



Thailand: *Legal Developments*

BATTLE AGAINST CYBERSQUATTER

First ever initiated, and won, by Thai IP rights-holders

by Piyawat Kayasit and Suradej Saengpetch

The Uniform Domain Name Dispute Resolution Policy ("Policy") and Rules for Uniform Domain Name Dispute Resolution Policy ("Rules") of the Internet Corporation for Assigned Names and Numbers (ICANN) were recently put to the test for the first time by Thai intellectual property rights-holders. The James H. W. Thompson Foundation and The Thai Silk Co., Ltd. initiated administrative proceedings for domain name cancellation via the WIPO Arbitration and Mediation Center (the "Center") based on the Rules and Policy.

The James H. W. Thompson Foundation (1st Complainant), owner of the famous trade name **Jim Thompson House**, and its affiliate, The Thai Silk Co., Ltd. (2nd Complainant), owner of the trademark **JIM THOMPSON**, lodged a complaint with the Center on May 16, 2000 asking for the transfer of the domain names <jimthompsonhouse.com> and <jimthompsonhouse.org> from a Thai individual (Respondent), who had registered the domain names, to the 1st Complainant.

The Complaint

The Foundation was named after Mr. James H. W. Thompson (popularly known as Jim Thompson), the late US military intelligence officer who made Thailand his home after World War II and is credited with reviving and developing the Thai silk industry. His Thai house, which had been

constructed by combining six traditional teak structures several centuries old, and his art collection attracted so much interest that he opened his house to the public as a museum and donated the proceeds to Thai charities. He disappeared mysteriously in Malaysia on March 27, 1967, but his famous Thai house remains as a lasting reminder of his creative genius and his deep love for Thailand. The name Jim Thompson's Thai House (commonly referred to as **Jim Thompson House**) enjoys worldwide recognition and is considered one of Bangkok's foremost tourist attractions.

The Thai Silk Co., Ltd. was founded on February 1, 1951, with Mr. James H. W. Thompson as one of the founders. He also served as a director of the company until his disappearance in 1967. The 2nd Complainant is the owner of the registered trademark **JIM THOMPSON**, which is a representation of Mr. Jim Thompson's signature. It was first registered with the Thai Trademark Office on August 23, 1978.

Wishing to promote and disseminate information about Thai craftsmanship as well as Mr. Thompson's works and his collection of Asian antiques via the electronic highway, the 1st Complainant filed for registration of its trade name **Jim Thompson House** as a domain name with Network Solutions Inc. early last



Piyawat Kayasit (top) and Suradej Saengpetch (bottom) are associates in the Intellectual Property Department.

year, only to discover that the Respondent had already acquired registration of the domain name <jimthompsonhouse.com> on August 30, 1999. The Complainants made repeated attempts to settle the dispute amicably with the Respondent, but he refused to cooperate. Not only did he refuse to cooperate but also on December 6, 1999, with full knowledge of the ownership of the name **Jim Thompson House**, he registered a second domain name <jimthompsonhouse.org> with the Internet Domain Registrars. As an individual, not an "organization", the Respondent is not qualified to register and use ".org" in his domain name.

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SOFTWARE INFRINGEMENT

Out-of-court settlement second largest in Southeast Asia and the largest in Thailand

by Darai Suvarnajata

A multinational corporate end-user in Thailand has settled with the Business Software Alliance (BSA) for copyright infringement after a raid of its premises conducted early this year together with the Economic Crime Investigation Division.

The company agreed to pay BSA for damages arising from its use of unlicensed software and the costs of legal action taken

against it by BSA. In addition, the company agreed to remove unlicensed software from all its computers and replace them with licensed software. Finally, the company agreed to issue a public apology for its use of unlicensed software and allow BSA to conduct a software audit within a year to ensure its compliance with the agreement.

UPDATE ON THAILAND'S IP&IT COURT

by Lauri Boxer-Macomber and Kanokluck Boonsakulkit



Lauri Boxer-Macomber (top photo) is a summer intern while Kanokluck Boonsakulkit (lower photo) is an associate in the Intellectual Property Department.

The Court's success is linked to a brighter economic future for Thailand.

The Central Intellectual Property and International Trade Court (the IP&IT Court) was established by Thailand's Ministry of Commerce and inaugurated on December 1, 1997. The IP&IT Court has exclusive jurisdiction over both civil and criminal matters related to the enforcement of intellectual property rights throughout the Kingdom and handles cases related to the protection of trademarks, copyrights, patents and plant varieties. Commencing August 10, 2000, the Court will also have jurisdiction over cases relating to the enforcement of the intellectual property rights associated with layout designs of integrated circuits.

From the date of its inception to May 31, 2000, well over 4,000 criminal actions have been brought before the IP&IT Court. Most of the cases (2,679) allege violations of the Trademark Act. Another 33% of the actions involve violations of the Copyright Act. Although fewer in number, 151 cases have been brought for violations of Sections 271-275 of the Penal Code and 13 cases have been filed for violations of the Patent Act.

The Attorney General's Office reports that 3,865 offenders of anti-counterfeiting laws have been sent for prosecution between January 1, 1998 and May 31, 2000. The majority of these individuals (2,611) were found guilty of violating the Trademark Act. Another 1,172 people were found guilty of violating the Copyright Act, 74 of violating the Penal Code, and 8 of violating the Patent Act. Upon finding a party guilty,

the Court normally orders a cessation of the infringement activity, a forfeiture of counterfeit goods, the payment of monetary fines, imprisonment or a combination of the above.

The number of civil actions brought before the IP&IT Court within this same time period is considerably smaller than the number of criminal actions brought before it. In total, 185 civil cases have been filed with the IP&IT Court, most of which involve alleged violations of the Trademark Act.

As civil actions tend to be more lengthy and time consuming than criminal actions, most intellectual property owners usually elect to file criminal complaints. When guilty parties have numerous assets, a civil action may be the best way to deter them from future infringement activity. However, when guilty parties are insolvent, which is often the case, the most effective way for an intellectual property owner to seek legal redress is often through a criminal action.

Within the first five months of this year, the IP&IT Court made final rulings on 737 criminal cases and 26 civil cases. The Court's ability to process such a high volume of cases can be attributed to its liberal rules, which promote judicial efficiency and speedy trials. Unlike other courts in Thailand, the IP&IT Court permits the use of video conferencing for cross-examination of witnesses outside the court, prohibits the unnecessary postponement of hearing dates, and routes all appeals directly to the Supreme Court. The IP&IT Court also has the authority to order preventive injunctions (which prohibit violators of IP

laws from placing products into the stream of commerce) and prevent the destruction of critical evidence via a modified version of the Anton Piller Order.

While the IP&IT Court boasts a high level of success, the nascent institution faces a number of challenges. In addition to the aforementioned problems related to trying civil actions, there are also a number of problems related to investigation of infringement activities. Proprietors of intellectual property often fail to file the necessary documents to initiate actions, or they file the documents improperly. Likewise, the Office of Public Prosecutors is understaffed and finds it difficult to keep up with the high volume of cases.

Irrespective of these problems, the initial success of the IP&IT Court, coupled with Thailand's decision to bring its intellectual property laws in compliance with the TRIPS agreement and adhere to WTO standards, has increased the world's confidence in Thailand's commitment to justice. International investors and developed countries are also impressed with the country's new legal body and see the Court's success as linked to a brighter economic future for Thailand.

Note: Statistics were obtained from the IP&IT Court.

BOARD OF TRADEMARKS DECISIONS: NEW TREND

Until the first quarter of the year 2000, decisions of the Board of Trademarks followed a more or less predictable pattern. However, since the early part of 2000, when new faces appeared on the Board to replace some members whose tenure had ended, a new trend has emerged in the decisions made by the Board.

Take, for example, the prevalent practice of the Trademark Registrar to require, as a condition of registration, disclaimers from applicants to the exclusive right of use of a part, word, or device of a trademark which he considered non-distinctive under Section 17 of the Thai Trademark Act 1991. In past appeals, the Board either upheld the Registrar's decision or ruled in favor of the applicant. However, this has not been the case recently. In most of the appeals of this nature brought to it, the new Board has ruled that the particular mark was not registrable as a whole for the reason that the non-distinctive part of a mark should be considered an equally vital part of the mark. Hence, if a mark has a non-distinctive part, it is non-distinctive as a whole and should be rejected regardless of the Registrar's willingness to register the mark as long as his requirement was met. Based on the unfavorable decisions handed down by the Board recently, a trend can be seen among its members to consider future cases in the same manner, suggesting that appeals under these circumstances would be useless. The Board's decision would only turn out to be unfavorable, and a new application in an attempt to register the same mark would be difficult in view of the trend.

Moreover, the Board has the power to rule beyond the Registrar's initial rejection of a trademark, as in the case of the trademark BRITISH AMERICAN TOBACCO (word & device) filed by British American Tobacco. In the Registrar's opinion, the word group BRITISH AMERICAN TOBACCO must be disclaimed

under Section 17 of the Thai Trademark Act 1991 because it is a non-stylized juristic name. However, he considered the device in the mark to be a distinctive part. The applicant appealed to the old Board contesting the Registrar's requirement of a disclaimer. In its decision, the old Board stated that the mark BRITISH AMERICAN TOBACCO (word & device) is not registrable as a whole because the words BRITISH AMERICAN TOBACCO signify "tobacco belonging to the British and American people". As such, the mark is prohibited under Section 8 (12) of the Trademark Act 1991 and the decree issued by the Ministry of Commerce, Volume 11 (B.E. 2540). It is obvious that the Board paid no regard to the aspect of the mark being a non-stylized juristic name as initially raised by the Registrar.

Interestingly, the new Board recently rendered a decision related to the same mark, BRITISH AMERICAN TOBACCO (word & device), filed by the same applicant in a different class of goods, which was ultimately accepted for registration. The Registrar initially rejected the application on the basis that BRITISH AMERICAN TOBACCO is a non-stylized juristic name, and he asked the applicant to disclaim the words. The applicant appealed to the old Board at the time, which thereafter, issued an official notification stating that the mark BRITISH AMERICAN TOBACCO (word & device) was not registrable because the word group BRITISH AMERICAN TOBACCO, the vital part of the mark, means "tobacco belonging to the British and American people". When used with goods in Class 28, the mark was deemed to be misleading and would cause public confusion as to the origin and ownership of the goods. The old Board thus ruled that the mark was prohibited from registration

under Section 8(12) of the Thai Trademark Act 1991 and the decree issued by the Ministry of Commerce, Volume 11 (B.E. 2540). The old Board, at that time, however, decided to hold the application in abeyance and let the applicant file an explanatory letter within 60 days following the date of receipt of the official notification.

Based on our experience, applications rejected in this manner were always ultimately refused registration as a whole by the old Board. However, it was fortunate that the above case came under the consideration of the new Board. Consequently, upon the filing of the required explanatory letter, the new Board ultimately issued a ruling that even though BRITISH AMERICAN TOBACCO is the name of a juristic entity and not represented in a special or stylized design, the mark is combined with a device. The mark is thus considered to be a distinctive trademark under Section 7(1) of the Thai Trademark Act 1991. In addition, the evidence of use submitted by the applicant sufficiently proved that the trademark is widespread and well known to the extent that confusion as to the origin and ownership of the goods will not occur. The applicant's trademark is, therefore, not contrary to Section 8(12) in combination with the decree issued by the Ministry of Commerce, Volume 11 (B.E. 2540). The trademark BRITISH AMERICAN TOBACCO (word & device) is thus registrable under Section 6 of the said Act.

From the foregoing discussion, it can only be concluded that the new Board members do play an important role in influencing and deciding the outcome of appeals, which has given rise to this new trend.

by Supatra
Watanavorakitkul



Supatra Watanavorakitkul is a supervisor in the Pre-Litigation Section of the Intellectual Property Department.

Since new faces appeared on the Board to replace some members whose tenure had ended, a new trend has emerged in the decisions made by the Board.

PIRACY OR FAIR USE?

by Woranuch Periera and Kanokluck Boonsakulkit

Public Prosecutor
Office of the Attorney General (Plaintiff)

Prentice-Hall, Inc.;
The McGraw-Hill Companies, Inc.;
International Thompson Publishing, Inc. (Co-Plaintiffs)

VS

Mr. Somsak Thanasarnsenee (Defendant)



Woranuch Periera (top) and Kanokluck Boonsakulkit (bottom) are associates in the Intellectual Property Department.

The issue was whether or not the photocopy shop owner was eligible to raise exemption from copyright infringement on the grounds that the photocopied materials from his shop were used by students for educational purposes.

The Case

Under the Thai Copyright Act 1994 (the "Act"), infringement of copyrighted work arises from a reproduction, adaptation or dissemination to the public, of all or parts of another person's copyrighted work without permission from the owner. One is deemed to infringe upon a copyrighted work if he knows or should have known that the work is another person's copyrighted work and commits acts for profit including selling, possessing for sale, offering for sale, letting, or offering for lease such infringed work.

However, there are exemptions from copyright infringement under Section 32 paragraph 2(1) of the Act. These include the act of using copyrighted works for study or research when not motivated by profit.

In this case, the Intellectual Property and International Trade Court (IP&IT Court) was faced with the issue of whether or not the Defendant, a photocopy shop, was eligible to raise the same exemption from copyright infringement on the grounds that the photocopied materials from his shop were used by students for educational purposes.

The Facts

The co-plaintiffs are publishers enrolled with the Association of American Publishers and are the owners of the copyrighted textbooks in this case. The Defendant carries on a photocopying and bookbinding business at his shop located near a Bangkok university. Most of his customers are students and lecturers from this university.

As the US and Thailand are contracting parties to the international convention governing copyrights, Thailand is, therefore, committed to grant protection to all American copyrighted works. The plaintiff claimed that the co-plaintiffs are the copyright owners of the textbooks, which are copyrighted works under US law. Accordingly, the co-plaintiffs are entitled to claim the rights provided under the Thai Copyright Act.

The plaintiff alleged that the defendant committed an infringement against the co-plaintiffs' copyrighted works by making reproductions by photocopier of original editions

of the copyrighted works without legal authorization from the owners and offering for sale to the public such reproductions, which is deemed to be a profit-seeking activity.

The defendant denied the charge and gave a verbal statement that his copying of the co-plaintiffs' copyrighted works was done under orders of students, who can rely on exemption from copyright infringement. The defendant argued that his activity should also be exempted from copyright infringement since he performed the activities for students who would use the copied textbooks for education.

As the defendant raised exemption from infringement as a defense, the IP&IT Court viewed that pursuant to Section 32 paragraph 2(1) of the Copyright Act concerning exceptions to infringement in case of study or research, three elements should be considered: (1) whether such act neither conflicts with the normal exploitation of the work nor unreasonably prejudices the lawful rights of the owner; (2) whether such act is a research or study of the work; and (3) whether the act is not for profit.

With regard to the first element, the IP&IT Court held that making of photocopies of books must be in part as instructed by the lecturers and by the students. In addition, the Court ruled that as students hire photocopy shops to make photocopies on their behalf, such photocopy shops should also be able to rely on the same exemption from copyright infringement as the students.

Under the law, if the defendant raises exemption from infringement as a defense, he has the duty to adduce evidence to prove his claim. However, in this particular case, the defendant had no evidence to prove that students instructed or ordered or hired him to make photocopies of the copyrighted works for use in study or research.

After hearing the testimony and evidence, the IP&IT Court concluded that the defendant made photocopies on his own initiative rather than under the instruction of students. The Court, therefore, ruled that the defendant could not avail himself of the exemption that educational photocopying does not constitute copyright infringement because he acted with his own business interests in mind.

The plaintiff requested the IP&IT Court to order the confiscation of the defendant's copying machines, which were the instruments used in

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THE CONTROL OF THE MANUFACTURING OF CD BILL

by Darai Suvarnajata



Darai Suvarnajata is an associate in the Intellectual Property Department.

The Control of the Manufacturing of CD Bill ("the Bill") is a new mechanism intended to better combat CD piracy in Thailand. Despite the Copyright Act of 1994 and other relevant laws which provide penalties for copyright infringement, the number of pirated CDs has increased tremendously in the past few years, causing more damage not only to copyright owners but also to the Thai economy.

The idea of CD manufacturing control was introduced in hopes of enhancing the ability of the government and other parties concerned to combat the manufacture of pirated CDs in the country. The Drafting Committee, which was appointed by the Minister of Commerce, consists of representatives from both the government sector, including the Department of Intellectual Property (DIP), the Intellectual Property and International Trade Court, the Royal Thai Police, and the Office of the Intellectual Property and International Trade Litigation, and the private sector, including companies in

the motion picture, sound recording and software industries. The Drafting Committee used the laws of Hong Kong and Malaysia as guidelines in drafting the Bill.

In addition to combating CD piracy, it is hoped that the Bill, when passed into law, will encourage local CD manufacturers to do business lawfully as well as enable the State to have full control of the collection of customs and revenues. The Bill provides high fines and imprisonment for violations.

Under the Draft Bill, CD manufacturers must comply with the following principal requirements:

1. Obtain a license to manufacture CDs from the Director-General of the DIP prior to manufacturing.
2. Obtain permission to import into Thailand machinery and devices for use in the manufacture of CDs from the Director-General of the DIP prior to importation.
3. Obtain prior permission from the Director-General of the DIP for

the removal of machinery and devices (imported with approval) from the place of business shown on the license. In case of sale, transfer or disposal of the machinery and devices, the registered manufacturer is required to report the transaction to the Director-General of the DIP within a specified period.

4. Display the serial numbers of CDs on the die and on the CDs manufactured in the place of business as shown on the license.

5. Report the quantity of imported or ordered raw materials for use in the manufacture of CDs and the storage place thereof, as well as the quantity of CDs manufactured in the place of business as shown on the license to the Director-General of the DIP.

The Bill is currently being drafted by the Drafting Committee. It is anticipated that the new law will be implemented by the end of the year or early next year.

DOMAIN NAME REGISTRATION IN THAILAND

by Suradej Saengpetch



Suradej Saengpetch is an associate in the Intellectual Property Department.

Thailand Network Information Center ("THNIC"), the local registry of domain names, has authority over the registration of country-code Top Level Domain Names (ccTLDs). There are currently seven categories of domain names available at THNIC:

.co.th: for commercial entities and business entities. This category is similar to .com.

.ac.th: for academic institutions. Applicants must be educational institutions registered within Thailand.

.go.th: for government use, such as ministries or agencies of the government. Applicants must be members of the Royal Thai Government.

.net.th: for Internet or network service providers. Applicants are required to obtain a verification from the Communications Authority of Thailand (CAT).

.or.th: for non-profit organizations.

.mi.th: for military use.

.in.th: for individuals/corporations.

THNIC requires overseas companies wishing to register a domain name in Thailand to have a local representative in Thailand. The local representative must be a registered entity (a company, a current representative office, or a branch office) which has the same name as the company seeking to register a domain name. Each company can apply for only one domain name registration for all the above domain names (except .in.th, as explained below) and must adhere to the requirements below.

In order for an overseas company to obtain a domain name registration, the local representative must provide THNIC with a written authorization from an overseas company

indicating that it may register a domain name on behalf of the overseas company, as well as provide details of the registration of the local representative. In addition, **the chosen name must be the same or closely similar to the company name.** If an abbreviation is used, it must be an appropriate abbreviation of the company name.

The local representative must also provide THNIC with three representatives/contacts in order to register a domain name, namely:

- **An administrative contact.** The administrative contact must be an employee of the organization requesting the domain name who can speak on behalf of the organization regarding the use of the domain name. He/she should also be able to answer non-technical questions about the organization's plans for the name and procedures for establishing sub-domains.

- **A billing contact.** The billing contact must be a person in Thailand, or as long as the administrative contact is in Thailand, he/she may also serve as the billing contact.

- **A technical contact.** The Internet Service Provider (ISP) often performs this role. The administrative contact and the technical contact must NOT be the same person.

THNIC recently set up a new secondary level domain name under .th for individuals or corporations which is in **.in.th**. While a domain name registered under **.in.th** has less commercial value in the Internet business than a domain name registered under **.co.th**,

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THE PROTECTION OF INTEGRATED CIRCUIT DESIGNS ACT B.E. 2543

by Geraldine Tracy, Sunee Osatarayakul and Sasima Tinirut

Thailand recently adopted a new legislation called "The Act on the Protection of Integrated Circuit Designs B.E. 2543" which will come into force on August 10, 2000. The protection of integrated circuit designs is being introduced in Thailand due to the country's strong commitment to the TRIPs Agreement and policy promoting technological transfer and development.

Pursuant to the Act, an integrated circuit is defined as a "product, finished or semi-finished and intended to perform an electronic function, consisting of components capable of activating electronic impulses, including parts connecting those components wholly or in part, which are combined together in a layer formation in and/or on the same semiconductor". A circuit design is a "design, layout or diagram made out in any form or manner that shows the arrangement of an integrated circuit".

The protection is provided for circuit designs that are not commonplace in the integrated circuit industry and for circuit designs newly created through the rearrangement of the components and connecting parts of circuit designs or integrated circuits that are commonplace in the integrated circuit industry, resulting in a form of circuit design that is not commonplace.

A circuit designer, an official or employee who has created a circuit design has the right to apply for protection provided by this Act. However, if a circuit design is created under an employment contract, the

employer is entitled to apply for protection. A government agency, local government or state organization which is a juristic person is entitled to apply for protection of a circuit design created under a hire-of-work contract, made to order, or made under the supervision of such organization unless otherwise agreed in writing. If several persons have independently created identical circuit designs, the earlier applicant is entitled to the protection.

The Act requires the applicant for protection to be a Thai national or juristic person whose principal office is in Thailand, or a national of a country party to an international convention on the protection of integrated circuits to which Thailand belongs, or who is domiciled in or has an effective establishment for circuit design creation or production in Thailand or in a country party to an international convention as referenced above.

If the circuit design has been exploited commercially within or outside of Thailand, an application for registration must be filed within two years from the date commercial exploitation first took place. It should also be noted that circuit designs not commercially exploited within fifteen years from creation cannot be registered.

The right to a circuit design is protected once registration is granted and a certificate issued. The registration of a circuit design is valid for 10 years from the date of filing the

registration application or first date of commercial exploitation, whichever is earlier.

The right of the right-holder of a circuit design will expire if the right-holder renounces the right to the circuit design by surrendering his certificate of circuit design, or dies without leaving any heirs. An order of the Director-General or the Board, or a court judgment canceling the registration of the circuit design, will also result in the expiration of protection.

The right-holder has the exclusive right to reproduce, import, sell or distribute in any manner for commercial purposes his protected circuit design, an integrated circuit containing his protected circuit design, or a product incorporating such integrated circuit. However, reproduction for use in the course of evaluation, analysis, research or education, or reproduction for one's own benefit and not for commercial purposes, will not be held as an infringement of the right of the right-holder.

Under the Act, anyone reproducing a protected circuit design without the permission of the right-holder is liable to a fine from Baht 50,000 to Baht 500,000. Any infringer importing, selling or distributing for commercial purposes a circuit design is liable to a fine from Baht 20,000 to Baht 200,000. The court can also order the confiscation or destruction of all infringing circuit designs, integrated circuits and infringing products or take other action to prevent resale.



Geraldine Tracy (top photo) is a summer intern while Sunee Osatarayakul (middle photo) and Sasima Tinirut (bottom photo) are associates in the Intellectual Property Department.

Domain Names (continued from page 5)

it is, nonetheless, the only way for a company or individual that has a presence in Thailand to secure protection for more than one domain name. However, the requested domain name must not contradict the laws. For example, names of provinces and offensive words will not be accepted for registration.

An overseas company without local representatives in Thailand can request THNIC to register a domain name by reserving a domain name under **.in.th**. However, it should be noted that an overseas company that registers its domain name under this category may not use its domain name on the Internet. This category of domain name serves to provide an overseas company, which does not have any presence in Thailand, protection from others who may attempt to use the same name for the same category on the Internet. Moreover, while a registrant has to pay the same registration fees as those who register a domain name in other categories, domain names registered under **.in.th** by an overseas company that does not have any presence in Thailand will not be activated. In any event, should an overseas company wish to reserve

its domain name under this category, the most cost-effective way to initiate the registration process is to send a request directly to reserv@thnic.net.

The initial registration fee for a new domain name registration is Baht 1,500 (approx. US\$55) plus 7% Value Added Tax. This covers registration of one domain name for the first two years. There is a renewal fee of Baht 800 (approx. US\$28) plus 7% Value Added Tax every year after the first two years. It normally takes three working days to complete the registration procedures for each valid application.

If an overseas company would like its representative to apply for a domain name with THNIC, the representative may apply directly at: www.thnic.net/domain/domreg_manager.co.html for <.co.th>. www.thnic.net/domain/domreg_in.html for <.in.th>.

For more information regarding THNIC's policies and procedures concerning domain name registration, please visit THNIC's web site at <http://www.thnic.net/policy.html>.

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In addition, since the time he acquired registration of the disputed domain names, the Respondent has neither developed his web sites under those names nor made use of them in good faith. The domain names at issue are not, nor could they be construed as, the nickname of the Respondent or a member of his family or the name of a household pet, or in any other way identified with or related to any legitimate interest of the Respondent. The Respondent's unauthorized use of the Complainants' trade name and trademarks has infringed the Complainants' exclusive rights and caused injury to their trade name and trademarks. Such unauthorized use is intended to confuse the public into thinking that the domain names are those of the Complainants and clearly violates their lawful rights under the Thai Trademark Act, the Civil and Commercial Code and the Penal Code.

The Complainants requested the Administrative Panel appointed for the proceedings to rule that the domain names <jimthompsonhouse.com> and <jimthompsonhouse.org> be transferred to the 1st Complainant.

The Response

On June 17, 2000, the Respondent filed a response to the Center claiming, without any supporting evidence, that his family owned an exclusive hospitality business which it had been operating for the past 12

years. The business was in recognition of his mother's long-time mentor and best friend, Mr. Jim J. Thompson, a fact widely known to its customers. The Respondent claimed that he did not believe that <jimthompsonhouse.com> and <jimthompsonhouse.org> are confusingly similar to the Complainants' trademark or trade name since his business is totally different from that of the complainants. The Respondent further claimed that he was working on the web page under <jimthompsonhouse.com> and has no intention of selling or renting out the domain names. He plans to activate his web page by January 1, 2001.

The Outcome

After reviewing the complaint and the response, the Administrative Panel ruled in favor of the Complainants, stating that the grounds for the complaint were valid under the Policy, namely:

- (1) The Respondent's domain name <jimthompsonhouse.com> is identical or confusingly similar to the 2nd Complainant's trademark, and the Respondent's domain name <jimthompsonhouse.org> is identical or confusingly similar to the 1st Complainant's trade name.
- (2) The Respondent has no right or legitimate interest in the domain names.
- (3) The domain names were registered and are being used in bad faith.

In accordance with the Policy, the Panel issued its decision on July 10, 2000 ordering the transfer of the domain names <jimthompsonhouse.com> and <jimthompsonhouse.org> to the 1st Complainant.

Conclusion

The Complainants initiated the administrative proceeding with the Center out of a desire to utilize, as the rightful owners, their trade name and trademark as domain names by which they could promote and disseminate information about their businesses on the Internet. It was obvious that the Respondent registered the domain names in bad faith with the intention of profiting from his registration, but the Complainants nevertheless gave him the benefit of the doubt and made attempts to settle the dispute amicably. However, the Respondent rejected their attempts, thus the Complainants were left with no alternative but to initiate the administrative proceeding with WIPO.

As this administrative proceeding through the Center is the first ever initiated by Thai IP rights-holders against a Cybersquatter based on the ICANN Policy and Rules, the decision is of great interest and gives an indication to other Thai IP rights-owners of how well their rights will be protected in Cyberspace.

Piracy (continued from page 4)

committing the violation, and to impose severe punishment upon the defendant as infringement of foreign copyrighted works adversely affects international trade and relations.

The Court disagreed with the plaintiff on the confiscation order, explaining that the copying machines were not particularly intended for committing a copyright offense and that the defendant could still use them to copy documents under instructions from students or teachers for study or research, but not for commercial purposes.

As to the issue of imposing severe penalty on the defendant, the Court dismissed the charge, explaining that the co-plaintiffs, as the copyright owners, had no appointed representative in Thailand from whom permission to make copies of their copyrighted books could be sought. Thus, it was not possible for any Thai student or photocopy shop to ask for permission. In addition, the Court was of the opinion that the defendant should be given an opportunity to run a business in a lawful manner and to negotiate with the injured parties regarding the establishment of an organization that would handle the collection of royalties on copyrighted literary works for educational purposes. The Court, therefore, held that an imprisonment sentence was not suitable for the defendant and imposed only a

lenient fine since the injured parties were partly responsible for the damages arising from the offense.

The co-plaintiffs and the defendant appealed against the judgment of the IP&IT Court to the Supreme Court.

Held

The Supreme Court upheld the IP&IT Court's decision that the defendant had committed an offense, pointing out that he did not have sufficient evidence to prove that he had been hired by students to make photocopies of the copyrighted works. Therefore, the defendant was not entitled to claim exemption from copyright infringement based on Section 32 paragraph 2(1) of the Copyright Act.

With regard to the appeal of the co-plaintiffs for the confiscation of the four photocopiers based on Section 75 of the Copyright Act which reads, "...all articles used for committing a violation shall be forfeited", the Supreme Court was of the opinion that Section 75 of the Act is an undisputable legal enforcement mechanism. In this case, the co-plaintiffs were able to prove beyond a doubt that the photocopiers had been used in reproducing the copyrighted works, therefore, they must be forfeited according to Section 75 of the Act. The Supreme Court, therefore, reversed the judgment of the IP&IT regarding the confiscation of the defendant's copying machines.

TILLEKE & GIBBINS CELEBRATES ITS RANKING AS THE #1 INTELLECTUAL PROPERTY LAW FIRM IN THAILAND

Tilleke & Gibbins was voted as the "#1 Firm for Patent Work in Thailand" and the "#1 Firm for Trademark Work in Thailand" by IP practitioners around the world, according to the results of Managing Intellectual Property's Emerging Markets Survey 2000. To celebrate this double award, a distinction achieved for the first time in Thailand by a single law firm, the firm held a party on Wednesday, June 14, 2000 to thank clients and friends for their support. Over 300 guests attended the celebration at The Regent Bangkok's Ballroom, which was aptly decorated with colorful banners displaying the logos of well-known IP clients as well as interesting exhibits.



(From left): Mr. Narongchai Akrasanee (ex-Minister of Commerce), Mr. Aphisit Vejjajiva (Minister of the Prime Minister's Office), Ms. Say Sujintaya (Director of the firm's Intellectual Property Operations), Mr. Weerawit Weeraworawit (Deputy Director-General of the Department of Intellectual Property), Mr. Pramorn Sutivong (Chairman of BankThai) and Mr. David Lyman (the firm's Senior Partner).



Some of the distinguish clients who attended, Jim Thompson/Thai Silk Co.,Ltd. executives (from left): Mr. Eric Booth (Marketing Manager), Mr. Pichet Buranastidporn (Assistant to the Managing Director), Ms. Say Sujintaya, and Mr. William Mac Orr Booth (Managing Director).

Piracy (continued from page 7)

Comments

Based on the decisions of the Supreme Court and the IP&IT Court, the reproduction of copyrighted works for educational purposes under the context of Section 32 paragraph 2(1) of the Copyright Act should be limited to only a part of the books. We agree with the decision of the courts in this regard. If making photocopies of books within the context of Section 32 paragraph 2(1) means

unlimited reproduction, the copyright owner would incur severe losses in sales. And if unauthorized photocopying increases, books will become unsalable commodities or salable only to book collectors and lovers. As a result, the incentive to create textbooks will be gone, which eventually will have a negative impact not only on the educational system due to the lack of quality textbooks, but also on the economy and international trade relations.

Unfortunately, the Courts did not give clear guidelines on what constitutes limited reproduction within the context of Section 32 paragraph 2(1). The IP&IT Court merely mentioned that the determination of whether copying for study or research conflicts with the normal exploitation of an owner's work and unreasonably prejudices that lawful right will be done on a case-by-case basis based on the quality and quantity of reproduction.

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