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How to Use Customs to Protect your IP in China and South-East Asia

China & South-East Asia IPR SME Helpdesk

Philippe Girard-Foley
China and South-East Asia IPR SME
Helpdesk External Expert

Date: 20 February 2017

Welcome to the Webinar!



Helika Jurgenson
Project Officer

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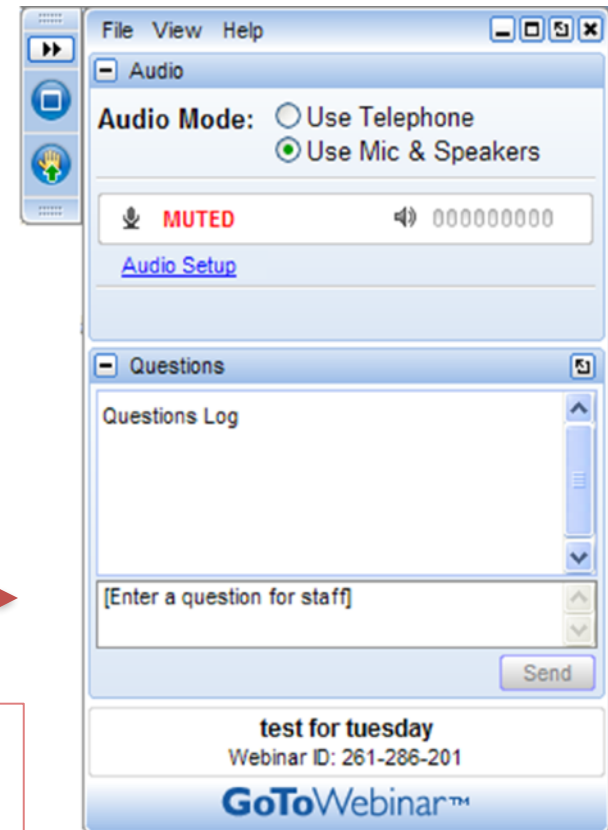
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Speaker's Bios

Name: Mr. Philippe Girard-Foley
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Over a continuous presence of more than 25 years, Philippe Girard-Foley has helped many European companies protect and defend their IP rights and establish a successful business in Asia, through direct investment, partnership, distributorship, agency, franchising or otherwise. He is a regular speaker at events focusing on ASEAN matters, and has authored several publications on ASEAN IP laws.

Philippe Girard-Foley has received both a civil law and common law education (Paris Sorbonne, Paris Institute of Political Sciences, University of Pennsylvania Law School, CIArb London) and is a member of the Paris Bar from France as well as an associate member of the Victoria Law Institute from Australia. Philippe joined the Helpdesk network in 2011.

Agenda

- Introduction to the central issue: “ex officio” or not “ex officio” powers for Customs officers
- A prerequisite: recording IPR’s with Customs
- Countries in Asia where recording is allowed and encouraged: China and Vietnam



The Central Issue: “ex officio” or not “ex officio”

1. A simplistic yet useful classification

- an ideal world: mandatory ex officio powers for Customs officers
- an intermediate world: discretionary ex officio powers
- a difficult world (for IPR’s owners): no ex officio powers



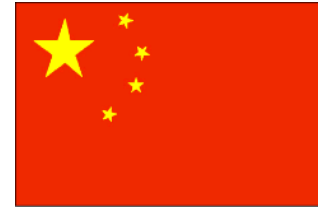
2. What ex officio powers means for Customs officers and for IPR’s owners?

3. Opportunities and challenges of each system

Ex Officio and Recordal

1. Ex officio powers go hand in hand with IPR Customs recordals: not one without the other
2. What is the meaning of Customs record. Difference with recording with other agencies
3. A line of divide in Asia: “recordal countries” i.e. China and Vietnam and “non recordal countries” i.e. the rest of Asia





China: “best in class”

1. How the system has been designed

- Customs Law of the People’s Republic of China
- Regulations on Customs Protection of IP Rights

2. How to use it as an IPR owner

- Recordal with GACC General Administration of Customs of PRC (paper/paperless)
- Ex officio action
- Detention Pursuant to an Application

3. Case studies with Ningbo Customs





Vietnam: a less convincing scenario

- Legal basis for customs recordal
- Administrative requirements
- Scope and limitations of the protection
- Monitoring of suspected goods
- Suspension of clearance



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Thailand

1. Recordal

- Application with the Thai Department of Intellectual Property (for forwarding to Customs); or
- Direct recordal with Customs « Customs Watch List »
- Includes trademarks and copyright but not designs and patents

2. Benefits of recordal

- Customs better equipped to separate counterfeit goods from genuine
- Possible application to request:
 - inspection of a particular shipment
 - detention of suspected infringing goods (confirmation within 24 hours)

“Non Recordal Countries”: the problematics

Problematics of a non recordal/non ex officio context

1. Identification procedures

- Lack of knowledge of Customs officers to distinguish counterfeits from genuine goods
- Not full briefing on IP protections
- Difficulties in contacting the IPR owner
- Not all containers screened

2. Border measure provisions

- Legal grounds for retention / suspension of release
- Even when “ad hoc” ex officio have powers, issues remain with information to be provided to Customs



Malaysia as an Example

- 1. Why Malaysia is a good example**
- 2. The legal framework including but beyond customs regulations:**

- Customs Act 1967
- Trade Descriptions Act 2011
- Trade Marks Act 1976
- Copyright Act 1987
- Whistleblower Protection Act 2010



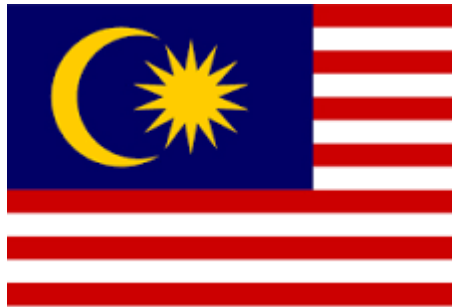
Malaysia (Continued)

1. How to assist Customs for the protection of one's IPR's - lessons to learn in relation to all "non recordal countries"
2. Failing a Customs recordal, a general one: the Basket of Brands registration with the Ministry of Domestic Trade.
3. Case study: the Philip Morris case



Hope for the (not so Distant) Future

- The EU -Malaysia FTA on-going FTA negotiation
- The chapter on border control infringements: a benchmark and an inspiration between the EU and other South-Asian countries?



Take-away Messages



- **Cooperation with Customs does not just mean relying on “textbook” but using one's own initiative and common sense**
 - Where there are loopholes in the legislation, fill them!
 - Do not just record IPR's (when possible) familiarise Customs with the overall appearance of your products.
 - Update! If you don't let Customs know about the new versions of your products they will regard them as counterfeit.
 - Establish and “feed” a personal contact with Customs officers.
 - Have and show respect for their workload and time pressure.
- **Have your own procedures in place to deal with Customs swiftly and efficiently**
 - Customs should not have to think as to how to alert you of a suspicious shipment. Make their task easier.
 - You have to be ready to reply by return and to dispatch someone with sufficient knowledge of the product to conduct a preliminary examination.

Take-away Messages (Continued)



- **Beware of deadlines**

- Specified period from the start of detention to confirm that the goods are counterfeit (e.g. Thailand 24 hours)
- Specified period to commence legal action against the infringer (e.g. Malaysia case by case decision of Royal Malaysian Customs)
- Statutory period to obtain a Court order (e.g. Malaysia 30 days from commencement)



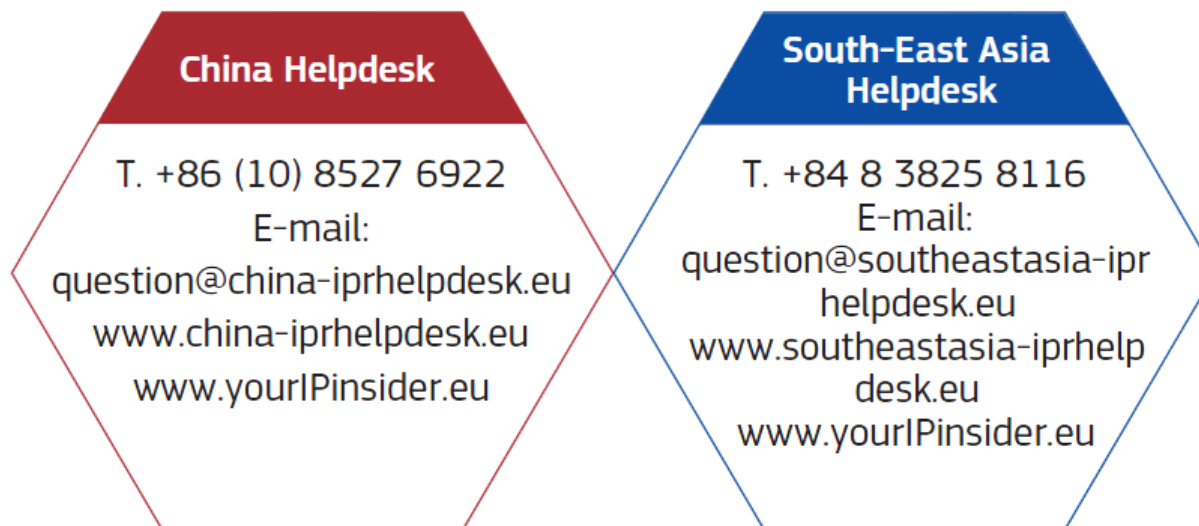
Q&A

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To learn about any aspect of intellectual property rights in Vietnam or elsewhere in South East Asia, including

✓Local partners

✓Due diligence

✓IP audits

✓Or to simply learn about the local landscape and adapt your IP plan accordingly - something which can save you EUR in the long term