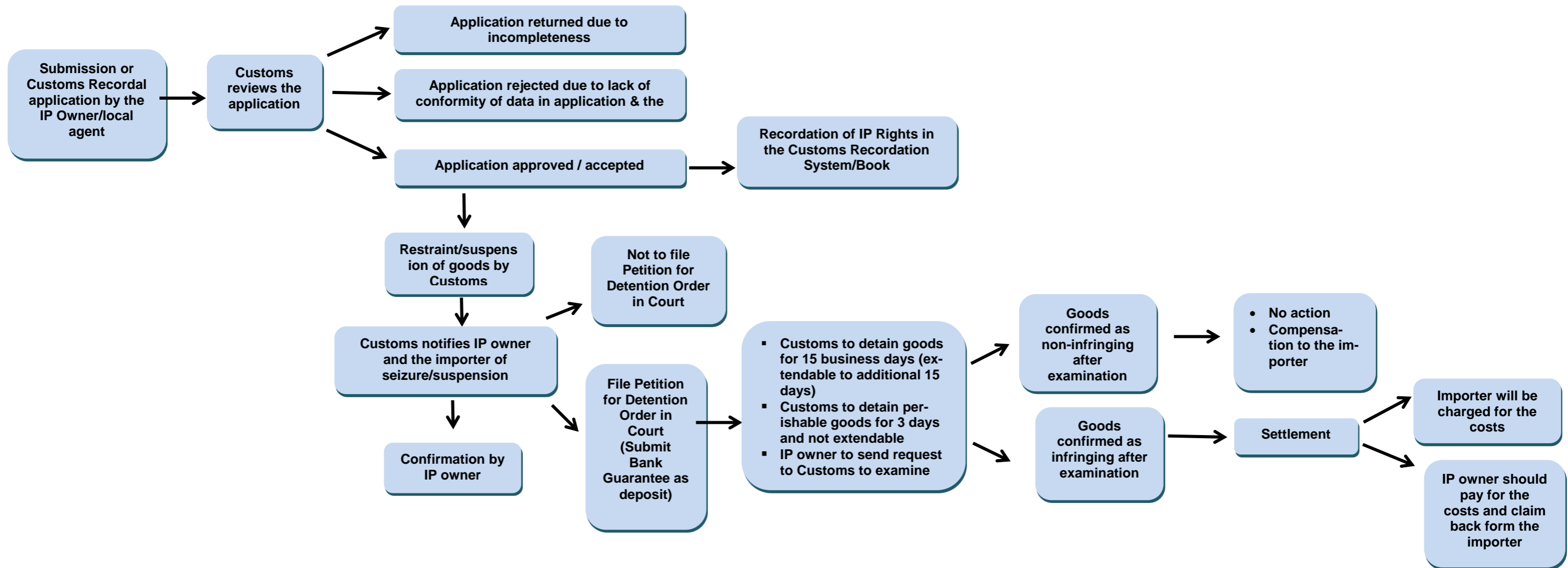
8.2 Warning letters and settlements

IP disputes can also be resolved by issuing a warning letter. Settlement Agreements and Undertakings can be used to reach a resolution and are enforceable before Myanmar Courts.

ANNEX 1: FLOWCHART FOR CRIMINAL PROCEDURE FOR TRADEMARK AND COPYRIGHTS



ANNEX 2: FLOWCHART ON CUSTOMS RECORDAL PROCESS FOR TRADEMARKS AND/OR COPYRIGHT





PHILIPPINES

The manual was developed under the Financial Sector and Intellectual Property (FSIP) programme, a component of the ASEAN Economic Reform Programme funded by the United Kingdom's cross government Prosperity Fund. This Chapter was drafted by Rouse & Co International. The authors are Edmund J Baranda and Ellen Rico.

IP ENFORCEMENT – PHILIPPINES

1. THE IP ENFORCEMENT SYSTEM UNDER TRIPS

The Philippines is primarily a civil law country. All the rules and procedures for IP enforcement are set out in laws and regulations. As a WTO TRIPS member, the Philippines commits to providing enforcement measures.²⁹ These comprise:

- civil and administrative remedies, including judicial procedures, evidence rules, injunctions, damages, other remedies, information to rights holder and right of indemnifications to defendants, as well as provisional measures (preliminary injunctions and search and seizure orders³⁰);
- criminal remedies; and
- customs interceptions of infringements.

This Manual sets out how these apply to counterfeiting (trademark infringements) and piracy (copyright infringements).

2. TRADEMARKS AND COPYRIGHT

Trademarks must be registered with the Intellectual Property Office of the Philippines (IPOP HL) in order to be granted protection under Republic Act No. 8293 or the Intellectual Property Code of the Philippines (the “IP Code”), as amended. Under the Madrid Protocol, the Philippines accepts applications under the international registration system.

Copyright protects a wide range of creative works under the IP Code. It confers the exclusive economic right to conduct and control activities in relation to the author or owner’s works as well as moral rights. A work is protected from the moment of creation, without need of registration. There is a voluntary recordal system for copyright at the National Library and IPOP HL. The copyright recordal serves as *prima facie* evidence of ownership of the copyright but is not required for enforcement.

3. CRIMINAL IP ENFORCEMENT

IP criminal disputes such as criminal actions for trademark or copyright infringement are under the jurisdiction of the Regional Trial Courts (RTCs) designated as Special Commercial Courts (SCCs). SCCs are RTCs that have been designated as such by the Supreme Court to handle matters concerning bankruptcies, intra-corporate disputes and intellectual property.

3.1.1 Criminal acts defined in the IP Code for Trademarks

Trademark infringement carries criminal penalties and occurs when an infringer does any of the acts defined in Section 155 of the IP Code, *i.e.*, use a registered mark in commerce without authority of the owner of the registered mark, which use is likely to cause confusion to the public. The elements of trademark infringement are as follows:

- The trademark is reproduced, counterfeited, copied, or colorably imitated by the infringer;
- The infringing mark is used in connection with the sale, offering or sale, or advertising of any goods, business or services, or the infringing mark is applied to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used upon or in connection with such goods, business or services;
- The use or application of the infringing mark is likely to cause confusion or mistake or to deceive purchases or others as to goods or services themselves or as to the source or origin of such goods or services or the identity of such business; and
- The use of the mark is without authority of the owner of the registered mark.³¹

²⁹ Part III of TRIPS - Articles 41-61

³⁰ A.M. No. 02-1-06-SC, Rule on Search and Seizure in Civil Actions For Infringement of Intellectual Property Rights issued on January 30, 2002

³¹ *Societe Des Produits Nestle, S.A. v. Dy, Jr.*, G.R. No. 172276, 9 August 2010

3.1.2 Criminal procedure for trademark infringement

The Rules of Procedure for Intellectual Property Rights Cases (A.M. No. 10-3-10-SC, 18 October 2011) (“Rules of Procedure for IPR Cases”) outlines the procedure in pursuing a criminal complaint or action for IP violations. Rule 12, Section 1 of the Rules of Procedure for IPR Cases states that the criminal complaint should be filed with the Department of Justice or office of the prosecutor that has jurisdiction over the offense.

3.1.3 The Philippine National Police and the National Bureau of Investigation

The Philippine National Police (PNP) and the National Bureau of Investigation (NBI) are the two main enforcement agencies that investigate crimes, including criminal acts under the IP Code such as trademark infringement. Section 24 of Republic Act No. 6975 provides the following relevant powers and functions of the PNP:

- Enforce all laws and ordinances relative to the protection of lives and properties;
- Maintain peace and order and take all necessary steps to ensure public safety;
- Investigate and prevent crimes, effect the arrest of criminal offenders, bring offenders to justice and assist in their prosecution;
- Exercise the general powers to make arrest, search and seizure in accordance with the Constitution and pertinent laws;
- Detain an arrested person for a period allowed by law, informing the person detained of rights under the Constitution; and
- Perform such other duties and exercise all other functions as may be provided by law.

Under Republic Act No. 10867, also known as the National Bureau of Investigation Reorganization and Modernization Act, among the powers and functions of the NBI is to undertake investigation and detection of crimes and offenses including violations of commercial, economic, and financial or white-collar crimes such as violations of the IP Code among others.³²

The agents of the NBI have the following powers and functions:

- Undertake investigations pursuant to the mandate of the NBI;
- Conduct searches, arrests, and seizures in accordance with existing laws, rules and regulations;
- Take and require sworn statements of any person or persons so summoned in relation to cases under investigation;
- Administer oaths in cases under investigation; and
- Such other functions as may be assigned by the NBI Director.

The results of the investigation of the NBI or the PNP may then be used to support the filing of a criminal complaint before the public prosecutor or the Department of Justice to commence the preliminary investigation.

3.1.4 Criminal prosecution for trademark infringement

The Revised Rules of Criminal Procedure of the Rules of Court is the general rule applicable in prosecuting criminal case. For IP cases, the Rules of Procedure for IPR Cases shall govern, as it is the special rule. However, when the court determines that the criminal action involves complex issues, the Rules of Court shall apply.

The steps in prosecuting criminal cases are as follows:

- Identify the venue for the filing of the complaint, which is the place where the infringement or some of its essential elements were committed.

³² Section 4 in relation to Section 5 of R.A. 10867

- File the complaint with the office of the prosecutor in that venue for the purpose of conducting preliminary investigation.
- The complaint is in the form of sworn written statement charging a person of an offense, such as trademark infringement, and subscribed by the offended party (the IP owner) or a public officer charged with the enforcement of the law violated (NBI or police).
- Filing of criminal information by the prosecutor with the court after determining during preliminary investigation that there is sufficient ground to hold the respondent for trial.

The criminal action shall be prosecuted under the direction and control of the public prosecutor. If the IP owner wishes to prosecute the criminal case, a private counsel may be appointed to do so but only upon prior authority of the office of the prosecutor and with all processes still being under the direction and control of the public prosecutor.

3.1.5 Criminal penalties for Trademark infringement

Section 170 of the IP Code provides criminal penalties of imprisonment and fine on any person violating Section 155 of the IP Code or committing trademark infringement. The court may impose the following penalties on any person found guilty of trademark infringement:

- Imprisonment of two (2) years to five (5) years; and
- Fine ranging from Php50,000.00 to Php200,000.00.

3.1.6 Defenses to Trademark Infringement

The following are limitations to an action for trademark infringement and may thus be raised as defense:

- A person who in good faith, before the filing or priority date of the registered trademark, was using the mark for the purposes of his business or enterprise (Section 159.1 of the IP Code);
- The innocent infringer who is engaged solely in the business of printing the mark or other infringing materials for others (Section 159.2 of the IP Code); and
- The infringement complained of is contained in or is part of paid advertisement in a newspaper, magazine, periodical or electronic communication (Section 159.3 of the IP Code).

3.2.1 Criminal acts defined in the IP Code for Copyrights

Infringement of copyright or related rights are laid down under Section 216 of the IP Code, as amended by Republic Act No. 10372, *i.e.*, any person who infringes any of the rights of a copyright owner or any person that exercise the rights of a copyright owner without the latter's authority, is criminally liable for copyright infringement. These are separated into three categories, as discussed below.

3.2.1.1 Direct infringement

Section 216(a) of the IP Code states that infringement is committed by a person who directly commits an infringement.

3.2.1.2. Secondary liability or Landlord liability

Section 216(b) of the IP Code states that infringement is also committed by a person who:

- Benefits from the infringing activity of another person who commits an infringement;
- The person benefitting has been given notice of the infringing activity; and
- The person benefitting has the right and ability to control the activities of the other person.

3.2.1.3. Contributory liability

Section 216(c) of the IP Code states that infringement is also committed by a person who with knowledge of the infringing activity, induces, causes or materially contributes to infringing conduct of another.

3.2.2 Criminal procedure for copyright infringement

The Rules of Procedure for IPR Cases shall likewise govern in the prosecution of infringement of copyright and related rights.

3.2.3 The Philippine National Police and the National Bureau of Investigation

The powers and functions of the PNP and the NBI in relation to copyright infringement are the same as to trademark infringement – please refer to Section 3.1.3 above.

3.2.4 Criminal Prosecution of copyright infringement

Criminal prosecution for copyright is the same as trademarks – please refer to section 3.1.4 above.

3.2.5 Criminal Penalties for copyright infringement

The Court may impose the following penalties on any person found guilty of copyright infringement:

- First offense: Imprisonment of one (1) to three (3) years and fine ranging from Php50,000.00 to Php150,000.00 – (a)
- Second offense: Imprisonment of three (3) years and one (1) day to six (6) years and fine ranging from Php150,000.00 to Php500,000.00 –(b)
- Third and subsequent offenses: Imprisonment of six (6) years and one (1) day to nine (9) years and fine ranging from Php500,000.00 to Php1,500,000.00 –(c)
- Subsidiary imprisonment in case of insolvency.

The respective maximum penalties in (a), (b) and (c) shall be imposed when the infringement is committed by:

- The circumvention of effective technological measures;
- The removal or alteration of any electronic rights management information from a copy of a work, sound recording, or fixation of a performance, by a person, knowingly and without authority; or
- The distribution, importation for distribution, broadcast, or communication to the public of works or copies of works, by a person without authority, knowing that electronic rights management information has been removed or altered without authority.

3.2.6 Defenses/exceptions: acts not considered as copyright infringement

Section 184 of the IP Code enumerates acts that are not considered as copyright infringement:

- The recitation or performance of a work, once it has been lawfully made accessible to the public, if done privately and free of charge or if made strictly for a charitable or religious institution or society;
- The making of quotations from a published work if they are compatible with fair use and only to the extent justified for the purpose, including quotations from newspaper articles and periodicals in the form of press summaries: Provided, That the source and the name of the author, if appearing on the work, are mentioned;
- The reproduction or communication to the public by mass media of articles on current political, social, economic, scientific or religious topic, lectures, addresses and other works of the same nature, which are delivered in public if such use is for information purposes and has not been expressly reserved: Provided, That the source is clearly indicated;
- The reproduction and communication to the public of literary, scientific or artistic works as part of reports of current events by means of photography, cinematography or broadcasting to the extent necessary for the purpose;
- The inclusion of a work in a publication, broadcast, or other communication to the public, sound recording or film, if such inclusion is made by way of illustration for teaching purposes and is

compatible with fair use: Provided, That the source and of the name of the author, if appearing in the work, are mentioned;

- The recording made in schools, universities, or educational institutions of a work included in a broadcast for the use of such schools, universities or educational institutions: Provided, That such recording must be deleted within a reasonable period after they were first broadcast: Provided, further, That such recording may not be made from audiovisual works which are part of the general cinema repertoire of feature films except for brief excerpts of the work;
- The making of ephemeral recordings by a broadcasting organization by means of its own facilities and for use in its own broadcast;
- The use made of a work by or under the direction or control of the government, by the National Library or by educational, scientific or professional institutions where such use is in the public interest and is compatible with fair use;
- The public performance or the communication to the public of a work, in a place where no admission fee is charged in respect of such public performance or communication, by a club or institution for charitable or educational purpose only, whose aim is not profit making, subject to such other limitations as may be provided in the regulations;
- Public display of the original or a copy of the work not made by means of a film, slide, television image or otherwise on screen or by means of any other device or process: Provided, That either the work has been published, or, that the original or the copy displayed has been sold, given away or otherwise transferred to another person by the author or his successor in title;
- Any use made of a work for the purpose of any judicial proceedings or for the giving of professional advice by a legal practitioner; and
- The reproduction or distribution of published articles or materials in a specialized format exclusively for the use of the blind, visually- and reading-impaired persons: Provided, That such copies and distribution shall be made on a non-profit basis and shall indicate the copyright owner and the date of the original publication.³³

Further, under Section 185 of the IP Code, the fair use of a copyrighted work for criticism, comment, news reporting, teaching including multiple copies for classroom use, scholarship, research, and similar purposes is not an infringement of copyright. In determining whether the use falls under the fair use exemption, the following factors are considered:

- The purpose and character of the use, including whether such use is of commercial nature or is for non-profit educational purposes;
- The nature of the copyrighted work;
- The amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- The effect of the use upon the potential market for or value of the copyrighted work.

*The criminal procedure for trademark and copyright infringement is shown by way of a flowchart in Annex 1 of this Chapter.

4. CIVIL IP ENFORCEMENT

IP civil disputes such as civil actions for trademark or copyright infringement are also under the jurisdiction of the Regional Trial Courts (RTCs) designated as Special Commercial Courts (SCCs).

³³ Introduced by R.A. No. 10372

4.1 Trademark and copyright civil case rules

4.1.1 Rules for civil IP cases

Four legal text set out the rules to apply in civil cases:

- The IP Code – sets out the remedies available to the complainant;
- The Civil Code of the Philippines – provides other damages that may be claimed;
- The Rules of Procedure for IPR Cases; and
- The Rules of Court apply in suppletory character to the Rules of Procedure for IPR Cases.

4.2 Trademark infringement

On top of criminal penalties, trademark infringement also carries civil liabilities.

4.2.1 Registered trademark infringement

In case of infringement of a trademark, the owner of the registered trademark is entitled to the following:

- Recover damages from any person who infringes the registered trademark rights (Section 156 of the IP Code);
- Seek injunction (Section 156 of the IP Code); and
- Seek the court to order the infringing materials to be destroyed (Section 157 of the IP Code).

Trademark infringement complaints may be resolved by arbitration or alternative dispute resolution. In any event all complaints must undergo mediation proceedings.

4.2.2 Well-known trademark infringement

Only registered trademarks may be subject to trademark infringement cases. However, owners of unregistered trademarks, including well-known trademarks, may sue for unfair competition.

4.3 Copyright infringement

On top of criminal penalties, copyright infringement also carries civil liabilities. Copyright disputes can be filed with the SCC by the copyright owner. The basis for copyright civil court cases includes:

- Infringement of copyright and related rights; and
- Moral rights violations

Copyright infringement complaints may be resolved through alternative dispute resolution or arbitration. In any event, civil cases for copyright infringement must undergo mediation proceedings.

Section 216.1 of the IP Code entitles the copyright holder to claim damages against the infringer. Further, the amount of damages to be awarded shall be doubled against a person who:

- Circumvents effective technological measures; or
- Having reasonable grounds to know that it will induce, enable, facilitate or conceal the infringement, remove or alter any electronic rights management information from a copy of a work, sound recording, or fixation of a performance, or distribute, import for distribution, broadcast, or communicate to the public works or copies of works without authority, knowing that electronic rights management information has been removed or altered without authority.

4.4 Civil IP remedies in trademark and copyright cases

This section covers specific IP remedies required by the TRIPS agreement. It is beyond the scope of this IP enforcement Manual to cover every kind of civil law procedure that might be possible in an IP case.

4.4.1 Injunctions and preliminary injunctions

IP owners may seek an injunction before the court to restrain or prevent further infringement. This is expressly provided in the IP Code in case of copyright infringement and trademark infringement.

Preliminary injunction is a provisional remedy available to the parties in IP disputes. The requirements are laid out in the Rule 58 of the Rules of Court, which have been summarized by jurisprudence as follows:

- The applicant must have a clear and unmistakable right to be protected;
- There is material and substantial invasion of such right;
- There is an urgent need to enjoin the action to prevent irreparable injury to the applicant; and
- No other ordinary, speedy and adequate remedy exists to prevent the infliction of irreparable injury.

4.4.2 Damages

The IP Code provides for recovery of damages to the complainant. In case of copyright infringement, the copyright owner may recover:

- Actual damages including:
 - legal costs;
 - expenses incurred due to the infringement; and
 - profits the infringer may have made due to such infringement;
- In lieu of actual damages and profits, such damages which the court deem just and which shall not be regarded as a penalty; or
- Statutory damages in a sum equivalent to the filing fee but not less than Php 50,000.00; in case the infringer is not aware and had no reason to believe that his acts constitute copyright infringement, the damages shall not be more than Php10,000.00.

The amount of damages shall be doubled against a person who circumvents effective technological measures or violates electronic rights management information.

4.4.3 Other remedies

Other remedies provided by the IP Code are:

- Disposal of the infringing goods outside the channels of commerce; and
- Seizure of tools and materials to create the infringing goods.

4.4.4 Right of Information

This refers to judicial orders that the infringer disclose the identity of third persons involved in the production and distribution of infringing goods. The IP Code does not provide for this specific remedy.

4.4.5 Indemnification of Defendant

This refers to protecting defendants from abuse by excessively aggressive complainants.

The IP Code does not expressly provide such right to indemnification, but the Civil Code of the Philippines gives the defendant the option to seek damages against the complainant for the latter's abuse of exercise of right.

4.4.6 Provisional measures

Preliminary injunctions are shown in section 4.4.1 above. However, other provisional orders can be made.

The complainant may also ask the court to attach the properties of the defendant as security for the satisfaction of any judgment that may be recovered.

5. E-COMMERCE IP INFRINGEMENT FOR TRADEMARK AND COPYRIGHT

This section sets out the possible violations that relate to traders online, as well as online intermediaries (such as ISPs, ecommerce platforms etc.) at a civil or criminal level.

5.1 Trademark violations

The IP Code does not have a specific provision on e-commerce digital infringement. Online trademark infringement cases by traders may follow the regular criminal or civil provisions. There is no specific liability for intermediaries.

5.2 Copyright violations

Similarly, as the IP Code does not have a specific provision on e-commerce digital infringement, online copyright infringement cases by traders may follow the regular criminal or civil provisions. There is a specific liability though that may apply to intermediaries such as through landlord liability or contributory liability. Please see 3.2.1.2 and 3.2.1.3 above.

5.3 Internet law violations by intermediaries

There is no separate internet or e-commerce law regime which provides a notice and takedown procedure, but Section 30 of Republic Act No. 8792 also known as the Electronic Commerce Act of 2000 provides for safe harbour protection for ISPs.

6. CUSTOMS IP BORDER ENFORCEMENT

A customs recordal system is in place in the Philippines. Seizures and alert orders by the Bureau of Customs are also available.

6.1 Recordal process for trademarks and/or copyright

The recordal system for trademarks and copyrights before the Bureau of Customs (BOC) is provided under Customs Administrative Order No. 6-2002. The following have to be submitted in support of the recordal:

- Trademark certificates or copyright information;
- Photos or samples of the genuine goods; and
- Information about the supplier, importer and distributor of the genuine goods.

Recordals are valid for two (2) years and are renewable for two-year periods.

6.2 Restraint/Seizure of Goods

Section 118(f) of Republic Act No. 10863 or the Customs Modernization and Tariff Act (CMTA Law) prohibits the importation and exportation of infringing goods. Section 216 gives the customs the power to seize the infringing goods, which are subject to forfeiture by the government.

6.3 Detention order

Section 117 of the CMTA Law provides the authority of the District Collector to issue a warrant of seizure of the goods upon determination of probable cause, which may include certification by the IP owner that the goods seized by the customs are indeed infringing goods.

6.4 Examination of detained goods

The BOC issues a Warrant of Seizure and Detention (WSD) to formally direct a customs officer to seize any goods when the goods involved are subject to forfeiture such as smuggled goods or prohibited importation of infringing goods. Upon issuance of WSD, the seizure and forfeiture proceedings will follow where the claimant of the seized/detained goods will have the opportunity to be heard, including contesting the seizure or detention of goods if upon issuance of WSD and upon examination of the

detained goods, the IP owner or its representative has not provided proof that the seized or detained goods are infringing goods.

6.5 Legal action/settlement

Section 1135 of the CMTA Law provides that the BOC, with the assistance of the Department of Justice, has the authority to institute civil and criminal actions and proceedings against persons found violating the CMTA Law.

Settlement of seizure case is provided in Section 1124 of the CMTA Law, which may be allowed by the BOC upon payment of fine, provided there is no fraud involved or when the discrepancy in duties and taxes to be paid between what is determined and what is declared exceeds 30%. Redemption of forfeited goods, however, is not allowed where importation is prohibited or when release of the goods is contrary to law such as in the case of infringing goods.

*The Recordal process for trademarks and/or copyright is shown in Annex 2 of this Chapter.

7. ADMINISTRATIVE IP ENFORCEMENT

Administrative remedies are available in the Philippines through the Bureau of Legal Affairs (BLA) of the IPOPHL. The BLA exercises original jurisdiction in administrative complaints for violations of laws involving intellectual property rights where the total damages claimed are not less than Two Hundred Thousand Pesos (Php 200,000). It also has the power to hold and punish for contempt all those who disregard orders or writs issued in the course of the proceedings.

The IPOPHL Intellectual Property Rights Enforcement Office (IEO), which was established to function as the enforcement arm of IPOPHL, can also receive complaints involving outright counterfeiting and piracy.

7.1 Trademark and copyright administrative case rules

Administrative cases are governed by the following rules:

- The IP Code – sets out the remedies available to the complainant;
- Rules and Regulations on Administrative Complaints for Violation of Law Involving IP Rights (IPV Rules), as amended;
- The Rules of Procedure for IPR Cases, which apply in suppletory character to the IPV Rules; and
- The Rules of Court, which also apply in suppletory character to the IPV Rules.

For cases filed with the IEO, the Rules and Regulations on Enforcement of IPOPHL³⁴ applies.

7.2 Trademark infringement

Under the IP Code and the IPV Rules, the owner of a registered trademark whose rights have been infringed is entitled to the following:

- Cease and desist order against the respondent (Sec. 10.2 (b) (i), IP Code)
- Recover damages from any person who infringes the registered trademark rights (Section 156 of the IP Code);
- Seek injunction (Section 156 of the IP Code);
- Seek the condemnation or seizure of the products subject of the offense, which may be disposed in a manner deemed appropriate by the Director of the Bureau of Legal Affairs of the IPOPHL (Rule 12, Section 1(c) of the IPV Rules);

³⁴ Office Order No. 13-170 which is the Rules and Regulations in the Exercise of Enforcement Functions and Visitorial Power of the Intellectual Property Office, and Creating Thereby an Intellectual Property Rights (IPR) Enforcement Office.

- Forfeiture of paraphernalia and properties used in the commission of the offense (Rule 12, Section 1(d) of the IPV Rules);
- Imposition of administrative fines of Php5,000.00 to Php150,000.00 and additional fine of not more than Php1,000.00 for each day of continuing violation (Rule 12, Section 1(e) of the IPV Rules);
- Cancellation of any permit, license, authority or registration granted by the IPOPHL (Rule 12, Section 1(f) of the IPV Rules);
- Withholding of any permit, license, authority or registration pending with the IPOPHL (Rule 12, Section 1(g) of the IPV Rules);
- Seek issuance of preliminary attachment as security for the satisfaction of any judgement (Rule of the IPV Rules)

Administrative complaints for trademark infringement may be resolved through alternative dispute resolution or arbitration. The IPOPHL under its Alternative Dispute Resolution (ADR) Services offers mediation proceedings and arbitration. Referral to mediation is mandatory in all administrative cases for violations of IPR filed with the IPOPHL except when there is application for TRO and/or injunction.

7.2.1 Well-known trademark infringement

Owners of registered well-known trademarks may file an administrative action for trademark infringement. However, owners of unregistered trademarks, including well-known trademarks, may sue for unfair competition.

7.2.2 Copyright infringement

Copyright disputes can be filed with the BLA of the IPOPHL on the grounds of:

- Infringement of copyright and related rights; and
- Moral rights violations.

Administrative complaints for copyright infringement may be resolved by alternative dispute resolution or arbitration. As a rule, all administrative cases filed with the BLA are mandatorily referred to ADR services for mediation proceedings except when there is an application for issuance of a TRO and/or preliminary injunction.

Section 216.1 of the IP Code entitles the copyright holder to claim damages against the infringer. Further, the amount of damages to be awarded shall be doubled against a person who:

- Circumvents effective technological measures; or
- Having reasonable grounds to know that it will induce, enable, facilitate or conceal the infringement, remove or alter any electronic rights management information from a copy of a work, sound recording, or fixation of a performance, or distribute, import for distribution, broadcast, or communicate to the public works or copies of works without authority, knowing that electronic rights management information has been removed or altered without authority.

7.3. Administrative IP remedies in trademark and copyright cases

7.3.1. Rules for administrative cases

Please see discussion in 7.1.

7.3.2. Injunctions and preliminary injunctions

The IPV Rules provide that parties in IPV cases may apply for an injunction. Please also see discussion in 4.4.1.

7.3.3. Damages

The IP Code provides recovery of damages to the complainant. In case of copyright infringement, the copyright owner may recover actual damages including:

- Legal costs;
- Expenses incurred due to the infringement; and
- Profits the infringer may have made due to such infringement.

In lieu of actual damages and profits, such damages which the court deem just and which shall not be regarded as a penalty.

The amount of damages shall be doubled against a person who circumvents effective technological measures or violates electronic rights management information.

7.4 Other remedies

Other remedies provided under the IP Code are:

- disposal of infringing goods outside the channels of commerce; and
- seizure of tools and materials to create infringing goods.

Right holders may also avail of the visitorial power of the IPOPHL by filing a complaint with the IEO. If the complaint is found sufficient and there is basis that a party is engaged in counterfeiting or piracy, the IEO can issue a warning order, visitorial order and/or compliance order.

7.4.1 Right of Information

This refers to judicial orders that the infringer disclose the identity of third persons involved in the production and distribution of infringing goods. The IP Code does not provide for this specific remedy.

7.4.2 Indemnification of Defendant

This refers to protecting defendants from abuse by excessively aggressive complainants.

The IP Code does not have an express provision on this. However, the defendant may, under the Civil Code, recover damages in a civil action against the complainant on the ground of the latter's abuse of exercise of right.

7.4.3 Provisional measures

Preliminary injunctions are described in section 4.4.1 above. However, other provisional orders can be made.

The complainant may ask the BLA to attach the properties of the defendant as security for the satisfaction of any judgment that may be recovered.

8. OTHER ENFORCEMENT ISSUES

8.1 Alternative Dispute Resolutions

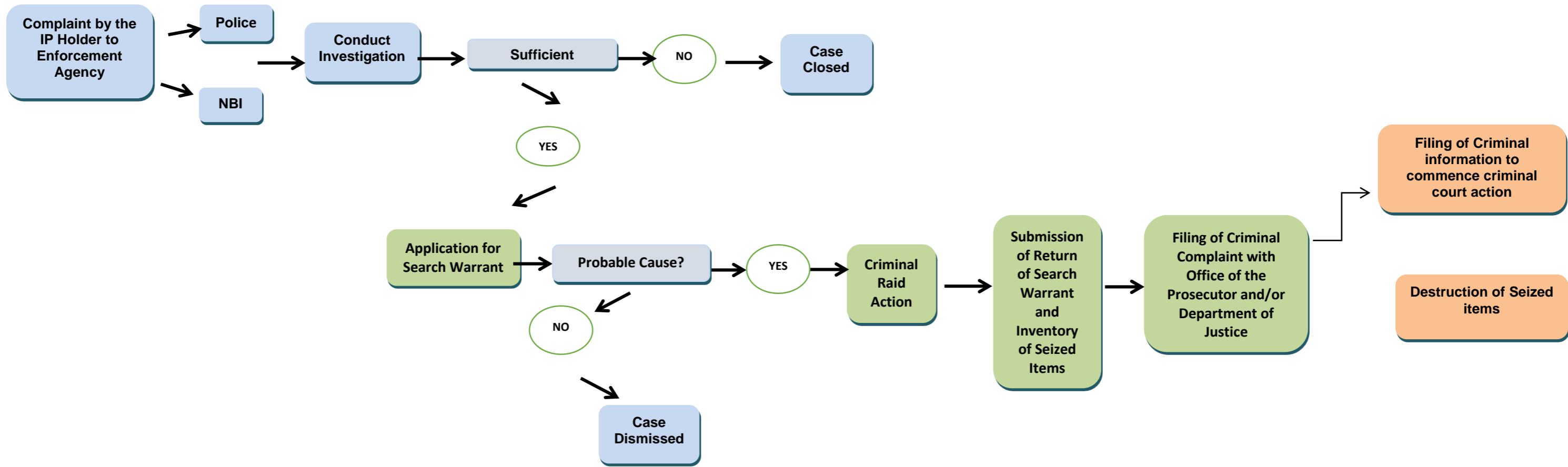
Civil and criminal trademark infringement disputes may be settled through alternative dispute resolutions. The Special Rules of Procedure for IPR Cases specifically requires the parties to go through mediation proceedings after pre-trial, for civil cases, and after arraignment but before pre-trial in criminal cases.

The IPOPHL also provides mediation cases for IP-related disputes. Administrative complaints for violation of IP rights such as trademark infringement and copyright infringement are required to undergo mediation proceedings. Further, the IPOPHL, through Memorandum Circular No. 2019-006, series of 2019, now accepts mediation outside of litigation, which contemplates seeking mediation before the filing of a case.

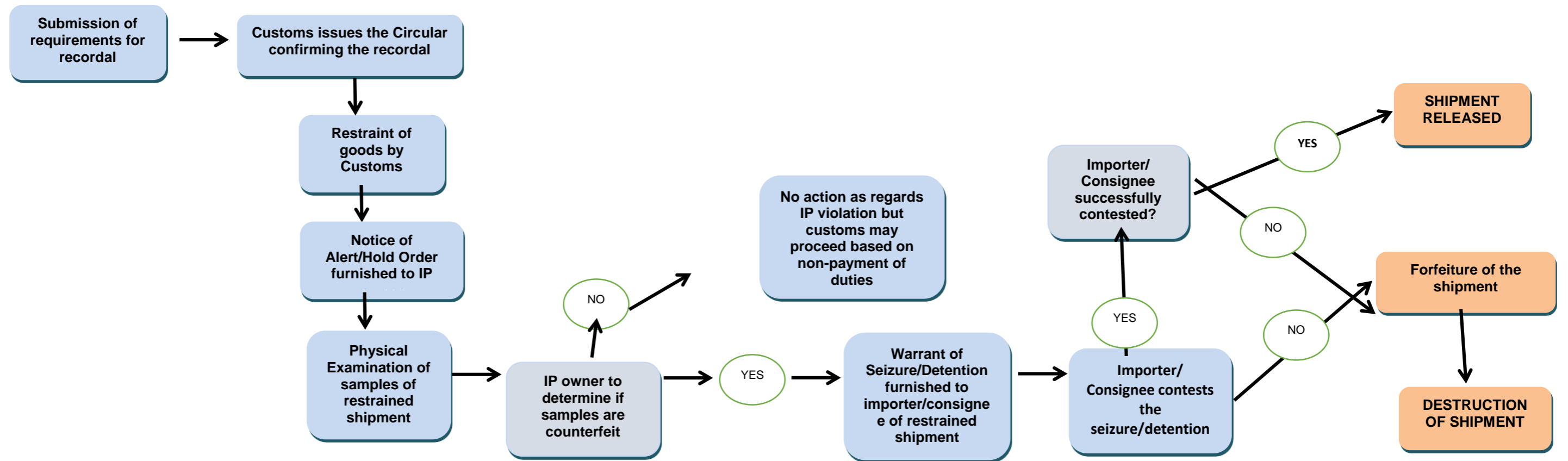
8.2 Warning letters and settlements

Many IP disputes are resolved by issuing a warning letter, and the IP owner and the alleged infringer resolve the dispute. Settlement Agreements and Undertakings can be used to reach a resolution.

ANNEX 1: FLOWCHART FOR CRIMINAL PROCEDURE FOR TRADEMARK AND COPYRIGHTS



ANNEX 2: FLOWCHART ON CUSTOMS ENFORCEMENT FOR TRADEMARKS AND/OR COPYRIGHT





SINGAPORE

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IP ENFORCEMENT– SINGAPORE

1. THE IP ENFORCEMENT SYSTEM UNDER TRIPS

As a member of the World Trade Organization's TRIPS Agreement, Singapore adopts stringent enforcement measures to protect Intellectual Property Rights, including:

- Civil actions with possible remedies such as injunctions to stop further infringing activity, damages as compensation and orders for the removal of infringing goods such as destruction;
- Criminal actions for willful trademark and copyright infringement; and
- Border enforcement provisions provide measures for the detection and enforcement of goods infringing copyright and trademarks being imported into and exported out of Singapore. Singapore does not provide border enforcement for goods in transit as of right. Customs authorities have ex-officio powers to stop infringing goods in transit. While it is possible for trademark and copyright owners to request for the seizure of infringing goods being imported and exported out of Singapore, they cannot do so for infringing goods in transit.

2. TRADEMARKS AND COPYRIGHT

Singapore has a dual system of protection for trademarks, provided by the Trademarks Act (Chapter 332) ("TMA") and the common law of passing off. These two systems are independent of each other.

Statutory protection and the provisions for enforcement of trademark rights in Singapore are conditional upon the registration of the trademark with the Intellectual Property Office of Singapore ("IPOS"). There are two exceptions: (i) special protection is granted under the TMA to 'well-known' trademarks, regardless whether they are registered and (ii) the common law of passing off.

Trademarks may be registered either through a domestic application with IPOS or an international application filed under the Madrid Protocol, designating Singapore as a country where protection is sought.

In Singapore, the Copyright Act (Chapter 63) ("CA") provides statutory protection, in the form of a bundle of exclusive rights, to the owner of original works for limited periods of time and subject to certain permitted exceptions. It is not possible to register a copyright in Singapore, as there is no Registry of Copyright; copyright exists at the point of creation. Singapore is also a party to the Berne Convention and thus copyrighted works in any of the 177 countries are similarly protected in Singapore.

For the purposes of this Manual, we will focus on the enforcement provisions of the TMA and CA. Unlike some of the other ASEAN countries, there are no specific e-commerce or administrative enforcement provisions under the TMA and CA.

3. CRIMINAL IP ENFORCEMENT

3.1.1. Criminal offences under TMA

The TMA provides several trademark related offences, allowing the registered proprietor to enforce his trademark rights in criminal proceedings. Any person shall be guilty of a criminal offence in Singapore if he or she commits any of the following:

3.1.1.1. Counterfeiting a trademark

Section 46 of the TMA provides that any person is deemed to counterfeit a registered trademark if he or she:

- Makes a sign identical to or so nearly resembling a registered trademark as to be calculated to deceive; or
- Falsifies a genuine registered trademark, whether by alteration, addition, effacement, partial removal or otherwise;
- without the consent of the registered proprietor.

3.1.1.2. Falsely applying a registered trademark to goods or services

Section 47 of the TMA provides that any person who falsely applies a registered trademark to goods or services, shall, unless a person proves that he or she acted innocently, will be guilty of an offence of falsely applying a registered trademark.

Falsely applying a registered trademark includes the following acts:

- The person applies the trademark or a sign likely to be mistaken for the proprietor's registered trademark to goods and services without the proprietor's consent; and
- If the mark or sign is applied to goods, the goods are not the genuine goods of the proprietor or licensee of the registered trademark.

A trademark is applied to goods or services if it is used in the following manner:

- any sign or advertisement; or
- any invoice, wine list, catalogue, business letter, business paper, price list or other commercial document, including any such document in any medium,
- and the goods are delivered, or services provided to a person in pursuance of a request or order made by reference to the trademark as so used.

3.1.1.3. Making or possessing of article for committing offence

Section 48 of the TMA provides that any person who:

- makes an article specifically designed or adapted for making copies of a registered trademark or a sign likely to be mistaken for that trademark; or
- has such an article in his possession, custody or control,
- knowing or having reason to believe that it has been, or is to be, used for, or in the course of, committing an offence against sections 46 or 47, shall be guilty of an offence for making or being in possession of such article.

3.1.1.4. Importing or selling, etc., goods with falsely applied trademark

Section 49 of the TMA provides that any person who:

- imports into Singapore for the purchase of trade or manufacture;
- sells or offers or exposes for sale; or
- has in his possession for the purpose of trade or manufacture,

Any goods to which a registered trademark is falsely applied will be guilty of an offence under this section, unless:

- he has taken all reasonable precautions against committing an offence, and had no reason to suspect the genuineness of the mark and gave to the prosecution, all information in his power with respect to the persons from whom he obtained the goods; or
- he had acted innocently.

3.1.1.5. Falsification of Register

Section 50 of the TMA provides that any person who:

- makes, or causes to be made, a false entry in the register;
- makes, or causes to be made, anything false purporting to be an entry in the register; or
- produces or tenders in evidence or causes to be produced or tendered in evidence anything referred to in paragraph (b),

- knowing or having reason to believe that the entry or thing, as the case may be, is false, shall be guilty of an offence under this section.

3.1.1.6. Falsely representing trademark as registered

Section 51 of the TMA provides that any person who falsely represents that a trademark is registered, or makes a false representation as to the goods or services for which a trademark is registered, knowing or having reason to believe that the representation is false, shall be guilty of an offence under this section.

3.1.1.7. Representation on trademarks of Arms or Flags prohibited, etc.

Section 52 of the TMA prohibits the unauthorized use or representation of the Arms or the Flag of Singapore, or of any arms or devices likely to be mistaken for them, for the purpose of trade, unless such trademark is authorized to be used by order of the President.

3.1.1.8. Forfeiture and destruction of goods, etc., on conviction

Section 53 of the TMA empowers the court to order any person who has been convicted of an offence relating to a registered trademark to forfeit to the Government all or any goods in relation to which, or articles by means of which the offence was committed.

Where any person has been convicted of falsely applying a registered trademark to goods or services (section 47 of the TMA) or importing or selling goods with falsely applied trademark (section 49 of the TMA), the court shall order the person to forfeit to the Government for destruction goods in relation to which the offence was committed; and goods in relation to which the trademark has been falsely applied, and goods or their packaging which bear the trademark or sign giving rise to the false application of the trademark, unless there are exceptional circumstances for deciding otherwise.

The forfeiture or forfeiture and destruction of goods is in addition to any penalty or punishment that the court may impose for the offence committed.

3.1.2. Criminal procedure for trademark infringement

In Singapore's context, criminal actions for trademark infringement could be commenced by either the right holders or the Police. Singapore adopts a 2-pronged approach for enforcing IP rights, namely (a) a police-led or collaborative approach and (b) a collaborative approach where the police works hand-in-hand with IP owners.

In the Police-led approach, on receipt of information relating to infringement activities, the police will make an assessment before the commencement of raids and investigations against the perpetrators. At the end of the investigations, the police will review the facts and evidence gathered before initiating criminal prosecution against perpetrators.

As for the Collaborative approach, the right holders will gather the necessary intelligence of the perpetrators before initiating raids with the full assurance of police's assistance and support. The right holders retain the control of the case and decide whether they should proceed to commence criminal proceedings against the perpetrators after obtaining authorisation (also known as fiat) from Attorney-General's Chambers (AGC).

3.1.2.1 Powers of entry, search and seizure

Search & Seizure under a Search Warrant

Pursuant to section 53A(3) of the TMA, the court may issue, either conditionally or subject to such conditions as the court thinks fit, a warrant authorizing a police officer to enter and search premises for articles and documents specified in the warrant, whether specifically or in any general category, and to seize any of such articles and documents found at the premises if he or she is satisfied that there is a reasonable cause for suspecting that there is in any premises any article or document which is evidence that an offence has been committed.

3.1.2.2 In the event where prosecution is not initiated within time limit

For seizure of any goods, material, article or document, which are made under 53A(3) of the TMA, Section 53A(4)(b) states that where no prosecution is initiated within six months of the seizure, the articles or documents seized shall be returned to the person in whose possession they were when they were seized or, be disposed of in accordance with the law regulating the disposal of lost or unclaimed property in the hands of police authorities if it is not reasonably practicable to return them to that person.

3.1.2.3 Police's power and powers of other officers

Search & Seizure without a Search Warrant

On the other hand, under Section 53A (2) TMA, any “**authorised officer**”, without a warrant issued under section 53A (3) TMA, may:

- stop, search and board, whether forcibly or otherwise, any conveyance in which he reasonably suspects there are goods to which a registered trade mark has been falsely applied; and
- seize, remove or detain any such goods and anything which appears to him —
 - to be or to contain; or
 - to be likely to be or to contain, evidence of any offence under section 46, 47, 48, 49 or 52.

“*Authorised Officer*” as defined in Section 53A (6) TMA consists of the following:

- a police officer;
- an officer of customs as defined in the Customs Act (Cap. 70);
- an immigration officer as defined in the Immigration Act (Cap. 133); or
- any officer or class or description of officers appointed by the Minister by notification in the Gazette to exercise the powers and perform the duties conferred and imposed on an authorised officer by this section.

Arrest and Investigation

In addition, Section 53A of the TMA empowers any police officer to arrest without warrant any person who, in any street or public place, does the following acts:

- sells or offers or exposes for sale; or
- has, or is reasonably suspected of having, in his possession for the purpose of trade or manufacture, any goods to which a registered trademark is falsely applied.

Under the Criminal Procedure Code (Chapter 68) (“CPC”), police officers may exercise any of the special powers of investigation when investigating an arrestable case, including:

- the power to require the attendance of witnesses;
- the power to examine witnesses;
- the power to search, without a warrant, for any document or thing in any place;
- the power to access computers and for search and inspection; and
- the power to require any complainant or witness to execute a bond to testify in court.

3.1.3 Criminal Prosecution of Trademark Infringement

Under Section 106 of TMA, a District Court or a Magistrate's Court have the jurisdiction to hear and determine all offences under TMA.

3.1.4 Criminal penalties for trademark infringement

3.1.4.1 Penalty for counterfeiting a registered trademark

On conviction under section 46 of the TMA, that person shall be liable to a fine not exceeding SGD100,000 or to imprisonment for a term not exceeding 5 years or to both.

3.1.4.2 Penalty for falsely applying a registered trademark

On a conviction under section 47 of the TMA, that person shall be liable to a fine not exceeding SGD100,000 or to imprisonment for a term not exceeding 5 years or to both.

3.1.4.3 Penalty for making or possessing an article for committing offence

On a conviction under section 48 of the TMA, that person shall be liable to a fine not exceeding SGD100,000 or to imprisonment for a term not exceeding 5 years or to both.

3.1.4.4 Penalty for importing or selling goods with falsely applied trademark

On a conviction under section 49 of the TMA, that person shall be liable to a fine not exceeding SGD10,000 for each goods or thing to which the trademark is falsely applied (but not exceeding in the aggregate SGD100,000), or to imprisonment for a term not exceeding 5 years or to both.

3.1.4.5 Penalty for falsification of register

On a conviction under section 50 of the TMA, that person shall be liable on conviction to a fine not exceeding SGD50,000 or to imprisonment for a term not exceeding 5 years or to both.

3.1.4.6 Penalty for falsely representing trademark as registered

On a conviction under section 51 of the TMA, that person shall be guilty of an offence and shall be liable on conviction to a fine not exceeding SGD10,000.

3.1.4.7 Penalty for representation of trademark of arms or flags

On conviction under section 52 of the TMA, that person shall be liable on conviction to a fine not exceeding SGD50,000 or to imprisonment for a term not exceeding 5 years or to both, and shall forfeit to the Government any goods or things to which the trademark bearing the prohibited representation is applied.

3.2.1 Criminal offences under the CA

- A person shall be guilty of an offence under section 136(1) of the CA if he or she:
 - makes for sale or hire;
 - sells or lets for hire, or by way of trade offers or exposes for sale or hire; or
 - by way of trade exhibits in public any article which he or she knows or ought reasonably to know, to be an infringing copy of the work at a time copyright subsists in the work. This encompasses the act of selling, regardless of whether there is a resulting transaction. – (1)
- A person shall be guilty under section 136(2) of the CA of an offence if he or she has in his or her possession or imports into Singapore any article which he or she knows, or ought reasonably to know to be an infringing copy of the work for:
 - selling, letting for hire, or by way of trade offering or exposing for sale or hire, the article;
 - distributing the article for the purpose of trade, or for any other purpose to an extent that will affect prejudicially the owner of the copyright in the work; or
 - by way of trade exhibiting the article in public. – (2)

- Any person shall be guilty of an offence under section 136(3) of the CA if any person distributes articles which he or she knows, or ought reasonably to know, to be infringing copies of the work either:
 - for purposes or trade; or
 - for other purposes, but to such an extent as to affect prejudicially the owner of the copyright at a time when copyright subsists in the work. – (3)
- Any person shall be guilty of an offence under section 136(3A) of the CA if a person does an act that constitutes an infringement of the copyright in the work or subject-matter; the infringement is willful; and either the extent of the infringement is significant or the person does the act to obtain a commercial advantage, or both. – (4)
- A person shall be guilty of an offence under section 136(4) of the CA if, at the time when copyright subsists in a work or subject-matter, the person makes or has in his or her possession an article specifically designed or adapted for making copies of the work that the person knows, or ought reasonably to know, is to be used for making infringing copies of the work or subject-matter. – (5)
- A person shall be guilty of an offence under section 136(6) of the CA if the person, who for his or her private profit causes a literary, dramatic or musical work to be performed in public, or causes a cinematograph film to be seen or heard or seen and heard in public, other than by the reception of a television broadcast or cable programme, where he/she knows, or ought reasonably to know that copyright subsists in the work or cinematograph film and that the performance consists an infringement of the copyright. – (6)
- A person shall be guilty of an offence under section 139 of the CA if he or she publishes, or causes to be published, in Singapore an advertisement for the supply in Singapore (whether from within or outside Singapore) of a copy of a computer program which is an infringing copy shall, unless he proves that he or she acted in good faith and had not reasonable grounds for supposing that copyright would or might thereby be infringed. – (7)

3.2.2 Criminal procedure for copyright infringement

Similar to trademark infringement, criminal actions for copyright infringement could be commenced by either the right holders or the Police. Please refer to para. [3.1.2] for the details.

3.2.2.1 Powers of entry, search and seizure

Search & Seizure under a Search Warrant

Pursuant to section 136(9) of the CA, the court may issue, either conditionally or subject to such conditions as the court thinks fit, a warrant authorizing a police officer to enter and search premises for articles and documents specified in the warrant, whether specifically or in any general category, and to seize any of such articles and documents found at the premises if he or she is satisfied that there is a reasonable cause for suspecting that there is in any premises any article or document which is evidence that an offence has been committed.

3.2.2.2 In the event where prosecution is not initiated within time limit

Section 136(10) of the CA states that where no prosecution is initiated within six months of the seizure, articles or documents seized shall be returned to the person in whose possession they were when they were seized or, be disposed of in accordance with the law regulating the disposal of lost or unclaimed property in the hands of police authorities if it is not reasonably practicable to return them to that person.

3.2.2.3 Police's power and powers of other officers

Search & Seizure without a Search Warrant

Section 138(1) of the CA permits any police officer to arrest any person in any street or public place without a warrant if he or she (1) sells or exposes or offers for sale; or (2) has, or is reasonably suspected

of having, in his or her possession for the purpose of selling or letting for hire, any infringing copy of any work or other subject-matter.

Any authorized officers are also permitted, pursuant to section 138(2) of the CA, to stop, search and board any conveyance which he or she reasonably suspects that has an infringing copy of any work or other subject-matter; and may seize, remove or detain any such infringing copy and anything which appears to him or her to be or to contain; or to be likely to be or to contain, evidence of an offence under the Copyright Act.

The definition of “*Authorised Officer*” under CA is defined in Section 136(3) and comprises the same group of officers as mentioned in para. [3.1.2.3].

The arrest and investigative powers granted to the Police for copyright infringement are similar to those mentioned in para. [3.1.2.3].

3.2.3 Criminal Prosecution of copyright crimes

Under section 140 of the CA, the District Court or Magistrate’s Court shall have jurisdiction to try any offence under the Copyright Act and award the full punishment for such offence.

3.2.4 Criminal Penalties for copyright infringement

- A fine of not more than SGD10,000 for each infringing copy up to a maximum fine of SGD100,000, or imprisonment for a term not exceeding five years or both for offences set out in (1) and (2) of 3.2.1 above. In practice, custodial sentences are the norm unless the quantity of infringing article is small.
- A fine of not more than SGD50,000 or imprisonment for a term not exceeding three years or both for offence set out in (3) of 3.2.1 above.
- A fine of not more than SGD20,000 or imprisonment for a term not exceeding six months or both. For any subsequent offence, the penalty is a fine not exceeding SGD50,000 or imprisonment for a term not exceeding three years or both. This penalty is in relation to the offence set out in (4) of 3.2.1 above.
- A fine of not more than SGD20,000 for each article in respect of which the offence is committed or imprisonment for a term not exceeding two years or both for the offence set out in (5) of 3.2.1 above.
- A fine of not more than SGD20,000 or imprisonment for a term not exceeding two years or both for the offences set out in (6) and (7) of 3.2.1 above.

The overall sentence imposed on an accused depends on the number of articles involved.

*The criminal procedure for trademark and copyright infringement is shown by way of a flowchart in Annex 1 of this Chapter.

4 CIVIL IP ENFORCEMENT

4.1 Trademark infringement

A person infringes a registered trademark under section 27(1) of the TMA if he/she uses, in the course of trade, a sign identical to the trademark in relation to the goods or services which are identical with those for which it is registered, without the consent of the proprietor of the trademark; or under section 27(2) of the TMA, where the sign is similar to the trademark and is used in relation to goods or services identical with or similar to which the trademark is registered, there exists a likelihood of confusion on the part of the public. Similarity between the marks and the goods that does not automatically mean that there is a likelihood of confusion.

4.1.1 Well known trademark infringement

A person infringes a well-known trademark under section 27(3) of the TMA if:

- without the consent of the proprietor of the trademark, he or she uses in the course of trade a sign which is identical with or similar to the trademark in relation to goods or services which are not similar to those for which the trademark is registered;
- the use of the trademark in relation to those goods or services would indicate a connection between those goods or services and the proprietor.
- there exists a likelihood of confusion on the part of the public because of such use; and
- the interests of the proprietor are likely to be damaged by such use.

4.1.2 Defences to trademark infringement or acts not amounting to infringement

4.1.2.1 Acts not amounting to infringement

Section 28 of the TMA sets out circumstances where a person does not infringe a registered trademark. These include:

- using his or her name or the name of his or her place of business; or the name of his or her predecessor in business or the name of his predecessor's place of business.
- using a sign to indicate the kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of the goods or services; or the time of production of goods or of rendering of services; or
- using the trademark to indicate the intended purpose of the goods (in particular as accessories or spare parts) or services, and such use is in accordance with honest practices in industrial or commercial matters.

Section 28 of the TMA also states that a person does not infringe a registered trademark if he or she, or he or she and his or her predecessor in title, have continuously used in the course of trade the unregistered trademark in relation to those goods and services from a time before the date of registration of the registered trademark; or the date the proprietor of the registered trademark, or a predecessor in title, or a person who was a registered user of the trademark under TMA first used the trademark, whichever is the earlier.

4.1.2.2 Exhaustion of rights

Section 29(1) of the TMA provides that a registered trademark is not infringed by the use of the trademark in relation to goods which have been put on the market, whether in Singapore or outside Singapore, under that trademark by the proprietor of the registered trademark or with his express or implied consent (conditional or otherwise).

4.1.2.3 Acquiescence

Section 24(1) of the TMA provides that where the proprietor of an earlier trademark or other earlier right has acquiesced for a continuous period of five years in the use in the course of trade of a later registered trademark in Singapore, he or she will, if he or she has been aware of the use, lose his entitlement:

- To apply for a declaration that the registration of the later trademark is invalid; or
- To oppose the use of the later trademark in relation to the goods or services in relation to which it has been so used,
- Unless the registration of the later trademark was applied for in bad faith.

4.2 Copyright infringement

4.2.1 Infringement by doing acts comprised in copyright

Section 31(1) of the CA provides that copyright in a literary, dramatic, musical or artistic work is infringed by a person who, not being the owner of the copyright, and without the license of the owner of the copyright, does in Singapore, or authorizes the doing in Singapore of, any act comprised in the copyright.

Without the license of the owner of the copyright, the doing in Singapore of any of the exclusive rights under section 26 of the CA will, subject to available defense, result in infringement.

These exclusive rights are as follows:

- To do all or any of the following acts in the case of a literary, dramatic or musical work:
 - To reproduce the work in a material form; (i)
 - To publish the work if the work is unpublished; (ii)
 - To perform the work in public; (iii)
 - To communicate the work to the public; (iv)
 - To make an adaptation of the work; (v)
 - To do, in relation to a work that is an adaptation of the first-mentioned work, any of the acts specified in relation to the first-mentioned work in sub-paragraphs (i) to (v);
- To do all or any of the following acts in the case of an artistic work:
 - To reproduce the work in a material form;
 - To publish the work in Singapore or any country in relation to which this Act applies, if the work is unpublished;
 - To communicate the work to the public; and
- To enter into a commercial rental agreement in respect of the program unless the program is not the essential object of the rental in the case of a computer program.

4.2.2 Infringement of copyright by reproduction

Pursuant to section 26(1) of the CA, the reproduction of a work in a material form is one of the exclusive rights conferred by copyright in relation to a work. Whether a work has been reproduced in a material form varies depending on the type of work in which copyright subsists.

- For literary, dramatic or musical work, reproduction includes reproduction in the form of a sound recording or cinematograph film of the work. It is reproduced if it is converted into or from a digital or other electronic machine-readable form, and any article embodying the work or reproduction of the work in such a form: section 15(1B) of CA.
- For artistic work, reproduction includes the making of a version or copy in three dimensions of a two-dimensional work and the making of a version or copy in two dimensions of a three-dimensional work: section 15(3) of the CA.
- Any other work: reproduction includes the making of a copy which is transient or is incidental to some other use of the work: Section 15(1A) of the CA.

Section 17 of the CA states that the reduction of any work or of an adaptation of a work to a material form, or to the reproduction of any work or of an adaptation of a work in a material form, includes the storage of that work or adaptation in a computer, on any medium by electronic means; or on any other medium from which the work or adaptation, or a substantial part of the work, can be directly reproduced. There must be sufficient objective similarity between the two works and a causal connection between them before a work can constitute a 'reproduction'.

4.2.3 Infringement by importing infringing copies

Under section 32 of the CA, any person infringes the copyright in a work if he or she, without the license of the owner of the copyright, imports an article into Singapore for the purpose of:

- Selling, letting for hire, or by way of trade offering or exposing for sale or hire, the article;
- Distributing the article for the purpose of trade or for any other purpose to an extent that will affect prejudicially the owner of the copyright; or
- By way of trade exhibiting the article in public, where he or she knows, or ought reasonably to know, that the making of the article was carried out without the consent of the owner of the copyright.

4.2.4 Defences/ exceptions: acts not considered as copyright infringement

4.2.4.1 The defence of fair dealing generally

Under section 35(1) of the CA, fair dealing with a literary, dramatic, musical or artistic work (or with an adaptation of a literary, dramatic or musical work) does not infringe the copyright in the work.

Section 35(2) of the CA sets out several matters that shall be regarded in determining whether a dealing with a literary, dramatic, musical or artistic work or with an adaptation of a literary, dramatic or musical work, being a dealing by way of copying the whole or part of the work or adaptation, constitutes a fair dealing with the work or adaptation:

- the purpose and character of the dealing, including whether such dealing is of a commercial nature or is for non-profit educational purposes;
- the nature of the work or adaptation;
- the amount and substantiality of the part copied taken in relation to the whole work or adaptation;
- the effect of the dealing upon the potential market for, or value of, the work or adaptation; and
- the possibility of obtaining the work within a reasonable time at an ordinary commercial price.

4.2.4.2 Fair dealing in relation to research or study

Pursuant to section 35(3) of the CA, dealings with a literary, dramatic or musical work, or with an adaptation of such a work are deemed to be fair dealings for the purposes of research or study if:

- the work or adaptation comprises an article in a periodical publication, copying the whole or a part of that work;
- in all other cases, copying not more than a reasonable portion of the work or adaptation.

4.2.4.3 Fair dealing for purposes of criticism or review

Pursuant to section 36 of the CA, fair dealing with a work (or with an adaptation of a work) for the purpose of criticism or review does not infringe the copyright in the work, provided that a sufficient acknowledgement of the work is made.

4.2.4.4 Fair dealing for purposes of reporting current events

Pursuant to section 37 of the CA, fair dealing for the purpose of reporting current events in a newspaper, magazine or similar periodical does not infringe the copyright in the work, provided that a sufficient acknowledgement of the work is made.

No acknowledgment is required in connection with the reporting of current events by means by broadcasting or a cable programme service or in a cinematograph film.

4.2.4.5 Acts done for purposes of judicial proceedings or professional advice

Section 38 of the CA states that any copyright in a literary, dramatic, musical or artistic work is not infringed by another done for the purpose of a judicial proceeding or of a report of a judicial proceeding; for the purpose of seeking professional advice from an advocate and solicitor; or for the purpose of, or in the course of, the giving of professional advice by an advocate and solicitor.

4.3 Civil IP remedies in trademark and copyright cases

4.3.1 Damages

The Court may grant damages to the proprietor of the registered trademark in an action for an infringement pursuant to section 31(2)(b) of the TMA. Damages is also one of the remedy a Court can grant under section 119(2)(b) of the CA.

4.3.2 Account of profits

Section 31(2)(c) of the TMA and section 119(2)(c) of the CA provides that the court can grant the remedy of an account of profits in an action for trademark infringement and copyright infringement respectively. Similar to the injunctions, account of profits is a discretionary remedy.

4.3.3 Injunction

Section 31(2)(a) of the TMA provides that the court may grant an injunction subject to such terms, if any, as it thinks fit. Similarly, section 119(2)(a) of the CA lists injunction as a remedy in an action for an infringement of copyright. Injunctions are discretionary remedies, and are broken down to interlocutory injunctions, which serves to preserve rights of the trademark or copyright owners, and final injunctions.

4.3.4 Statutory damages

Section 31(2)(d) of the TMA states that the court may grant the statutory damages provided in section 31(5)(c) where the infringement involves the use of a "counterfeit trademark". The objective of statutory damages is to compensate the trademark proprietor for losses suffered, particularly in cases where losses are hard to prove. Statutory damages are quantified not to exceed SGD100,000 for each type of goods or service in relation to which the counterfeit trademark has been used, and not to exceed SGD1 million, unless the plaintiff proves that his actual loss from the infringement exceeds SGD1 million.

Section 119(2)(d) of the CA states that the court may grant, where the plaintiff has elected for an award of statutory damages in lieu of damages or an account of profit, statutory damages of not more than SGD10,000 for each work or subject-matter in respect of which the copyright has been infringed; but not more than SGD200,000 in the aggregate, unless the plaintiff proves that his actual loss from such infringement exceeds SGD200,000.

4.3.5 To erase, remove obliterate offending sign and counterfeit goods

Under section 32(1)(a) of the TMA, the court may order a person who is found to have infringement a registered trademark to erase, remove or obliterate the offending sign from any infringing goods, material or articles in his possession, custody or control.

4.3.6 Delivery up/Destruction/Disposal of infringing goods, material or articles

Pursuant to section 32(1)(b) of the TMA, the court may order the infringing goods, material or articles, to be destroyed if it is not reasonably practicable for the offending sign to be erased, removed or obliterated. Section 33 of the TMA states that the court may order any infringing goods, material or articles in the possession of the defendant or before the court to be delivered up to the plaintiff. An application can then be made to the court for an order to destroy or forfeit the infringing goods as stated in section 34(1) of the TMA.

Pursuant to section 136(8) of the CA, regardless of whether a person is convicted of an offence under section 136 of the CA in relation to copyright infringement or not, the court may order any articles that appears to be an infringing copy or any article which has been used for making infringing copies in the possession of the alleged offender or before the court to be destroyed, delivered up to the owner of the copyright concerned or otherwise deal with in such a manner as the court thinks fit.

5 CUSTOMS IP BORDER ENFORCEMENT

5.1 Trademark

Seizure of goods on request (Lodgement of Notice)

5.1.1 Restriction of importation or exportation of infringing goods

Under section 82 of the TMA, a person who is the proprietor or a licensee of a registered trade mark may give the Director-General a written notice stating that he is the proprietor or a licensee of the registered trade mark and the goods in relation to the registered trade mark that are expected to be imported or exported are infringing goods, thereby requesting the Director to seize goods.

5.1.2 Seizure and inspection of counterfeit goods (transshipment)

Under section 93A of the TMA, an authorized officer may examine any goods, including goods in transit³⁵, or seize any goods that are imported into, or that are to be exported from, Singapore; and that are not goods in transit, unless they are consigned to a person with a commercial or physical presence in Singapore that the authorized officer reasonably suspects are counterfeit goods in relation to a registered trademark.

As soon as practicable after the goods are seized, the Director-General must give a written notice (personally, by post or (with the prior consent of the addressee) by email) to the importer, exporter or consignee of the seized goods, and the proprietor of the registered trademark of such seizure.

The Director-General can continue to detain the seized goods if the registered proprietor wishes to continue the detention to institute an infringement action. The Director-General can only do so if the proprietor satisfies the following conditions within the prescribed period after the date of the notice in section 93A:

- give to the Director-General a written notice of this in the form determined by the Director-General, supported by such documents and information as the Director-General may require, and accompanied by the fee prescribed under section 81B; and,
- either deposit a sum of money with the Director-General that is sufficient in the Director-General's opinion; or give security to the Director-General's satisfaction for such purpose, unless the owner had earlier given such deposit or security to the Director-General and the deposit had not been forfeited or returned or the security is still effective.

5.1.3 Powers of search in relation to vessels, aircraft and vehicles

Pursuant to section 94 of the TMA, a senior authorized officer or an authorized officer may board any conveyance in Singapore and may rummage and search all parts of the conveyance for goods liable to be seized.

Such powers include, amongst others:

- requiring the master of any vessel in Singapore to heave to;
- by direction to the master of any vessel or the pilot of any aircraft in Singapore, require the vessel or aircraft, as the case may be, not to proceed until so authorized; and
- break open and forcibly enter any place or receptacle in any conveyance to which he cannot otherwise reasonably obtain access.

An authorised officer may exercise, in respect of any vehicle or any vessel not exceeding 75 tons net tonnage, the powers conferred upon a senior authorised officer, other than the power to break open and forcibly enter any place or receptacle in any conveyance to which he cannot otherwise reasonably obtain access.

³⁵ "Goods in transit" is defined as "goods imported, whether or not landed or transshipped within Singapore, which are to be carried to another country either by the same or another conveyance".

An authorised officer may exercise the powers conferred by this section in respect of a vessel under way if he reasonably suspects that it is not in transit through Singapore.

5.1.4 Examination of packages, etc

Under section 95 of the TMA, any goods, package, box, chest or other article which is being or has been recently imported or is being exported, which is reasonably suspected to contain goods liable to be seized under Section 82 or 93A of the TMA may be examined and searched by an authorized officer, or detained until any person in charge has opened it for examination and search; subjected to infringement verification or tests or analysis as the authorized officer thinks fit, forcibly opened by, or by order of, a senior authorized officer to facilitate the examination and search with any person in charge of the package, box, chest or other article be afforded every reasonable facility for being present at the opening, examination and search; or marked, locked, sealed or otherwise secured by an authorized officer pending examination and search.

5.2 Copyright

5.2.1 Restriction of importation or exportation of copyrighted works

Singapore adopts a notification procedure to allow copyright owners or licensee to request the Director-General of Customs to seize specific infringing copies of copyright material to be imported or exported, without the consent of the copyright owner or licensee. This is set out in section 140B(1) of the CA. The notice must be accompanied by the fee prescribed under section 140AB and the copyright owner must also furnish a security deposit to the Director-General as part of the notification procedure.

As soon as practicable after copies are seized, the Director-General will issue a written notice to both the importer and the owner or licensee. Pursuant to section 140E(1) of the CA, seized copies will be released to the importer unless:

- an action for infringement of copyright in respect of the copies is instituted by the owner or licensee within a specified period; and
- the owner or licensee gives written notice to the Director-General within that period stating that the action for infringement of copyright has been instituted; and
- the owner or licensee deposits a security deposit with the Director-General for the reimbursement resulting from any liability or expense in relation to the seizure.

If the owner or licensee fails to commence infringement action in respect of the seized copies within the retention period, a person aggrieved by such seizure may apply to the court for an order of compensation against the requestor under section 140IA (1) of the CA.

5.2.2 Seizure and inspection of copyrighted works (transshipment)

In addition, customs officers may also exercise *ex officio* powers to seize copyright items. Pursuant to section 140LA(1) of the CA, an authorized officer may examine any copies of copyright material (including goods in transit), or detain any copies of copyright material that are imported into, or that are to be exported from, Singapore; and that are not goods in transit, unless they are consigned to a person with a commercial or physical presence in Singapore.

Section 140LA(3) states that as soon as practicable after the copies of the copyright material are detained, the Director-General must give a written notice (given personally, by post or with the prior consent of the addressee by email) to the importer, exporter or consignee of the seized copies, and the owner of the copyright in the copyright material.

Pursuant to section 140LB(1) of the CA, the Director-General can continue to detain the seized copies of the copyright material so that the owner of the copyright may institute an action for infringement of copyright in relation to them. The Director-General can only do so if the owner satisfies the following conditions within the prescribed period after the date of the notice in section 140 LA (3):

- gives the Director-General a written notice of this in the form determined by the Director-General, supported by such documents and information as the Director-General may require, and accompanied by the fee prescribed under section 140AB; and,

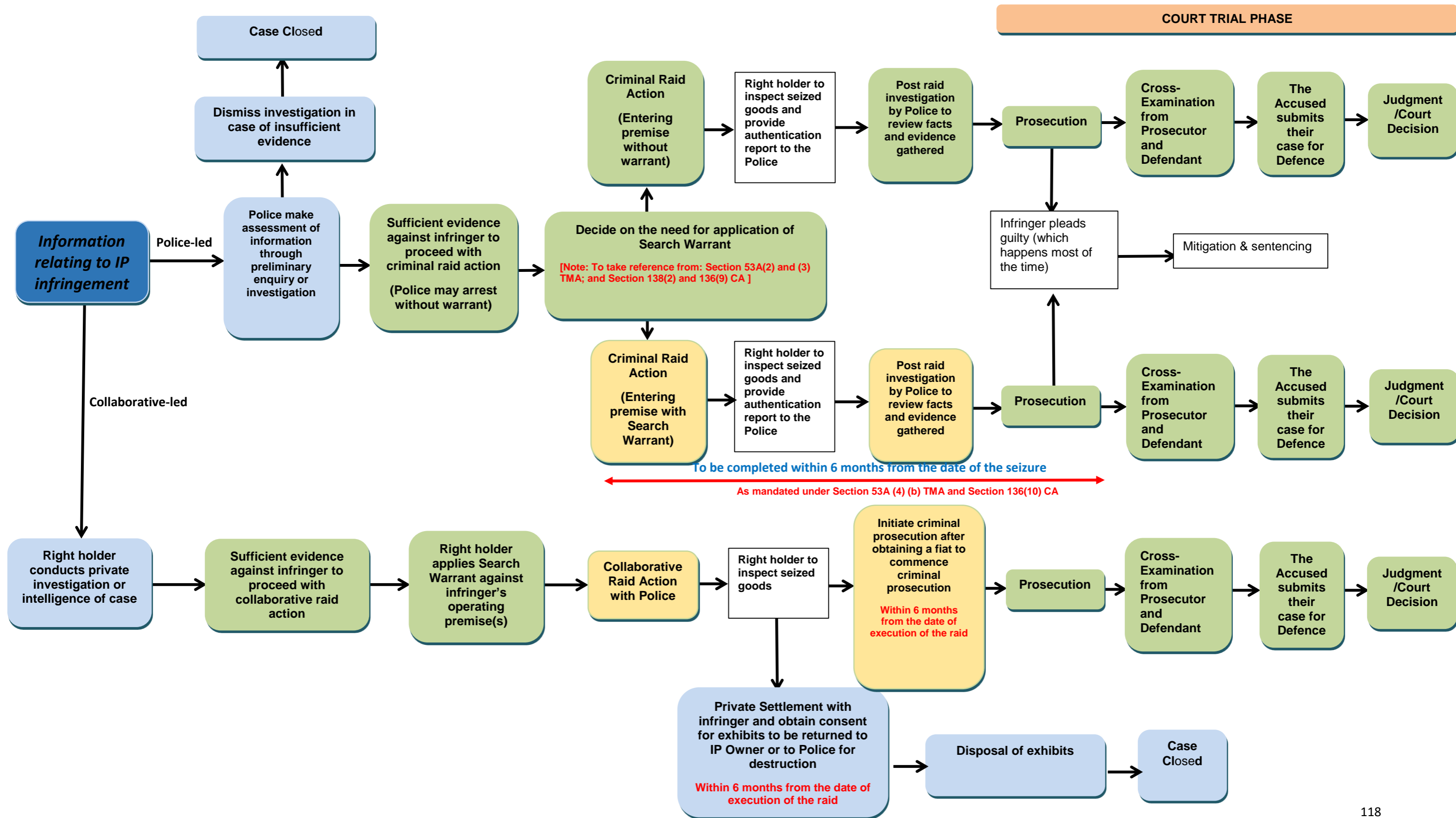
- either deposit a sum of money with the Director-General that is sufficient in the Director-General's opinion; or give security to the Director-General's satisfaction for such purpose, unless the owner had earlier given such deposit or security to the Director-General and the deposit had not been forfeited or returned or the security is still effective.

*The Seizure process for trademarks and/or copyright is shown in Annex 2 of this Chapter.

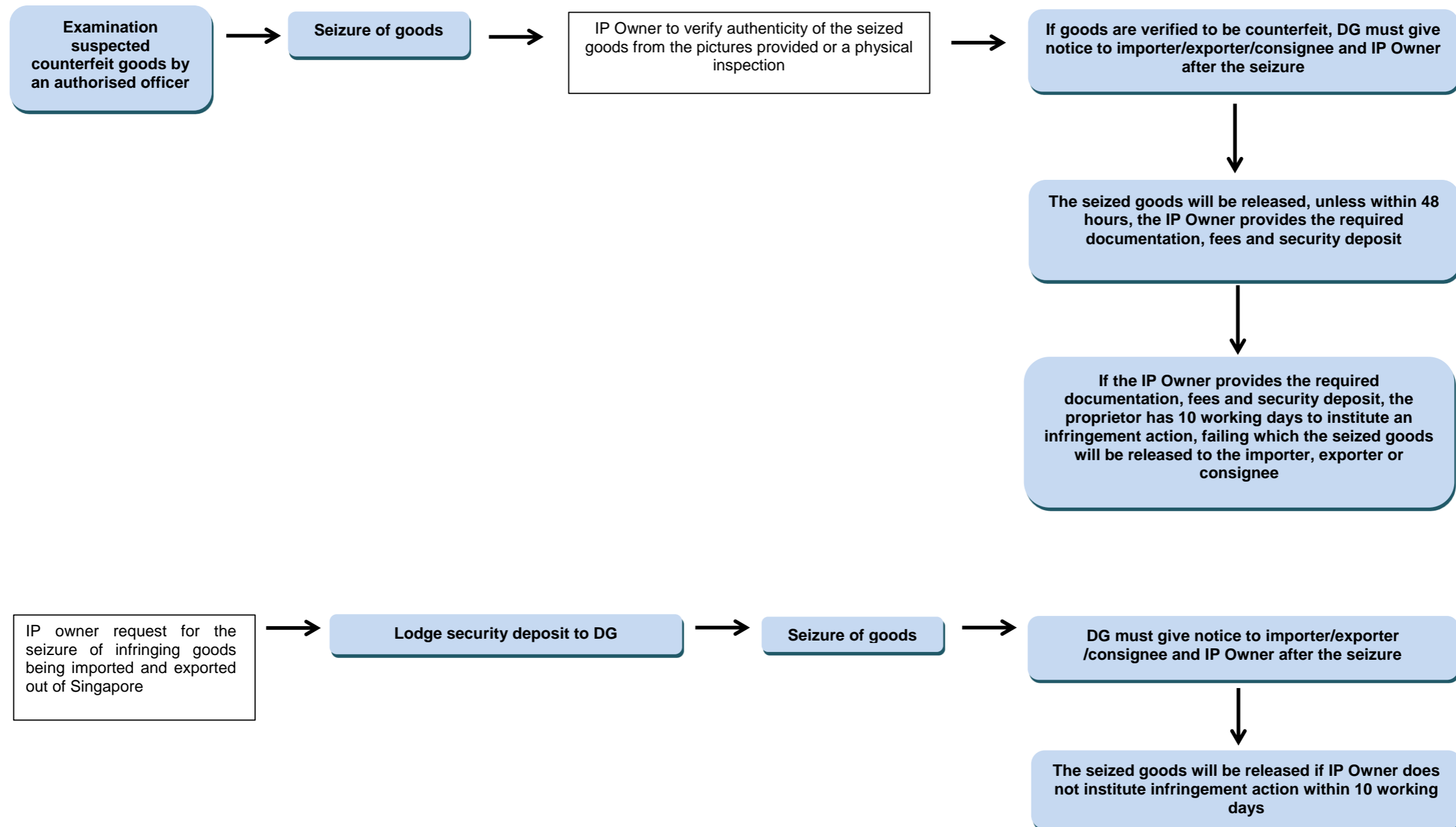
6 CEASE & DESIST LETTERS AND SETTLEMENTS

Most IP disputes in Singapore can be resolved by issuing a Cease & Desist letter and negotiating a settlement due to the strict enforcement of laws. Settlement agreements, including undertakings and statutory declarations, destruction of the infringing goods and compensation are commonly demanded and obtained in most out-of-court resolutions.

ANNEX 1: FLOWCHART FOR CRIMINAL PROCEDURE FOR TRADEMARK AND COPYRIGHTS



ANNEX 2: FLOWCHART ON CUSTOMS SEIZURE PROCESS FOR TRADEMARKS AND/OR COPYRIGHT





THAILAND

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IP ENFORCEMENT - THAILAND

1. THE IP ENFORCEMENT SYSTEM UNDER TRIPS

Thailand is a civil law country; therefore, written laws set out all the rules and procedures for IP enforcement. As a WTO TRIPs member, Thailand commits to providing enforcement measures¹, these comprise:

- civil remedies, comprising judicial procedures, evidence rules, injunctions, damages, other remedies, information to rights holder and rights of indemnifications to defendants, as well as provisional measures (preliminary injunctions, search and seizure orders);
- customs interceptions of infringements
- criminal remedies, at least for wilful trademark counterfeiting or copyright piracy on a commercial scale

This Manual sets out how these apply to counterfeiting (trademark infringements) and piracy (copyright infringements).

2. TRADEMARKS AND COPYRIGHT

A trademark must be registered with the Department of Intellectual Property to be protected, under the Trademark Act B.E. 2534 (1991) as amended by Trademark Act (No. 2) B.E. 2543 (2000) and Trademark Act (No. 3) B.E. 2559 (2016) (“TM Act”). But, for unregistered trademark, though it is not directly protected under the TM Act, they have some protection under general civil and criminal laws.

Copyright protects a wide range of creative works under the Copyright Act B.E. 2537 (1994) as amended by Copyright Act (No.2) B.E. 2558 (2015), Copyright Act (No.3), B.E. 2558 (2015) and Copyright Act (No.4), B.E. 2561 (2018) (“Copyright Act”). Under Section 6 of the Act, the copyright work means a work of authorship in the form of literary, dramatic, artistic, musical, audiovisual, cinematographic, sound recording, sound and video broadcasting work or any other work in the literary, scientific or artistic field whatever the mode or form of its expression. Copyright protection shall not extend to ideas or procedures, processes or systems or methods of use or operation or concept, principles, discoveries or scientific or mathematical theories.

3. CRIMINAL IP ENFORCEMENT

3.1.1 Criminal acts defined in the Trademark law

Trademark infringement occurs when an infringer does any of the acts defined in Section 108, 109, 109/1, 110 of the TM Act.

Section 108 Any person who counterfeits a trademark, service mark, certification mark or collective mark registered in Thailand by another person shall be liable to imprisonment not exceeding four years or a fine of not exceeding four hundred thousand baht or both.

Section 109 Any person who imitates a trademark, service mark, certification mark or collective mark registered in the Kingdom by another person in order to mislead the public into believing that it is the trademark, service mark, certification mark or collective mark of such other person shall be liable to imprisonment not exceeding two years or a fine of not exceeding two hundred thousand baht or both.

¹ Part III of TRIPS - Articles 41-61

Section 109/1 Any person using the packaging or utensils bearing another person's trademark, certification mark or collective mark registered in the Kingdom with his or other persons' goods to mislead the public into believing that the goods belong to the owner of the trademark or the collective mark or that the certification mark is allowed for use with the goods, shall be liable to imprisonment for a term not exceeding four years or a fine not exceeding four hundred thousand baht, or both.

Section 110 Any person who:

- Section 110 (1) imports, distributes, offers for distribution or has in possession for distribution goods bearing a counterfeit trademark, service mark, certification mark or collective mark under Section 108 or an imitation trademark, service mark, certification mark or collective mark under Section 109, or
- Section 110 (2) gives or offers a service under a counterfeit service mark, certification mark or collective mark under Section 108 or an imitation service mark, certification mark or collective mark under Section 109, shall be liable to the penalties provided in those Sections.

3.1.2 Criminal procedure for trademark infringement

The procedure for criminal action is as follows:

Offences under the TM Act are offences against the public or non-compoundable offences. A criminal procedure could be initiated either by the enforcement authorities themselves or by trademark owners (or their representatives) filing complaint to competent officers.

3.1.3 Competent officers

Section 4 of the TM Act defines competent officer and Registrar as person appointed by the Minister to act and be registrar to act under this Act respectively.

Section 106 bis of the TM Act provides competent officers and Registrar the following powers:

- To enter the place of business, place of production, place of distribution, place of purchasing and place of storage of any business operator or person, or any place in which he has a reasonable ground for suspecting that a violation of the provisions of this Act is likely to occur, or to enter a vehicle of any person, or order the owner or operator of a vehicle to stop or park to make inspection for the enforcement of this Act or to make a search or seizure of evidence or property forfeitable under this Act, or to arrest in the following circumstances:
 - where a flagrant offence is being committed in a place or vehicle;
 - a person having committed a flagrant offence has, while being pursued, taken refuge or there is a serious ground for suspecting that such person is concealing in the place or vehicle;
 - where there is a reasonable ground for suspecting that evidence or property forfeitable under this Act is kept in the place or vehicle, having a legitimate reason to believe that by reason of the delay in obtaining a warrant of search the evidence or property is likely to be removed, concealed, destroyed or altered from its original conditions;
 - when a person to be arrested is the owner of the place or vehicle and the arrest is made with a warrant of arrest or can be made without such a warrant. For such purposes, he shall have the power to inquire or require the business operator, owner or operator of the vehicle or persons concerned to submit books of accounts, registration documents, other documents or evidence, and also order the persons in such a place or vehicle to act or perform as it is necessary.
- In cases where there is clear evidence to believe that any provision of this Act is violated, to seize or confiscate goods, vehicle, documents or other evidence in connection with such violation. In such a case, he shall report to the Director-General for his approval within three days and shall comply with the rules and procedures prescribed by the Director-General with the approval of the Council of Ministers.

In practice, competent officials under the TM Act will join force with police officials to carry out criminal actions. More often, police officials can exercise the power under the Criminal Procedure Code in criminal trademark infringement cases.

Section 2(6) of the Criminal Procedure Code defines “inquiry official” to be an official to be vested by law with the power and duty to conduct an inquiry. And, Section 2(16) of Code defines “administrative of police official” as an official to be vested by law with the power and duty to keep the public peace, including gaolers, excise, customs, harbor, immigration and other officials when performing acts in connection with the arrest of offenders or the suppression of crime which they have the duty to arrest or suppress.

The inquiry officials have the powers and duties including:

- to gather all evidence possible to find out facts and circumstances relating to alleged offences, to learn of offender and to prove his guilt or innocence;
- to, if scientific evidence is necessary, examine persons, materials or documents using scientific methods;
- to gather evidence, by examining injured person (with consent) or suspect or materials or site that may be evidence;
- search for offending object or object acquired via the offence, used or suspected to have been used in the offence
- request potential evidence from any person in possession of the evidence
- seize materials found or received;
- summon injured party or any person believed to have useful information;
- give opinion whether or not suspect should be prosecuted to the public prosecutor.

3.1.4 Criminal prosecution of trademark crimes

The Criminal Procedure Code outlines the duties of the inquiry official which includes:

- Preparing a report on the results of inquiry and opinion whether suspect should be prosecuted
- The investigator shall hand over the dossier of the case to the public prosecutor

The handing over of the dossier may have several stages. At the first stage the inquiry official delivers the case dossier to the public prosecutor. If the public prosecutor considers it complete, the inquiry official transfers responsibility for the suspect and evidence materials to the public prosecutor to file the case at the court. In some cases the dossier is incomplete so is returned for more investigations. It is then be returned after completion to the public prosecutor to decide whether or not the dossier has met requirements for transfer to the court. Alternatively, injured person can lodge a criminal complaint to the Court directly. The complaint will have to go through one additional step of inquiry hearing for the Court to decide whether the case has the merit to be accepted, before it can proceed to other stages of court proceedings.

3.1.5 Criminal penalties for Trademark infringement

The criminal court judge may order the following penalties. In practice judges may award penalties lower than this in most cases.

3.1.5.1 Penalties (TM Act)

Section 108 Any person who counterfeits a trademark, service mark, certification mark or collective mark registered in Thailand by another person shall be liable to imprisonment not exceeding four years or a fine of not exceeding four hundred thousand baht or both.

Section 109 Any person who imitates a trademark, service mark, certification mark or collective mark registered in the Kingdom by another person in order to mislead the public into believing that it is the trademark, service mark, certification mark or collective mark of such other person shall be liable to imprisonment not exceeding two years or a fine of not exceeding two hundred thousand baht or both.

Section 109/1 Any person using the packaging or utensils bearing another person’s trademark, certification mark or collective mark registered in the Kingdom with his or other persons’ goods to mislead the public into believing that the goods belong to the owner of the trademark or the collective mark or that the certification mark is allowed for use with the goods, shall be liable to imprisonment for a term not exceeding four years or a fine not exceeding four hundred thousand baht, or both

Section 110 Any person who:

- imports, distributes, offers for distribution or has in possession for distribution goods bearing a counterfeit trademark, service mark, certification mark or collective mark under Section 108 or an imitation trademark, service mark, certification mark or collective mark under Section 109, or
- gives or offers a service under a counterfeit service mark, certification mark or collective mark under Section 108 or an imitation service mark, certification mark or collective mark under Section 109, shall be liable to the penalties provided in those Sections.

Section 111 Any person who:

- represents as registered in Thailand a trademark, service mark, certification mark or collective mark which is not so registered – (1)
- distributes or has in possession for distribution goods bearing a trademark or certification mark under (1) which he knows to be falsely represented, or – (2)
- gives or offers a service under a service mark, certification mark or collective mark under (1) which he knows to be falsely represented, shall be liable to imprisonment not exceeding one year or fine of not exceeding twenty thousand baht or both.

Section 113 The penalty for an offence under this Act committed within five years from the date of passing the punishment for another offence under this Act shall be doubled.

Section 114 In the event an offender liable under this Act is a juristic person, if the offence is committed by an order, act, failure to give an order or failure to act as required by his duties as a director, manager or any person responsible for the operation of such juristic person, shall also be liable to the penalty prescribed for such offence.

Section 115 All goods which are imported for distribution or had in possession for distribution in violation of this Act shall be confiscated whether or not anyone has been convicted of the offence.

Section 116 If there is clear evidence someone is committing or is about to commit an act under Sections 108, 109 or 110, the owner of the trademark, service mark, certification mark or collective mark may apply to the court to stop or refrain from such act.

3.1.5.2 Penalties (Criminal Code)

There are penalties provided under the Penal Code as well for trademark infringement. But provisions relating to trade mark infringement under the Penal Code would apply only in the case of infringement of marks unregistered in Thailand i.e. where the Trademark Act would not apply.

Section 272 Whoever:

- Uses a name, figure, artificial mark or any wording in the carrying on trade of the other person, or causes the same to appear on a goods, packing, coverings, advertisements, price lists, business letters or the like in order to make the public to believe that it is the goods or trade of such other person;
- Imitates a signboard or the like so that the public are likely to believe that his trading premises are those of another person situated nearby;
- Circulates or propagates the false statement in order to bring discredit to the trading premises, goods, industry or commerce of any person with a view to obtaining benefit for his trade, shall be punished with imprisonment not exceeding one year or fined not exceeding two thousand Baht, or both.

The offence under this Section is a compoundable offence.

Section 273 Whoever, forging the registered trademark of other person, whether to be registered inside or outside the Kingdom, shall be imprisoned not out of three years or fined not out of six thousand Baht, or both.

Section 274 Whoever, imitates the registered trade-mark of the other person, whether it be registered within or outside the Kingdom in order to make the public to believe that it is the registered trade-mark of such other person, shall be punished with imprisonment not exceeding one year or fined not exceeding two thousand Baht, or both.

Section 275 Whoever, bringing into the Kingdom, disposing or exposing for disposing the goods bearing the name, figure, artificial mark or any wording as prescribed by Section 272 (1), or the goods bearing the forged or imitated trade-mark to belong to the other person under Section 273 or Section 274, shall be punished in such Section.

3.1.6 Defences to trademark infringement

There is a defence of use of trademark as a bona fide description. Section 47: No registration under this Act shall interfere with any bona fide use by a person of his own personal name or surname or the name of his place of business or that of any of his predecessors in business or the use by any person of any bona fide description of the character or quality of his goods.

3.2.1 Criminal acts defined in the Copyright Law

Criminal offenses for copyright or related rights infringement are laid down under Section 27 to 31 of the Copyright Act. In addition, there are two separate categories of infringing criminal acts.

3.2.1.1	Rights management information and technological circumvention	<p>CHAPTER II/I contain give unlawful acts in relation to rights management information and technological circumvention.</p> <p>Section 53/1 Removal or alteration of rights management information knowing that such act may induce, enable, facilitate or conceal infringement of copyright or performers' rights shall be deemed infringement of the rights management information.</p> <p>Section 53/2 Any person with prior knowledge that rights management information of a copyrighted work, or a copy of a copyrighted work, has been removed shall be liable for infringement of rights management information if she or she commits any of the following acts:</p> <ul style="list-style-type: none"> ▪ bring or order for import into the Kingdom the work or a copy of the work for distribution. ▪ to disseminate the work or copies of the work to the public. <p>Section 53/3 The following acts shall not be deemed infringement of rights management information:</p> <ul style="list-style-type: none"> ▪ removal or alteration of the rights management information by lawfully authorized officials for execution of law, necessity for national defence, the preservation of national security or other similar objectives – (1) ▪ removal or alteration of the rights management information by educational institutions, national archives, libraries, or public non-profit broadcasting organizations. – (2) ▪ communication to the public of a work or a copy of copyright work, rights management information attached thereto has been removed or altered by educational institutions, national archives, libraries or public non-profit broadcasting organizations.- (3) <p>The characteristics of the rights management information covered under (2) and a work or a copy of copyrighted work of which the rights management information has been removed or altered covered under (3) shall be as prescribed by the Ministerial Regulation.</p> <p>Section 53/4 Circumvention of technological measures or services enabling the circumvention of technological measures by knowing that such act may induce or enable infringement of copyright or performers' rights shall be deemed infringement of technological</p>
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		<p>measures.</p> <p>Section 53/5 Any of the acts committed under section 53/4 shall not be deemed an infringement of technological measures in the following circumstances:</p> <ul style="list-style-type: none"> ▪ if it is necessary for an act involving a copyrighted work that has been exempted from copyright infringement. ▪ to analyse elements of a computer program necessary to achieve interoperability other computer program; ▪ for the purpose of research, analysis and identifying flaws of encryption technologies, if it is carried out by a person has obtained the copyrighted work or the copy of the copyrighted work lawfully, and, if such person has made an effort in good faith to obtained authorization from the copyright owner; ▪ for the purpose of testing, examining, repairing the security of a computer, computer system or computer network, with the authorization of its owner, as the case may be; ▪ to stop the operation of a technological measure related to collecting or disseminating personally identifying information about the online activities of a person accessing a copyright work, provided that such act does not impact access by another person to copyrighted works. ▪ an act done by lawfully authorized officials for execution of law, necessity for national defense, the preservation of national security or other similar objectives. ▪ an act done by educational institutions, national archives, libraries or public non-profit broadcasting organizations to access the copyright work which cannot be accessed by other ways. <p>Note: Thailand is in the process of amending Technological Protection Measure (TPM) in Section 53/4 – 53/5.</p>
3.2.1.2	Economic rights infringement	<p>Different economic rights are addressed in Section 15.</p> <p>Section 15: Subject to Section 9, Section 10 and Section 14, the owner of copyright has the exclusive rights of:</p> <ul style="list-style-type: none"> ▪ reproduction or adaptation, -(1) ▪ communication to public, -(2) ▪ letting of the original or the copies of a computer program, an audiovisual work, a cinematographic work and sound recordings -(3) ▪ giving benefits accruing from the copyright to other persons, ▪ licensing the rights mentioned in (1), (2) or (3) with or without conditions provided that the said conditions shall not unfairly restrict the competition. Whether the conditions as mentioned in sub-section (5) of the paragraph one are unfair restrictions of the competition or not shall be considered in accordance with the rules, methods and conditions set forth in the Ministerial Regulation.
3.2.1.3	Landlord liability- Sale of copyright infringing goods on landlord premises	<p>In Thailand, there is no provision for landlord liability. Though, it might be possible (yet untested) to pursue criminal liability against landlords for their supporting roles provision of assistance or facilitation of the offense under Section 86 of the Criminal Code.</p>

3.2.1.4	Infringement of publicity/advertising rights	In Thailand, there is no specific provision of publicity rights. Such rights are partially protected when they can be classified as performers rights.
3.2.1.5	Infringement of Performers rights	<p>Performer rights are provided in Section 44:</p> <p>Section 44 The performer has the following exclusive rights with respect to the acts concerning his performance.</p> <ul style="list-style-type: none"> ▪ sound and video broadcasting or communication to public of the performance except the sound and video broadcasting or communication to public from a recording material which has been recorded; ▪ recording the performance which has not been recorded; ▪ reproducing the recording material of the performance which has been recorded without the consent of the performer or the recording material of the performance with the consent of the performer but for another purpose or the recording material of the performance which falls within the exceptions of the infringement of performer's rights by virtue of Section 53. <p>Infringement of performers rights is set out in Sections 51/1 and 52.</p> <p>Section 51/1 Unless otherwise agreed in writing, a performer shall have the right to be identified as the performer of his or her performances and have the right to prohibit an assignee of performers' rights or any other person from distorting, mutilating, modifying or any other action to his or her performances that would prejudice his or her reputation or honour; and, after the performer's death, his or her heirs shall have the right to bring legal actions to enforce such rights throughout the term of protection of the performers' rights.</p> <p>Section 52 Whoever acts as specified in Section 44 without the consent of the performer or without paying remuneration in accordance with Section 45 shall be deemed to infringe the performer's rights.</p>
3.2.1.6	Infringement of phonogram/sound recording rights of Producers	<p>Section 28 Any of the following acts against an audiovisual work, a cinematographic work or a sound recording copyrightable by virtue of this Act without the permission in accordance with Section 15(5) whether against the sound or image shall be deemed an infringement of copyright:</p> <ul style="list-style-type: none"> ▪ reproduction or adaptation, ▪ communication to public, ▪ letting of the original or copies of the work. <p>Section 28/1 Reproduction of the sounds, images or both sounds and images of a film copyrighted under this Act, whether wholly or partly, while the film is being shown in a cinema venue as defined in the law on Film and Video shall be deemed copyright infringement if such reproduction is done without permission pursuant to Section 15 (5). Section 32 paragraph two (2) shall not be applicable to such reproduction.</p>

3.2.1.7	Infringement of Broadcast rights	<p>Section 29 Any of the following acts against a sound and video broadcasting copyrightable by virtue of this Act without the permission in accordance with Section 15 (5) shall be deemed an infringement of copyright :</p> <ul style="list-style-type: none"> ▪ making an audiovisual work, a cinematographic work, a sound recording or a sound and video broadcasting work whether of the whole or in part, ▪ rebroadcasting whether of the whole or in part, ▪ making a sound and video broadcasting work to be heard or seen in public by charging money or another commercial benefit. <p>Section 28/1 Reproduction of the sounds, images or both sounds and images of a film copyrighted under this Act, whether wholly or partly, while the film is being shown in a cinema venue as defined in the law on Film and Video shall be deemed copyright infringement if such reproduction is done without permission pursuant to Section 15 (5). Section 32 paragraph two (2) shall not be applicable to such reproduction.</p>
3.2.1.8	Collective Management Organization (CMO) offences	<p>In Thailand, there is no provision for collective management organization and thus there is no provision for offences concerning such organization.</p>

3.2.2 Criminal procedure for copyright crimes

Section 66 states that criminal offences under the Copyright Act constitute compoundable offences. Copyright owners are required to file a complaint to either police official or the Court within 3 months of knowing of the offence and offender. Police officials cannot initiate or pursue such cases by themselves.

3.2.3 Competent officials

Section 4 of the Copyright Act defines competent officer as person appointed by the Minister to act under this Act.

Section 67 For the benefit of operation under this Act, the officials shall be the officials according to the Penal Code and have the following authorities:

- to enter a building, office, factory or warehouse of any person during sunrise and sunset or during the working hours of such place or to enter a vehicle to search or examine the merchandise when there is a reasonable suspicion that an offence under this Act is committed,
- to seize or forfeit documents or materials relating to the offence for the benefit of proceeding a litigation when there is a reasonable suspicion that an offence under this Act is committed,
- to order any person to testify or submit accounting books, documents or other evidences when there is a reasonable suspicion that the testimony, accounting books, documents or such evidences shall be useful for the finding or the use as evidence for proving the offence under this Act.

Any person concerned shall provide suitable convenience for the operation of the officials

In practice, as with criminal trademark infringement cases, competent officials under the Copyright Act will join force with police officials to carry out criminal actions. Police officials can also exercise the power under the Criminal Procedure Code in criminal trademark infringement cases, without joining force with officials under the Copyright Act.

3.2.4 Criminal Prosecution of copyright crimes

Criminal prosecution for copyright is the same as trademarks—please refer to Section 3.1.4 above.

3.2.5 Criminal Penalties for copyright infringement

Section 69 Whoever infringes the copyright or the performer's rights according to Section 27, Section 28, Section 29, Section 30 or Section 52 shall be inflicted with a fine from twenty thousand Baht up to two hundred thousand Baht.

If the offence in paragraph one is committed with the commercial purpose, the offender shall be inflicted with imprisonment for a term from six months up to four years or a fine from one hundred thousand Baht up to eight hundred thousand Baht or both imprisonment and fine.

Section 69/1 Whoever commits copyright infringement under section 28/1 shall be liable to imprisonment for a term of six months to four years or to a fine of one hundred thousand to eight hundred thousand baht, or to both.

Section 70 Whoever commits a copyright infringement according to Section 31 shall be inflicted with a fine from ten thousand Baht up to one hundred thousand Bath.

If the offence in paragraph one is committed with the commercial purpose, the offender shall be inflicted with imprisonment for a term from three months up to two years or a fine from fifty thousand Baht up to forty hundred thousand Baht or both imprisonment and fine.

Section 70/1 Whoever infringes the rights management information under section 53/1 or section 53/2 or infringes the technological measures under section 53/4 shall be liable to a fine of ten thousand baht to one hundred thousand baht.

If the offence under paragraph one is committed for commercial purpose, the offender shall be liable to imprisonment for a term of three months to two years or a fine of fifty thousand baht to four hundred thousand baht or to both.

Section 71 Whoever fails to testify or submit any documents or materials as the Committee or the Subcommittee has ordered according to Section 60 paragraph three shall be inflicted with imprisonment for a term not exceeding three months or a fine not exceeding fifty thousand Baht or both imprisonment and fine.

Section 72 Whoever obstructs or fails to provide a convenience to an official who performs his duty according to Section 67 or defies or ignores the order of the official who gives the order according to Section 67 shall be inflicted with imprisonment for a term not exceeding three months or a fine not exceeding fifty thousand Baht or both imprisonment and fine.

Section 73 Whoever having committed an offence and having been penalized by virtue of this Act subsequently commits an offence under this Act within five years after being discharged from the penalty shall be inflicted with double penalty as prescribed for the offence.

Section 74 In case a juristic person commits an offence under this Act, if such offence of the juristic person is caused by the command or conduct of director or manager or person responsible for operation of such juristic person or in case such person has duty to command or act and omit to command or act, causing such juristic person to commit offence, such person shall be liable as set out in such offences.

Section 75 All articles made or imported into the Kingdom constituting the infringement of copyright or performers' rights and articles used in commission of an offence under this Act, shall be confiscated, or in the case where the court deems appropriate, the court may make an order to make such articles useless or to destroy such articles. The court shall order the infringer to cover related expenses.

Section 76 One half of the fine paid in accordance with the judgement shall be paid to the owner of copyright or performer's rights provided that the right of the owner of copyright or performer's rights to bring a civil action for damages for the amount which exceeds the fine that the owner of copyright or performer's rights has received shall not be prejudiced.

Section 77 Offences under section 69 paragraph one, section 70 paragraph one and section 70/1 paragraph one may be settled by the Director General who is authorised to prescribe a fine to settle the case.

3.2.6 Defences/ exceptions: acts not considered as copyright infringement

Defences/exceptions to copyright infringement are set out in Sections 32 to 43 of the Copyright Act.

Section 32 An act against a copyright work by virtue of this Act of another person which does not conflict

with a normal exploitation of the copyright work by the owner of copyright and does not unreasonably prejudice the legitimate right of the owner of copyright shall not be deemed an infringement of copyright.

Subject to the provision of paragraph one, any act against the copyright work in paragraph one shall not be deemed an infringement of copyright provided that the act is each of the followings:

- research or study of the work which is not for profit;
- use for personal benefit or for the benefit of himself and other family members or close relatives;
- comment, criticism or introduction of the work with an acknowledgement of the ownership of copyright in such work;
- reporting of the news through mass-media with an acknowledgement of the ownership of copyright in such work;
- reproduction, adaptation, exhibition or display for the benefit of judicial proceedings or administrative proceedings by authorized officials or for reporting the result of such proceedings;
- reproduction, adaptation, exhibition or display by a teacher for the benefit of his teaching provided that the act is not for profit;
- reproduction, adaptation in part of a work or abridgement or making a summary by a teacher or an educational institution so as to distribute or sell to students in a class or in an educational institution provided that the act is not for profit;
- use of the work as part of questions and answers in an examination.

Section 32/1 Sale of an original or copy of a copyright work by a person legally acquiring ownership of the original or the copy of such copyright work shall not be deemed a copyright infringement.

Section 32/2 Any act involving a copyrighted work stored in a computer system that constitutes reproduction of the work is not a copyright infringement, provided that the work was legally made or acquired, such act is necessary to obtain a copy thereof to enable a device in the computer system, or a process of transferring copyright works via the computer system, to function normally.

Section 32/3 In the case where there is reliable evidence showing that there is a copyright infringement in the computer system of a service provider, a copyright owner may submit a petition requesting the court to order the service provider to cease such copyright infringement.

For the purposes of this section, a service provider means:

- a person who provides to another person a service enabling the service recipient to access the internet, or to connect with other persons by other means via a computer system, regardless of whether the service is provided under the name of the service provider or under the name, or for the benefits, of another person;
- a person who provides a service to store a database for another person's benefits.
- The petition under paragraph one shall have explicit details about the information, the evidence and the relief sought, as follows:
 - name and address of the service provider;
 - the copyrighted work that is allegedly infringed;
 - the allegedly infringing work;
 - the detecting process, date and time when the act was discovered, as well as the act committed or circumstances, including evidence relating to the copyright infringement;
 - damage that may occur from the alleged copyright infringement;
 - the request to order the service provider to remove the infringing work from
 - service provider's computer system or to suppress copyright infringements by other means.

Upon receipt of the petition under paragraph one, the court shall hold an examination. If the court holds that the petition is complete as specified under paragraph three, and, if there are necessary grounds for the court to approve the petition, the court shall order the service provider to cease said infringement or remove the alleged infringing work from the computer system of the service provider for the period of

time prescribed by the court. The court's order shall be enforced against the service provider immediately and shall be notified to the service provider without delay. In this regard, the copyright owner shall file legal proceedings against an infringer of copyright within the period of time ordered by the court to cease the alleged infringement or remove the alleged infringing copy from the computer system.

In the case where the service provider is not a person controlling, initiating or ordering alleged infringement in the computer system of the service provider and such service provider has proceeded the court's order as prescribed under paragraph four, the service provider shall not be liable for alleged infringement occurring prior to the issuance of the court order and after the expiry of the court's order.

The service provider shall not be liable for any damage arising from implementing the court's order under paragraph four.

Note: Thailand is in the process of amending Section 32/3 in order enhance mechanism to protect digital contents. This piece of legislation will provide for a notice and take down system which will help facilitate cooperation between the copyright owners and the ISP.

Section 32/4 Any of the following acts by an organization permitted or recognized organization for the benefits of the disabled who are unable to access to copyrighted works under this Act owing to impairment of vision, hearing, mobility, intellectuality, or learning, or other impairments, as prescribed by the Minister in the Government Gazette, shall not be regarded as a violation of copyright, provided it is not for the purpose of profit making, and Section 32, paragraph one, have been duly complied with:

- Duplication or modification of a copyrighted work which has been advertised or published to the general public and it has been obtained by legitimate means – (1)
- Publication to the general public of a copy of a copyrighted work which has been duplicated or modified under (1), including a copy of a copyrighted work obtained from a permitted or recognized organization in Thailand or abroad.

A permitted or recognized organization, a form of duplication or modification according to necessity of the disabled, including bases and procedures on duplication or modification and publication to the general public under paragraph one, shall be as prescribed by the Minister in the Government Gazette.

Section 33 A reasonable recitation, quotation, copy, emulation or reference in part of and from a copyright work by virtue of this Act with an acknowledgement of the ownership of copyright in such work shall not be deemed an infringement of copyright provided that Section 32 paragraph one is complied with.

Section 34 A reproduction of a copyright work by virtue of this Act by a librarian in the following cases shall not be deemed an infringement of copyright provided that the purpose of such reproduction is not for profit and Section 32 paragraph one is complied with:

- reproduction for use in the library or another library;
- reasonable reproduction in part of a work for another person for the benefit of research or study.

Section 35 An act against a computer program which is a copyright work by virtue of this Act in the following cases shall not be deemed an infringement of copyright provided that the purpose is not for profit and Section 32 paragraph one is complied with:

- research or study of the computer program
- use for the benefit of the owner of the copy of the computer program,
- comment, criticism or introduction of the work with an acknowledgement of the ownership of the copyright in the computer program;
- reporting of the news through mass media with an acknowledgement of the ownership of copyright in the computer program
- making copies of a computer program for a reasonable quantity by a person who has legitimately bought or obtained the program from another person so as to keep them for maintenance or prevention of loss
- reproduction, adaptation, exhibition or display for the benefit of judicial proceedings or administrative proceedings by authorized officials or for reporting the result of such proceedings;
- use of the computer program as part of questions and answer in an examination;

- adapting the computer program as necessary for use;
- making copies of the computer program so as to keep them for the reference or research for public interest.

Section 36 The public performance of a dramatic work or a musical work as appropriate which is not organized or conducted for seeking profit from such activity and without direct or indirect charge for watching the performance and the performers not receiving remuneration for such performance shall not be deemed an infringement of copyright provided that it is conducted by an association, foundation or another organization which has objectives for public charity, education, religion or social welfare and that Section 32 paragraph one is complied with.

Section 37 A drawing, painting, construction, engraving, molding, carving, lithographing, photographing, cinematographing, video broadcasting or any similar act of an artistic work, except an architectural work, which is openly located in a public place shall not be deemed an infringement of copyright in the artistic work.

Section 38 A drawing, painting, engraving, molding, carving, lithographing, photographing, cinematographing or video broadcasting of an architectural work shall not be deemed an infringement of copyright in the architectural work.

Section 39 A photographing or cinematographing or video broadcasting of a work of which an artistic work is a component shall not be deemed an infringement of copyright in the artistic work.

Section 40 In case another person apart from the author jointly owns the copyright in an artistic work, the subsequent creation by the same author of the artistic work in such a manner that a part of the original artistic work is reproduced or the printing pattern, sketch, plan, model or data acquired from a study which has been applied in the creation of the original artistic work is used shall not be deemed an infringement of copyright in the artistic work provided that the author does not reproduce or copy the substantial part of the original artistic work.

Section 41 A restoration in the same appearance of a building which is a copyright architectural work by virtue of this Act shall not be deemed an infringement of copyright.

Section 42 When the term of protection for a cinematographic work has come to an end, the communication to public of the cinematographic work shall not be deemed an infringement of copyright in the literary work, dramatic work, artistic work, musical work, audiovisual work, sound recording or any work previously used to create such cinematographic work.

Section 43 A reproduction of a copyright work by virtue of this Act which is in the possession of the government by an authorized official or by an order of such official for the benefit of government service shall not be deemed an infringement of copyright provided that Section 32 paragraph one is complied with.

*The criminal procedure for trademark and copyright infringement is shown by way of a flowchart in Annex 1 of this Chapter.

4. CIVIL IP ENFORCEMENT

Thailand has a three-tiered court system. Particularly, for IP related cases, there is a specialized IP court. All intellectual property and international trade cases must be filed with the Central Intellectual Property and International Trade Court (IP&IT Court). Then, any judgments or orders of the IP&IT Court must be appealed to the Court of Appeal for Specialized Cases. And, under certain conditions, it may be possible to further appeal a judgment or order of the Specialized Appeal Court to the Supreme Court.

4.1 Trademark and copyright civil case rules

Civil cases are governed by three groups of rules:

- The Law under which case is filed- the TM Act or the Copyright Act. They set out some procedural rules such as prescriptions.
- The Civil Procedure Codes and the Act for the Establishment of the Procedure for the Intellectual Property and International Trade Court B.E. 2539 (1996)

- Rules for Intellectual Property and International Trade Cases B.E. 2540 (1997)

4.2 Trademark and Copyright Infringement

4.2.1 Registered trademark infringement

Section 44 Subject to Sections 27 and 68, a person who is registered as the owner of a trademark shall have the exclusive right to use it for the goods for which it is registered. Section 44 of the TM Act can be relied on to claim damages and/or cessation of infringing acts.

4.2.2 Well known trademark infringement

There is no specific provision for well-known trademark infringement. Instead, combination of provisions can be used.

If the well-known mark is registered, then Section 8(10) of the TM Act can be used in addition to Section 44 of the TM Act.

If the well-known mark is unregistered, then Section 8(10), Section 46 concerning unregistered mark and Section 420 of the Civil and Commercial Code may be used.

4.2.3 Copyright infringement

Copyright disputes can be filed by authors, related rights owners and heirs. The basis for copyright civil court cases includes:

- Infringement of copyright and related rights
- Cases of Piracy
- Moral rights violations

Section 64 In the case of infringement of copyright or performer's rights, the Court has the authority to order the infringer to compensate the owner of copyright or performer's rights for damages the amount which the Court considers appropriate by taking into account the seriousness of injury including the loss of benefits and expenses necessary for the enforcement of the right of the owner of copyright or performer's rights.

In the case where there is clear evidence that infringement of a copyright or performers' right was committed with intent to enable the public to access the copyrighted work or the performers' right widely, the court shall have the power to order the infringer to pay additional damages not exceeding twice the amount of damages under paragraph one.

Section 76 One half of the fine paid in accordance with the judgement shall be paid to the owner of copyright or performer's rights provided that the right of the owner of copyright or performer's rights to bring a civil action for damages for the amount which exceeds the fine that the owner of copyright or performer's rights has received shall not be prejudiced.

4.3 Civil IP remedies in trademark and copyright cases

This section covers specific IP remedies required by the TRIPS agreement. It is beyond the scope of this IP enforcement Manual to cover every kind of civil law procedure that might be possible in an IP case.

4.3.1 Rules for civil IP cases

The Trademark Law and Copyright Law both set out the procedures to file a civil lawsuit in the Central Intellectual Property and International Trade Court, they cover matters such as deadlines.

The applicable rules are provided by the Act for the Establishment of the Procedure for the Intellectual Property and International Trade Court B.E. 2539 (1996) and the Rules for Intellectual Property and International Trade Cases B.E. 2540 (1997). Where they are silent, rules in the Civil Procedure Code shall apply.

4.3.2 Injunctions and preliminary injunctions

Section 116 of the TM Act provides that, if there is clear evidence someone is committing or is about to

commit an act under Section 108, 109 or 110, the owner of the trademark, service mark, certification mark or collective mark may apply to the court to stop or refrain from such act.

Section 65 of the Copyright Act In case there is an explicit evidence that a person is doing or about to do any act which is an infringement of copyright or performer's rights, the owner of copyright or performer's rights may seek the injunction from the court to order the person to stop or refrain from such act.

The injunction of the court according to paragraph one does not prejudice the owner of copyright or performer's rights to claim damages under Section 64.

Articles 12 – 19 of the Rules for Intellectual Property and International Trade Cases B.E. 2540 (1997) also set out procedures for preliminary injunctions. Injunctions in general are governed by the Civil Procedure Rule.

4.3.3 Damages

The TM Act does not have specific provision on calculation of damages so general provision for damages under Section 438 of the Civil and Commercial Code.

Section 64 of the Copyright Act (stated above) address calculation of damages for copyright infringement.

4.3.4 Other remedies

Section 115 of the TM Act provides that all goods which are imported for distribution or had in possession for distribution in violation of this Act shall be confiscated whether or not anyone has been convicted of the offence.

Section 75 of the Copyright Act provides that all articles made or imported into the Kingdom constituting the infringement of copyright or performers' rights and articles used in commission of an offence under this Act, shall be confiscated, or in the case where the court deems appropriate, the court may make an order to make such articles useless or to destroy such articles. The court shall order the infringer to cover related expenses.

Section 76 of the Copyright Act provides that one half of the fine paid in accordance with the judgement shall be paid to the owner of copyright or performer's rights provided that the right of the owner of copyright or performer's rights to bring a civil action for damages for the amount which exceeds the fine that the owner of copyright or performer's rights has received shall not be prejudiced.

Section 77 of the Copyright Act provides that Offences under section 69 paragraph one, section 70 paragraph one and section 70/1 paragraph one may be settled by the Director General who is authorized to prescribe a fine to settle the case.

4.3.5 Right of Information

This refers to judicial orders that the infringer disclose the identity of third persons involved in the production and distribution of infringing goods. No specific provisions in the TM Act or Copyright Act exist.

4.3.6 Indemnification of Defendant

This refer to protecting defendants from abuse by excessively aggressive Plaintiffs.

The TM Act and Copyright Act provide rights of appeal to the Appeal Court and in some cases the Supreme Court and in the case of preliminary Injunctions a right to indemnification in the case of wrongful grant of such an order.

4.3.7 Provisional measures

Preliminary injunctions are described in section 4.3.2 above.

The Anton Piller order is also provided in the Act for the Establishment of and Procedure for Intellectual Property and International Trade Court and the Rules for Intellectual Property and International Trade Cases.

5. ECOMMERCE IP INFRINGEMENT FOR TRADEMARK AND COPYRIGHT

This section sets out the possible violations that relate to traders online, as well as online intermediaries (such as ISPs, ecommerce platforms etc.) at a civil or criminal level.

5.1 Trademark violations

The TM Act contains no specific provisions on e-commerce digital infringement. Cases about online trademark infringements by traders may follow the regular criminal or civil provisions. For intermediaries there is no specific trademark law liability.

Nonetheless, there is a measure for blocking of sites violating IP rights under Section 20(3) of the Computer Crime Related Act.

Section 20 When there is an action to disseminate computer data as follows, the competent official, with approval from the Minister, may file a petition with supporting evidence, to the court of jurisdiction, for a court order to suppress the dissemination or to remove such computer data from a computer system.

(1) [...]

(2) [...]

(3) Computer data which is a criminal offense per laws related to intellectual property or other laws, where such computer data is a breach to the public order or moral high ground of the people, and the law enforcement official or the inquiry official per the Criminal Procedure Code has made a request about.

When there is an action to disseminate computer data which deemed to be a breach to the public order or moral high ground of the people, the Minister, with approval of the Computer Data Screening Committee, may authorize a competent official to file a petition with supporting evidence to the court of jurisdiction for a court order to suppress the dissemination or to remove such computer data from a computer system. The meeting of the Computer Data Screening Committee shall be governed by provisions on the committee authorized to carry out administrative procedure under the administrative procedure law *mutatis mutandis*.

The Minister shall appoint one or more of Computer Data Screening Committee per Paragraph Two. Each committee shall be consisted of nine members, three of whom must come from private sector in the fields of human rights, mass communication, information technology, or other relevant fields. The committee members shall be remunerated as per the criteria prescribed by the Minister with approval from the Ministry of Finance.

The act of the court per Paragraph One and Paragraph Two shall be guided by the Criminal Procedure Code *mutatis mutandis*. When the court issues an order to suppress the dissemination or to remove such computer data per Paragraph One or Paragraph Two, the competent official may suppress the dissemination or remove the computer data themselves or instruct the service provider to suppress the dissemination or remove the computer data. The Minister shall issue a Ministerial Notification prescribing the criteria, duration, and procedure to suppress the dissemination or to remove the computer data, for the competent official and the service provider, and they shall be made compatible to each other, with the consideration of the changing technological development, unless the court had instructed otherwise.

In case of necessity and emergency, the competent official may file the petition for the court order per Paragraph One before obtaining any approval from the Minister, and the competent official with approval from the Computer Data Screening Committee may file the petition for the court order per Paragraph Two before obtaining any authorization from the Minister, but it is obliged that they urgently bring the matter to the attention of the Minister.

Note: Section 20(3) of the Computer Crime Related Act provides measures for the Court to order ISPs to cease infringement. Internet law violations by intermediaries are provided in Section 20(3) of the Computer Crime Related Act. It covers all IP areas.

5.2 Copyright violations

Section 32/3 of the Copyright Act described in section 3.2.6 above provides measures for the Court to order ISPs to cease infringement.

Also, Section 20(3) of the Computer Crime Related Act described in section 5.1 above also cover blocking of websites violating copyright rights.

5.3 Internet law violations by intermediaries

Section 32/3 of the Copyright Act described in section 3.2.6 above provides measures for the Court to order ISPs to cease infringement.

Internet law violations by intermediaries are provided in Section 20(3) of the Computer Crime Related Act. It covers all IP areas. Section 20(3) of the Computer Crime Related Act in section 5.1 above provides measures for the Court to order ISPs to cease infringement.

Note: Thailand is in the process of amending Section 32/3

6. CUSTOMS IP BORDER ENFORCEMENT

Thai Customs operates a trademark recordal system, allowing trademark holders to record their rights with Customs for border protection. For Copyright, recordal is not available. The right owner must inform and request the Customs to inspect and detain the goods on a case by case basis. The border enforcement is not mentioned in the TM Act or the Copyright Act themselves, but mainly in the legal framework listed out below.

- Customs Act, B.E. 2560 (2017)
- Export and Import of Goods Act, B.E. 2522 (1979)
- Notification of the Ministry of Commerce regarding Exportation out of and Importation into the Kingdom, B.E. 2530 (1987)
- Notification of the Ministry of Commerce regarding Exportation out of and Importation into the Kingdom no.94, B.E. 2536 (1993)
- Notification of the Ministry of Commerce regarding Exportation out of and Importation into the Kingdom no.95, B.E. 2536 (1993)
- Notification of the Ministry of Commerce regarding Goods Prohibited from Being Brought in Transit through the Kingdom, B.E. 2559 (2016)

6.1 Recordal process for trademarks and/or copyright

For trademark, the process is that the recordal application is filed at Office of Prevention and Suppression of IPR Violation of DIP (Department of Intellectual Property). The DIP then notifies Customs of the recordal. The documents are straight forward but a hardcopy application must be filed. Detail is regulated in Notification of the Ministry of Commerce regarding Exportation out of and Importation into the Kingdom, B.E. 2530 (1987) ("Notification 2530") and Regulation of Ministry of Commerce regarding Exportation out of and Importation into the Kingdom of the Goods having Counterfeit or Imitated Trademark B.E. 2530 (1987) ("Regulation 2530").

Under Article 5 of the Notification 2530, an applicant who wishes to have his/her mark protected shall inform the Trademark Registrar and submit evidence under the methods as regulated (in the Regulation 2530).

6.2 Restraint/Seizure of Goods

Under Section 166 of the Customs Act, B.E. 2560 (2017), prohibited goods (which include goods having counterfeit/imitated trademarks and copyright infringing goods), shall be forfeitable under this Act.

Section 167 of the Customs Act B.E. 2560 (2017) says:

A customs officer, an administrative officer or a police officer shall have a power to seize or sequestrate any article, which is forfeitable or suspected to be forfeitable under this Act.

If it is found after an investigation that a sequestered article is not forfeitable, such sequestration shall be revoked. In the case where such article is forfeitable, the customs officer, the administrative officer or the police officer shall have the power to seize it.

If the seized article is a means of transport used to commit an offence, and its owner or an entitled person does not submit a request to claim such means of transport back within sixty days from the date of seizure, or within thirty days from the date of seizure in case the seized article is not a means of transport, such unclaimed articles shall be deemed as ownerless and shall become properties of the State.

6.3 Detention order

Please see 6.2.

6.4 Examination of detained goods

Under Article 6 of the Notification, in case the Customs officer could not determine whether the goods imported or exported are the goods having counterfeit/imitated trademarks, the Customs officers shall forward the matter to the Trademark Registrar to determine using the same criteria for consideration of registration of marks. Please note that the TM owners or their representatives will be notified and requested for verification of the detained goods.

For copyright, the Notification of the Ministry of Commerce regarding Exportation out of and Importation into the Kingdom no.95, B.E. 2536 (1993) says, in Article 4, the copyright owners or their representatives may ask the Customs officers to detain and examine the goods if they suspect that those goods infringe their copyrights. Under Article 5, upon the Customs officers' discretion that the goods shall be detained, the Customs officers shall notify such copyright owners or their representatives to examine the goods within the prescribed period.

6.5 Legal action/settlement

According to the Export and Import of Goods Act, Section 20 mentions that whoever exports or imports the prohibited goods shall be imprisoned for not less than 10 years or fined for five times of the price of such exported/imported goods, or both.

*The Recordal process for trademarks and/or copyright is shown in Annex 2 of this Chapter

7. ADMINISTRATIVE IP ENFORCEMENT

Thailand does not use administrative remedies. Trademark and Copyright infringement is either criminal or civil only.

8. OTHER ENFORCEMENT ISSUES

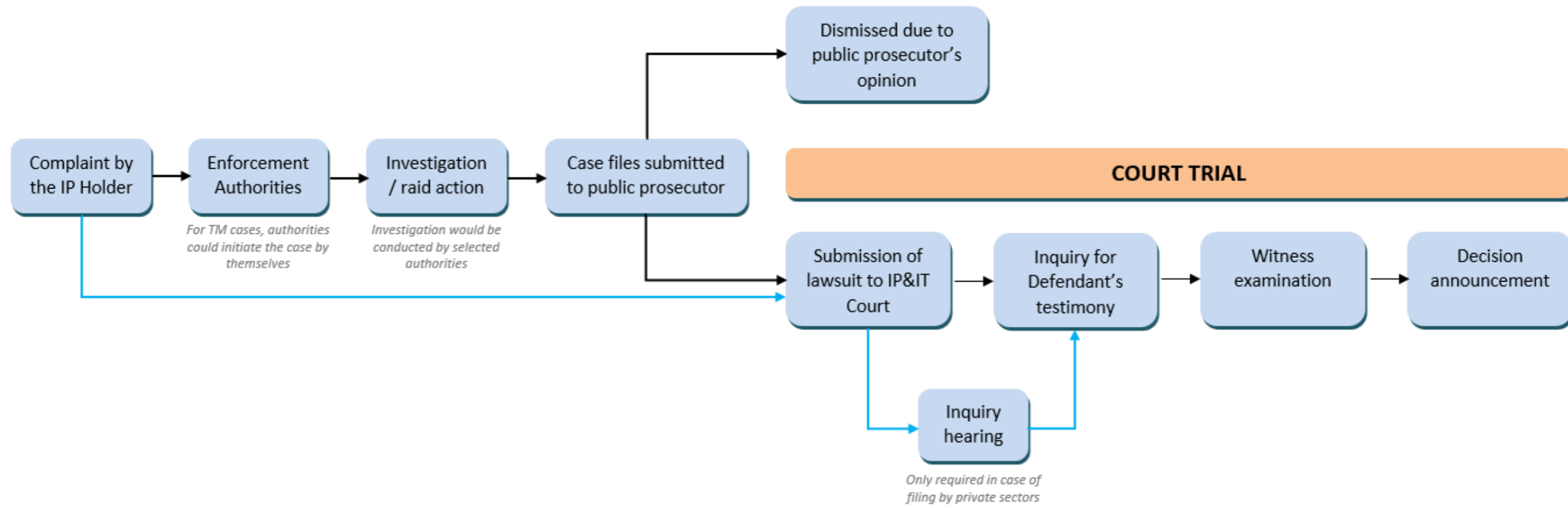
8.1 Alternate Dispute Resolution

Alternate dispute resolution is not explicitly addressed in the TM Act or Copyright Act. But, the IP & IT Court often encourages parties to engage in mediations, and the Department of Intellectual Property has the mediation center to facilitate discussions between parties.

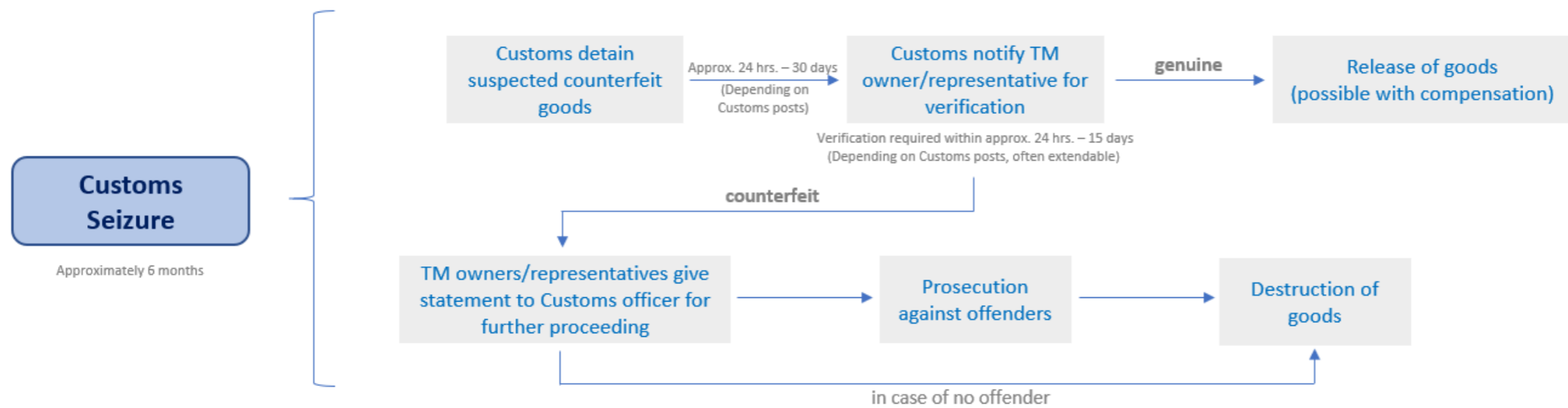
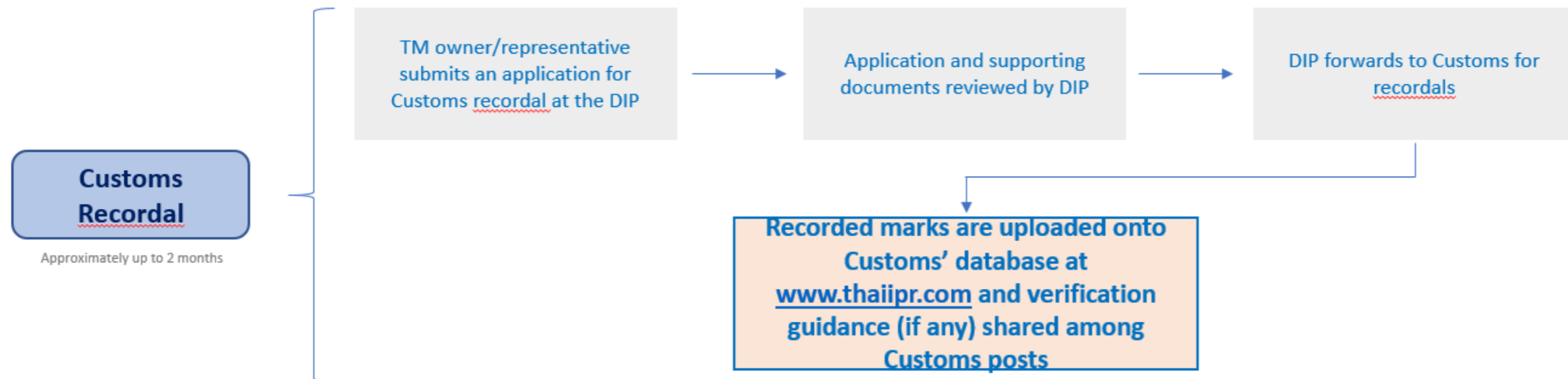
8.2 Warning letters and settlements

Many IP disputes are resolved by issuing a warning letter, and the IP owner and the alleged infringer resolve the dispute. Settlement Agreements and Undertakings can be used to reach a resolution.

ANNEX 1: FLOWCHART FOR CRIMINAL PROCEDURE FOR TRADEMARK AND COPYRIGHTS



ANNEX 2: FLOWCHART ON CUSTOMS RECORDAL AND SEIZURE PROCESS FOR TRADEMARKS





VIETNAM

The manual was developed under the Financial Sector and Intellectual Property (FSIP) programme, a component of the ASEAN Economic Reform Programme funded by the United Kingdom's cross government Prosperity Fund. This Chapter was drafted by Rouse & Co International. The authors are Yen Vu, Trung Tran and Lam Nguyen.

IP ENFORCEMENT– VIETNAM

1. THE IP ENFORCEMENT SYSTEM UNDER TRIPS VIETNAM

Vietnam is a civil law country; therefore, written laws set out all the rules and procedures for IP enforcement. As a WTO TRIPS member Vietnam commits to providing enforcement measures³⁶. These comprise of:

- civil remedies, comprising judicial procedures, evidence rules, injunctions, damages, other remedies, information to rights holder and rights of indemnifications to defendants, as well as provisional measures (preliminary injunctions and search and seizure orders);
- customs interceptions of infringements.
- criminal remedies, at least for wilful trademark counterfeiting or copyright piracy on a commercial scale.
- administrative remedies for handling administrative offences.

This Manual sets out how these apply to counterfeiting (trademark infringements) and piracy (copyright and related rights infringements).

2. TRADEMARKS AND COPYRIGHT

Vietnam's Law on Intellectual Property³⁷ ("**IP Law**") stipulates trademark rights, copyright and related rights, among others, and protection of such rights. The law sets out general trademark and copyright/related rights infringing acts. IP Law also specifies infringing acts that constitute IP administrative offences.

2.1. Rights establishment

Under Article 6.3a of IP Law, trademarks must be registered at the Intellectual Property Office of Vietnam ("**IP Vietnam**") to be protected; rights to well-known trademarks are established based on trademark use. Under the Madrid Agreement and Madrid Protocol, Vietnam accepts applications under the international registration system.

The IP Law protects literary, artistic and scientific works under copyrights, with the work types specified in Article 14.1 of IP Law. Copyright and related rights are established automatically upon creation and fixation of the works³⁸, without registration required (Articles 6.1, 6.2 and 49.2 of the IP Law). However, holders of registration certificates shall not bear the burden of proving their ownership of the copyrights and related rights in a dispute, unless there is otherwise evidence (Article 49.3 of the IP Law). Copyrights under the IP Law include economic rights and moral rights.

2.2. IP infringement acts

2.2.1. Trademark rights infringement acts

According to Article 129.1 of the IP Law, trademark infringement occurs when an infringer, without consent of the trademark holder:

- uses³⁹ a sign, identical to a registered trademark, for identical goods/ services; or

³⁶ Part III of TRIPS - Articles 41-61

³⁷ Law No. 50/2005/QH11 on Intellectual Property issued by the National Assembly on 29 November 2005 ("**IP Law 2005**"), with a number of provisions amended by Law No. 36/2009/QH12 on amendments and supplementations to a number of provisions of IP Law, issued by the National Assembly on 19 June 2009 ("**Amended IP Law 2009**") and Law No. 42/2019/QH14 on amendments and supplementations to a number of provisions of Insurance Business Law and IP Law, issued by the National Assembly on 14 June 2019 ("**Amended IP Law 2019**").

³⁸ Copyrights are established at the moment a work is created and fixed in a certain material form, irrespective of its content, quality, form, mode and language and irrespective of whether or not such work has been published or registered (Article 6.1 of IP Law 2005). Related rights shall arise at the moment a performance, audio and visual fixation, broadcast or satellite signal carrying coded programmes is fixed or displayed without causing loss or damage to copyright (Article 6.2 of IP Law 2005).

³⁹ "Use" of a trademark is defined in Article 124.5 of the IP Law 2015 as follows:

- Affixing the mark on goods, goods packages, business facilities, means of service provision or transaction documents in business activities; or
- Circulating, offering, advertising for sale or stocking for sale goods bearing the mark; or
- Importing goods or services bearing the mark.

- uses a sign, identical to a registered trademark, for similar or related goods/ services, if the use may cause confusion as to the origin of the goods/ services; or
- uses a sign, similar to a registered trademark, for identical, similar or related goods/ services, if the use may cause confusion as to the origin of the goods/ services; or
- uses a sign, identical or similar to a well-known trademark, including signs in the form of translation or transliteration of the well-known trademark, for goods or services of any kind, including unidentical, dissimilar or unrelated goods/ services, if the use may cause confusion as to the origin of the goods/ services or mislead about relationships between the infringer and the well-known trademark's holder.

2.2.2. Copyright infringement acts

Article 28 of the IP Law set out the following acts that infringe copyright:

- Appropriating the copyright in works.
- Impersonating the author.
- Publishing, distributing a work without the author's consent.
- Publishing, distributing a work subject to joint authorship without a co-author's consent.
- Editing, modifying or distorting a work in any way that prejudices the honour and reputation of the author.
- Reproducing a work without consent of the author or copyright holder⁴⁰.
- Making a derivative work without consent of the author or copyright holder of the work used for making such derivative work.⁴¹
- Using a work without consent of the copyright holder and without paying royalties, remuneration or other material benefits in accordance with IP Law⁴².
- Renting a work without paying royalties, remuneration or other material benefits to the author or copyright holder.
- Duplicating, producing copies of, distributing, displaying a work or communicating a work to the public via a communications network or digital means without consent of the copyright holder.
- Publishing a work without consent of the copyright holder.
- Deliberately destroying or deactivating technical protection measures applied by the copyright holder to protect copyright.
- Deliberately deleting or modifying electronic copyright management information in a work.
- Manufacturing, assembling, transforming, distributing, importing, exporting, selling or renting equipment knowing, or having grounds to know, that such equipment may deactivate technical protection measures applied by the copyright holder to protect copyright.
- Making and selling a work with a forged signature of the author.
- Exporting, importing or distributing copies of a work without consent of the copyright holder.

2.2.3. Related rights infringement acts

Article 35 of the IP Law sets out the following acts that infringe related rights:

- Appropriating rights of performers, producers of audio/ visual recordings, or broadcasting organizations.

⁴⁰ Except for cases according to Article 25.1a and 25.1dd of the Amended IP Law 2009, i.e. reproduction for scientific research or teaching purposes without commercial purposes and reproduction by libraries for archival and research purposes.

⁴¹ Except for transcribing a work into braille or into characters of other languages for the blind (Article 25.1i of the Amended IP Law 2009).

⁴² The exceptions and limitations are set out in Article 25.1 of the Amended IP Law 2009.

- Impersonating performers, producers of audio/ visual recordings, or broadcasting organizations.
- Publishing, producing and distributing a fixed performance, audio and visual recording or broadcast without consent of the performer, producer of the audio/ visual recording or broadcasting organization.
- Modifying, editing or distorting a performance in any way which prejudices the honor and reputation of the performer.
- Copying or extracting from a fixed performance, audio/ visual recording or broadcast without consent of the performer, producer of the audio/ visual recording or broadcasting organization.
- Deliberately deleting or modifying electronic related right management information without consent of the related right holder.
- Deliberately destroying or deactivating the technical protection measures applied by the related right holder.
- Publishing, distributing or importing for public distribution of performances, copies of fixed performances or audio/ visual recordings knowing, or having grounds to know, that the electronic related right management information has been deleted or modified without consent of the related right holder.
- Manufacturing, assembling, transforming, distributing, importing, exporting, selling or renting equipment knowing, or having grounds to know, that such equipment helps illegally decode satellite signals carrying coded programs.
- Deliberately receiving or relaying satellite signals carrying coded programs without consent of the legal distributor.

2.2.4. Collective Management Organization (CMO) offences

The following acts by CMO, among others, constitute offences and cause the CMO to suffer administrative sanctions:⁴³

- Carry out activities outside of the scope of the written licensing agreement with the copyright and related right holders.
- Carry out activities without written licensing agreements with copyright and related right holders.
- Carry out activities beyond the spheres permitted by the State.
- Impersonate a CMO to operate.

3. CRIMINAL IP ENFORCEMENT

The 2015 Criminal Code⁴⁴ specifies factors for IP infringing acts to constitute criminal offences, and criminal penalties.

3.1. Trademark rights

3.1.1. Criminal Infringement

Trademark Infringement (Article 226 of the Criminal Code (amended under Article 1.53 of the 2017 Law on Amendments to the Criminal Code⁴⁵):

- Criminal charges on a person will be triggered in case he or she deliberately conducts an act of trademark infringement involving trademark counterfeits: -
 - with a commercial scale; or

⁴³ Article 5, Decree 131/2013/ND-CP on Sanctioning of Administrative Violations in Copyright and Related Rights issued by the Government on 16 October 2013 ("Decree 131")

⁴⁴ Criminal Code No. 100/2015/QH13 issued by the National Assembly on 27 November 2015 ("2015 Criminal Code").

⁴⁵ Law No. 12/2017/QH14 on Amendments to the 2015 Criminal Code issued by the National Assembly on 20 June 2017.

- to earn an illegal profit from VND 100 million; or
 - causing a loss from VND 200 million to the trademark holder; or
 - with the infringing goods worth from VND 200 million .
- Criminal charges on a legal entity will be triggered in case it deliberately conducts an act of trademark infringement involving trademark counterfeits: -
 - with a commercial scale; or
 - to earn an illegal profit from VND 200 million; or
 - with a loss from VND 300 million caused to the trademark holder; or
 - with infringing goods worth from VND 300 million.
- In case the infringing legal entity has suffered administrative sanctions before or unspent convictions for trademark infringement, an infringing act to earn a profit from VND 100 million, or with a loss from VND 100 million caused to the trademark holder, or with infringing goods worth from VND 100 million may also trigger criminal charges.

Counterfeit Manufacturing and Trading (Article 192 of the 2015 Criminal Code (amended under Article 1.42a of the 2017 Law on Amendments to the Criminal Code))

- Criminal charges on a person or a legal entity will be triggered in case such person/ entity manufactures and/ or sells counterfeits with: –
 - the counterfeits worth⁴⁶ from VND 30 million, or the counterfeits worth below VND 30 million but the infringer has suffered administrative sanctions before or unspent convictions for certain economic crimes⁴⁷; or
 - injury or health damage caused to others with a 31% - 60% whole person impairment; or
 - an illegal profit worth from VND 50 million earned; or
 - a property loss worth from VND 100 million caused.
- In case the counterfeits are food, food additives and medicines, the criminal charges on a person or a legal entity will be triggered if that person/entity manufactures and/or sells such counterfeits⁴⁸.

According to Article 213 of the IP Law, trademark counterfeits are goods bearing trademarks or having packaging with trademarks indistinguishably similar to others' protected trademarks without consent of trademark holders. However, in practice, to enforce according to Article 192 of the 2015 Criminal Code above, authorities usually require genuine goods for comparison with their counterfeit counterparts in terms of technical features, functions, quality, etc. (please refer to Section 3.1.7 – Defences to trademark infringement below for more details).

3.1.2 Criminal procedure for trademark infringement

- Trademark Infringement: According to Article 155 of the 2015 Criminal Procedure Code, criminal proceedings are initiated against the act of trademark infringement only upon the victim's petition. If the victim withdraws the petition, the proceedings must be suspended, and the victim does not have the right to refile a new petition, unless such withdrawal results from coercion or duress. The petition may be filed with the economic police (EP) or people's procuracies.

⁴⁶ The counterfeits' values will be calculated based on the values of their genuine counterparts, or goods with the same technical features and functions, in the same quantity.

⁴⁷ The economic crimes in this respect include Smuggling; Illegal transport of goods or money across the border, manufacturing and trading of banned goods; Possession and transport of banned goods; Manufacturing and trading of counterfeit goods; Manufacturing and trading of counterfeit food or food additives; Manufacturing and trading of counterfeit animal feeds, fertilizers, veterinary medicines, pesticides, plant varieties, animal breeds; Speculation; Tax evasion (Articles 188, 189, 190, 191, 192, 193, 194, 195 and 200 of the 2015 Criminal Code).

⁴⁸ Article 193 and 194 of the 2015 Criminal Code.

- Counterfeit Manufacturing and Trading: Criminal proceedings against counterfeit manufacturing and trading may be initiated upon ascertainment of the crimes based on criminal information from any sources.⁴⁹

3.1.3 Economic Police

Under Circular 56/2017/TT-BCA⁵⁰ amended by Circular 26/2018/TT-BCA⁵¹, the Police for Corruption, Smuggling and Economic Crimes (Economic Police – “EP”) under Vietnam People’s Public Security has the authority to investigate IP related infringements for criminal prosecutions.

EP is formed at three levels. Each level of EP would conduct investigations into corresponding scales of infringements:

Level of EP	Scale of Infringement ⁵²
Central level - EP Department, under the Ministry of Public Security	Extremely serious or complicated crimes occurring in more than one province and/or centrally run city; transnational crimes.
Provincial level – EP Division, under the provincial Public Security Department	Infringing acts occurring in more than one district within the province/centrally run city at issue.
District level – EP Team, under the district-level Public Security Section	Infringing acts occurring within a district.

The EP has the main authorities to:

- directly inspect and verify the initial information regarding the criminal acts;
- conduct searches at houses, workplaces, locations or vehicles that are alleged to have documents, items, property and any other materials in relation to the criminal acts;
- seize the infringing goods, materials and other documents in relation to the criminal acts;
- file charges against the suspects; summon and interrogate the suspects;
- cooperate with relevant authorities to arrest and detain the suspects;
- request testimony of person related to the criminal acts;
- request expert assessment and property valuation;
- close the investigation if there is no sufficient evidence proving the criminal acts.

3.1.4 Criminal prosecution of trademark crimes

According to Article 34 of the 2015 Criminal Procedure Code, authorities that conduct criminal proceedings include investigation agencies (EP in IP criminal cases), People’s Procuracies and Courts.

3.1.4.1 Jurisdiction according to court level:⁵³

- Cases involving IP crimes classified as “less serious crime”, “serious crime” or “very serious crime” are heard by district-level courts.
- Cases involving IP crimes classified as “extremely serious crime”, or IP crimes committed outside of Vietnam, or IP crimes with defendants, victims, litigants (i.e. civil plaintiffs, civil defendants, and persons with relevant interests and obligations) located outside of Vietnam are heard by provincial-level courts⁵⁴.

⁴⁹ According to Article 143 of the 2015 Criminal Procedure Code, the sources may include individuals’ denunciations, reports from agencies, organizations and individuals, reports on the mass media, requisitions from state agencies, direct detection of signs of crimes by the authorities that conduct the proceedings, or the criminals’ confessions.

⁵⁰ Article 6, 12, 19 Circular No. 56/2017/TT-BCA issued on 16 November 2017 by the Minister of Public Security Ministry, stipulating the authority for criminal investigation of the Vietnam People’s Public Security and investigation teams of the investigating police offices under the district-level Public Security Sections (“Circular 56”).

⁵¹ Circular No. 26/2018/TT-BCA on amendments and supplementations to several provisions of Circular 56 issued by the Minister of Public Security Ministry on 10 August 2018.

⁵² Article 19, 20, 21 Law No. 99/2015/QH13 on Organization of Criminal Investigation Bodies issued on 26 November 2015 by the National Assembly.

⁵³ Article 268 of the 2015 Criminal Procedure Code.

⁵⁴ According to Article 268.2b of the 2015 Criminal Code, criminal cases with defendants, victims, litigants (i.e. civil plaintiffs, civil defendants, and persons with interests and obligations related to the criminal case) are heard by provincial-level courts. However, for the acts of manufacturing and trading counterfeits (*Article 192 of the 2015*

- Cases involving complicated facts, with natures difficult to assess and agree on, or involving multiple of authority levels and industries; cases where defendants are judges, procurators, investigators, primary governmental leaders at district and provincial levels, religious dignitary or persons with high prestige in minority communities are heard by provincial-level courts.

3.1.4.2 Jurisdiction according to territory⁵⁵:

- The Court at the place where the crime is committed has the jurisdiction to hear the case. In case the crime is committed in multiple or unidentifiable places, the Court at the place where the investigation is completed has the jurisdiction to hear the case.
- In case the defendant committed the crime abroad, the provincial-level court at the last residential place of the defendant has the jurisdiction to hear the case. In case the last residential place of the defendant is unidentifiable, Chief Justice of the Supreme People's Court, as the case may be, will assign the Hanoi, Ho Chi Minh City or Da Nang People's Courts to hear the case.

3.1.5 Criminal prosecution procedure

The criminal procedure for trademark infringement is shown by way of a flowchart in Annex 1 of this Chapter.

3.1.6 Criminal penalties for trademark infringement

Trademark Infringement [Article 226 of the 2015 Criminal Code (amended under Article 1.53 of the 2017 Law on Amendments to the Criminal Code)]:

	Individual Infringer	Corporate Infringer
Minimum fine/penalty	<ul style="list-style-type: none"> ▪ VND 50 million ▪ Up to three years' community sentence 	<ul style="list-style-type: none"> ▪ VND 500 million
Factors raising fine/penalty	Greater illegal profits reaped, greater loss caused, greater values of infringing goods, infringements committed on an organisational basis, infringements committed more than once.	
Maximum fine/penalty	<ul style="list-style-type: none"> ▪ VND 1 billion ▪ 3 years' imprisonment 	<ul style="list-style-type: none"> ▪ VND 5 billion ▪ Up to 2 years' suspension of operations
Possible supplemental penalties	<ul style="list-style-type: none"> ▪ Fine up to VND 200 million ▪ Bans from holding positions, practicing certain jobs or doing certain works in a period from 1 to 5 years 	<ul style="list-style-type: none"> ▪ Fine up to VND 500 million ▪ Bans from business activities, operations in certain fields or fundraising in a period from 1 to 3 years

Criminal Code), it is not clear by law whether IP holders are considered as "litigants" in criminal cases. Therefore, in practice, there have been counterfeiting cases with foreign IP holders designated to district-level courts for handling.

⁵⁵ Article 269 of the 2015 Criminal Procedure Code

Counterfeit Manufacturing and Trading (Article 192 of the 2015 Criminal Code (amended under Article 1.42a of the 2017 Law on Amendments to the Criminal Code)):

	Individual Infringer	Corporate Infringer
Minimum fine/penalty	<ul style="list-style-type: none"> ▪ VND 100 million ▪ 1 year's imprisonment 	<ul style="list-style-type: none"> ▪ VND 1 billion
Factors raising penalty	<ul style="list-style-type: none"> ▪ Higher counterfeits' values, higher percentages of whole person impairment caused by injury/health damage, numbers of injured people, illegal profits reaped, or property losses caused; or ▪ Infringement conducted on an organisational basis, or with a professional nature, with an abuse of position or power, with an abuse of names of agencies or organisations, with deaths caused, with cross-border trading or with dangerous recidivism. 	
Maximum fine/penalty	<ul style="list-style-type: none"> ▪ VND 1 billion ▪ 15 years' imprisonment 	<ul style="list-style-type: none"> ▪ VND 9 billion ▪ Permanent cessation of business operations
Possible supplemental penalties	<ul style="list-style-type: none"> ▪ Fine up to VND 50 million ▪ Bans from holding positions, practicing certain jobs or doing certain works in from 1 to 5 years ▪ Confiscation of a part or the whole of properties 	<ul style="list-style-type: none"> ▪ Fine up to VND 200 million ▪ Bans from business activities, operations in certain fields or fundraising in a period from 1 to 3 years

3.1.7 Defences to trademark infringement

According to Article 125 of the IP Law, the trademark holders shall not have the right to prevent others from circulating, importing, exploiting utilities of the goods that were lawfully put on the market, including overseas markets.

Therefore, if the goods were put on the overseas markets by the trademark owners or their licensees, the acts of circulating, importing, exploiting utilities of such goods do not trigger trademark infringement

In addition, the prosecutor must prove that the accused has carried out the infringing acts deliberately.

Counterfeit Manufacturing and Trading (Article 192 of the 2015 Criminal Code (amended under Article 1.42a of the 2017 Law on Amendments to the Criminal Code)):

- The prosecutor must present evidence regarding the quality of the suspected counterfeit goods in order to prove that the goods are either substandard, falsified or without use value. Such evidence requires genuine products for comparison and analysis.
- This evidence requirement is based on the broad definition of counterfeit under Article 3.8 of Decree 185/2013/ND-CP56, which covers the trademark counterfeit goods, the falsely labelled goods57 and the counterfeits in quality/use value. The counterfeits in quality include
 - substandard forged goods58

⁵⁶ Decree 185/2013/ND-CP on Providing the Penalties on Administrative Violations in Commercial Activities, Production of, Trading in Counterfeit or Banned Goods and Protection of Consumer Rights issue by the Government on 15 November 2013 ("Decree 185").

⁵⁷ Goods with counterfeit packaging of other businesses, or with labels or packaging that falsely claimed name or address of an entrepreneur, trade name, product name, circulation registration code, bar codes, the indication of the goods' origin, places of manufacturing, packaging and assembly (Article 3.8dd and 3.8e of the Decree 185).

⁵⁸ Goods with at least one quality standard or basic technical characteristic creating the goods' use value of 70% or lower comparing with the quality or technical standard applied for the genuine products (Article 3.8b of the Decree 185).

- falsified forged goods⁵⁹
- goods that have no use value or utility (or the use value does not match the goods' nature, their names or announced/registered use value).

3.2 COPYRIGHT

3.2.1 Criminal Infringement

Copyright and Related Right Infringement (Article 225 of the 2015 Criminal Code (amended under Article 1.52a of the 2017 Law on Amendments to the Criminal Code):

- Criminal charges on a person will be triggered in case he or she, without the copyright/ related right holder's consent, deliberately conducts an act of (i) reproducing copyrighted works or audio/ visual recordings, or (ii) distributing to the public copies of copyrighted works or audio/ visual recordings:
 - with a commercial scale; or
 - to earn an illegal profit from VND 50 million or
 - causing a loss from VND 100 million to the copyright/ related right holder; or
 - with the infringing goods worth from VND 100 million
- Criminal charges on a corporate entity will be triggered in case it deliberately conducts an act of copyright infringement:
 - with a commercial scale; or
 - to earn an illegal profit from VND 200 million; or
 - causing a loss from VND 300 million to the copyright/ related right holder; or
 - with the infringing goods worth from VND 300 million
- In case the infringing corporate entity has suffered administrative sanctions before or unspent convictions for copyright/ related right infringement, an infringing act to earn a profit from VND 100 million, or with a loss from VND 100 million caused to the copyright/ related right holder, or with infringing goods worth from VND 100 million may trigger criminal charges.

Counterfeit Manufacturing and Trading (Article 192 of the 2015 Criminal Code (amended under Article 1.42a of the 2017 Law on Amendments to the Criminal Code)

According to Article 213 of the IP Law, copyright and related right counterfeits are copies manufactured without the copyright/ related right holders' consent. The factors that trigger criminal charges of manufacturing and trading in copyright and related right counterfeits according to this Article are similar to those in the case of trademark counterfeit manufacturing and trading.

3.2.2 Criminal procedure for copyright and related right crimes

Criminal proceedings against both –

- copyright and related right infringement; and
- copyright and related right counterfeit manufacturing and trading

may be initiated upon ascertainment of the crimes based on criminal information from any sources.

⁵⁹ Applying for medicine and plant protection products that having insufficient substance content (for medicine) or active ingredients (for plant protection products) to the registered substance content (or active ingredients); or having substances additional (or active ingredients) to that stated on the labels (Article 3.8c and 3.8d of the Decree 185).

3.2.3 Economic Police

For copyright and related rights cases, EP has the same authorities as for trademark cases. Please refer to sub-Section 3.1.4 above for the details.

3.2.4 Criminal prosecution of copyright and related right crimes

Criminal prosecution for copyright and related right crimes is the same as trademark cases – please refer to Annex 1 below.

3.2.5 Criminal Penalties for copyright infringement

Copyright and Related Right Infringement [Article 225 of the 2015 Criminal Code (amended under Article 1.52(a) of the 2017 Law on Amendments to the Criminal Code)]:

	Individual Infringer	Corporate Infringer
Minimum fine/ penalty	<ul style="list-style-type: none"> ▪ VND 50 million ▪ Up to 3 years' community sentence 	<ul style="list-style-type: none"> ▪ VND 300 million
Factors raising penalty	Greater illegal profits reaped, greater loss caused, higher values of infringing goods, infringements committed on an organisational basis, infringements committed more than once.	
Maximum fine/ penalty	<ul style="list-style-type: none"> ▪ VND 1 billion ▪ 3 years' imprisonment 	<ul style="list-style-type: none"> ▪ VND 3 billion ▪ Up to 2 years' suspension of operations
Possible supplemental penalties	<ul style="list-style-type: none"> ▪ Fine up to VND 200 million ▪ Bans from holding positions, practicing certain jobs or doing certain works in 1 – 5 years 	<ul style="list-style-type: none"> ▪ Fine up to VND 300 million ▪ Bans from business activities, operations in certain fields or fund-raising in 1 – 3 years

Counterfeit Manufacturing and Trading (Article 192 of the 2015 Criminal Code (amended under Article 1.42a of the 2017 Law on Amendments to the Criminal Code)):

The penalties are the same as those in cases of trademark counterfeit manufacturing and trading.

3.2.6 Defences/ exceptions: acts not considered as copyright and related right infringement

Exceptions and limitations to copyright

Article 25 of the IP Law set out cases where published works may be used without any consent or payment of royalties or remuneration:

- Make a copy of works for personal scientific researching and teaching (this exception is not applied for architectural works, art works or computer programs);
- Reasonable quoting for commentary or illustrative purposes without misrepresenting the authors' ideas;
- Quoting without misrepresenting the authors' ideas for writing articles, using in periodicals, radio/ television broadcasts, or documentaries;
- Quoting for lecturing without misrepresenting the authors' ideas and commercial purposes;
- Copying by libraries for archival and researching purposes (this exception is not applied for architectural works, art works or computer programs);
- Performing stage works or other performance arts in cultural and propaganda activities without charging in any form;
- Recording live performances for reporting news or teaching;

- Photographing/ broadcasting art, architectural, photographic, applied-art works displayed in public areas for presentation of images of the works;
- Transcribing works into Braille or other languages for the blind;
- Import copies of others' works for personal use.

The application of the above exceptions must not affect the normal exploitation of the works, prejudice the rights of the authors and copyright holders, and must be subject to citation of the authors' names and sources/ origins of the works.

Article 26 of the IP Law set out cases where published works may be used without consent, but royalties and remunerations must be paid to the copyright holders, i.e. where broadcasting organisations use published works for broadcasting with or without sponsorship, advertising or charges. This exception is not applied for cinematographic works.

The application of the above limitations must not affect the normal exploitation of the works, prejudice the rights of the authors and copyright holders, and must be subject to citation of the authors' names and sources/ origins of the works.

Exceptions and limitations to related rights

Article 32 of the IP Law sets out cases where related rights may be used without any consent or payment of royalties or remuneration:

- Making a copy for personal scientific researching and teaching;
- Making a copy for teaching purposes (this exception is not applied in cases of performances, audio-visual recordings, broadcasts have been published for teaching);
- Reasonably quoting for providing information;
- A broadcasting organization making provisional copies of a work for broadcasting when such organization has the right to broadcast.

The application of the above exceptions must not affect the normal exploitation of the performances, audio-visual recordings, broadcasts, and prejudice the rights of the performers, producers of the audio-visual recordings, broadcasting organizations.

Article 33 of the IP Law sets out cases where published audio-visual recordings may be used without consent, but royalties or remuneration must be paid to authors, copyright holders, performers, producers of audio-visual recordings, broadcasting organisations:

- Directly or indirectly using the audio-visual recordings published for commercial purposes to broadcast with or without sponsorship, advertising or charges in any forms;
- Using published audio-visual recordings in business and commercial activities.

*The criminal procedure for trademark and copyright infringement is shown by way of a flowchart in Annex 1 of this Chapter.

4. CIVIL IP ENFORCEMENT

Vietnam's civil court system includes:

- The Supreme People's Court;⁶⁰
- Superior People's Courts;⁶¹
- Provincial-level People's Courts;⁶²

⁶⁰ The highest judicial body of Vietnam, reviewing legally effective judgments and decisions of courts, which are protested against, under cassation or re-opening procedures.

⁶¹ Hearing appeals of trial decisions, judgments of People's Courts of provinces or cities under directly central authority within their territorial jurisdiction which have not yet taken legal effect and are appealed or protested against; Reviewing under cassation or re-opening procedure legally effective judgments or decisions of People's Courts of provinces, municipalities, rural districts, urban districts, towns, cities or the equivalents within their territorial jurisdiction which are protested against.

⁶² Hearing first-instance cases in accordance with the law; hearing appeals from People's Courts of rural districts, urban districts, towns, cities or the equivalents which have not been legally effective and are appealed or protested against in accordance with the law; reviewing legally effective judgments, decisions of People's Courts of rural

- District-level People's Courts.⁶³

4.1 Jurisdiction

Jurisdiction according to court level:

- IP (trademark, copyright and related right) disputes that do not involve commercial purposes are under the jurisdiction of district-level civil courts⁶⁴, except for those involving parties or properties in foreign countries or requiring overseas judicial entrustment – which are under the jurisdiction of Provincial-level Civil Courts⁶⁵.
- IP disputes that involve a commercial purpose are under the jurisdiction of Provincial-level Economic Courts⁶⁶.

4.1.1 Jurisdiction according to territory:

IP disputes are handled by the court where the defendant resides or is domiciled. However, the parties have the right to agree in writing that the disputes are handled by the court where the plaintiff resides or is domiciled.⁶⁷

The plaintiff has the right to petition⁶⁸:

- the court of the area where the defendant last resided or was domiciled, in case the current area where the defendant resides or is domiciled cannot be identified;
- the court of the area where the defendant has offices or branches, in case the dispute arises from the operation of the branch;
- the court of the area where the plaintiff resides or is domiciled, in case the defendant does not have a domicile in Vietnam;
- the court of the area where the dispute arises, in case the dispute is about compensation for non-contractual damage;
- the court of the area where the contract is performed, in case the dispute arises from a contractual relation.
- the court of the area where one of the defendants resides or is domiciled, in case the defendants reside or are domiciled in different areas.

4.2 Trademark, copyright and related rights civil case rules

Civil IP cases are governed by the following groups of rules:

- Specific provisions for handling IP infringement and disputes with civil measures are set out under in the IP Law (including civil measures the Court may apply, litigants' rights and obligations to prove, principles for determination of damage, grounds for determination of levels of damages, preliminary injunctions);
- Civil procedures for handling IP infringement and disputes in the Civil Procedure Code.

4.3 Trademark infringement

4.3.1 Registered trademark infringement

According to Article 198.1b, d of the IP Law, IPR holders (including trademark holders) are entitled to:

districts, urban districts, towns, cities and the equivalent, and request Chief Judge of High People's Court or Chief Justice of the Supreme People's Court to consider, protest against such judgments, decision if there are violations of the law or new facts.

⁶³ Hearing first-instance cases in accordance with the laws.

⁶⁴ District-level Civil Courts handle civil, business, commercial and labour matters that fall into district-level courts' jurisdiction (Article 35.1a and 36.1, Civil Procedure Code No. 92/2015/QH13 issued by the National Assembly on 25 November 2015 ("2015 Civil Procedure Code")).

⁶⁵ Provincial-level Civil Courts handle civil matters that fall into provincial-level courts' jurisdiction (Article 35.3 of the 2015 Civil Procedure Code).

⁶⁶ Provincial-level Economic Courts handle business and commercial matters that fall into provincial-level courts' jurisdiction (Article 37.1a and 38.1 of the 2015 Civil Procedure Code).

⁶⁷ Article 39.1 of the 2015 Civil Procedure Code.

⁶⁸ Article 40.1 of the 2015 Civil Procedure Code.

- request the infringer to terminate the infringements, make a public apology or rectification, and pay damages;
- initiate a lawsuit to protect their legitimate rights and interests.

According to Article 202 of the IP Law, the court may apply the following remedies against IP (including trademark) infringers:

- Termination of infringing acts.
- Public apology and rectification.
- Implementation of civil obligations.
- Payment of damages.
- Destruction, distribution or use for non-commercial purposes of goods, raw materials, materials and means used mainly for the manufacturing or trading of infringing goods, on the condition that the exploitation of rights by IPR holders will not be affected.

4.3.2 Well-known trademark infringement

Well-known trademark holders' entitlements in protection of their marks and remedies applied by the court against infringers are the same as those in cases of registered trademarks – please refer to Section 4.2.1 above.

4.4 Copyright and related right infringement

Please refer to Section 4.2.1 above for copyright and related right holders' entitlements in protection of their rights and remedies applied by the court against infringers.

4.5 Civil IP remedies in trademark and copyright cases

4.5.1 Preliminary injunctions

According to Article 206 of the 2005 IP Law, when or after initiating a lawsuit, the IPR holder is entitled to request that the Court apply the preliminary injunctions to goods suspected as infringing IPRs and raw materials, materials and means for manufacturing and trading such goods if (i) there is a threat of irreparable damage suffered by the IPR holders; or (ii) there is a threat of dispersal or destruction of suspected infringing goods and related evidence if they are not protected in time. The preliminary injunctions include retention, seizure, sealing, prohibiting any alteration of the original state, prohibiting any movement, prohibiting transfer of ownership of the infringing goods, raw materials, materials and means.

According to Article 208 of the IP Law, the plaintiffs bear the burden of proving the rights to the preliminary injunctions request by providing documents evidencing that they are the IPR holders.⁶⁹

Detailed procedures for preliminary injunctions request are stipulated under Chapter VIII of the 2015 Civil Procedure Code. The request must include information about the plaintiff, a summary of the dispute/ infringement, reasons for application of the preliminary injunctions, types of injunctions applied and specific requirements. When receiving the request for preliminary injunctions enclosed with the petition and evidence, the Chief Justice shall immediately assign a Judge to handle the request. Within 48 hours since receiving the request, the Judge must issue a decision to apply preliminary injunctions; if the request is rejected, the Judge must issue a notification setting out the refusal grounds.

4.5.2 Other remedies

Other remedies on IP infringement are regulated under provisions on administrative enforcement (please refer to Section 7 below).

⁶⁹ According to Article 203 of the 2005 IP Law, the evidentiary documents may be copies of trademark, copyright or related right registration certificates, or an extract of the registration information from the National Register of Copyright and Related Rights/ National Register of Industrial Property, evidence on rights to well-known trademarks, copies of IP licensing agreements, etc.

4.5.3 Damages

Damage under the IP Law includes material damage and spiritual damage. Material damage include property losses, decreases in income and profit, loss of business opportunities, reasonable expenses for prevention and remedying of such damages.⁷⁰ Spiritual damage includes damages to the honor, dignity, prestige, reputation of the authors and performers.⁷¹ The level of damages is calculated based on the actual loss that the IPR holder suffers due to the infringement.⁷²

Once the plaintiff manages to prove the infringement has caused the plaintiff material damage, the plaintiff may request the Court to decide the damages based on:⁷³

- Total material damages in money plus the profit gained by the defendant by the infringement, if the decrease in profit of the plaintiff has not been included in the total material damages; or
- The licensing price on the assumption that the defendant was licensed by the plaintiff to use the IP under a license contract within a scope corresponding to the infringement; or
- Other ways of calculation IPR holder proposed in accordance with laws.

Where the damages cannot be calculated based on the above methods, the Court may decide the amount of damages based on the extent of the losses, but the amount will not surpass VND 500 million.

Once the plaintiff manages to prove that the infringement has caused the plaintiff spiritual damages, the plaintiff is entitled to request the Court to decide the damages depending on the extent of loss, with the range from VND 5 million to VND 50 million.

The plaintiff is also entitled to request the Court to compel the infringer to pay reasonable costs for lawyers.

4.5.4 Right of Information

Article 203.5 of the IP Law stipulates that where a party in an IP infringement lawsuit can prove that appropriate evidence proving such party's claim is under the control of the other party and is therefore inaccessible, the former party shall have the right to request the court to compel the latter party to provide such evidence.

Article 70.7 of the 2015 Civil Procedure Law provides for the right of parties in the litigation to petition the Court to request other involved parties to present materials and evidences they are keeping, petition the Court to issue the decision to request the agencies, organizations and individuals that are keeping and managing materials/evidences to supply such materials and evidences.

4.5.5 Indemnification of Defendant

According to Article 208 of the IP Law, the plaintiffs must pay compensation for loss caused to the person suffering the preliminary measures in case such person is found not to infringe the IPR. The plaintiff must deposit a bond in forms of money (a sum of money equal to 20 per cent of the value of the goods subject to the application of provisional urgent measures, or at least VND 20 million where it is impossible to value such goods) or a deed of guarantee issued by a bank/ credit institution.

According to Article 198.4 of the IP Law (as amended in 2019), the defendant, if receive acquittal from the Court, is entitled to request the Court to order the plaintiff to reimburse for their reasonable expenses such as the cost of hiring a lawyer or other expenses in accordance with laws.

4.5.6 Provisional measures

Apart from preliminary injunctions described in sub-Section 4.3.1 above, other provisional measures under Article 114 of the 2015 Civil Procedure Code may also be applied if they are relevant, including freezing accounts at banks or other credit institutions, state treasury; freezing properties at places of their deposit; prohibiting involved parties from performing, or forcing them to perform certain acts; etc.

⁷⁰ Article 204.1a of the 2005 IP Law

⁷¹ Article 204.1b of the 2005 IP Law

⁷² Article 204.2 of the 2005 IP Law

⁷³ Article 205.1 of the 2005 IP Law, amended under Article 2.11 of the 2019 Amended IP Law

5 ONLINE IP INFRINGEMENT FOR TRADEMARK AND COPYRIGHT

5.1 Trademark violations

- Article 4 of Decree 52/2013/ND-CP on E-commerce⁷⁴ (“Decree 52”) prohibits acts of taking advantage of e-commerce to trading in counterfeits and goods/ services infringing IPRs (including trademarks, copyright and related rights).
- Under Article 83.4a of the Decree 185 on administrative sanctions against violations in commercial activities, failure to apply measures against legal violations on the platforms upon self-discovery or upon the receipt of consumer’s reports may cause the platforms to suffer a monetary fine of VND 30 million to 40 million.
- However, both Decree 52 and Decree 185 provide no guidance on the measures that the platforms should take (including whether and how the platforms must establish notice and take mechanism).
- According to Article 11.15 of Decree No. 99/2013/ND-CP on administrative sanctions of violations in the field of Industrial property (Decree 99), a fine of between VND 10 million and 20 million, shall be imposed for acts of using signs infringing upon rights to trademarks, geographical indications, trade names on signboards, business transaction papers, means of business or service, goods packages.
- Article 14.15b of Decree 99 provides that a fine of between VND 5,000,000 and 15,000,000 million shall be imposed for any of the following acts: Using on transaction papers, means of business, including also means of service, signboards and goods packages, trade indications which mislead as to business entities or activities or trade origin of goods or services or origin, method of production, utilities, quality, quantity or other features of goods or services or conditions for provision of goods or services.
- Article 21 of Circular 11/2015/TT-BKHCH dated 26/6/2015 on detailing and guiding a number of articles of the Government’s Decree No. 99/2013/ND-CP of August 29, 2013, on administrative sanctions of violations in the field of Industrial property provides that means of business shall be understood as any means bearing or containing a protected industrial property subject matter or trade indication and used to serve business activities (for example, websites, introduction documents, name cards, means of transport and utensils and decorations in business establishments).

5.2 Copyright and related right violations

Enforcement against online copyright infringements may follow the criminal, civil or administrative procedures set out above. For administrative violations, Decree 131 specifies “Compelled removal of infringing electronic copies of works, performances, audio/ visual recordings and broadcasts on the Internet and digital environment” as one of the remedies.

Article 5.3 of Joint Circular No. 07/2012/TTLT-BTTTT-BVHTTDL⁷⁵ requires Internet service providers (“ISPs”) a duty to remove and delete digital content that violates copyright and related rights, and cut, stop or suspend an individual's internet/telecommunication line under orders of Inspectorates of Ministry of Information and Communications (MoIC) and MoCST.

According to Article 5.5 of the same Joint Circular, ISPs are directly responsible for paying damages due to copyright and related right infringement in the following circumstances:

- ISP acts as the source for the start of the uploading, transmission or provision of digital content via telecommunications and Internet networks without IPR holders’ consent;
- ISP edits, modifies, copies digital content without IPR holders’ consent;

⁷⁴ Decree 52/2013/ND-CP on E-commerce issued on 16 May 2013 (“Decree 52”)

⁷⁵ Joint Circular No. 07/2012/TTLT-BTTTT-BVHTTDL Stipulating Duty of Enterprises Providing Intermediary Service in Protection of Copyright and Related Rights in The Internet and Telecommunication Networks Environment jointly issued by Ministry of Information and Communications and Ministry of Culture, Sports and Tourism on 19 June 2012.

- ISP intentionally ruins or disables technical measures for protection of copyright and related rights;
- ISP operates as a source of secondary distribution of digital content obtained through copyright and related right infringement.

6 CUSTOMS IP BORDER ENFORCEMENT

Customs measures for protection of IPR include:

- Suspension of customs procedures for suspected infringing goods;
- Inspection and supervision for detecting goods with signs of IPRs infringement.

Customs can act at the request of IPRs holders to temporarily deter suspected infringing goods coming into the border. If Customs detects IP counterfeits in the suspension, inspection and supervision processes, Customs have the right and obligation to impose administrative sanctions, remedies, preventive measures and measures to ensure enforcement of administrative penalties described in Section 7 below.

6.1 Recordal process for trademarks and/or copyright and related rights

According to Article 6, Circular 13/2015/TT-BTC⁷⁶ (“**Circular 13**”):

- IPR holders file customs recordals with General Department of Vietnam Customs (“GDVC”) with the following documents:
 - Request for supervision and inspection of exported and imported goods in the provided form;
 - Copies of documents evidencing IP protection titles, e.g. registration certificates, licensing recordal certificates;
 - Detailed description of IP counterfeits, with photos and features that help distinguish counterfeits and their genuine counterparts;
 - A list of authorized importers/exporters of the genuine goods;
 - A list of possible exporters/ importers of infringing goods.
- The customs recordal will be valid for 2 years with a possibility of renewal for another 2 years (Article 74.2d, Customs Law⁷⁷).

6.2 Suspension of Customs Procedure

- When detecting signs of IP infringement in a consignment, Customs will stop the customs procedures and send a notice on suspected infringing goods to the IPR holders (Article 14.1, Circular 13).
- Within 3 working days from the date of receipt of the notice on suspected infringing goods, the IPR holders must submit a request on suspension of customs and a bond in the form of money or a deed of guarantee issued by a bank/ credit institution⁷⁸ (Article 76.1b, Customs Law).
- Within 2 hours from receipt of the suspension request, other required documents in the dossier and the bond from the IPR holders, Customs will issue a decision on suspension of goods (Article 10.1, Circular 13).
- In case there is no information on requests for IPR protection, but Customs detects goods with signs of IPR infringements in the process of customs dossier examination/ goods check-up,

⁷⁶ Circular 13/2015/TT-BTC on Inspection, Supervision, Temporary Suspension of Customs Procedures for Exported and Imported Goods That Are Subjects of Intellectual Property Rights; Control of Counterfeit Goods and Goods Infringing Intellectual Property Rights issued by Ministry of Finance on 30 January 2015 (“**Circular 13**”)

⁷⁷ Laws No. 54/2014/QH13 on Customs issued by the National Assembly on 23 June 2014 (“**Customs Law**”)

⁷⁸ The amount must be equal to 20% of the value of the suspended consignment, or minimum VND 20 million in case the consignment’s value is unidentifiable, and other fees that may be incurred due to a wrong request for suspension of customs procedures.

Customs will examine, take samples of or photograph the suspected infringing goods, and cooperate with other IP authorities to suspend the goods if signs of infringement are determined (Article 14.3, Circular 13).

- When the requester for suspension of customs procedures has fulfilled the obligations specified in Article 217 of this Law, the customs authority shall issue the decision of suspension

When the requester for suspension of customs procedures has fulfilled the obligations specified in Article 217 of this Law, the customs authority shall issue the decision of suspension. The customs authority shall provide the intellectual property rights holder with information on name and address of shipper; exporter, consignee or importer; description of goods; quantity of goods; origin of goods (as the case may be), within 30 days from the date of issuance of the decision to apply administrative measures to handle trademark counterfeiting and smuggled goods specified in Article 216(4) of this Law. (Article 148.12, Law No. 42/2019/QH14 dated June 14, 2019 amending some articles of Law on Insurance business and Law on Intellectual Property)

6.3 Examination of Suspended Goods

The examination is carried out during the suspension period. The time limit for the suspension is 10 working days from the date the suspension decision is issued. In case there are needs for assessment or consultation of technical opinions from IP authorities, the suspension may be extended until receipt of the assessment results or technical opinions (Article 10.2, Circular 13).

While temporarily suspending or applying the preventive measures as prescribed, Sub-department of Customs which decides to temporarily suspend the goods in question may solicit assessment in specialized organizations of customs or other verifying organizations as prescribed in Clause 1, Article 40 of the Government's Decree 105/2006 / ND-CP dated September 22 , 2006 providing instructions on the implementation of a number of articles of the Law on Intellectual property and protection of intellectual property rights and State management of intellectual property or consult the expertise of State management agencies on intellectual property to identify signs of infringement of intellectual property. (Article 10.3b of Circular 13).

*Note: The Customs Recordal process for trademarks and/or copyright is shown by way of a flowchart in Annex 2 of this Chapter.

6.4 Legal action/settlement

According to Article 10.4a, Circular 13, upon expiration of the suspension period, Customs must:

- Issue a decision to accept the case according to administrative procedures once confirming the suspended goods infringe IPRs.
- Issue a decision on detention of goods in case there are sufficient grounds to determine the suspended goods as infringing IPRs.
- Impose administrative sanctions and remedies if there are sufficient grounds to determine the suspended goods as infringing IPRs.

Upon expiration of the suspension period, if the IPR holders does not initiate a lawsuit, or Customs does not decide to accept the case according to administrative violation handling procedures, Customs will resume the customs procedures for the consignment (Article 76.4 of Customs Law).

7 ADMINISTRATIVE IP ENFORCEMENT

7.1 Trademark, copyright and related rights administrative offences

According to Article 211 of the IP Law (as amended in 2009), the following acts constitute IP administrative offences:

- Infringe IPRs causing damage to the authors, owners, consumers or society.

- Produce, import, export, transport, or trade in IP counterfeits as defined in Article 21379 of the IP Law or assign other people to commit these acts.
- Produce, import, transport, trade in or store stamps, labels or other articles bearing a counterfeit trademark or assign other people to commit these acts.
- Specific infringing acts subject to administrative sanctions are stipulated in:
- Decree 99/2013/ND-CP on Sanctioning of Administrative Violations in Industrial Property issued by the Government on 29 August 2013 (“Decree 99”);
- Decree 131/2013/ND-CP on Sanctioning of Administrative Violations in Copyright and Related Rights issued by the Government on 16 October 2013 (“Decree 131”).

7.2 Jurisdiction

Authorities with the jurisdiction to conduct administrative enforcement are described as follows:

- Economic Police (EP)
- Market Management Bureau (MMB)
- Inspectorate of Ministry of Culture, Sport and Tourism (MoCST) and Departments of Culture, Sport & Tourism (DoCST) at the provincial level
- Inspectorate of Ministry of Science and Technology (MoST) and Department of Science and Technology (DoST) at the provincial level
- Inspectorate of Ministry of Information and Communications (MoIC) and Department of Information and Communications (DoIC) at the provincial level
- People’s Committees
- Customs

7.3 Administrative Procedure

7.3.1 Trademark infringement

The administrative procedure for handling trademark infringements is stipulated in Chapter IV of Decree 99. The procedure for a straightforward case of trademark infringement is set out below:

- The trademark holders (or their authorized representatives) shall file written requests for handling of the infringing acts to the competent authorities. The request must be enclosed with documents proving the trademark holders’ rights to request handling of violations, evidence of the infringing act, goods or services in the form of descriptions or photos, the location where the infringement occurs and other necessary information.⁸⁰
- If the request dossier is considered sufficient, within 30 days since the date of receipt, the competent authority must notify the trademark holder of the projected handling timeframe, procedure and applied measures; and may request the trademark holders’ cooperation in the handling process.⁸¹
- The competent authority can carry out the following activities to verify the infringements⁸² –
 - Request the alleged infringer and parties with related rights and interests to provide the information, document, evidence, explanations, arguments or counterarguments

⁷⁹ According to Article 213 of the 2005 IP Law, trademark counterfeits are goods bearing trademarks or having packaging with trademarks indistinguishably similar to others’ protected trademarks without consent of trademark holders, copyright and related right counterfeits are copies manufactured without the copyright/ related right holders’ consent.

⁸⁰ Article 24 of Decree 99

⁸¹ Article 25.2 of Decree 99

⁸² Article 25 of Decree 99

- Request the trademark holder to provide document, evidence, clarification on the case, genuine samples for comparison (in case of trademark counterfeits), confirmation on the counterfeit nature of the infringing goods, etc.
 - Solicit expert assessment to clarify the nature of the infringement
 - Conduct their own investigation into the infringement to collect evidence, verify the facts and the nature of infringement
- In case of trademark infringement with complicated circumstances or involving several organisations and individuals, the competent authority shall coordinate with other authorities for handling the infringement.⁸³
 - In case the request is accepted and being handled by the competent authorities, but the involving parties reach an agreement and suggest measures⁸⁴, the competent authorities shall acknowledge such measures and terminate the handling process;
 - After the handling process, if the trademark infringement is established, competent authority shall issue Sanctioning Decision against the infringers.

7.3.2 Copyright and related right infringement

There are no separate regulations on the administrative procedure of handling copyright and related right infringement. The handling of this matter could follow general principles on handling complaints on IP infringements set out in Decree 105⁸⁵. The complaint must be enclosed with evidence on the IPR holders' status (i.e. copyright registration certificates; originals or copies of the compositions, fixations of the performances, audio/ visual recordings, broadcasts, satellite signals carrying encoded programs together with other documents evidencing the creation, publication, dissemination the works, etc.)⁸⁶, evidence on the infringement (in the forms of descriptions and specimens of the protected works; specimens, related exhibits, photos or recordings of the examined products; written explanations and comparisons between the examined products and protected works; minutes, testimonies and other documents evidencing acts of infringement).⁸⁷ The authority receiving the complaint must handle it (if having jurisdiction) or transfer it/ guide the IP holders to transfer it to the competent authority within 30 days upon receipt. In case required documents/ materials are missing, the handling authority must request the complainant to supplement within 30 days.⁸⁸

7.4 Sanctions

Administrative sanctions as set out in Article 214 of the IP Law may be warning or monetary fines, alongside termination of the infringing acts. Possible supplemental sanctions include confiscation of the counterfeits, and raw materials, materials and means used mainly for production or trading of such counterfeits, and suspension for a definite time of business activities in the area of infringement.

Sanction forms, amounts and procedures for each type of infringing acts are stipulated in Decree 99 and Decree 131.

7.5 Other Remedies

Beside the above sanctions, the following remedies may be applied according to Article 214.3 of the IP Law (as amended in 2009):

- Destruction or distribution or putting into use for non-commercial purposes of the counterfeits and the raw materials, materials and means used mainly for the production or trading of such counterfeits, provided that the destruction, distribution or putting into use does not affect the normal exploitation of rights by the IPR holders;

⁸³ Article 29 of Decree 99

⁸⁴ According to Article 27.2 of the Decree 99, the agreed measures shall be in accordance with law on IP and not affect the legitimate rights and interests of third parties, consumers and the public.

⁸⁵ Decree 105/2006/ND-CP Detailing and Guiding the Implementation of A Number Of Articles of The Law on Intellectual Property on Protection of Intellectual Property Rights And on State Management of Intellectual Property issued by the Government on 22 September 2006 ("Decree 105"), amended by Decree No. 119/2010/ND-CP amending and supplementing a number of Decree 105 issued by the Government on 30 December 2010 ("Decree 119")

⁸⁶ Article 24, Decree 105, amended by Article 1.4 Decree 119

⁸⁷ Article 25, Decree 105

⁸⁸ Article 27, Decree 105

- Ejection of infringing goods in transit or compelled re-export of the counterfeits, and imported means, raw materials and materials used mainly for production or trading of the counterfeits out of Vietnam, after removal of the infringing elements.

More specific remedies are stipulated in Decree 99 and Decree 131. For example, the following remedies may be in copyright and related right cases:

- Compelled removal of infringing electronic copies of works, performances, audio/ visual recordings and broadcasts on the Internet and digital environment;
- Refund of royalties, remuneration, or material benefits obtained from the violation to copyright or related right holders.

7.6 Preventive measures and measures to ensure enforcement of administrative penalties

According to Article 215 of the IP Law, in cases where (i) the IP infringing act is posing a threat of serious damage to consumers or the society, or (ii) there is a threat of dispersal or destruction of evidentiary materials, or a sign that the infringer is evading the liability, the following preventive measures and measures to secure enforcement of administrative penalties may be applied:

- Temporary detention of persons;
- Temporary custody of infringing goods, evidentiary materials and infringing facilities;
- Body search;
- Searches of means of transport and objects; searches of places where infringing goods, evidentiary material and infringing facilities are hidden;
- Other administrative preventive measures in accordance with the law on dealing with administrative breaches.

8 OTHER ENFORCEMENT ISSUES

8.1 Alternate Dispute Resolution

Article 198.1d of IP Law, IPR holders could choose to settle the trademark, copyright and related right infringement disputes through arbitration. The procedure of arbitration is regulated under Arbitration Law.⁸⁹ Parties may choose arbitration in advance through contracts or decide on pursuing arbitration after a dispute arises. An arbitration award is legally binding on the parties of the dispute and could be enforced through Civil Judgment Enforcement Agency if the parties do not voluntarily comply.

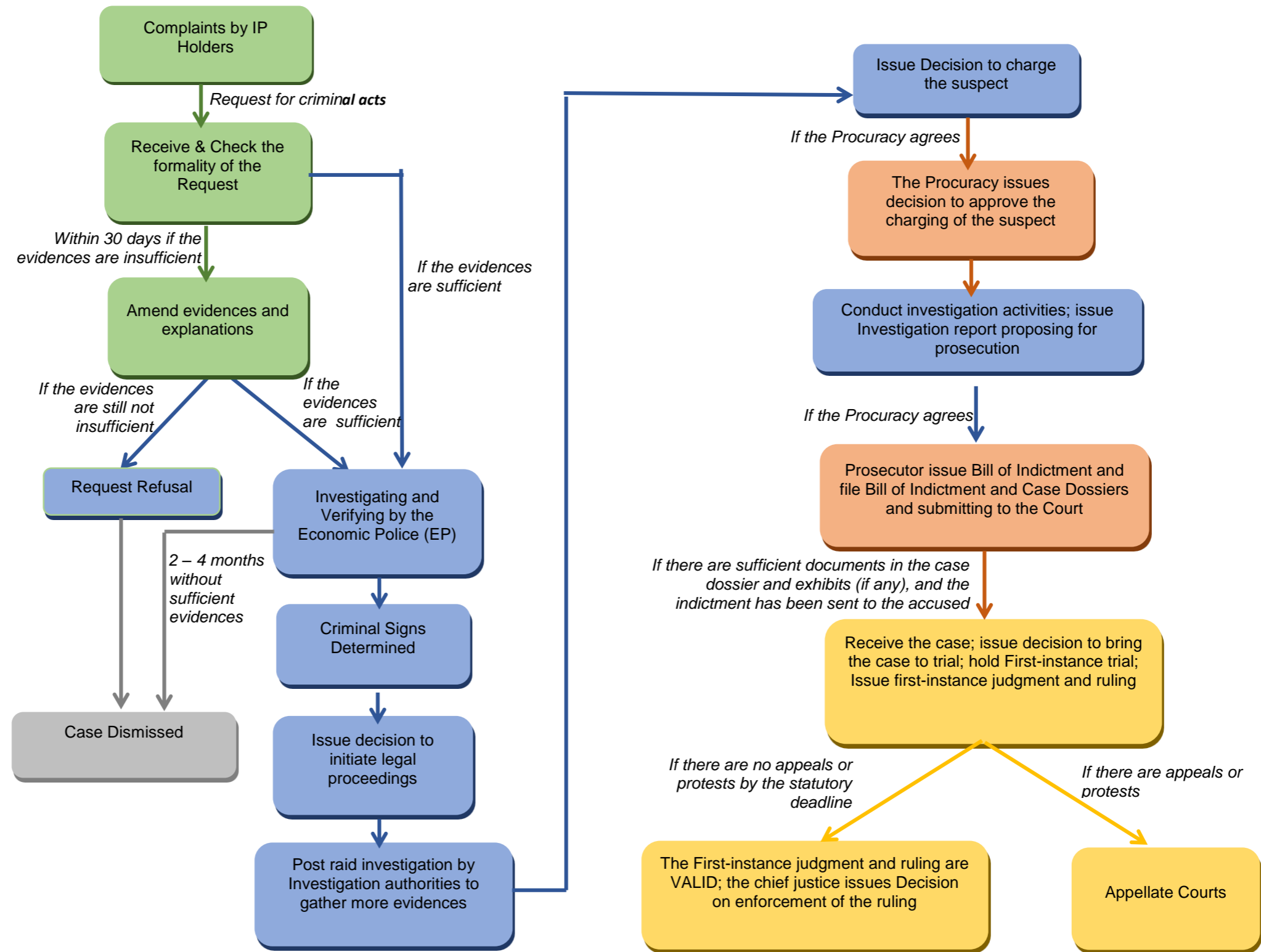
8.2 Warning letters and settlements

As a self-protection measure under Article 198.1b, an IPR holder can send a warning letter to trademark, copyright and related right alleged infringers, asking them to stop the acts of infringement. Persistent follow-ups subsequent to the dispatch of the letter is proved to be efficient to resolve the dispute. A mutual Settlement Agreements or the infringer's signed Undertakings can be used to settle the disputes.

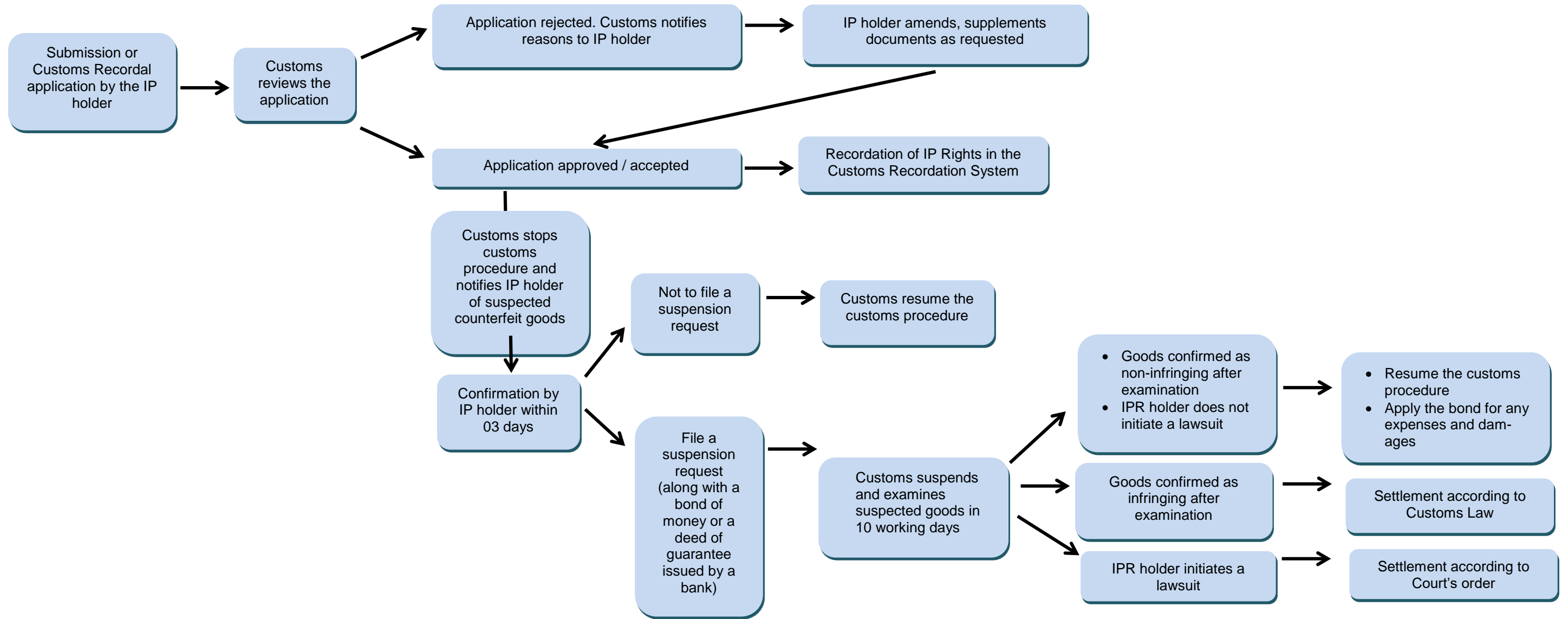
⁸⁹ Law No. 54/2010/QH12 on Commercial Arbitration issued by the National Assembly on 17 June 2010 ("Arbitration Law")

ANNEX 1: FLOWCHART FOR CRIMINAL PROCEDURE FOR TRADEMARK AND COPYRIGHTS

	IP Holders
	Economic Police
	Procuracy
	Court



ANNEX 2: FLOWCHART ON CUSTOMS RECORDAL PROCESS FOR TRADEMARKS AND/OR COPYRIGHT



ANNEX 1: CONTACT DETAILS OF INTELLECTUAL PROPERTY OFFICES OF ASEAN COUNTRIES

Country	Contact details of IP Offices	Website
Brunei Darussalam	<p><u>Brunei Intellectual Property Office (BRUIPO)</u></p> <p>Address: Level 2, Knowledge Hub, Anggerek Desa, Simpang 32-37, Kg. Anggerek Desa, Jalan Berakas, Bandar Seri Begawan BB3713, Brunei Darussalam</p> <p>Tel: +673-2380965 Email: enquiries@bruipo.gov.bn</p>	https://www.bruipo.gov.bn
Cambodia	<p><u>Ministry of Commerce (Trademark)</u></p> <p>Address: Lot 19-61, MOC Road (113B Road), Phum Teuk Thla, Sangkat Teuk Thla, Khan Sen Sok, Phnom Penh, Kingdom of Cambodia</p> <p>Tel: (855-23) 866 115, (855-12) 807 346, (855-11) 888 969 E-mail: cambodiaip.dip@gmail.com</p>	http://www.cambodiaip.gov.kh/
	<p><u>Ministry of Culture and Fine Arts (Copyright)</u></p> <p>Address: N° 227, Norodom Blvd, Sangkat Tonle Basac, Khan Chamkamorn, Phnom Penh, Kingdom of Cambodia</p> <p>Tel: (855-23) 218 148 Email: info@mca.gov.kh</p>	http://www.mca.gov.kh/
Indonesia	<p><u>Directorate General of Intellectual Property (DGIP)</u></p> <p>Address: Jl. H. R. Rasuna Said No. kav 8-9, RT.16, Kuningan, Kuningan Tim., Kota Jakarta Selatan, Daerah Khusus Ibukota Jakarta 12940</p> <p>Tel: (021)50810300</p>	https://www.dgip.go.id/
Laos	<p><u>Department of Intellectual Property, Ministry of Science and Technology</u></p> <p>Address: Nahaidyo Road, Chanthabouly District, P.O. Box 2279, Vientiane</p> <p>Tel: (856) 20 55 511 924 (856) 21 213 470 ext 154</p>	https://dip.gov.la/
Malaysia	<p><u>Intellectual Property Corporation of Malaysia (MyIPO)</u></p> <p>Address: Menara Uoa Bangsar, Jalan Bangsar Utama 1, Bangsar, 59000 Kuala Lumpur, Wilayah Persekutuan Kuala Lumpur</p> <p>Tel.: +603-2299 8400</p>	http://www.myipo.gov.my/en/home/
Myanmar	<p><u>Department of Trade, Ministry of Commerce</u></p> <p>Address 1: 6th floor of Export/Import office under Department of Trade, Ministry of Commerce, Strand road, Yangon</p> <p>Address 2: Building 52, Ministry of Commerce, Naypyitaw</p>	https://www.commerce.gov.mm/
Philippines	<p><u>IP Office of Philippines (IPOP HL)</u></p> <p>Address: Intellectual Property Center, 28 Upper McKinley Rd, Taguig, 1634 Metro Manila, Philippines</p> <p>Tel. +63 2 7238 6300</p>	https://www.ipophil.gov.ph/
Singapore	<p><u>Intellectual Property Office of Singapore (IPOS)</u></p> <p>Address: 1 Paya Lebar Link #11-03 PLQ 1, Paya Lebar Quarter, 408533</p> <p>Tel: 6339 8616</p>	https://www.ipos.gov.sg/
Thailand	<p><u>Department of Intellectual Property (DIP)</u></p> <p>Address: 563 Nonthaburi 1Rd., Bangkrasor, Muang Nonthaburi 11000 Thailand</p> <p>Tel: (+66) 02 547 5024</p>	www.ipthailand.go.th
Vietnam	<p><u>Intellectual Property Office of Vietnam (IP Vietnam)</u></p> <p>Address: 384-386, Nguyen Trai Street, Thanh Xuan District, Ha Noi, Vietnam</p> <p>Tel: (+84)24 3858 3069</p>	http://www.ipvietnam.gov.vn/ http://noip.gov.vn/

ANNEX 2: REFERENCES TO COPYRIGHT AND TRADEMARK LAWS

Country	Relevant link from WIPO Lex
Brunei Darussalam	Trademark Law: https://wipolex.wipo.int/en/legislation/details/482 Copyright Law: The Copyright Order not available on WIPO Lex
Cambodia	Trademark Law: https://wipolex.wipo.int/en/legislation/details/5780 Copyright Law: https://wipolex.wipo.int/en/legislation/details/5782
Indonesia	Copyright Law: https://wipolex.wipo.int/en/legislation/details/15600 Trademark Law: Law No. 20 of 2016 not available on WIPO Lex
Laos	Trademark and Copyright Law covered under IP Law: https://wipolex.wipo.int/en/legislation/details/18024
Malaysia	Trademark Law as amended in 2019: https://wipolex.wipo.int/en/legislation/details/19564 Copyright Law: https://wipolex.wipo.int/en/legislation/details/7603 Copyright amendment: https://wipolex.wipo.int/en/legislation/details/7538
Myanmar	Trademark Law: Trademark Law passed by the Assembly of the Union on January 30, 2019 not available on WIPO Lex Copyright Law: Law No. 15/2019 Not available on WIPO Lex
Philippines	Trademark and Copyright Law covered under IP Law: https://wipolex.wipo.int/en/legislation/details/12953
Singapore	Trademark Law: https://wipolex.wipo.int/en/legislation/details/18797 Copyright Law: https://wipolex.wipo.int/en/legislation/details/18348
Thailand	Trademark Law: [Trademark Act (No. 3) B.E. 2559 (2016)]: https://wipolex.wipo.int/en/legislation/details/17164 Copyright Law: [Copyright Act (No.4), B.E. 2561 (2018)]: https://wipolex.wipo.int/en/legislation/details/18436
Vietnam	Trademark and Copyright Law covered under IP Law: https://wipolex.wipo.int/en/legislation/details/12011