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- 1 How are industrial designs relevant to your business?
- 2 What are industrial designs and what do you need to know?
- 3 How to protect an industrial design in South-East Asia
- 4 Enforcement
- 5 Case studies
- 6 Take away messages
- 7 Glossary of terms
- 8 Related links and additional information

1. How are industrial designs relevant to your business?

As an European SME doing business in South-East Asia, protecting your intellectual property rights (IPR) in these markets is essential to business success.

An industrial design right, also known as a design patent in certain jurisdictions, is an exclusive right, which protects designs which confer a competitive edge to the owner over his competitors due to their aesthetic appeal. Industrial designs can take the form of either two- or three-dimensional shapes, configuration or patterns. Prominent examples include the iPod, shape of the Coca Cola bottle, computer icons, and even the design of mobile applications.

In order to obtain industrial design protection, the designer or owner must file an application to register the design. Similar to patents, protection for industrial rights lasts for a limited period of time and the duration can vary from country to country. Generally, protection lasts for at least 10 years. Like all IP rights, industrial design rights are territorial in nature and protection is limited to the jurisdiction in which it is registered.

Industrial rights protection can be a valuable asset to businesses. The success of a product or service is usually influenced by its visual appearance, where aesthetic appeal is one of the critical factors influencing consumer decisions. It is important for owners of industrial designs to draw up a protection strategy which coheres with the business strategy for the product or service in question.

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2. What are industrial designs and what do you need to know?

Who grants the registration of the industrial design?	The registration of industrial designs is usually performed by an administrative body under the Government's authority. Typically, registration is performed by the Registry Designs unit within the individual country's IP Office.
What is the duration of the monopoly?	The period of protection differs between the various South-East Asian ("SEA") countries, although it amounts to at least 10 years or sometimes longer.
What type of monopoly is it?	Protection for industrial designs is a legal monopoly.
Who are the stakeholders in the industrial design process?	Government, IP Office, Industrial Design agent, designer, registered designed owner, assignee, licensee, members of the public.
What are the common requirements for industrial design protection to be granted?	1. Novelty 2. Industrially applied onto an article
Is there a global industrial design?	No, there is no global industrial design and the right is territorial in nature. However, there is an "international application" via the Hague System.

As industrial designs are territorial rights, careful consideration must be taken when deciding in which countries to register the designs, such as to maximize commercial exploitation.

An industrial design confers on the owner the right to prevent third parties from making, selling or importing articles bearing or embodying the design or a substantially similar design without the owner's consent when such acts are undertaken for commercial purposes.

Industrial design rights are enforceable in courts, and the remedies and penalties differ between countries.

As industrial designs are territorial rights, careful consideration must be taken when deciding in which countries to register the designs, such as to maximize commercial exploitation. While industrial designs registered in Europe have no legal effect in any of the ten countries in SEA, the use of the Hague System can be considered to seek protection simultaneously in multiple countries by filing a single "international" application in one language and one set of fees. However, it should be noted that in SEA, only Brunei, Cambodia, and Singapore are contracting states in the

Hague System as of November 2017. This means that EU SMEs seeking to protect their Industrial Designs in other SEA jurisdictions would need to apply for domestic registrations and would not be able to obtain such "international registrations" at present.

Businesses that operate in the contracting states to the Hague System can consider the possibility of cost savings and convenience in seeking protection for their industrial designs by filing their application using the Hague System. You can learn more about the Hague System in Section 6 of this guide.

Industrial rights protection could be particularly relevant in certain industries with fast moving product cycles and/or large variation in design production, especially if designs may become quickly obsolete. In relation to South-East Asia, it should be noted that industrial rights protection can be subverted by slight amendments to competing designs, and in some cases it might not be cost-effective to implement effective enforcement, in the light of the owners' need to show evidence of the designs' creation and their entitlement to rights over the same.

Design patents

In certain countries in South-East Asia, like for instance Vietnam, industrial designs are termed "design patents" and are protected as such. Regardless of whether the design is protected under the term "industrial designs" or "design patents", IP protection is similarly directed towards the prevention of unauthorized copying of the design's visual and aesthetic appearance.



3. How to protect an industrial design in South-East Asia

I. Getting protection for your industrial design and IP strategies

Generally, in order to register a design, it must meet the following requirements:

- 1) It must be **novel**; and
- 2) It must be **applied industrially**.

a) Type of Examinations conducted by the various IP Offices

It should be noted that most IP Offices in SEA do not conduct substantive examinations to determine whether the proposed industrial design fully meets the above stated requirements, i.e. only the formal requirements such as the provision of stipulated documents will be examined and therefore examination is limited to formal requirements only.

It is therefore recommended that EU SMEs should monitor designs registrations to be able to present timely oppositions if they believe that these may infringe upon their own rights.

b) Getting protected

The designer is considered as the owner of the industrial design and is entitled to apply for protection. This arrangement can be varied in several instances, e.g. a commissioning party is the owner unless otherwise agreed or the employer is the owner if the design was developed by the employee in the course of employment. It is recommended that EU SMEs consult local attorneys on issues of entitlement to the design pursuant to the applicable national laws as this is a key legal issue to be addressed in the beginning.

Once a design is created, it must not be disclosed in order to preserve the novelty, since failing to do so, would expose EU SMEs to the risk that their design may then be considered as non-novel and incapable of registration. If disclosure is necessary for business operations, it is recommended that you enter into a Non-Disclosure Agreement (NDA) or an undertaking of confidentiality, which could preserve the novelty of your design. For instance, under Singapore law, disclosures of the design in breach of confidence will not destroy the novelty of the design. EU SMEs should consult local attorneys on the available mechanisms under the applicable laws to preserve novelty of the design if disclosure is unavoidable.



c) IP strategies for your business

Industrial design rights confer exclusive rights on the owner to the commercial production, marketing and sale of his products. As industrial design rights are property rights, they can be assigned or licensed as appropriate to achieve better commercialisation of the design.

Furthermore, your IP strategy should not be limited to sole reliance on industrial design rights as a legal monopoly. As most SEA countries do not conduct substantive examinations, the rights granted by a registered design might be relatively uncertain. If you seek to enforce your exclusive rights in the industrial design against another party, the other party will most likely challenge enforcement on the ground that the design does not satisfy the substantive requirements, for instance on the ground that the design is not novel.

Additionally, the interaction between industrial design rights and other IP rights such as copyright should be carefully considered. In some instances, designs which qualify for protection are also material where copyright subsists.

In Singapore for example, where there is an overlap with copyright protection, there is no cumulative protection under registered design and copyright law, protection is available under registered designs only. Therefore, if the artistic work is a registrable design, you should take steps to apply to register the design, or there will be no protection for the design.

Concurrent protection under trade mark law is also a possibility as far as the protection of the shape and/or color is concerned. Those are considered unconventional trade marks and can be protectable in the majority of jurisdictions of South-East Asia, excluding Myanmar. If the industrial design is sufficiently distinctive of the proprietor's products or services, it may be possible for him/her to also apply for a trade mark depending on the individual SEA countries' laws. Unlike patents, copyright and industrial design rights, the duration of trade mark rights can be indefinite with sustained use as it is valid for 10 years and always renewable. EU SMEs shall consider adding layered protection when possible to strengthen their IP strategy.

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II. Industrial Designs Application Process

The procedure and process for an industrial design application differs between the ten SEA countries.

The costs of obtaining an industrial design in the various SEA countries can differ quite significantly, with the possibility of added translation costs for those countries that only accept registrations in local languages. As English is not the working language of the agents in all the SEA countries, it is recommended that you make prior enquiries with the local agents to determine if their working language is English.

Below is a checklist of the documents which may be required for registration. Each country may require a slightly different list of documents upon their discretion.

a) Researches

It is important to conduct searches for existing industrial designs to ensure the novelty of a proposed design to be registered and / or to avoid any potential infringement. It is crucial for businesses to be certain whether they have freedom to undertake particular activities without fear of infringement or whether a certain proposed design was still novel such as to be registrable before incurring substantial investment costs. Due diligence researches can also be focused with a view to acquire third party industrial designs rights to enhance your IP portfolio.

ASEAN Designview is the common online industrial design information platform of the ASEAN Member States aimed at making ASEAN industrial design data widely available and easily accessible to all interested stakeholders. ASEAN Designview offers free of charge online access to information on industrial design registrations and published industrial design applications in the participating ASEAN countries.

ASEAN Designview is an online tool to consult on publicly available data on industrial design. It does not constitute an official industrial design register and is of purely informative nature.

ASEAN Designview was developed by the Intellectual Property Offices of the ASEAN Member States with the support of the EU-ASEAN Project on the Protection of Intellectual Property Rights (ECAP III Phase II), an EU-funded programme, implemented by the European Union Intellectual Property Office (EUIPO).

For more information about ASEAN Designview, please refer to our [How to Guide on ASEAN Designview](#).

b) Checklist

Items/documents required for registration	Checklist
Application Form	✓
Application Fee	✓
English translation	✓
Power of Attorney / Form to appoint a local agent (if not domicile or real business operations in the country)	✓
Priority right claim (if any)	✓
Statement of novelty / Description of design	✓
Representations of the design	✓
Representation applied to each article in a set (if any)	✓



It is recommended that EU SMEs consult with local lawyers located in the country of their interest to double check the latest official list of documents required by the relevant IPO.

c) What makes up an industrial design?

It is generally a requirement for applicants to provide a representation of the design as part of the registration formalities. Some countries might require a physical sample of the article embodying the industrial design, where the design is two-dimensional (e.g Cambodia and the Philippines).

Depending on the country, applicants may be required to give details on the articles which the design is to be applied or provide a clear description of what the design claims a monopoly over (e.g Thailand).

d) Goods and services classification

For ease of reference, applicants are required to classify the article to which the design is applied. The Locarno Classification, established by the Locarno Agreement (1968), is administered by WIPO and is an international classification system for industrial designs. There are 32 classes such as “Tools and Hardware” and “Musical Instruments”, which are further divided into sub-classes.

e) Priority Right

Under the Paris Convention, an applicant who has filed an earlier corresponding design application in a Paris Convention country or a WTO member country can claim priority from the first-filed application, provided that the subsequent application is made within six (6) months of the date of the first filing.

f) Who can register?

SEA Country	Who can register?
Brunei	The owner of the design is entitled to register it, which could be the designer, commissioning party, or employer depending on the circumstances. Any other party may register the industrial design if they hold rights over it (e.g assignment).
Cambodia	The owner of the design is entitled to register it, which could be the designer or employer depending on the circumstances. Any other party may register the industrial design if they hold rights over it (e.g assignment).
Indonesia	The owner of the design is entitled to register it, which could be the designer, commissioning party, or employer depending on the circumstances. If filed by a person other than the designer, a statement providing details of the designer must be provided.
Laos	The owner of the design is entitled to register it, which could be the designer or employer depending on the circumstances. Any other party may register the industrial design if they hold rights over it (e.g assignment).
Malaysia	The designer, commissioning party (unless otherwise agreed by contract), and employer where the design was created by the employee in the course of employment are entitled to apply for registration. ¹ Any other party may register the industrial design if they hold rights over it (e.g assignment).
Myanmar	There is presently no functioning system of protection for industrial designs. However, the draft legislation for industrial designs was published in 2015 and is awaiting deliberation in Parliament.
The Philippines	The designer, commissioning party (unless otherwise agreed by contract), and employer where the design was created by the employee in the course of employment are entitled to apply for registration. Any other party may register the industrial design if they hold rights over it (e.g assignment).
Singapore	The designer, commissioning party (unless otherwise agreed by contract), and employer where the design was created by the employee in the course of employment are entitled to apply for registration. Whilst there are no restrictions as to nationality or residency, a Singapore address for service must be provided, to which all correspondences will be sent.
Thailand	The designer and employer where the design was created by the employee in the course of employment are entitled to apply for registration.
Vietnam	The designer and employer where the design was created by the employee in the course of employment are entitled to apply for registration.

g) Industrial designs examination

As IP Offices in most SEA countries generally only conduct a formal examination of the industrial design application, which pertains to whether the necessary documentation and details are provided, a substantive examination of the registrability requirements, such as novelty and industrial application, is not undertaken. Consequently, it is often faster for industrial designs to be registered when compared to other IP applications such as patents or trade marks, barring any deficiencies in the required documents.



h) Term of protection for industrial designs

Generally, registration of the industrial design will grant protection to the applicant for an initial period, e.g 5 years, which can be further extended. For an outline of the period of protection extended to industrial rights in each SEA country, please refer to the table below:

SEA Country	Period of Protection
Brunei	Initial period of 5 years, and extendable for 2 periods of 5 years each, up to a maximum of 15 years from the filing date.
Cambodia	Initial period of 5 years, and extendable for 2 periods of 5 years each, up to a maximum of 15 years from the filing date.
Indonesia	10 years from filing date.
Laos	Initial period of 5 years, and extendable for 2 periods of 5 years each, up to a maximum of 15 years from the filing date.
Malaysia	Initial period of 5 years, and extendable for 4 periods of 5 years each, up to a maximum of 25 years from the filing date.
Myanmar	As of November 2017, there is presently no functioning system of protection for industrial designs. However, the draft legislation for industrial designs was published in 2015 and is awaiting deliberation in Parliament.
The Philippines	Initial period of 5 years, and extendable for 2 periods of 5 years each, up to a maximum of 15 years from the filing date.
Singapore	Initial period of 5 years, and extendable for 2 periods of 5 years each, up to a maximum of 15 years from the filing date.
Thailand	10 years from filing date.
Vietnam	Initial period of 5 years, and extendable for 2 periods of 5 years each, up to a maximum of 15 years from the filing date.

III. Applications in multiple countries via the Hague System

While only Brunei, Cambodia and Singapore are contracting states in the Hague System as of June 2017 in the SEA Region, you may still consider the use of the Hague System to make applications in signatory countries of interest including various EU countries. Moreover, it is expected that a few other SEA countries might join the Hague System in the near future although a specific timeline for this is not officially stated.

Instead of filing individual national applications, you would have the convenience and cost-savings of filing one single “international” application, in one language and one set of fees in one currency (charged in Swiss Francs).

Here below a summary of practical aspects of the international registrations using the Hague System.

a) Advantages of the Hague System

- Cost-savings on filing only one application, and paying one set of fees to one office, and in one language.
- Changes to the application, such as address and renewal of the term, can be made via one application to the International Bureau of the World Intellectual Property Organisation (WIPO).
- Administrative convenience in not needing to monitor the progress of individual applications proceeding throughout the countries of interest.

b) Disadvantages of the Hague System

- The local rules and legal formalities requirements in the designated countries still apply. Potential for increased preparation costs as you might have to submit an application that adapt to the formalities of each country.
- There are relatively few participating SEA countries.

If you do not intend to register your industrial design in many countries, it may be more cost-effective to make individual national applications.



4. Enforcement

The owner of a registered industrial design is conferred the right to exclude others from using or applying the design for commercial purposes. Depending on the specific legislation in the different SEA countries, other parties such as exclusive licensees can be granted the right to enforce this legal monopoly against third parties. For instance, an exclusive licensee can commence legal proceedings against unauthorized parties dealing with the design without needing the sanction of the registered owner.

There are several approaches to dealing with infringement of an industrial design right. In general, a cease and desist letter (C&D) can be issued as a show of force to the infringer to demand a halt to the infringing activity. A C&D letter can also have the additional effect of giving due notice to the infringer, which can have a material effect on the extent of damages awarded if the matter proceeded to litigation. If a C&D letter does not have the desired effect on the infringer, more robust courses of action may have to be taken such as offering a license to the industrial design rights on one extreme and litigation on the other extreme.

It should be noted that in some countries like Singapore, Malaysia and Vietnam, an infringer who has no knowledge or had no reasonable ground for believing that the design was registered, will not be liable for damages.

In certain countries like Vietnam and Thailand, administrative actions are also possible cost-effective and time-efficient options although they tend to be limited in effectiveness due to the relative inexperience of administrative bodies in dealing with more specialized areas such as industrial designs.

It should be noted that in some countries like Singapore, Malaysia and Vietnam, an infringer who has no knowledge or had no reasonable ground for believing that the design was registered, will not be liable for damages. An owner should consider applying the words "registered" or of similar meaning coupled with the registration number of the design to prevent infringers escaping from the payment of damages.

When a civil action is brought in front of the court, if an owner of a registered industrial design is successful in his legal claim against the infringer, he/she is usually entitled to the following remedies:

- An injunction against the infringer restraining him from committing the infringing acts;
- Damages or an account of profits;
- Delivery up of infringing articles or tools used to make said infringing articles.

Depending on the SEA country in question, the infringer may also face criminal penalties along with civil liability. For instance, in Singapore and Malaysia, it is not a criminal offence to infringe a registered industrial design although there are criminal penalties for falsely representing a design to be registered when it is not. In other countries like Vietnam, criminal sanctions can be imposed where there has been organized or recalcitrant infringement, or serious prejudice has been suffered by the IPR holder. In Singapore, they can be counter-sued by the infringer for making threats of infringement, if they are unable to show infringement of the design or the design is found to be invalid.

5. SME Case Studies

Case study 1: Infringement of electrical meter box designs in Singapore²

Background

Companies 'C1' and 'C2' were the registered proprietor and exclusive distributor of an industrial design relating to an electrical meter box called "AMB box" respectively. Company 'M' was the manufacturer and supplier of electrical meter boxes and was alleged to have infringed the AMB box design.

Action taken

During a civil lawsuit for design infringement brought by C1 and C2, in its defense Company M argued that (1) the registered industrial design was invalid; (2) that it had no knowledge or reasonable belief that the design was registered; and (3) only Company C2 was the proper owner of the registered design and thus Companies C1 and C2 were not entitled to any joint legal claim.

Outcome

The court of Singapore found that the registered design was indeed valid, and that C1 and C2 were legally entitled to sue Company M according to the Singapore law. However, as Company M was able to prove lack of knowledge and intention to infringe a registered design and therefore was found not liable for damages during the period of infringement where it had no knowledge or reasonable belief that the design was registered.

Lessons Learnt

- Owners of registered industrial designs may run the risk of having their design revoked by defendants who counterclaim for invalidity.
- It is important to be clear on the relevant party's entitlement to the industrial design, whose corresponding legal right to sue can be challenged in legal proceedings.
- It is best to place potential infringers on notice with notifications that the design is protected, such as to avoid infringers escaping liability for damages.

² Hunter Manufacturing Pte Ltd and another v Soundtex Switchgear & Engineering Pte Ltd and another appeal [1999] 3SLR(R) 1108, SGCA.

Case study 2: Manufacturers of electrical isolators in Singapore³

Background

Company P and D were two independent manufacturers of electrical isolators in Singapore. Company P alleged that Company D's model of its electrical isolator which had an attached right-angled jack plug infringed its registered industrial design for electrical isolators.

Action taken

Company P filed a lawsuit against Company D before the Singapore Civil court. Company D argued that (1) the registered industrial design was invalid; and (2) there was no infringement by its product.

Outcome

The court found that the registered industrial design was invalid because it had been disclosed prior to its application date and was thus non-novel. Further, the design fell into certain categories of design which could not be registered. Under Singapore law, if a design is solely functional in nature (e.g. dictated by industry standards) or its features served the purpose of accommodating and enabling other articles to perform their function (e.g. shape or dimensions of the design planned to be compatible with other articles). Lastly, the difference in orientation of the jack plug in Company D's electrical isolator rendered it substantially different from the registered design such that there was no infringement.

Lessons Learnt

- Owners of registered industrial designs should be reminded that as there is no substantive examination of the design's registrability, there can be increased uncertainty as to whether the design can survive an attack on validity.
- Owners must ensure that the industrial design does not fall within any of the exceptions to registrability as provided under the applicable law.
- Articles must be identical or substantially similar to the registered industrial design before infringement will be found.



6. Take away messages

- IP rights are territorial and industrial designs must be registered in each country that you have a business interest in.
- Protect valuable assets in an appropriate way. Some IP may be better managed as copyright or trade marks as opposed to registered industrial designs.
- Consider the best way to make use of your IP. If you are unable to fully commercialise it through your own efforts, licensing of industrial design rights could be a viable option.
- IP audit should be performed on a regular basis. As with other aspects of a business strategy, your IP can evolve over time.

7. Glossary of terms

- **Article** - This refers to an object to which the design has been applied.
- **Counterclaim of invalidity** - This refers to the alleged infringer bringing a counter-action against the owner of the industrial design right in an infringement suit to invalidate the registration of the industrial design.
- **Due Diligence** - A research and search exercise conducted to gather all material relevant relating to the viability of the registration of the proposed industrial design, and any conflicting third party rights which may be of concern to a business' commercial activities.
- **Formalities Examination** - This refers to the examination conducted by IP Offices to ensure that the formal requirements for the registration of an industrial design are met, such as the required documents and representation of the design.
- **Hague System** - The Hague System for the International Registration of Industrial Designs provides a practical

³ *Nagasima Electronic Engineering Pte Ltd v APH Trading Pte Ltd* [2005] 2 SLR(R) 641, SGHC.



business solution for registering up to 100 designs in over 66 territories through filing one single international application.

- **Industrial application** - The design must be applied to an article by an industrial process. For instance, in Singapore, a design is industrially applied if it has been reproduced more than 50 times.
- **Novelty** - The design must be new and not registered in any prior application or disclosed anywhere in the world.
- **Priority Date** - Refers to an earlier date which the applicant may claim in one country as the date of application for a prior registration in another country, where both countries are signatories to the Paris Convention or WTO countries and the subsequent application is made within 6 months of the earlier filing.
- **Representation of the Design** - This refers to the drawing, photograph or other graphic of the industrial design.

8. Related links and additional information

Helpdesk resources

- [Helpdesk Guides](#)
- [Helpdesk Case Studies](#)
- [Helpdesk Infographics](#)
- [Helpdesk IP Country Factsheets](#)
- [Helpdesk Blog Your IP Insider](#)

External resources

- [Paris Convention for the Protection of Industrial Property](#)
- [Locarno Classification](#)
- [Hague Agreement](#)
- [World Intellectual Property Organization \(WIPO\)](#)
- [ASEAN IP Portal](#)

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The South-East Asia IPR SME Helpdesk provides free, business-focused advice relating to South-East Asia IPR to European Small and Medium Enterprises (SMEs).

Helpdesk Enquiry Service: Submit further questions to the Helpdesk via phone or email (question@southeastasia-iprhelpdesk.eu), or visit us in person and receive free and confidential first-line advice within three working days from a South-East Asia IP expert.

Training: The Helpdesk arranges trainings on South-East Asia IPR protection and enforcement across Europe and South-East Asia, tailored to the needs of SMEs.

Materials: Helpdesk business-focused guides and training materials on South-East Asia IPR issues are all downloadable from the online portal.

Online Services: Our multilingual online portal (www.ipr-hub.eu) provides easy access to Helpdesk guides, case studies, E-learning modules, event information and webinars.

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