

U.S. Intellectual Property Rights (IPR) Policies & Enforcement

organized by the
Department of Foreign Trade, Ministry of Commerce

Sofitel Central Plaza Hotel
Bangkok, Thailand
18 September 2007

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U.S. INTELLECTUAL PROPERTY RIGHTS (IPR) POLICIES & ENFORCEMENT

Enforcement of IP Rights

PROTECTION AND ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS OVERSEAS

Why protect your trademark overseas?

- to prevent others from using/registering it (third party, distributor, etc.)
- to gain exclusive right to use the mark
- to ensure that you are not infringing anyone else's mark
- presumption of ownership
- renewable
- some distributors request that the mark be registered



Misunderstandings about extent of protection



- registered trademark covers all products
- registered trademark in Thailand is protected worldwide
- trademark is protected once filed
- no need to use the mark once registered

Trademark Registered overseas

Similar Principle

1. Trademarks that cannot be registered
 - Generic
 - Descriptive
2. Product Classifications
 - International system, except Burma
3. The benefit from the registration
 - Presumption of ownership
4. The limitation of right
 - Only in the territory of the country where registered
 - Only with the registered products
5. Period of protection
 - 10 years (renewable)
6. Process of the registration
 - Publication/Advertisement

What should be registered, a word mark or device?

- If using a word, should register as a word.
If using a device, should register as a device.
- register label to protect word mark, device, colors, graphics printed on the package.



Example of mark

word

EQUANT

INTERNATIONAL RESCUE COMMITTEE

LATHEO

IJS GLOBAL

BLUEARC

STAR ALLIANCE

SOLEX

MAE PLOY

CHAOKOH

word mark

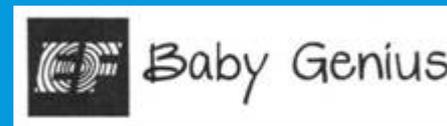
Smiling Fish

dnin

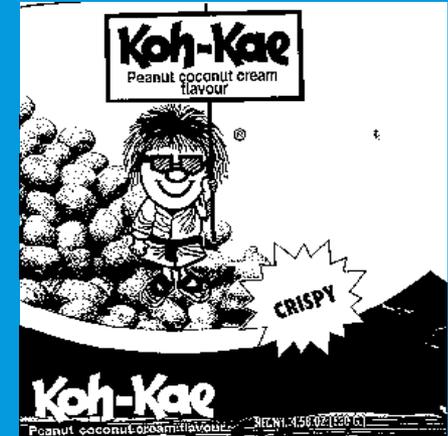
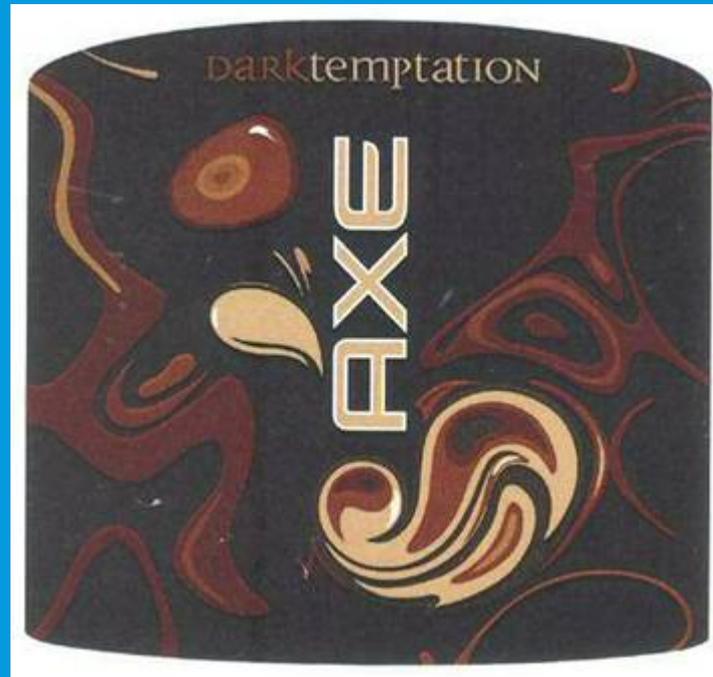
**you
me**

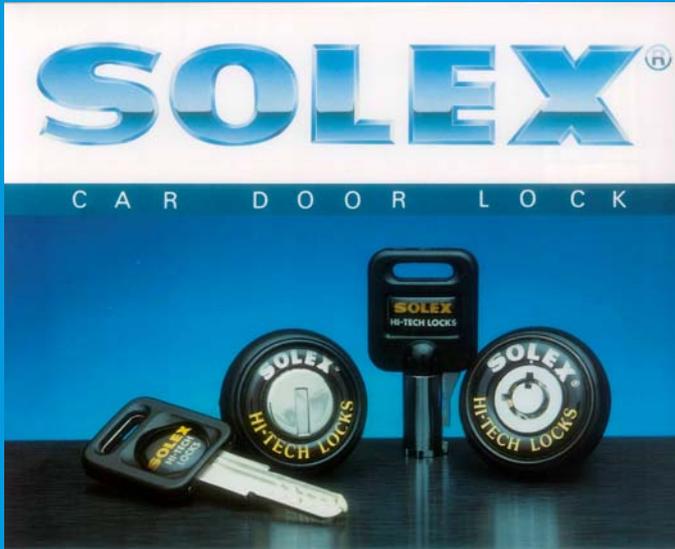
Koh-Kae

Example of device

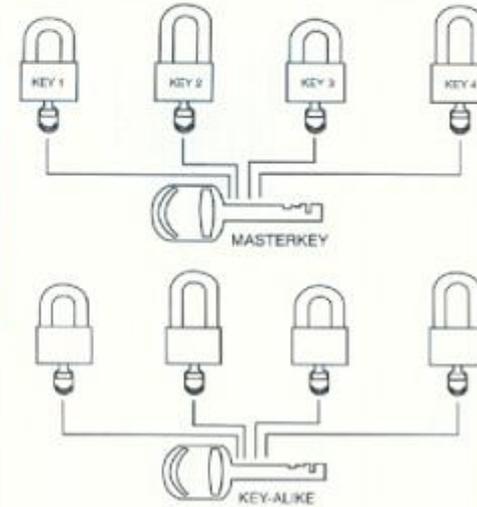


Example of label





Case Study: Solex International (Thailand) Co. Ltd.



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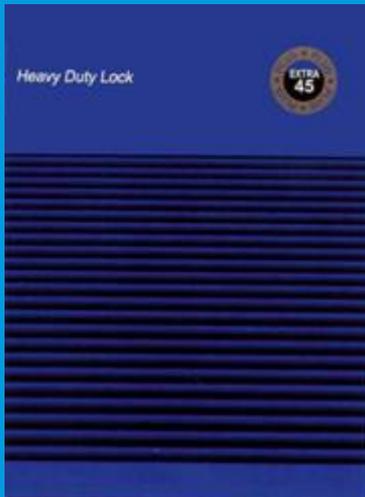
Family owned business

Solex products are designed and manufactured only in Thailand

- some parts may be imported but all products assembled in Thailand
- distributed in over 60 countries; small market in the US
- usually appoints sole distributor in each territory
- will not sell directly to end users



Solex' trademarks



IPRs registered in Thailand

Trademark Registrations

# of marks	Total Applns/ Registrations	Registered	Pending Applications
5	5	5	-

Patent Registrations

	Filed	Granted	Pending
Patents (Invention)	8	3	5
Petty Patents	8	5	3
Design Patent	1	1	-

Trademark Registrations

OVERSEAS

# of marks	Total Applns/ Registrations	Registered	Pending Applications
30	221	183	38

Remark : First Filing Date: 1980

Patent Registrations

OVERSEAS

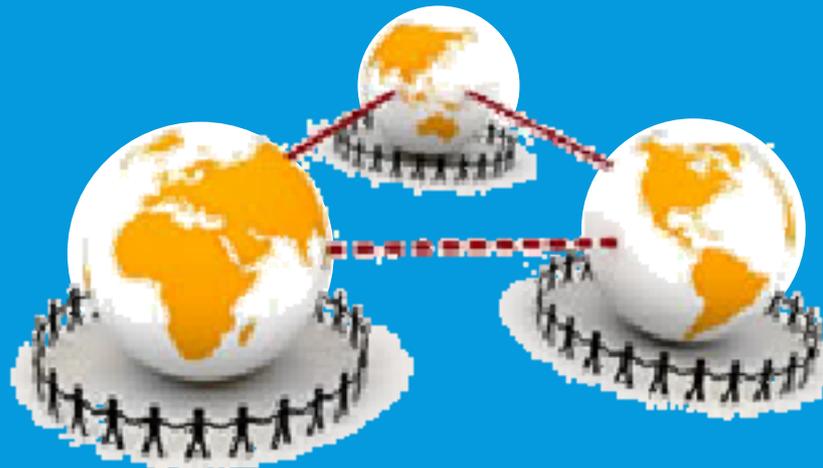
	Filed	Granted	Pending
Invention	36	21	15
Design	12	12	-
Petty patent	9	6	3

Remark : First Filing Date: 1980



All National Applications, Why?

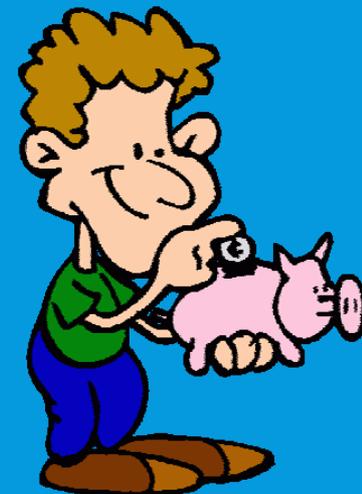
- Thailand not a member of Madrid Agreement
- Thailand not a member of PCT
- Utilize AIPO for filing in French speaking African countries
- Eligible to file for CTM, Benelux and ARIPO



Trademark Registration (Cost savings)

AIPO/OAPI (The African Intellectual Property Organization)

1. Benin
2. Burkina Faso
3. Cameroon
4. Central Africa Republic
5. Chad
6. Republic of Congo
7. Cote d'Ivoire
8. Equatorial Guinea
9. Gabon
10. Guinea
11. Guinea Bissau
12. Mali
13. Mauritania
14. Niger
15. Senegal
16. Togo



Trademark Registration (Cost savings)



CTM (Community Trademark)

1. Austria
2. Belgium
3. Luxembourg
4. The Netherlands
5. Denmark
6. Finland
7. France
8. Germany
9. Greece
10. Ireland
11. Italy
12. Portugal
13. Spain
14. Sweden
15. UK
16. Cyprus
17. Czech Republic
18. Estonia
19. Hungary
20. Latvia
21. Lithuania
22. Malta
23. Poland
24. Slovak Republic
25. Slovenia
26. Bulgaria
27. Romania

Trademark Registration (Cost savings)

Benelux

1. Belgium
2. Luxemburg
3. The Netherlands



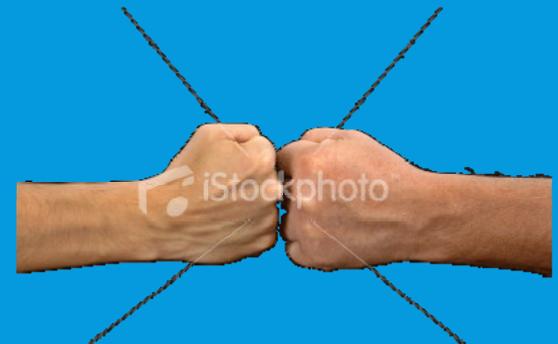
ARIPO (The African Regional Industrial Property Organization)

- | | |
|---------------|------------------------------------|
| 1. Botswana | 9. Sierra Leone |
| 2. The Gambia | 10. Somalia |
| 3. Ghana | 11. Sudan |
| 4. Kenya | 12. Swaziland |
| 5. Lesotho | 13. Uganda |
| 6. Malawi | 14. United Republic
of Tanzania |
| 7. Mozambique | 15. Zambia |
| 8. Namibia | 16. Zimbabwe |

Not all applications were successfully filed at first



- faced rejection to due to identical mark already registered (France - SOLEX for bicycles and parts, locks, etc.) or opposition in some countries
- obtained coverage in most countries for which registration was sought
- offensive filings in some countries (i.e GOLEX)
- continuing to file new applications for new mark, device and labels



Solex' Anti-Counterfeit Actions Overseas

Passive and Active Enforcement

Passive Enforcement

- educate buyers, potential buyers, retailers, etc.
- create public awareness through public relations i.e. publishing advertisements in local newspapers

Active Enforcement

- market monitoring
- warning letters
- investigations
- taking criminal and/or civil action or both



Solex is very pro-active in its enforcement program

- will usually take criminal action if available
- has taken criminal actions in Taiwan, Brazil, Malaysia, China, Philippines, Vietnam, Cambodia, Indonesia, United Arab Emirates, etc.
- will follow up with civil action if target has assets to satisfy judgment, pending civil actions in Malaysia, Philippines, etc.
- will engage in market sweeps for small retailers
- no tolerance policy



Currently, most counterfeiting is taking place in China

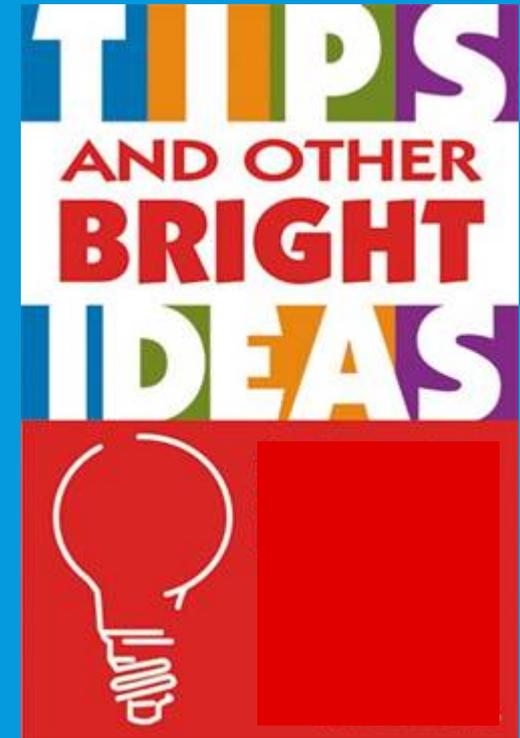
- most budget is spent on China
- customs enforcement in China and along the Thai Border

Actions in Thailand

- currently, no counterfeit problems in Thailand
- most problems are imitations/passing-off (i.e. ROLUX, etc.)
- takes action against all imitations/passing off in Thailand

Tips and Helpful

- register all IP rights in Thailand and overseas (where you intend to do business)
- continuously monitor the markets for counterfeiting activity
- seek trustworthy investigators to work with and, if possible, ask to work on a success fee basis (with flexibility)



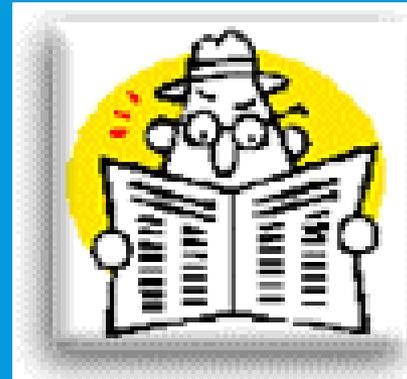
Tips and Helpful Hints (Cont.)

- educate local distributor to look out for and report counterfeiting activity which they see in the market - prepare standard sighting reports for them to complete (no need for them to get directly involved in taking action).
- take immediate action when IPR violation occurs (don't wait until it is widespread or becomes uncontrollable)



Tips and Helpful Hints (Cont.)

- keep in touch with your local legal representative to monitor any changes in the law/business environment that may affect your business either positively or negatively (i.e. USA -Thai FTA)
- publicize successful actions to create greater awareness among the consumers of the counterfeit problems
- engage good local counsel!



Thank you

For further information, please contact

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