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Intellectual property Litigation & enforcement



Enforcing your rights

IP Policy is an integral feature towards realization of a vibrant Economic Community. There has been some regional IP cooperation in the past decade though there is still a disparity in the level of IP protection in each member country. Some countries such as Singapore, Malaysia and Thailand have a far more robust IP legal system than others though Vietnam and Indonesia are fast catching up.

The effectiveness and ease of enforcement of IP rights vary from country to country. The increase in intra-trade flows and free movement of goods present larger practical issues to IP enforcement with the already porous borders between certain ASEAN countries and especially with China.

Border measures have been adopted in most countries in ASEAN to curb influx of counterfeit and pirated goods although the vigilance and involvement of the Customs departments of each country in combatting IP infringement is at relatively low levels. Most do not have IP enforcement high on the priority list of actions, as Customs are mainly tasked with revenue collection for the governments of the day. Still, there has been great push from stakeholders towards a more pro-active Customs to enforce border measures and that has led to Thailand and Vietnam implementing a system of trade mark registration with Customs to facilitate border enforcement. One of the ambitious blueprints of the AEC development is to standardize the practice of Customs across the region and IP enforcement should be included in the agenda of any intended harmonization.

Administrative and criminal enforcement of IP rights are generally available across ASEAN for counterfeit and pirated goods (trade mark and copyright infringement cases involving identical or substantially similar marks and products). It is noteworthy that Thailand has a criminal enforcement route against patent infringement. The other countries in ASEAN have not implemented such a measure. Fines and terms of imprisonment are prescribed in laws though deterrent punishment is not uniformly meted out across member countries.





Civil enforcement of IP rights hinges on the available legal infrastructure of each country. Experience of IP owners with civil enforcement in ASEAN will be varied and mixed. There is no single unified legal system in ASEAN. Historically, countries such as Malaysia, Singapore and Brunei adopt the common law system due to their being former colonies of the British. The rest of the ASEAN countries largely follow the civil law system.

However, the greater push towards knowledge economy has elevated IP protection to a much higher platform than before. To this end, Malaysia and Thailand have established for a number of years now dedicated specialized IP courts to deal with IP disputes and infringement issues whilst Singapore is known for its expedient judicial system in handling IP conflicts. At the other end of the spectrum, litigation in Indonesia is costly and unpredictable whilst in Myanmar, Laos, Cambodia and Vietnam, civil enforcement through the courts is still relatively rare.

The following serves to provide a summary of the available methods of IP enforcement and remedies in ASEAN countries (excluding the Philippines) with focus on counterfeit/pirated goods. Design and patent infringements are enforced predominantly through civil courts and the civil remedies stated are generally applicable to such infringements.












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		 Brunei	 Cambodia	 Indonesia	 Laos
Borders Measures	Is there a system of registration of rights with Customs? If so, is registration mandatory?	No	No	No	No
	Will the Customs act ex-officio?	Yes	No	Yes	No
	Any legal provisions on border measures?	<ul style="list-style-type: none"> Sections 82-93 Laws of Brunei (Chapter 98 – Trade Marks) Sections 109-117 Emergency (Copyright) Order, 1999 	Articles 35-47 of the Law Concerning marks, Trade Names and Acts of Unfair Competition 2002 (Chapter 10)	<ul style="list-style-type: none"> Article 85 of Law No 15 of 2001 (Trademark); Articles 54 – 64 of Law No 17 of 2006 (Custom) Supreme Court Regulation No. 4 of 1992 	Articles 4-13 of the Instruction On Customs Measures For The Protection of Intellectual Property Rights No. 1970/MOF (Section II)
Administrative Actions / Criminal Enforcement	What authorities are tasked with administrative / criminal enforcement?	<ul style="list-style-type: none"> Police Customs 	<ul style="list-style-type: none"> Police Customs Department of Intellectual Property Cambodia Import-Export Inspection and Fraud Repression Directorate-General (CAMCONTROL) 	<ul style="list-style-type: none"> Police Civil Servant Investigator at the IP Directorate General Customs 	<ul style="list-style-type: none"> Customs Department of Intellectual Property
	What are the grounds of complaint?	<ul style="list-style-type: none"> Use of counterfeit trade mark (nearly resembling that trade mark as to be calculated to deceive or falsify any genuine trade mark) Making, selling, distributing, importing pirated copies i.e. copies of works that infringe copyright(non-exhaustive list of infringing acts) 	<ul style="list-style-type: none"> Unauthorised use of a registered trade mark, in relation to goods or services registered Unauthorised reproduction, performance, or communication to the public, by whatever means, of a work in violation of the author's right, as defined by the Law of Copyrights and Related Rights 	<ul style="list-style-type: none"> Unlawful use of an identical or substantially similar mark for the same goods and/or services registered; Making, selling, distributing, importing pirated copies i.e. copies of works that infringe copyright(non-exhaustive list of infringing acts) 	<ul style="list-style-type: none"> Dealing by way of trade in counterfeit goods (identical to the registered trade mark which cannot be distinguished in its essential aspects) Making, selling, distributing, importing pirated copies i.e. copies of works that infringe copyright(non-exhaustive list of infringing acts)
	What are the requirements to lodge a complaint?	<ul style="list-style-type: none"> Police report for criminal investigation to be undertaken Power of Attorney 	<ul style="list-style-type: none"> Copy of registration certificate or declaration of ownership for copyright Power of Attorney Evidence of infringement (investigation report and sample of counterfeit goods) 	<ul style="list-style-type: none"> Complaint letter Power of Attorney Copy of registration certificate or declaration of ownership for copyright 	<ul style="list-style-type: none"> Copy of registration certificate or declaration of ownership for copyright Power of Attorney Evidence of infringement (investigation report and sample of counterfeit goods)
	What actions will be taken by the authorities?	<ul style="list-style-type: none"> Seizure of infringing goods and contrivances used to produce infringing goods 	<ul style="list-style-type: none"> Official warning Seizure of infringing goods and contrivances used to produce infringing goods Arrest of infringers 	<ul style="list-style-type: none"> Seizure of infringing goods. and contrivances used to produce infringing goods Arrest of infringers 	<ul style="list-style-type: none"> Official warning Seizure of infringing goods and contrivances used to produce infringing goods
	What are the penalties?	Fine, term of imprisonment or both	Fine, term of imprisonment or both	Fine, term of imprisonment or both	Fine, term of imprisonment or both

 Malaysia	 Myanmar	 Singapore	 Thailand	 Vietnam
No	No	No	Yes. Mandatory	Yes. Mandatory
Yes	Yes	Yes	Yes	Yes
<ul style="list-style-type: none"> Sections 70C-70P Trade Marks Act 1976 Section 39 Copyright Act 1987 	Section 18 of the Sea Customs Act (Chapter IV)	<ul style="list-style-type: none"> Sections 81-93A Trade Marks (Chapter 332) Division 6 of the Copyright Act (Chapter 63) 	Section 27 of Customs Act B.E. 2469	Articles 73-76 Law on Customs 2014, Articles 216-219 Law on Intellectual Property 2005
<ul style="list-style-type: none"> Ministry of Domestic Trade, Co-operatives and Consumerism Police Customs 	<ul style="list-style-type: none"> Police Customs 	<ul style="list-style-type: none"> Police Customs 	<ul style="list-style-type: none"> Police Customs Department of Special Investigation 	<ul style="list-style-type: none"> Police Customs Scientific and Technological inspectors Information and Communications inspectors Market management offices
<ul style="list-style-type: none"> Dealing by way of trade in counterfeit goods bearing a false trade description (identical to the registered trade mark or pursuant to a Trade Descriptions Order) Making, possessing other than for private and domestic use, selling, distributing, importing pirated copies i.e copies of works that infringe copyright (non-exhaustive list of infringing acts) 	<ul style="list-style-type: none"> Dealing by way of trade in counterfeit goods or unauthorised use of a mark Making, selling, distributing, importing pirated copies i.e copies of works that infringe copyright (non-exhaustive list of infringing acts) 	<ul style="list-style-type: none"> Use of counterfeit trade mark (identical sign made or falsification of a genuine registered trade mark) Making, selling, distributing, importing pirated copies i.e copies of works that infringe copyright (non-exhaustive list of infringing acts) 	<ul style="list-style-type: none"> Dealing by way of trade in counterfeit goods bearing a forged or imitated registered trademark Making, selling, distributing, importing pirated copies i.e copies of works that infringe copyright (non-exhaustive list of infringing acts). 	<ul style="list-style-type: none"> Unauthorised use of a registered trade mark, in relation to goods or services registered Making, selling, distributing, importing pirated copies i.e copies of works that infringe copyright (non-exhaustive list of infringing acts)
<ul style="list-style-type: none"> Complaint letter; Investigation report to support the complaint; Copy of registration certificate or declaration of ownership for copyright; and Letter of authorization/Power of Attorney. 	<ul style="list-style-type: none"> Copy of declaration of ownership of trademark or declaration of ownership for copyright Power of Attorney Evidence of infringement (investigation report and sample of counterfeit goods) Notice to the Director General of Customs to prohibit importation of infringing works 	<ul style="list-style-type: none"> Copy of registration certificate or declaration of ownership for copyright Letter of Authorisation/Power of Attorney In the case of suspected illegal shipment, written notice in the official form together with a statutory declaration that the particulars in the notice are true 	<ul style="list-style-type: none"> Copy of registration certificate or declaration of ownership for copyright Power of Attorney Evidence of infringement (investigation report and a sample of counterfeit goods) 	<ul style="list-style-type: none"> Copy of registration certificate or declaration of ownership for copyright Power of Attorney Evidence of infringement (investigation report and sample of counterfeit goods)
<ul style="list-style-type: none"> Seizure of infringing goods and contrivances used to produce infringing goods Arrest of infringers 	<ul style="list-style-type: none"> Seizure of infringing goods and contrivances used to produce infringing goods Arrest of infringers 	<ul style="list-style-type: none"> Seizure of infringing goods and contrivances used to produce infringing goods Arrest of infringers 	<ul style="list-style-type: none"> Seizure of infringing goods and contrivances used to produce infringing goods Arrest of infringers 	<ul style="list-style-type: none"> Official warning Seizure of infringing goods and contrivances used to produce infringing goods Arrest of infringers.
Fine, term of imprisonment or both	Fine, term of imprisonment or both	Fine, term of imprisonment or both	Fine, term of imprisonment or both	Fine, term of imprisonment or both

IP Litigation & Enforcement

Summary judgment procedure available for clear infringement cases

	 Brunei	 Cambodia	 Indonesia	 Laos	 Malaysia	 Myanmar	 Singapore	 Thailand	 Vietnam
Are Ex-parte and interim injunctions available?	Yes. (High Court)	Yes. (Municipal / Provincial Courts)	Yes. (Commercial Court)	Yes. (District / Provincial Courts)	Yes. (IP High Court)	Yes. Granted by court	Yes. (High Court)	Yes. (IP&IT Court)	Yes. Granted by court
Summary judgment procedure available for clear infringement cases	Yes. For clear-cut cases whereby there is no arguable defence	Yes. For clear-cut cases whereby there is no arguable defence	No	No	Yes. For clear-cut cases whereby there is no arguable defence	No	Yes. For clear-cut cases whereby there is no arguable defence	No	No
How long will a trial generally take?	1 to 2 years	12-18 months	6 to 18 months	At least 4 months	12-18 months	1 year	12-18 months	12-18 months	At least 10 months
Is there any recourse for appeal?	<ul style="list-style-type: none"> • Yes • Appeal from High Court to the Court of Appeal • Appeal from the Court of appeal to the Privy Council (by written consent of parties) 	<ul style="list-style-type: none"> • Yes • Appeal to the Appeal Court and the Supreme Court 	<ul style="list-style-type: none"> • Yes • Appeal to the Supreme Court • Appeal from the Court of Appeal to the Privy Council (by written consent of parties) 	<ul style="list-style-type: none"> • Yes • Appeal to the appeal Court and the Supreme Court 	<ul style="list-style-type: none"> • Yes • Appeal up to the Court of Appeal as of right • Appeal from Court of Appeal to Federal Court (the apex court) requires leave and only on limited grounds 	<ul style="list-style-type: none"> • Yes • Appeal up to the Supreme Court 	<ul style="list-style-type: none"> • Yes • Appeal from High Court to the Court of Appeal. 	<ul style="list-style-type: none"> • Yes • Appeal up to the Supreme Court 	<ul style="list-style-type: none"> • Yes • Appeal to the Supreme People's Court
What are the remedies available to IP owners?	<ul style="list-style-type: none"> • Injunction • Damages • Account of profits • Order for erasure of the offending mark/ destruction of the of the infringing goods • Delivery up of the infringing goods 	<ul style="list-style-type: none"> • Injunction • Delivery up/ destruction of infringing goods • Damages including statutory damages • Order to erase the mark from infringing goods 	<ul style="list-style-type: none"> • Injunction • Delivery up of the infringing goods • Damages 	<ul style="list-style-type: none"> • Injunction • Delivery up/ destruction of infringing goods • Damages including statutory damages • Order to erase the mark from infringing goods • Withdraw of business license 	<ul style="list-style-type: none"> • Injunction • Delivery up/ destruction of infringing goods • Damages • Statutory damages for copyright infringement • Account of profits 	<ul style="list-style-type: none"> • Injunction • Delivery up/ destruction of infringing goods • Damages including statutory damages • Order to erase the mark from the infringing goods 	<ul style="list-style-type: none"> • Injunction • Delivery up/ destruction of infringing goods • Damages including statutory damages • Order to erase the mark from infringing goods 	<ul style="list-style-type: none"> • Injunction • Delivery up/ destruction of infringing goods • Damages including statutory damages • Order to erase the mark from the infringing goods • Public apology 	<ul style="list-style-type: none"> • Injunction • Delivery up/ destruction, distribution or use of infringing goods for non commercial purposes • Damages • Compelling performance of civil obligations • Public apology



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