

## Southeast Asia: Useful Trademark Practices and Peculiarities

- **Singapore – Avoiding citations of marks belonging to the same Applicant**

Every Applicant is assigned a Company Code on the Trademark Register. Should there be a small discrepancy in the name or address of an Applicant, for e.g. there is an additional full stop, or comma or a different spelling in the name of the Applicant, this will result in IPOS assigning a completely new Company Code for the same Applicant. Often we find Trademark Registrars citing trademarks belonging to the same entity against each other due to this discrepancy. Therefore, it is highly recommended that when an application is filed in Singapore, the name and address of the Applicant is exactly the same. If there is more than one Company Code for the same Applicant, the best option is to file a recordal of change in name or address to ensure that all the relevant marks of the same Applicant fall within the one Company Code. For IRs, the recordal should be filed at WIPO.

- **Malaysia – Ex-parte Hearings may yield positive results**

Where the Trademark Examiner refuses to register a trademark based on absolute or relative grounds, and written arguments have been unsuccessful, the Applicant has to option to request for an ex-parte hearing where the hearing officer will be different from the initial Trademark Examiner. The Applicant will be required to file written submissions and supporting case law for purposes of the hearing, and present oral arguments before the officer. In our experience, there is a higher probability of the hearing officer waiving the grounds of refusal as a result of the oral arguments and allowing the application to proceed further.

- **Indonesia – Overcoming citations through non-use cancellation actions**

Should a similar registered trademark be cited in Indonesia, the chances of overcoming the citation objection through written arguments are low and in a lot of cases, the Applicant has to resort to filing a cancellation action against the prior registration which could cost over US\$20,000 and depending on the grounds / evidence available, the chances in such an action may be just as low. Letters of Consent are not acceptable in Indonesia. Therefore, to avoid unnecessary costs, it is highly recommended that trademark searches are conducted in Indonesia prior to filing an application in Indonesia.

- **Thailand – Letters of consent not accepted; disclaimer requests cannot be resisted**



## Did you know...?

Should a similar registered trademark be cited in Thailand, a letter of consent is not accepted. Further, the Trademark Examiner almost always asks for disclaimers which cannot be resisted, and trademarks owned by the same Applicant must be associated.

- **Philippines – Declaration of Use within the 3<sup>rd</sup> year of the application date**

The Applicant has to file a Declaration of Use within 3 years of the application date, regardless of whether the application registers. If the deadline is not met, the application will lapse and there is no possibility of revival. The Applicant will have to re-apply for the mark, losing the earlier filing date.

- **Vietnam – Trademark oppositions**

Trademark applications filed nationally are published in the national Gazette for oppositions but trademarks filed via the Madrid Protocol System designating Vietnam are not published in the national Gazette. Rather, these marks are published in the WIPO Gazette and Applicants looking to oppose IRs filed in Vietnam have to keep watch of the WIPO Gazette.