

SOUTH-EAST ASIA
IP SME HELPDESK

CHINA
IP SME HELPDESK

LATIN AMERICA
IP SME HELPDESK

INDIA
IP SME HELPDESK

Protecting your IP at Trade Fairs

1. **Introduction**
2. **Preparing for the trade fair**
 - Are your rights registered?
 - Does the trade fair have an IP office?
 - Preparing certification of ownership documents
 - For Patents & Designs
 - For Trade marks
 - For Copyrights
3. **Attending the trade fair**
 - How much of my IP should I disclose?
Potential Loss of Novelty
 - In case of an infringement: Gathering Enforcement Evidence
 - The first step in order to enforce your IPRs is to have them legally registered and being the owner
 - Types of notarisation at trade fairs
4. **Taking actions against an infringer**
 - Enforcement options and possible actions during trade fairs
 - Evidence and burden of proof
 - Proceedings
5. **Case Studies and Take Away Messages**
6. **Glossary of Terms**
7. **Contact Us**

Note to the reader: The China, India, Latin America and South-East Asia IP SME Helpdesks are three projects launched by the European Innovation Council and SME Executive Agency (EISMEA) in order to assist SMEs in protecting their Intellectual Property (IP) when doing business in or with China, India, Latin America and South-East Asia. During the past years of their operation, the Helpdesks have supported SMEs in their internationalisation efforts, by providing information about how to protect, manage and enforce their Intellectual Property Rights (IPR) while attending trade fairs. This publication aims to provide SMEs with a checklist and the tools needed (to protect their IPR) before attending a trade fair. The information in this handbook is non-exhaustive, but aims to clarify the basics. For further details, you may download our guides from the ec.europa.eu/ip-helpdesk website, contact the enquiry helplines or seek advice from legal professionals.

1. INTRODUCTION

This guide provides an overview of Intellectual Property (IP) protection strategy for EU SMEs specifically on how to be ready before, during and after a trade fair or exhibition in China, South-East Asia, India and Latin-America.

Trade fairs provide IP owners with the opportunity to present their innovations and ideas to potential business partners and customers. In addition, participation in exhibitions and trade fairs allows them to learn from and collaborate with other innovators. With the advent of increasingly integrated global-value chains and the continuous drive to innovate, trade fairs have become one of the most important and most efficient instruments for accessing new markets worldwide.

From a prevention point of view, although attending a trade fair or exhibition can reap substantial benefits, SMEs should be aware of the possible IP risks that are implied. There is for example the risk that by disclosing your innovations to the public you are exposing yourself to third parties copying and infringing your IP. When talking about 'infringement' in this guide, it is important to note that we do not solely refer to mere counterfeiting of a product or un-authorized usage of a brand. Competitors could be using, intentionally or otherwise, a certain part

of your product or innovation. When internationalising your business, it is therefore of crucial importance to be as diligent as possible and to know your competitor's products almost as well as your own. Anticipating how new trends and development in your industry and other industries could potentially make use of your innovation is also very important.



IP Expert Eli Salis presenting the technical session on IPR protection during the BBB event at Genera (February 2017)

A practical and realistic approach must be taken when preparing for (and whilst attending) trade fairs. This guide will put forward a number of steps IP owners can take before, during, and after the trade fair to enhance IP protection, which will assist SMEs in making a balanced and considered decision about how to exhibit their products or services.

IPR protection has been a key topic during the technical sessions of internationalisation events such as the European Commission (EC)-funded initiative Business Beyond Borders (BBB). Seeking to help European SMEs to expand their business abroad and find new international partners, the BBB initiative organises matchmaking events in renowned trade fairs around the world.

Considering the inclusive and comprehensive nature of the BBB initiative – which organises matchmaking events for companies and clusters from several key EU industries –, the technical sessions provide guidance to companies on challenges and opportunities faced as they undergo internationalisation.

Specific workshops on IPR have been part of the BBB events agenda in trade fairs such as GENERA (energy and environment, Madrid), Texworld Paris (textile, clothing and apparel, Paris) and FIDAE (aerospace, defence and security exhibition, Chile).

IPR protection continues to be a key topic during the technical sessions of internationalisation events organised in the framework of the Enterprise Europe Network (EEN) and other EU COSME and Horizon Europe programmes.

During these Trade Fairs, and other trade fairs where the International Helpdesks are represented, SMEs have the opportunity to ask questions to the experts regarding negotiations with local counterparts.



IP Expert Alessandra Chies presenting the technical session on IPR protection during the BBB event at Texworld Paris (September 2017)

2. PREPARING FOR THE TRADE FAIR

Determine and start your strategy well in advance of the trade fair. In addition to preparing products for the trade fair, it is recommended that you also prepare your IP strategy with an experienced lawyer and, when needed, a local notary public, both of whom are familiar with working at trade fairs. A good understanding of the market and geographic origin of the competitors is crucial. It is advisable to protect your IP in your own local jurisdiction and also in those markets where you are trading, manufacturing or exhibiting. For example, if you are attending a trade fair in Latin America and know in advance that there will be visitors coming from China and Singapore, it would be important to explore protecting your IP in all three (3) markets. You should also consider the time needed to register your IP in the various countries of interest (especially for trade marks or patents), and be aware that registration time and costs differ in various jurisdictions. It is therefore important to have this information in advance for a proper preparation. Information regarding these registrations and their regional requirements are covered in the following sections.

In addition to the above-mentioned, there are a few key questions and considerations each SME should bear in mind:

Are your rights registered?

Identify your key IP assets (trade marks, patents, industrial designs) and register them in the respective country as soon as possible. The basic rule is that unless the right in question is registered in a specific country, it will not be enforceable there. It is recommended for SMEs to incorporate an IP protocol into their normal business operations. This allows for regular innovation and products check-ups to analyse whether and where to file for the protection of your IP. When preparing the materials for the exhibition or trade fair, it is wise to notify the visitors to your stand, where appropriate, regarding IP ownership. This can be done using the following symbols and phrases.

©	This shall be combined with the year of creation or publication and name of the author to assert copyright ownership in works such as brochures, websites, software, pictures, music, etc.
TM	If you have applied for a trade mark but it is not yet registered or even if you have not applied but are using the trade mark, the TM abbreviation can be used to assert your trade mark.
®	This symbol can only be used for registered trade marks. It can be a criminal offence to use this symbol if the trade mark is not registered (prosecutions are however very rare).
Patent Pending	If the patent application has been made but has not yet been granted, this phrase can be used.
Patented or Patent No.	Once the patent is granted, usually the patent number and jurisdiction are used to show where the patent has been issued.

Does the trade fair have an IP office?

In the preparation phase, visit the trade fair's website or contact the organiser to gather information on possible complaint centers that may be at the trade fair and whether there is any

IP protection information and dispute resolution mechanisms available for companies attending the trade fair.

If the Trade Fair does have an IP Office, on the first day of the trade fair, spare some time to visit it. This is important for the following reasons. First, it is useful to familiarise yourself with the location of the office in case there is any urgent need to return during the following exhibition days. Second, it is a good idea to make yourself known to the authorities before any potential issues arise. In the case of infringement, please make sure you already have secured evidence as witnessed by a notary public, before contacting the trade fair IP office.

Preparing certification of ownership documents

Leave some time to prepare your documents and have them in order. It is important to have at least a copy of your IP certificates with you at the trade fair. Additionally, all foreign language documents shall be translated into the respective language of the country (e.g.: English, Chinese, Spanish, Portuguese, Vietnamese, Bahasa, etc.)

For Patents & Designs:

Patent certificate; text of published patent (copy of the Patent Gazette on which the subject patent is published); documents certifying the identity of the patent owner (e.g. notarised and legalised certificate of incorporation appropriately translated); confirmation of the legal status of your patent (that the patent remains in force); and official receipts that confirm that the annuities for the current year have been paid.

Regarding patent registration and utility models, most LA countries will let you benefit, under certain conditions, from a grace period. Should you disclose your invention during this period it will not affect the novelty requirement of patentability. Remember that some patent registrations will take more time, notably in Latin American countries.

PATENT APPLICATION				
COUNTRY/REGION	TYPE	PERIOD OF PROTECTION	APPLICATION TIME	ESTIMATED COST OF OFFICIAL APPLICATION FEES ¹
CHINA IP SME HELPDESK				
Mainland China	Invention Patent	20 years	3-5 years	950 RMB (approx. EUR 121.79) ²
	Utility Model	10 years	1 year	500 RMB (approx. EUR 64.10)
	Design Patent	10 years	1 year	500 RMB (approx. EUR 64.10)
Taiwan	Invention Patent	20 years	2-3 years	NT\$ 3500 (approx. EUR 106)
	Utility Model	10 years	6-12 months	NT\$ 3000 (approx. EUR 91)
	Design Patent	12 years	6-12 months	NT\$ 3000 (approx. EUR 91)
Honk Kong	Standard Patent	20 years	4 months	HK\$ 896 (approx. EUR 105)
	Short-Term Patent	8 years	2 months	HK\$ 823 (approx. EUR 96)
Macau	Invention Patent	20 years ³	2-8 years	MOP 800 (approx. EUR 91)
	Industrial Models & Designs	25 years	N/A	MOP 1000 (approx. EUR 113)
	Utility Model Patent	10 years	N/A	MOP 400 (approx. EUR 45)
LATIN AMERICA IP SME HELPDESK^{4,5}				
Argentina	Patent	20 years	5 years	EUR 333
	Utility Model	10 years	3 years	EUR 164
	Industrial Design	5 years up to 15 years	1 week	EUR 53
Brazil	Invention Patent	20 years	10 years	EUR 175
	Utility Model	15 years	8 years	EUR 130
	Industrial Design	10 years up to 25 years	1 year	EUR 135
Chile	Invention Patent	20 years	2 years	EUR 757
	Utility Model	10 years	3- 5 years	EUR 598
	Industrial Design	10 years	18-24 months	EUR 488

1. Please note that these amounts do not include other costs (such as drafting, translations, representative's fee...) that you may incur during the registration procedure.

2. Currency exchange as of June 2020.

3. The protection of pharmaceutical inventions may be extended by up to 27 years to compensate the patent holder for the time he may have to wait for marketing approval for his product.

4. Please note that these are estimated prices. Patent application fees in Latin American countries may vary depending on the number of claims, the legal status of the applicant -legal or a natural person-, and the required costs by each NIPO – e.g. publication, examination or certificate issuance fee-.

5. In Chile the applicant, under certain conditions, may request an extension of its Patent protection due to unjustified delay in the administrative procedure of the patent application.

LATIN AMERICA IP SME HELPDESK				
Colombia	Invention Patent	20 years	2-3 years	EUR 377
	Utility Model	10 years	2-3 years	EUR 230
	Industrial Design	10 years	15-20 months	EUR 194
Mexico	Invention Patent	20 years	3- 5 years	EUR 353
	Utility Model	10 years	1.5 years	EUR 123
	Industrial Design	15 years	3 years	EUR 92
Peru	Invention Patent	20 years	4- 6 years	EUR 406
	Utility Model	10 years	4-6 years	EUR 230
	Industrial Design	10 years	5-7 months	EUR 192
SOUTH-EAST ASIA IP SME HELPDESK				
Brunei Darussalam	Patent	20 years from filing date	2-4 years	Filing fee B\$ 160 (approx. EUR 102); Examination fee B\$ 4000 (approx. EUR 2500)
	Industrial Design	A maximum of 15 years (5+5+5) from filing date	8-12 weeks	From B\$ 300 (approx. EUR 175) to B\$ 500 (approx. EUR 290)
Cambodia	Patent	20 years from the filing date	N/A	Riels 320,000 (approx. EUR 70)
	Utility Model	7 years from the filing date	N/A	Riels 160,000 (approx. EUR 35)
	Industrial Design	A maximum of 15 years (5+5+5) from filing date	N/A	Riels 80,000 (approx. EUR 17)
Indonesia	Patent	20 years from filing date	3-5 years	IDR 1,250,000 (approx. EUR 77)
	Simple Patent	10 years from filing date	2-3 years	IDR 800,000 (approx. EUR 49)
	Industrial Design	A maximum of 15 year maximum of 15 years (5+5+5) from filing date	N/A	IDR 800,000 (approx. EUR 49)
Laos	Patent	20 years from filing date	N/A	LAK 1,110,000 (approx. 112)
	Petty Patent	10 years from filing date and can be renewed once for an additional 2 years	N/A	LAK 1,110,000 (approx. 112)
	Industrial Design	A maximum of 15 years (5+5+5) from filing date	6-12 months	LAK 82,000 (approx. EUR 8)
Malaysia	Patent	20 years from filing date	26 months	MYR 260 (approx. EUR 54) MYR 290 (approx. EUR 60) in case of manual filing
	Utility Innovation	10 years from filing date and extendable for another 2 consecutive 5-year terms	20 months	MYR 130 (approx. EUR 27) MYR 140 (approx. EUR 29) in case of manual filing
	Industrial Design	A maximum of 25 years (initially 5 years and extendable for four times for five years each extension)	8 months	MYR 480 (approx. EUR 100) MYR 500 (approx. EUR 105) in case of manual filing
Myanmar	There is presently no functioning system of patent or design protection in Myanmar.			

The Philippines	Patent	20 years from filing date	4 years	From PHP 2,000.00 to PHP 4,320.00 Big entities (approx. 35 EUR to 77 EUR)
	Utility Innovation	7 years from filing date	8 months	From PHP 1,720 to 3,600 (approx. EUR 31 to 64)
	Industrial Design	A maximum on 15 years ((5+5+5) from filing date	6 months	From PHP 1,720 to 3,600 (approx. EUR 31 to 64)
Singapore	Patent	20 years from filing date	1/2 years	SG 160 (approx. EUR 102)
	Industrial Design	A maximum on 15 years ((5+5+5) from filing date	4 months	SGD 250 (approx. EUR 160)
Thailand	Patent of Invention	20 years from filing date	up to 10 years	THB 500 (approx. EUR 14)
	Utility Model/Petty Patent	6 years from filing date and extendable twice for 2 more years (i.e. maximum of 10 years)	2 years	THB 500 (approx. EUR 14)
Vietnam	Invention Patent	20 years from filing date	20 months	VND 150,000 (approx. EUR 6)
	Utility Solution Patent	10 years from filing date	18 months	VND 150,000 (approx. EUR 6)
	Industrial Design	A maximum on 15 years (5+5+5) from filing date	15 months	VND 150,000 (approx. EUR 6)
INDIA IP SME HELPDESK				
India	Patent	20 years from filing date	4-6 years	INR 5,600 (approx EUR 64) * fees applicable to SMEs, fees may be higher for larger businesses
	Industrial Design	A maximum of 15 years (10+5) from the filing date	6-12 months	INR 1,000 (approx. EUR 11)* fees applicable to SMEs, fees may be higher for larger businesses



For Trade marks:

China: Trade mark certificates for an international registration through the Madrid Protocol indicating China, you need to separately apply for a Trade Mark Registration Certification from the Trade Mark Office of China National Intellectual Property Administration (CNIPA); any renewals of the trade mark (if it is over 10 years since the original registration); and documents certifying the identity of the trade mark owner. Keep in mind that Hong Kong, Macao and Taiwan are not part of the Madrid Protocol.

Latin America: Trade mark certificates; documentation supporting the validity and enforceability of the trade marks (such as renewals of the trade mark if it is over 10 years since the original registration); documents certifying the identity of the trade mark owner and accreditation of represent/act on behalf of the trade mark holder (lawyers and/or representatives acting on behalf of the IPR holder). Be aware

that in Latin America, only Brazil, Chile (from 2022), Colombia, Cuba, and Mexico are part of the Madrid Protocol.

South-East Asia: Trade mark certificates, either for domestic registrations or for an international registration through the Madrid Protocol indicating one of countries of South-East Asia that are party to the Madrid System. Please note that among the ten countries of South-East Asia, only Myanmar is currently not party to the Madrid System. Additional documents include any renewals of the trade mark (if it is over 10 years since the original registration); and documents certifying the identity of the trade mark owner.

India: Trade mark certificates, renewal certificate (if the trade mark was originally registered more than 10 years prior) and any additional document certifying the identity of the trade mark owner. Note that India is party to the Madrid System.

TRADE MARK APPLICATION			
COUNTRY/REGION	PERIOD OF PROTECTION	APPLICATION TIME	ESTIMATED COST OF OFFICIAL APPLICATION FEES ⁶
CHINA IP SME HELPDESK			
Mainland China	10 years and renewable	9 months	RMB 300 (approx. EUR 40)
Taiwan	10 years and renewable	8-12 months	NT\$ 5500 (approx. EUR 165) ⁷
Honk Kong	10 years and renewable	6-9 months	HK\$ 2000 (approx. EUR 214.42)
Macao	Indefinitely ⁸	6 months	EUR 104
LATIN AMERICA IP SME HELPDESK			
Argentina	10 years and renewable	20 months	EUR 46
Brazil	10 years and renewable	36 months	EUR 85-99
Chile	10 years and renewable	4-12 months	EUR 194
Colombia	10 years and renewable	9-12 months	EUR 225
Mexico	10 years and renewable	6 months, if no opposition filed	EUR 124
Peru	10 years and renewable	5 months, if no oppositions are filed	EUR 143
SOUTH-EAST ASIA IP SME HELPDESK			
Brunei Darussalam	10 years and renewable	15-18 months	BSD 210 (approx. EUR 150)
Cambodia	10 years and renewable	9-12 months	KHR 420 000 (approx. EUR 92)
Indonesia	10 years and renewable	24-36 months	IDR 2 000 000 (approx. EUR 128)
Laos	10 years and renewable	12-15 months	LAK 1,120,000 (approx. EUR 116)
Malaysia	10 years and renewable	12-24 months	MYR 1,020 (approx. EUR 222)
Myanmar	There is presently no trade mark registry in Myanmar		
The Philippines	10 years and renewable	12-15 months	- Small entity: PHP 1,770 (approx. EUR 31) - Big entity: PHP 3,792 (approx. EUR 66)
Singapore	10 years and renewable	6-9 months	SGD 341 (approx. EUR 223)
Thailand	10 years and renewable	18-24 months	THB 1 000 (approx. EUR 29)
Vietnam	10 years and renewable	15-18 months	VND 1 360 000 (approx. EUR 54)
INDIA IP SME HELPDESK			
India	10 years and renewable	18-24 months	INR 4,500 (approx. EUR 52)* fees applicable to SMEs, fees may be higher for larger businesses

6. Please note that these amounts do not include other costs (such as drafting, translations, representative's fee...) that you may incur during the registration procedure.

7. Currency exchange as of June 2020.

8. Provided renewal is applied for, and the fee is paid, every seven years.

For Copyright:

Copyright protection arises automatically as soon as a work is created in one of the country signatory to the Berne Convention. Therefore, there is no need for registration. However, various jurisdictions allow copyright voluntary recordal which is very helpful to state and prove the ownership, especially in case of enforcement.

China: If you have exercised the option to register your copyright in China, the certification of the copyright, and documents certifying the identity of the copyright owner are required. Although copyright is an automatic right, China offers voluntary copyright registration which provides proof of ownership. A voluntary copyright registration is not a pre-requisite for enforcing your copyrights but it will make the enforcement process much easier. If no copyright registration is made, you may need to bring the original work showing the author's name and the date of creation or first publication (with the notarised and legalised mandarin translation, when it's a foreign work).

Please note that Taiwan is not part of the Berne Convention. Also, there is no official registry in Hong Kong, your copyrights under the Berne Convention will be automatically enforceable. Macao is part of the Berne Convention and, like Hong Kong, there is no official registry for copyright in Macao.

Latin America: All Latin American countries are part of the Berne Convention. Hence, protection arises automatically and registration is therefore optional. However, registration is advisable, taking into account that is relatively cheaper compared to other IPRs (e.g. in Colombia it is free-of-charge), fast, and it provides you with a presumption of authorship, which can be very useful to enforce your rights against third parties.

South-East Asia: Among the ten countries of South-East Asia, except for Brunei, Myanmar and Singapore, all other countries allow voluntarily recordal for copyright. This is usually recorded with the competent national copyright authority and is an inexpensive and relatively fast process (generally it takes about thirty (30) days to complete). EU SMEs are recommended to use this recordal system when doing business in or with South-East Asia countries that allow to do so.

India: India allows for the voluntary registration of copyright with the Copyright Office, though it is not required to ascertain one's rights over their work. Copyright registration serves to provide evidence of ownership should a dispute arise: having a registered copyright can significantly ease enforcement actions in India.

3. ATTENDING THE TRADE FAIR

How much of my IP should I disclose? Potential Loss of Novelty

If you are exhibiting at a trade fair, you should review and consider what materials you are displaying and distributing, especially if they relate to new products. Remember, displaying products at trade fairs can (but not in all circumstances) constitute 'publication' which may affect their novelty value. If you display a new product at a trade fair in such a way that its innovative elements are clearly visible and have been documented in some manner then you could be prevented at a later stage from obtaining patent registration for that product or, if a patent is obtained, it may be subject to invalidation.

In case of an infringement: Gathering Enforcement Evidence

Trade fairs provide a genuine opportunity to learn about innovations and to discover new potential business partners. As exhibitions and trade fairs mirror a large spectrum of a market, they may also allow you to discover and catch an infringer of your rights. Whether you are investigating a potential

collaboration or wish to gather evidence regarding a possible infringement, you may legally collect evidence during the trade fair to support your actions.

The first step in order to enforce your IPRs is to have them legally registered and being the owner.

The second step is to enforce your legal right through either the administrative route or civil action. No matter which enforcement action is best suited to your purpose, you will need to prove your IPR has been infringed by producing a significant volume and quality of evidence. Proving the infringer's bad faith (i.e. the infringement is committed with awareness of the existence of another person's IP rights) might be required. For example, during your conversation with the exhibitor, you discover that the exhibitor was already aware of the existence of your brand or your product. If recorded by lawful means, such a conversation can be used as a supporting evidence to other evidences proving the bad faith of the infringer. Please consult a lawyer beforehand to make sure you meet the lawful means requirement.

Any evidence showing the scale of the infringement which can indirectly testify to the impact on potential consumers and profit is considered valuable evidence material (e.g. catalogues including price lists, sales performance and/or distribution network of the infringing product; size of the exhibition booth, location of the booth at a trade fair).

Types of notarisation at trade fairs

Notarised evidence has strong probative force, more likely to be accepted by a Court or any other enforcement authority. In practice, the most common ways to secure the relevant evidence of infringement at trade fairs by means of notarisation are:

- (1) Notarised purchases (i.e. purchasing a sample infringing product at a trade fair whilst accompanied by a public notary);
- (2) Notarised photography of the presence of the infringer and/or infringing product(s) at a trade fair (i.e. taking photos at trade fairs of the infringer's exhibition booth, infringing products/exhibits, infringing advertisement with a public notary).

The aim of this type of notarisation is to preserve the relevant evidence that proves that the infringer has been committing or has committed IPR infringement at trade fairs.

In general, it is important to be pro-active rather than reactive. Try and visit the booth of known, past, or suspected infringers as early as possible during the fair, even during the set-up stage if possible. This will provide more time to complete evidence collection and/or enforcement procedures.

4. TAKING ACTIONS AGAINST AN INFRINGER

Enforcement options and possible actions during trade fairs

It may be more sensible to wait instead of taking immediate enforcement action. Pursuing networks of manufacturers, traders and overseas customers often leads to the discovery of common links, clarifies priority targets and makes progress easier to measure. For example, enforcement action at the trade fair may not be appropriate if your rights are not entirely in order, if the case of infringement is arguable, if you have not secured notarised evidence yet, or if the Trade Fair representatives (IP Officer in China) does not have the technical expertise to make a decision on infringement at the trade fair. In addition, if it is obvious that the exhibitor is not the

main target (the exhibitor may be a small reseller or trading company) it might make sense to obtain evidence at the trade fair and investigate the exhibitor after the trade fair so that more substantial targets, a manufacturer or even infringing networks, can be disclosed or pursued. Even if you do not take any enforcement action, do ensure that you maintain a database, recording the details of suspected infringers and obtain as much evidence as possible which can be used for potential enforcement later.

If you decide to take enforcement action, you may file a complaint at the IP Office at the trade fair. There are several enforcement options that are usually recommended:

- **A notification letter:** this letter simply provides the infringer with a notice of your IP rights. You may wish to also include a statement that you would be willing to discuss the issue or offer to license the IP to them. This is usually the more amiable approach. It is possible to send such a letter on the letterhead of the IP owner (i.e. without instructing lawyers).
- **A cease and desist (C&D) letter:** such a letter will usually threaten legal proceedings and demand that the infringer ceases and desists from infringing the IP in question. It is possible to ask for damages and legal costs in such letters. The letter may be accompanied by a form of settlement agreement known as 'undertakings' to contractually bind the infringer by the settlement terms. Usually lawyers are instructed to send these letters
- **Search and seize actions:** this is usually done ex parte i.e., without informing the infringer in order to take them by surprise. Local legal advice for such proceedings is crucial and they are performed by local public authorities.
- **Issue legal proceedings:** This is often a last resort. Legal actions are not as costly in Latin America, China and South-East Asia as they are in Europe, but they can still be a significant drain on resources, especially for an SME. Both criminal and civil actions may be available to the IP owner for injunctions and damages.

Evidence and burden of proof

China: In China's People's Court the burden of proof lies with the plaintiff (claimant) and notarised documentary evidence, as well as the official IPR registrations, should be used. As well as proving your ownership via IPR certificates you must prove the infringement via physical evidence including contracts, photographs of infringing products and proof of sale which have been validated by a notary public (a public officer or other person who is authorised to authenticate documents, evidence, etc). If you wish to seek assistance from an administrative body (e.g. State Administration for Market Regulation (SAMR) for trade marks) you must provide a similar body of evidence for your case to be accepted. For Hong Kong, Macao and Taiwan, the burden of proof also lies with the plaintiff. Similar volume and quality of evidences might be requested depending on the authority reached.

Latin America: In Latin America, as a rule of thumb, the burden of proof lies with the plaintiff, who should use registration certificates and official documents to prove ownership, as well as physical evidence (contracts, photographs of infringing products or the goods that have been seized in customs) to prove the infringement -whenever possible, notarised documentary evidence should be provided.

However, each country has its own specialities: in Chile, for example, any IPR protected object must display visibly the registration number and indication of IP registration; failure to meet the requirement will not affect the validity of the

rights but will prevent the right holder from bringing criminal actions. Regarding Brazil, and in civil litigation, non-resident claimants are required to pay a deposit of between 10% and 20% of the damages claimed (this does not apply to international companies with a subsidiary or antenna situated in Brazil).

South-East Asia: Generally in South-East Asia, the burden of proof also lies with the plaintiff (claimant) and in various jurisdictions, for example as Vietnam and Indonesia, notarised documentary evidence should be used. This means that evidences of the infringement shall be validated by a notary public. Not all countries of South-East Asia offer IP Claim desks at trade fairs and therefore EU SMEs shall immediately contact their lawyers in case they would find themselves in the situation where an infringement occurs at a trade fair and they wish to collect valid evidences during the trade fair to be used in legal proceedings at a later stage. Each country in South-East Asia may differ in relation to the formal requirements for the validity of evidence to be presented in legal proceedings and burden of proof. The provisions of procedural law apply in each different country.

India: In India, the burden of proof in IP infringement cases lies with the owner of the right which has allegedly been infringed. As well proof of ownership of the IP right in question, it is necessary to provide evidence of the infringement (photos, specimens of the infringing products, proofs of sale, etc.). These do not need to be notarised, except in the case that these pieces of evidence come from abroad.

Most trade fairs organised in India do not offer IP claim desks or other services during the fair to help participants in case they encounter IP-related issues. Therefore it is highly recommended that EU SMEs participating in these events prepare them carefully following the best practices detailed above, and react as soon as possible when a potential infringement is spotted by contacting their IP lawyer to ensure swift action is taken.

Proceedings

Enforcement remains a strictly domestic matter and therefore it is recommended to seek the advice of an IP lawyer with local expertise in the country where the infringement takes place. In this respect, please make reference to the guides on enforcement avenues available for each regional IPR Helpdesk.

For detailed information regarding proceedings, please see the China IP SME Helpdesk Guide to Enforcement of Intellectual Property Rights in [China](#) and factsheets for [Hong Kong](#), [Macao](#) and [Taiwan](#).

For more detailed information, please check our [Factsheets](#) on how to enforce your IP in Brazil, Argentina, Chile and Andean Community, as well as our [Country Factsheets](#) of Argentina, Brazil, Chile, Colombia, Mexico and Peru.

For detailed information regarding proceedings in South-East Asia, please see the [Guide to IPR Enforcement in South-East Asia](#).

For more detailed information regarding IP protection in India, please see our [Factsheets](#) on the matter.

If action was taken at the trade fair, maintain contact with the authorities and conduct follow up investigations to check if the infringer has halted the infringing activities.

5. CASE STUDIES

Mainland China

Country of origin: France

Industry: Manufacturing of bathroom equipment

Status in China: Manufacturing and selling products

Background

A French manufacturer and designer of bathroom equipment was showing their new products at the Canton Fair in Guangzhou. One year prior to going to the trade fair, the SME registered its French and Mandarin Chinese names as trade marks in China. During the fair, the company's staff noticed that a Chinese company had used their trade mark and copied their product. The business manager of the French company visited the Chinese company's booth to gather business cards and take photographs of the infringing products. The French company contacted the China IP SME Helpdesk to seek advice on how they could enforce their rights given that evidence had been obtained.

Action given

The Helpdesk informed the company that only notarised evidence is accepted in China, and advised the company to go back to the Canton Fair with a Chinese notary public to obtain the evidence of the infringement. In addition, the Helpdesk advised to consider waiting and not taking immediate action against the company, without first finding out whether or not

the company is just a small company acting as a distributor for a 'bigger fish'. For example, the Chinese company at the trade fair may only be distributing the products, whilst there is a large-scale manufacturing of infringing products done by someone else. The rationale behind such a strategy is that in case a company is alerted, it will be harder to find evidence with regard to infringement from the 'bigger fish', i.e. the brains behind the operation.

Action taken

The French company went back to the Canton fair with a Chinese notary public and obtained the evidence. In their specific case, the infringing company was the manufacturer, and with the evidence, the SME took down the company in a court case, so that the infringement in China was stopped.

Lessons learned

- In order to enforce your trade marks or patents at a trade fair, you must have IP registrations of these rights in China, either domestically or via an international route
- Make sure that the evidence of IPR infringement you obtain is notarised by a Chinese notary public. If that is not the case then you will not have the evidence to prove IPR infringement.

South-East Asia

Country of origin: Slovenia

Industry: Automotive

Status in China: Manufacturing and selling products

Background

A Slovenian company in the automotive industry exhibiting at the Automotive Trade Fair in Vietnam is aware that a Chinese company which has been reported infringing its design in the past is also exhibiting at the same fair. The Slovenian company had checked the list of exhibitors before starting the exhibition and therefore had the time to be prepared should any infringement occur during the fair.

At the trade fair the Chinese competitor was displaying a model of scooter with an almost identical design to the one owned by the Slovenian company.

Action given

By checking in advance the list of other exhibitors to the trade fair, the Slovenian SME had time to prepare beforehand including preparing the original certificate of its design registration in Vietnam and identifying a lawyer who could provide advice directly at the exhibition in case of need.

Action taken

With the help of the staff, the Slovenian company has taken pictures of the infringing products as well as brochures and

other marketing materials. The SME called in the lawyer to advice on how to collect sufficient evidence of the infringement and which actions to be taken next.

Outcome

The Chinese company has received a notification letter during the trade fair and was asked to remove the products infringing the design owned by the Slovenian company from the exhibition booth. Subsequently a cease and desist letter was sent and the case proceeded to settlement.

Lessons learnt

- Prepare in advance knowing who will be participating at the same trade fair you will attend to identify if potential infringements may take place and prepare a copy of your IP certificates
- Register IP in the country of the exhibition and where you intend to trade in
- Use the help and support of a local lawyer to obtain advice on how to collect valid evidences and the options available to you
- Mediation and settlement can be sufficient to stop an infringement

Latin America

Country of origin: Spain

Industry: Manufacturing of kitchen appliances

Status in China: At the time of the trade fair, the Utility Model was not yet registered in Mexico

Background

A Spanish manufacturer of kitchen appliances attended a Trade Fair in Mexico. During the event, the company disclosed their newest product: an improved device that allows you to carry your coffee cup in the car without the risk of spilling liquids. A couple of months before attending to the Mexican Fair, the company filed a Utility Model application before the Spanish Patent and Trademark Office, the registration of which was successfully granted 4 months later. Given the good reception of the product at the Trade Fair, and taking into account that the EU applicant could benefit from a 12-months priority period, the company decided to extend the protection of the Utility Model to Mexico. While organising and gathering all legal documents, the company's representative in Mexico discovered that another Mexican competitor had copied the invention and started distributing it under their trade mark. They contacted the LA IP HD to obtain professional advice on how to proceed on this matter.

Action given

In light of the information provided by the company, the LA IP Helpdesk recommended to start by sending a documented cease and desist letter (C&D) to the infringing company. In most cases, the C&D letter will be enough to get the infringer to stop its illegal conduct, saving you both time and money. Turning to Courts should be considered as a last resort, when the company persists on the infringement. The HD pointed out that in Mexico, companies cannot claim damages through a civil procedure until a final judgement is obtained from the relevant court (administrative or criminal).

Action taken

The company, with the support of a local expert, carried out an investigation regarding the infringing company. The IP expert discovered that the Mexican company had visited the Spanish company stand at the Trade Fair and require the Trade Fair organisers their support for collecting more information. The performance of the local expert was key for collecting and providing enough evidences. The expert, with the support of a public notary, identified and took photos of the infringing goods commercialised by the unauthorized party in Mexico. They were also able to gather sufficient information regarding the infringing Mexican company. A C&D letter was sent to the Mexican infringer who immediately removed the merchandise from the market. Because of the increasing interest for the product in the market, the two companies were able to negotiate a license agreement that was suitable for the needs of both companies.

Lessons learnt

- IPRs are territorial rights. Make sure to register your Utility Model in the country before operating.
- Stay in touch with Trade Fair organizers. They can assist you in the event that another attendee clearly infringes your IPRs.
- Take into account the specialties of each country. Thanks to the Paris Convention, EU applicants can benefit from a 12-months priority period in Mexico.
- Litigation is time and money consuming. Therefore, you should first try to solve the situation through a cease and desist letter.

Take Away Messages

Prevention:

The benefits of attending a trade fair are undeniable. However, "Fail to prepare, prepare to fail". IP Prevention at Trade Fairs is an essential part of avoiding future problems arising. A good protection is the best defence against IP infringements. It is key to make sure that all the preventive measures are taken before going to the Trade Fair. Before attending one, conduct an investigation and choose carefully. The Global Association of the Exhibition Industry (UFI) has developed some useful recommendations for events' organisers. Check if they are met before attending and know in advance what tools are available in case of potential IP infringements: Is there a specific list with IP information available before hand or at registration? Is there a person in charge of IP issues? Do they provide contact information of customs authorities, lawyers or IP offices?

Is there an IP consultation and complaint center? You should also review the list of participants; even run a background investigation to make sure there is no potential infringer attending the Trade fair.

Enforcement:

IP enforcement at trade fairs could form part of your broader enforcement strategy. Information gathered and lessons learned at a trade fair can be utilised in developing or improving your IP strategy. Before you consider any of the above options, you should first make sure your IP rights are in place (i.e. are appropriately registered) and that you have the best protection in the country/countries or regions of interest. Make sure you develop a strong IP strategy and prepare carefully for trade fairs. Through due diligence and a good IP protection strategy, potential IP enforcement situations can be handled with the upper hand.

Best Practices

- Register your IP such as Trade Marks, Patents, and Designs in each country of interest otherwise you are not protected in jurisdictions. Do not forget that, many Latin American countries provide, under certain conditions, a grace period regarding Patent and Utility Models.
- China, the majority of countries of Latin America and the majority of countries in South-East Asia are generally understood as so called 'first-to-file' system jurisdictions. Therefore register your IP before anyone else does or you will not be protected.
- Do not disclose your product before registering your patents or designs. China, the majority of countries of Latin America and the majority of countries in South-East Asia operate under the novelty system. If your product has been disclosed anywhere in the world prior, the novelty requirement is not met and therefore it can make the patent or the design invalid in China, Latin America, India and South-East Asia.
- Do not engage in any business operations or negotiations in China, Latin America, India or South-East Asia without signing an NNN or an NDA first. Otherwise you will not be protected against your Trade Secrets being leaked and or used.
- Litigation is not always the best option. First, try to solve the conflict through out-of-court tools or settlements.

6. GLOSSARY OF TERMS

- **Madrid Protocol/Madrid System:** The Madrid Protocol is a centralised system for registering and managing trade marks worldwide. This Protocol has been ratified by many countries around the world, including the EU, the US and China. It allows the owners to register in different countries through one application instead of applying individually.
- **Berne Convention:** The Berne Convention for the Protection of Literary and Artistic Works is an international agreement that regulates copyright. It allows the copyright to be recognised by all the parties of the Convention from creation instead of from registration.
- **Cease and Desist Letter (CDL):** The owner of an IPR can send this letter to inform the infringer their intention to enforce their rights, but it also could include a license offer. It is normally the intermediate step between infringement and enforcement.
- **Non-Disclosure Agreement (NDA):** This is a legal agreement between two parties impeding them to disclose the information agreed upon to third parties.
- **NNN (Non-use, Non-disclosure, and Non-circumvention):** Legal agreement between two parties.
 - Non-use: Not to use any of the confidential information for other purposes than to consider the potential business relationship
 - Non-disclosure: Not to disclose the information agreed upon the agreement to third parties.
 - Non-Circumvention: Circumvention refers to a company which, after acquiring another company's technology, IP rights, confidential information, etc. through negotiation, cooperation or collaboration, by-passes that company and sells directly to the market

7. Contact us

China IP SME Helpdesk:

The Helpdesk operates an Enquiry Helpline that can be reached via: question@china-iprhelpdesk.eu or the following link: http://https://intellectual-property-helpdesk.ec.europa.eu/services/helpline_en. Upon contacting us, you will receive a reply within three (3) working days. You can also call us at +86 (10) 6462 0892, from 9am to 6pm, China Standard time. You can also schedule an appointment for one-on-one consultation at our Beijing office.

Latin America IP SME Helpdesk:

The Helpdesk operates an Enquiry Helpline that can be reached via: helpline@latinamerica-ipr-helpdesk.eu or the following link: https://intellectual-property-helpdesk.ec.europa.eu/services/helpline_en. Upon contacting us, you will receive a reply within three (3) working days. You can also call us at +34 965 90 96 84, from 9am to 16:30pm, CET.

South-East Asia IP SME Helpdesk:

The Helpdesk operates an Enquiry Helpline that can be reached via: question@southeastasia-iprhelpdesk.eu or the following link: https://intellectual-property-helpdesk.ec.europa.eu/services/helpline_en. Upon contacting us, you will receive a reply within three (3) working days. You can also call us at +84 (8) 38258116, from 9am to 6pm, Vietnam Standard time. You can also schedule an appointment for one-on-one consultation at our office in Ho Chi Minh City, Vietnam.

India IP SME Helpdesk

The Helpdesk operates an Enquiry Helpline that can be reached via: india@iprhelpdesk.eu or the following link: https://intellectual-property-helpdesk.ec.europa.eu/regional-helpdesks/india-ip-sme-helpdesk/india-helpline_en. Upon contacting us, you will receive a reply within three (3) working days. You can also call us at +34 96 590 70 70, from 9am to 5pm, CET.

Disclaimer:

The contents of this publication do not necessarily reflect the position or opinion of the European Commission. The services of the China IP SME Helpdesk, Latin America IP SME Helpdesk, India IP SME Helpdesk and South-East Asia IP SME Helpdesk are not of a legal or advisory nature and no responsibility is accepted for the results of any actions made on the basis of its services. Before taking specific actions in relation to IPR protection or enforcement all customers are advised to seek independent advice.

Free IP advice for European SMEs

> **For more information and to discuss how we can work together, please contact us:**

For South-East Asia:

Tel: +84 28 3825 8116 | Tel: +32 2 663 30 51

Email: question@southeastasia-iprhelpdesk.eu

Online: ec.europa.eu/ip-helpdesk

For China:

Tel: +86 (10) 6462 0892

Email: question@china-iprhelpdesk.eu

Online: ec.europa.eu/ip-helpdesk

For Latin America:

Tel: +34 96 590 9684

Email: info@latinamerica-ipr-helpdesk.eu

Online: ec.europa.eu/ip-helpdesk

For India:

Tel: +34 96 590 70 70

Email: india@iprhelpdesk.eu

Online: ec.europa.eu/ip-helpdesk

Download guide:



© European Union, 2021.

Reuse is authorised provided the source is acknowledged.

The reuse policy of European Commission documents is regulated by Decision 2011/833/EU OJ L 330, 14.12.2011, p.39.

The contents of this publication do not necessarily reflect the position or opinion of the European Commission. The services of the South-East Asia, China, India and Latin-America IP SME Helpdesk are not of a legal or advisory nature and no responsibility is accepted for the results of any actions made on the basis of its services. Before taking specific actions in relation to IPR protection or enforcement all customers are advised to seek independent advice.



Publications Office
of the European Union

Luxembourg: Publications Office of the European Union, 2021

Print ISBN 978-92-9460-959-5 doi:10.2826/177441 EA-01-21-358-EN-C
PDF ISBN 978-92-9460-960-1 doi:10.2826/316261 EA-01-21-358-EN-N



The paper used in this product is manufactured
from managed forests and is FSC certified.