Fighting Fakes: Strategies to Enforce IP Rights in Thailand

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Enforcement Strategies

Suspected Infringement

Trademark

Passing off

Patent

Investigations

Copyright

Evaluation

Case to Proceed?

Negotiations

C & D Letter

Civil Action

Raid

Prosecution

Judgment
Available Remedies for IP Infringement in Thailand

- Civil Action
- Criminal Action
- Sending a Cease and Desist Letter
- Border Control: Customs
- Alternative Dispute Resolution
  - Mediation at DIP or IP&IT Court
  - Negotiation
- Notification in the Local Newspapers
Government Authorities

Active Thai government authorities concerning IP Enforcement

- Department of Intellectual Property (DIP)
- Department of Special Investigation (DSI)
- Customs Department
Government Authorities

Active Thai government authorities concerning IP Enforcement

- Royal Thai Police
  - Metropolitan Police Bureau
  - Economic Crime Division
Government Authorities

Active Thai government authorities concerning IP Enforcement

- Department of Intellectual Property and International Trade Litigation,
  Office of the Attorney General (Public Prosecutor)

- Intellectual Property & International Trade Court
IP Enforcement Options

Criminal Action

Police Raid Seizure

- Very popular: cost effectiveness & less time-consuming
- Procedure:
  - IP owner files a complaint with the police
  - Police obtains a Search Warrant from the IP&IT Court
  - Police raids the counterfeiter’s premises, seize infringing products, and arrest individuals being involved in the infringement
  - Police completes their investigation and forward the case to Public Prosecutor
  - Public prosecutor will try the case in the IP&IT court
  - For a simple case, IP&IT Court may take about 10 - 12 months to reach a judgment
IP Enforcement Options

Criminal Action

Customs Seizure

- Well trained officers with active enforcement
- There is a “fast track” informal procedure by providing TM Watch to Customs Bureau
- Border control at important customs ports:
  - Klongtoei Port
  - Leamchabang Port
  - Suvarnabhumi Port
  - Maesai Port
  - Arunyaprasathes Port
  - Nongkhai Port
Civil Action

Enforcement in IP&IT Court

A. Preliminary Injunction

- Can be filed either prior to or during court proceedings to stop infringement
- Available for all major IP laws i.e. Copyright, Patent, Trademark, and Trade Secret
- IP owner must demonstrate:
  1) Prove legitimate ownership in the infringed IP;
  2) Show evidence of actual/potential infringement activities by the alleged infringer;
  3) Show evidence of irreparable harm; and
  4) Be able to provide sufficient reasons for the court to conclude that the injunction is appropriate
IP Enforcement Options

Civil Action

Enforcement in IP&IT Court

- **A. Preliminary Injunction**
  - Rather difficult because the Court will need extensive and sufficient reasons to conclude that the injunction is appropriate
  - Also depends on the extent of damages both parties may incur if the injunction is granted and the difficulty of enforcing the judgment against the alleged infringer
IP Enforcement Options

Civil Action

Enforcement in IP&IT Court

- **B. Anton Piller Order**
  - Another civil action in addition to the Preliminary Injunction
  - Similar to civil search warrant
  - Ex parte order for search and seizure of evidence prior to filing a complaint to the court (not yet an injunction)
  - Search and seizure can be conducted when:
    - Immediate risk that evidence of infringement of IP rights will be destroyed, tampered with or concealed.
Civil Action

Enforcement in IP&IT Court

- B. Anton Piller Order
  - Require alleged infringer to allow IP owner to inspect and seize evidence at infringer’s premises
  - IP owner must demonstrate:
    1) Strong prima facie case;
    2) Damage, potential or actual, must be considered to be an irreparable harm; and
    3) Clear evidence that the defendant has in its possession the alleged documents or materials regarding the infringement activities, and that there is a real possibility that the evidence may be destroyed, damaged, concealed or disappear
IP Enforcement Options

Option 2: Civil Action

Enforcement in IP&IT Court

• **B. Anton Piller Order**
  - Rarely granted, but more possibilities than Preliminary Injunction
  - In practice, officers from Legal Execution Department (LED) will join the raid seizure together with police as witness
  - IP owner is required to simultaneously submit a complaint to the IP&IT Court requesting for a permanent injunction by the court’s decision
Option 2: Civil Action

Enforcement in IP&IT Court

- B. Anton Piller Order
  - Concerns
    - Execution officers can be liable for the value of the infringing product that the IP owner wants them to seize - if the charges are later shown to lack merit and the claim against the accused is ultimately unsuccessful.
    - IP&IT Court very carefully considers whether an Anton Piller order is unfair to the accused party and requires very clear evidence before granting the order.
    - Active collaboration between IP Owner and lawyer can make clear to the Court the urgency of the situation and the severity of the damages, the greater the possibility of obtaining an Anton Piller order from the Thai IP&IT Court.
### Statistics of Suppression of IP Rights
Violation by Government Authorities (DIP)

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</thead>
<tbody>
<tr>
<td></td>
<td>Arrests</td>
<td>Materials Seized</td>
<td>Arrests</td>
<td>Materials Seized</td>
</tr>
<tr>
<td>(Copyright Act B.E. 2537)</td>
<td>4,562</td>
<td>524,671</td>
<td>5,121</td>
<td>1,216,567</td>
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<tr>
<td>(Trademark Act B.E. 2534)</td>
<td>2,473</td>
<td>227,202</td>
<td>4,377</td>
<td>964,627</td>
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<tr>
<td>(Patent Act B.E. 2535)</td>
<td>13</td>
<td>1,137</td>
<td>29</td>
<td>10,863</td>
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<tr>
<td>(The Act Controlling the Cassette Business and Television Devices B.E. 2530)</td>
<td>343</td>
<td>68,477</td>
<td>268</td>
<td>181,343</td>
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<tr>
<td><strong>TOTAL</strong></td>
<td>7,391</td>
<td>821,487</td>
<td>9,795</td>
<td>2,373,400</td>
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Source: Department of Intellectual Property
Statistics of IP Infringement Goods Seized by the Customs Department

![Bar chart showing the number of cases for each year from 2009 to 2015.]

(October 1, 2014 – July 31, 2015)
2015 Top 5 of IPR Seized Products by the Customs Department (Quantity)

<table>
<thead>
<tr>
<th>No.</th>
<th>Product</th>
<th>Quantity (pcs)</th>
<th>Value (THB)</th>
</tr>
</thead>
<tbody>
<tr>
<td>1</td>
<td>Glasses</td>
<td>315,389</td>
<td>31,705,240</td>
</tr>
<tr>
<td>2</td>
<td>Mobile, Parts and Accessories</td>
<td>261,049</td>
<td>9,176,036</td>
</tr>
<tr>
<td>3</td>
<td>Clothes</td>
<td>256,188</td>
<td>17,910,949</td>
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<tr>
<td>4</td>
<td>Shoes</td>
<td>142,496</td>
<td>16,833,229</td>
</tr>
<tr>
<td>5</td>
<td>Bags</td>
<td>91,776</td>
<td>55,606,128</td>
</tr>
</tbody>
</table>

October 1, 2014 – July 31, 2015
Amendments of Thai IP Laws

- **Trade Secret Act Amendments** - effective on February 6, 2015

- **Copyright Act Amendments**
  - Effective on April 6, August 4, 2015

- **Trademark Act Amendments** - effective on July 28, 2016
Copyright Act Amendments


- Unauthorized camcording in cinema
- Infringement exception under the first sale doctrine
- Exception for temporary reproduction in computer system
- Preliminary injunctive relief for copyright infringement in computer system
- Exception of copyright infringement for the benefit of disabled persons
- Protection of performer’s moral rights
- Protection of rights management information (RMI)
- Protection of technological protection measures (TPM)
- Punitive damages
- Seizure and destruction of counterfeits
Trade Secret Act Amendments

- Came into force February 6, 2015.
  - Reorganization and qualification of Trade Secret Board members
  - Maximum penalties for the disclosure of trade secrets by officials have been reduced.
Trademark Act Amendments

- Came into effect on July 28, 2016.

- **Sound mark** is registrable.

- **Multiple-class application** is allowed.

- **Timeframe** for response to official action and appeal petition against Registrar’ order, publication period for opposition, and period to file counterstatement to opposition is reduced from 90 days to 60 days.

- **Associated mark** is no longer required.
Trademark Act Amendments

- Came into effect on July 28, 2016.

- **License Agreement** will not be terminated as a result of the transfer or inheritance of the right of the mark for which the license agreement is made unless there is a provision in the agreement to the contrary.

- **Expiry grace period.** After the expiry date, there is a grace period of six months to renew the registration of a mark.

- **Government fees.** The government fees for certain transactions have been revised.

- **Refilling.** A person who reuses or refills packaging or containers bearing another’s registered trademarks to mislead the public into believing that the goods are of the trademark owner will be liable for imprisonment of up to four years and/or a fine of up to THB 400,000.
Museum of Counterfeit Goods
For more information please visit our website:

www.tilleke.com