

# Thailand: IP Developments

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## LEGAL REMEDIES FOR TRADE NAME INFRINGEMENT

by Parichart Monaiyakul and Srila Thongklang



Left: Parichart Monaiyakul, Attorney-at-Law  
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Intellectual Property

Reputable companies often face difficulties when parasitic third parties attempt to derive benefit from a famous trademark when registering their company names. In Thailand, this is a serious concern because the registration system within the Department of Business Development at the Ministry of Commerce does not include a process for determining whether a new company name is similar to trademarks which have been registered with the Department of Intellectual Property. Most commonly, these disputes arise when a company registers a name which appropriates the essential element of a famous trademark, and then includes additional secondary elements, such as a reference to the nature of its business. Once such a name has been registered, it can only be challenged by the rightful owner of the trademark through litigation. The case study presented below involves a dispute based on the infringement of a trade name and trademark, thus providing a worthwhile overview of the remedies available to commercial entities which face problems with such free riders.

Universal City Studios Inc. (Universal), the famous American production company, became involved in a dispute with a Thai company operating under the name of Universal Pictures (Thailand) Co., Ltd. (UPT) and its director, Mr. Sahawat Katapitak, based on their use of the word "Universal" as the essential part of their company name and trademark. In 2002, UPT filed an application to register "Universal Pictures (Thailand) Co., Ltd." as its company name with the Department of Business Development for the purpose of producing and distributing CDs, VCDs, SVCDs, DVDs, and related equipment. Mr. Katapitak filed an application to register the trademark UPT UNIVERSAL PICTURES (THAILAND) CO., LTD. under Application No. 481081 for the goods Super VCDs in Class 9.

### IP&IT Court Decision

When it became aware of these activities, Universal filed a complaint on July 31, 2003 against UPT and Mr. Katapitak based on the use of a name similar to Universal's

well-known trade name and trademarks UNIVERSAL and UNIVERSAL PICTURES. In its complaint, Universal requested that the IP&IT Court order the following remedies:

1. UPT shall withdraw or change its company name;
2. Mr. Katapitak shall withdraw the trademark application for UPT UNIVERSAL PICTURES (THAILAND) CO., LTD.;
3. UPT and Mr. Katapitak shall be prohibited from using UNIVERSAL and UNIVERSAL PICTURES (both in Thai and English) in their commercial activities; and
4. UPT and Mr. Katapitak shall pay compensation to Universal in the amount of THB 200,000 per month from the date of filing the complaint until both defendants withdraw or change the name and trademark and cease the infringement of Universal's trademark and trade name.

In considering the case, the IP&IT Court rejected most of the defenses that were presented by UPT and Mr. Katapitak. The defendants stated that "universal" and "pictures" were general words and should thus be available to be used by any party. The Court rejected this argument because it was of the opinion that the defendants used these two words together in order to make the public understand that UPT was related to Universal in Thailand. The defendants further claimed that Universal had not yet registered "Universal Pictures" as its company name in Thailand, based upon which Universal should not be entitled to request that UPT change its name. The Court held that this lack of registration did not mean that UPT had the lawful right to the use of such name. Further, UPT was in the business of selling Super VCD products, some of which were movies produced by Universal. Thus, it can be concluded that UPT was aware of the existence of Universal's name. Universal therefore had the better right to UNIVERSAL PICTURES and had the right to prohibit UPT from using UNIVERSAL PICTURES as its company name according to Section 18 of the Civil and Commercial Code.

**Section 18.** *If the right to the use of a name by a person entitled to it is disputed by another, or if the interest of the person*

*entitled is injured by the fact that another uses the same name without authority, then the person entitled may demand from the other abatement of the injury. If a continuance of the injury is to be apprehended, he may apply for an injunction.*

Having established that Universal had a better right to the name, the Court turned its attention to Universal's request for withdrawal of Mr. Katapitak's trademark application. The IP&IT Court informed Universal that it had the right to file an opposition against this application with the Department of Intellectual Property. The filing of a trademark application according to the procedure did not constitute infringement of Universal's rights. There was therefore no basis to mandate that Mr. Katapitak must withdraw his trademark application. (It should be noted that, apart from the subject civil suit, Universal was separately pursuing opposition proceedings against this mark.)

With respect to the compensation, the Court found that Universal did not clearly prove the damages in the amount of THB 200,000 per month. Thus, the Court awarded compensation in the amount of THB 5,000 per month until UPT changed its name. In addition, the Court ordered the defendants to pay attorney's fees to the plaintiff in the amount of THB 2,000.

### Supreme Court Decision

In response to the first-instance court's decision which was mainly in favor of Universal, the defendants filed an appeal to the Supreme Court. The Supreme Court agreed with the IP&IT Court that Universal, as the owner of the trade name and trademark, had the right to prohibit other parties from using UNIVERSAL PICTURES in bad faith in such a way that may cause the public to be unable to distinguish the entity or the owner of goods/service and may cause confusion amongst the public. However, the Supreme Court ruled that

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## LASERJET DEEMED DISTINCTIVE IN THAILAND

by Nuttaphol Arammuang



Nuttaphol Arammuang, Attorney-at-Law  
Intellectual Property

A recent Supreme Court decision, *Hewlett-Packard Company v. The Department of Intellectual Property*, provides important insight into the concept of “distinctiveness through use” or “secondary meaning” under the Thai trademark practice. This case, which focuses on the distinctiveness of Hewlett-Packard’s LASERJET trademark, is illustrative of the different perspectives used by the Department of Intellectual Property (DIP), the Central Intellectual Property and International Trade Court (IP&IT Court), and the Supreme Court in interpreting the notion of distinctiveness under Section 7 of the Thai Trademark Act.

Section 7 of the Act stipulates a fundamental condition for trademark registration. It holds that a “distinctive” trademark must allow the general public or consumers to understand that the goods bearing the mark are different from the goods of other parties (which can be referred to as inherent distinctiveness). The second paragraph of this provision then lists a number of essential elements that constitute distinctiveness, including the requirement that the mark must not directly refer to the character or quality of the goods. In the third paragraph of Section 7, an exception is made under which a mark that would normally be viewed as non-distinctive (and thus unregistrable) can nevertheless be deemed to be distinctive if it has been widely distributed or extensively used. Further to claiming that their trademarks themselves are inherently distinctive (e.g., a fanciful and unusual combination) under paragraphs 1 and 2 of Section 7, trademark owners generally submit evidence of use to the authorities to prove the distinctiveness through use under paragraph 3 at the same time. The following case study offers different perspectives on both the concept of inherent distinctiveness and the evidence required to demonstrate distinctiveness through use.

In 2001, Hewlett-Packard filed Trademark Application No. 464131 for registration of the mark LASERJET with the DIP for the goods “toner cartridges for photocopiers and printers” in Class 2. The Registrar rejected the application by reasoning that the trademark LASERJET means “to spout liquid,” which makes direct reference to the character and quality of the goods. Thus, the mark was determined to be non-distinctive and non-registrable. Hewlett-Packard filed an appeal petition against the Registrar’s order with the Board of Trademarks. The Board, however, affirmed the Registrar’s order and dismissed the disputed application.

Hewlett-Packard then filed a civil suit against the DIP with the IP&IT Court in an attempt to overturn the Board’s decision. Hewlett-Packard insisted that the trademark LASERJET is an inherently distinctive trademark because the mark is a fanciful and unusual combination with no meaning. In addition, Hewlett-Packard believed that the mark had been used widely in Thailand and other countries for a long time, and thus, had achieved distinctiveness through use. More than 30 boxes of documentary evidence were presented to the Court during the trial to support this fact, including the following key documents and evidence:

1. Samples, pictures, and packaging of the toner cartridges bearing the trademark LASERJET;

2. Advertising materials, news articles, Web sites, online discussion forums, and several IT magazines providing information regarding the plaintiff’s products bearing the trademark LASERJET in Thailand (initiated by Hewlett-Packard and the public);

3. Invoices and other sales documents demonstrating the sales figures and prices of the plaintiff’s products (more than 20 boxes);

4. Certificates of trademark registration of the plaintiff’s trademark in other countries;

5. Affidavit or written statement of the authorized person of the plaintiff providing the history of the company and trademark; and

6. Four computer dictionaries providing definitions of the word LASERJET.

On August 31, 2004, the IP&IT Court rendered its judgment dismissing the Registrar’s order and the Board’s decision. The IP&IT Court viewed that the trademark LASERJET itself was sufficiently distinctive to be registered for the goods in Class 2. The Court considered that although the trademark LASERJET could imply the definition “to spout liquid” and liquid is the form of the ink, such meaning is not “an exclusive meaning” of the mark. In addition, there are several forms and types of ink, including powder. In conclusion, the IP&IT Court ruled that the mark LASERJET did not directly refer to the quality and character of the goods sought for registration and, thus, was an inherently distinctive mark. The DIP, as the defendant, disagreed with the IP&IT Court’s decision and filed an appeal petition with the Supreme Court.

On November 17, 2008, the Supreme Court rendered its judgment affirming that the trademark LASERJET was registrable. The Supreme Court, however, exercised a

different view in considering the case. Instead of agreeing with the IP&IT Court’s finding that the disputed trademark was inherently distinctive under Section 7 paragraph 1, the Supreme Court relied on the same reasoning as the Registrar and the Board in determining that the trademark LASERJET itself was non-distinctive based on its consideration that the trademark LASERJET means “to spout liquid.” Thus, the Court concluded that the trademark LASERJET was not an inherently distinctive trademark under Section 7 paragraph 1 and paragraph 2 of the Trademark Act. In light of this, the Court also considered the issue of whether the plaintiff’s trademark had obtained distinctiveness through use under Section 7 paragraph 3.

The Court found that the plaintiff adduced evidence and witness testimony including the testimony of the plaintiff’s subsidiary that the printers and toner cartridges incorporating the trademark LASERJET had been widely known in Thailand for an extended period of time (more than 10 years). Moreover, these products were widely distributed from the plaintiff’s subsidiary to various wholesalers and retailers. The products incorporating the trademark LASERJET generated income for the plaintiff’s subsidiary in the amount of several million baht each year and such products achieved market share of more than 50 percent. The plaintiff’s annual budget was approximately THB 50 million for advertisement and promotion, through many channels, of its products relating to printer ink. Furthermore, in the market, no other business operators use the trademark LASERJET with printers and printer ink.

Several computer dictionaries as submitted by the plaintiff were important in the Supreme Court’s decision. The dictionaries recognized and defined that LASERJET is a trademark used by the plaintiff with printers. For example, *Prentice Hall’s Illustrated Dictionary of Computing*, Second Edition, states that “HP LaserJet” means “a trademark of Hewlett-Packard, assigned to its range of laser printers, first introduced in 1984 with one built-in font (Courier) offering a resolution of 300 dots per inch.”

Hence, the Supreme Court found that the plaintiff had widely used the trademark LASERJET with its products, including printers and toner cartridges, and widely sold these products for a substantial period of time to the extent that the Thai public can

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## GLOBAL PATENT EXAMINATION STILL CONCEPTUALIZED

by Radeemada Mungkarndee



Radeemada Mungkarndee, Patent Agent  
Intellectual Property

The twenty-first century is an era of rapid change driven by human creativity in developing new technology. A patent is a means to protect the fruits of this technological revolution. A patent cannot claim an exclusive right for something that previously exists, nor can it claim something obvious. To determine these conditions, patent examination involves looking for *prior art*: earlier publications that show the technology is not new or is obvious. Prior art is interpreted differently in different jurisdictions. For example, in the United States, the first-to-invent system prevails. Consequently, there is a one-year grace period during which publications by the inventor will not undermine patentability. Of course, this principle has inevitable consequences in countries which do not apply the same principle, where prior art is determined from the filing date of the patent.

Since Thailand uses a first-to-file system, no matter which invention is firstly developed, a patent will only be granted to

the party who files a patent application first. Therefore, the filing date of the patent is absolutely critical. If the applicant files a patent application in a foreign country, he is entitled to file the application in Thailand within twelve months from such first foreign filing date. Then, the date of the first application in the foreign country is treated as the filing date in Thailand based on a priority claim. Any publication disclosed between the filing date in the first country and in Thailand will not be counted as prior art of the application. However, if the applicant failed to claim the priority date in the first country or does not have a valid right to do so, the filing date would be deemed to be the date of the application filed in Thailand and any publication during such an interim period would immediately be treated as the prior art.

In general, an examination result obtained in one country should be deemed as valid in other countries for the same technology. Many countries have included this principle in their patent laws. In this

regard, Section 25 of the Thai Patent Act states that, to facilitate the examination of a patent application, an examination done by any foreign or international patent office or organization may be treated as having been done by the competent officer. However, the same invention has to go through substantive examination separately on a country-by-country basis. Each country has a different approach to what the examination entails and whether or not the requirements of patentability have been met. Therefore, an application which has already been granted in another country may not necessarily be patentable in Thailand. The case described below provides an illustration of how country-by-country examination differences can impact a patent application.

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### TRADE NAME INFRINGEMENT (from page 1)

the IP&IT Court decision ordering UPT to change its name by prohibiting the use of UNIVERSAL PICTURES was legally incorrect. In referring to Section 18 of the Civil and Commercial Code, the Supreme Court held that Universal only had the right to request that the Court prohibit UPT from using UNIVERSAL PICTURES as part of its juristic name. Section 18 does not grant Universal the right to force UPT to change its name. The Supreme Court found that this was an issue of law which involved the public order. On this basis, the Supreme Court had the discretion to consider this matter even though none of the parties to the case raised this issue.

The Supreme Court overturned the IP&IT Court decision ordering the change of name. Rather than *change* its name, the

Court ordered that UPT must *cease using* UNIVERSAL PICTURES (both in Thai and English) as part of its name and trademark. Both defendants must pay compensation to Universal in the amount of THB 5,000 per month from the date of filing the complaint (July 31, 2003) until UPT ceases using UNIVERSAL PICTURES as part of its name. Since this decision was issued in December 2008, the total damages awarded to Universal amounted to THB 325,000 (USD 9,750).

### Conclusion

Ultimately, the Supreme Court clarified the remedies available to the owners of famous names under the broad wording of Section 18. Whereas the first-instance decision had ordered that the name shall be changed, the Supreme Court limited the remedy by ordering that the use of the

name shall cease. Nevertheless, the result of the judgment reached the same conclusion: the defendants were required to stop using the disputed words with their trade name. Although the compensation in this case is notable, this can be attributed primarily to the fact that the defendants failed to cease using the disputed name while the appeal to the Supreme Court was ongoing. In reality, the damages of only THB 5,000 represent a rather limited amount. This once again reinforces the fact that compensation in Thailand is generally determined only by the actual proven damages, which are very difficult to demonstrate. In this case, the Court found that the plaintiff was unable to prove the actual damages, and the Court therefore ordered an amount of compensation which it deemed appropriate, although this amount was quite minimal. ♦

### LASERJET (from page 2)

differentiate the plaintiff's printer ink from the printer ink of other manufacturers. The trademark LASERJET had achieved distinctiveness through use in accordance with the Trademark Act 1991 Section 7 paragraph 3. The Supreme Court therefore overturned the Registrar's order and the Board of Trademarks' decision and ordered the DIP to proceed with registration of Hewlett-Packard's trademark LASERJET.

This judgment demonstrates the

Supreme Court's view in interpreting the meaning of a trademark. When compared to the IP&IT Court, the Supreme Court employs a more conservative approach in considering this issue. In this case, the Supreme Court applied the same opinion in analyzing the meaning of the mark as earlier used by the Registrar and the Board of Trademarks. However, the Supreme Court provided more emphasis on the criteria in considering whether the trademark had achieved distinctiveness through use under Section 7 paragraph 3. Hewlett-Packard

presented a large volume of evidence of use to the Court in this case. From this, it can be concluded that when a trademark owner is interested in registering a trademark that may potentially be rejected based on lack of distinctiveness under Section 7 paragraph 1, it is important to have a substantial amount of evidence of use to prove that the mark has gained distinctiveness through its wide distribution and extensive use. The Hewlett-Packard case provides significant guidelines regarding how to achieve this goal. ♦

## THE EFFECT OF ASEAN HARMONIZATION ON PHARMACEUTICAL REGISTRATION

by Mallika Veravithayanan and Paul Russell



Left: Mallika Veravithayanan, Manager  
Right: Paul Russell, Of Counsel & Director  
Regulatory Affairs

After two years of postponement, the Thai Food and Drug Administration (FDA) has announced the implementation of ASEAN Harmonization on Pharmaceutical Registration effective January 1, 2009. This represents a significant change in the Thai FDA's history of the registration of pharmaceutical products.

The ASEAN members have implemented, through their Pharmaceutical Product Working Group, the ASEAN Common Technical Requirements and Dossier (ACTR/ACTD) on Quality, Safety and Efficacy, which provide guidelines on analytical and process validation, stability studies, and bioavailability/bioequivalence (BA/BE). The ACTR is a set of written materials that serves as a guide for applicants when preparing their application dossiers. The ACTD is a part of the marketing authorization application dossier, which is common to all ASEAN member countries. These guidelines are compliant with the minimum standards set forth within the ICH guidelines. The ACTD includes a Common Technical Document, which is organized into four main parts:

Part 1: Administrative Data and Product Information;

Part 2: Quality (Overall Summary and Reports);

Part 3: Nonclinical/Safety (Summary

and Study Reports);

Part 4: Clinical/Efficacy (Overview, Summary, Assessment Reports, and Study Reports).

The first part of the document shall include the administrative data and general product information, such as application forms, labels, package inserts, modes of action, and side effects.

The Quality Document will contain the quality control information on both the drug substance and the drug product (e.g., the general information, characterization, control, stability, container, etc., of the drug substance; the description, composition, and manufacture of the drug product; the control of the finished product; the interchangeability/equivalence evidence of the product; etc.).

The Nonclinical Document will include the data on pharmacology, toxicology, pharmacokinetics, local tolerance, other toxicity studies, and the list of the key literature references.

Finally, the Clinical Documents will consist of the clinical overview and the clinical summary. More specifically, it will contain the BA/BE and other pertinent studies, efficacy and safety, post-marketing data (if available), and references.

The new ASEAN Harmonization rules will have a substantial impact on those

who register pharmaceutical products at the Thai FDA. Local manufacturers and generic drug companies will be the most affected by ASEAN Harmonization because their dossiers/documents have not been prepared in accordance with ICH guidelines. They will now have to prepare more new forms, request from their customers more details for every part specified in the ASEAN Harmonization guidelines, and conduct more searches from websites and pharmacopoeia for all the new information which is now required.

Multinational companies, in contrast, will be less affected by the implementation of ASEAN Harmonization because they are already accustomed to preparing their dossiers/documents in compliance with ICH guidelines.

Since ASEAN Harmonization is new to all concerned with regulatory work, FDA officers, and even the experts who read the files, a longer lead time will now be required in obtaining the approval of the registration of pharmaceutical products. Due to these new requirements, Regulatory Affairs specialists will need to ensure that all files are thoroughly prepared prior to submission to the FDA. ♦

### GLOBAL PATENT (from page 3)

An application for an invention patent, designated as Application No. 031087, entitled "Pipe of polyethylene having improved mechanical properties" was filed in Thailand on April 26, 1996, without claiming priority to the first filing date, April 28, 1995, in Germany. According to this application, high-strength pipe of ethylene polymer can be obtained if the ethylene polymer material can be prepared according to the method disclosed in WO 91/18934. As a result of the lack of priority claim, any invention that was disclosed before April 26, 1996 would be considered as prior art of this application.

On May 27, 1998, three parties filed oppositions against this application based on different technical and legal grounds focusing on the argument that the claim and the detailed description are not consistent, as well as the contentions that the application lacks enablement of disclosure, novelty, and inventiveness.

The Director-General ruled that the relevant prior art did not disclose the preparation of polyethylene having a

density and a melt flow index as specified in the application and/or the production of a pipe made from polyethylene having said properties. However, the relevant prior art showed that the improved mechanical properties of the pipe depend on the properties of polyethylene material, not on the preparation process thereof. The Director-General thus ruled that the invention was obvious to a person skilled in the art and has no inventiveness.

On April 5, 2006, the applicant filed an appeal petition with the Board of Patents against the Director-General's decision by explaining that the invention related not only to the polymer compositions, but also to "pipe" having the improved mechanical properties. The knowledge of combination between low molecular weight of homopolymer and high molecular weight of copolymer had never been disclosed. There was no prior art demonstrating the improvement of mechanical resistance, especially in terms of stress cracking stability. Additionally, since this invention had been examined and granted a patent in the U.S., the American application was deemed to have inventiveness.

The Board of Patents weighed these arguments and ultimately ruled on the same ground as the Director-General's decision that the invention was not widely known or used in Thailand, or not described in a document or printed publication in Thailand or a foreign country. Nevertheless, this invention was obvious to a person ordinarily skilled in the subject. As such, the Board of Patents held that the invention lacked inventiveness and was not patentable.

In filing an application in Thailand or any other countries, a patent owner should be aware that a patent which has been granted in the U.S., for example, does not provide absolute assurance that an equivalent application for the same patent will be granted in another country. Not only the rules regarding prior art, but also the examination system itself can differ and lead to discrepancies in the examination results. It is therefore necessary to analyze the patent application according to each country's patent examination system in order to avoid the possibility of rejection of a patent already granted in another country. ♦

## NEW DEFINITION OF CONTROLLED COSMETICS WILL CHANGE THE BEAUTY INDUSTRY

by Areeya Ratanayu and Pairoj Osatapirat



Left: Areeya Ratanayu, Consultant, Intellectual Property  
Right: Pairoj Osatapirat, Consultant, Regulatory Affairs

It is generally known to practitioners in the cosmetics industry that the Thai Cosmetic Act requires registration of *specialty controlled cosmetics* prior to an act of manufacture, sale, or import. Similarly, any business operator who wishes to manufacture or import *controlled cosmetics* must notify the Thai Food and Drug Administration (FDA) of the required information according to the law. *General cosmetics*, meaning those which neither contain controlled or specialty controlled substances nor qualify as *specialty controlled cosmetics* or *controlled cosmetics* by way of Ministry Announcement, have traditionally been subject to lenient requirements such as label control prior to marketing activity.

The foregoing practice changed when the Ministry of Public Health (MoPH) issued an Announcement regarding the Definition of Controlled Cosmetics on July 8, 2008. Published on September 25, 2008 in the *Royal Gazette*, the law became effective on the day after publication, i.e. September 26, 2008. This recently issued MoPH Announcement, on one hand, will no longer provide leniency to *general cosmetics* manufacturers and importers. On the other hand, this Announcement will

relieve the burdens that had previously been placed upon the manufacturers and importers of *specialty controlled cosmetics*.

According to the Announcement, all cosmetics are now categorized as *controlled cosmetics*. Manufacturers and importers of *general cosmetics* and *specialty controlled cosmetics* are now subject to the same regulatory compliance as manufacturers and importers of *controlled cosmetics*. This means that submission of notification to the FDA prior to the initiation of marketing or manufacturing activity is required.

The obligation for the importers and manufacturers of *specialty controlled cosmetics* to register their products prior to marketing activities will no longer exist. To meet the FDA's compliance requirement, *specialty controlled cosmetics* (which are now treated as *controlled cosmetics*) are merely required to file a notification to the FDA before manufacturing or selling.

To provide notification regarding *controlled cosmetics* with the Thai FDA, the following information is required:

1. Registered business name and address of office and storage place of manufacturer or importer;

2. Name, category, or kind of cosmetics to be manufactured or imported;
3. Details of all ingredients; and
4. Product label.

The FDA allows approximately two years of adjustment period for the industry. Manufacturers and importers of *general cosmetics* (which are now categorized as *controlled cosmetics*) must comply with these requirements and notify the FDA of their products by December 31, 2010. Within the same time frame, the manufacturers and importers of both *specialty controlled* and *controlled cosmetics* must adjust their labels to comply with the *controlled cosmetics* standard.

The changes in the product registration procedure being implemented by the FDA are the result of ASEAN Harmonized Cosmetic Regulatory Scheme whereby the requirements or procedures shall be reduced to the simplest form, lessening the FDA's role in pre-marketing control. Under the ASEAN Harmonized Cosmetic Regulatory Scheme, the FDA will focus on a post-marketing surveillance system. ♦

## RAID SEIZURES OF AUTO PARTS AND ALLOY WHEELS BY DAIMLER AG

by Titirat Wattanachewanopakorn



Titirat Wattanachewanopakorn, Attorney-at-Law  
Intellectual Property

The increasing volume of counterfeit automotive components and accessories in the Thai market has raised concerns among many companies in recent years. Many Tilleke & Gibbins clients now clearly recognize that appropriate enforcement measures are not optional; they are a necessity. Such actions allow automotive companies not only to secure their intellectual property rights, but also to ensure the safety of their loyal customers.



In mid-2008, Daimler AG found that counterfeit spare parts and accessories, especially alloy wheels, were being openly displayed and offered for sale on some Web sites and in shops in Bangkok. A series of market surveys and in-depth investigations were then conducted in order to reveal the identity of the illegal business operators and collect evidence to pursue legal actions.

After months of strategic planning and preparation, successful police raids were carried out against three targets in Bangkok in October 2008. As a result, alloy wheels and accessories bearing "Mercedes-Benz" and "Three-Pointed Star" trademarks were seized representing a value of over THB 500,000.

In order to ensure that these wrongful traders will not repeat these activities, Daimler AG was committed to pursuing all available legal remedies.

While the criminal cases were proceeding, Tilleke & Gibbins was instructed to concurrently commence civil suits against all three targets, each of which was eventually concluded with favorable settlement results for Daimler AG.

The news about these raids spread quickly in the automotive industry in Thailand. The results were readily apparent as many shops immediately removed the infringing products from their shelves and online catalogs. While the possibility exists that the disappearance of these counterfeit products from the market may only be temporary, Daimler AG and Tilleke & Gibbins are well prepared with proactive and creative solutions in order to handle any future challenges. ♦

## TILLEKE & GIBBINS' SEMINARS AND COLLABORATIVE EFFORTS WITH GOVERNMENT OFFICIALS

by Titirat Wattanachewanopakorn and Sukontip Jitmongkolthong

In the last quarter of 2008, Tilleke & Gibbins lawyers organized a total of eight

training sessions for Customs and police on behalf of several reputable IP owners.



The main objectives of these seminars were to educate the officers with some basic information regarding how to detect the shipments and identify counterfeit products, and to strengthen the collaborative efforts with the government sector to combat counterfeit products in the future. The training sessions were attended by over 300 officers including Economic and

Left: Titirat Wattanachewanopakorn, Attorney-at-Law  
Right: Sukontip Jitmongkolthong, Attorney-at-Law  
Intellectual Property

Cyber Crime Division (ECOTEC) police, local police from Police Region III in northeastern Thailand, officers from the Investigation and Suppression Division of the Thai Customs Department, and customs inspection officers from several offices in Bangkok and its suburbs. Additional training sessions have already been planned in 2009 both in Bangkok and in other regions throughout the country. ♦

## DESTRUCTION CEREMONY ORGANIZED BY DIP, CUSTOMS DEPARTMENT, ECD, AND DSI

by Wiramrudee Mokkhavesa

The Department of Intellectual Property (DIP) organized a grand destruction ceremony at Klongluang District, Pathumthani Province on December 17, 2008. Ms. Puangrat Udsawawisit, the Director-General of the DIP, gave the opening remarks. The seized goods that were destroyed at this event came from finalized cases from three main government departments: Customs Department, Economic and Cyber Crime Division (ECD, formerly ECOTEC), and Department of Special Investigation (DSI).

mobile phone accessories, wristwatches, bags, shoes, CDs, calculators, electronic appliances, etc. The goods that could not be recycled were destroyed by incinerator,



Different processes of destruction were used by these three bureaus depending on the goods being destroyed. A wide variety of goods were destroyed, including garments,

while the goods that could be taken apart were destroyed by recycling process. Three machines were used in the first steps of destroying the goods: (1) a bulldozer; (2) cutting machines; and (3) a waste grinder.

The total number of destroyed goods was 1,667,715 items, coming from a total of 1,527 cases. The total value of the products amounted to approximately THB 164 million. These seized goods involved various intellectual property owners including Nokia, Casio, Levi's, Epson, Canon, Citizen, Chanel, Timberland, Lacoste, Adidas, Rado, Louis Vuitton, etc. ♦

Wiramrudee Mokkhavesa, Attorney-at-Law  
Intellectual Property

## NEW CHIEF JUDGE AND DEPUTY CHIEF JUDGES AT THE IP&IT COURT

by Nuttaphol Arammuang

Per normal practice, the Chief Judge and the Deputy Chief Judges of the Central Intellectual Property and International Trade Court (IP&IT Court) rotated into new positions in October. These officials have been replaced by Hon. Maitree Sutapakul, the new Chief Judge, and Hon. Pataraporn Chakarangkoon and Hon. Sornchai Sirariyakul, the Deputy Chief Judges. The new Chief Judge has been relocated from the Supreme Court, while the two Deputy

Chief Judges have been promoted from their previous roles as Panel Judges in the IP&IT Court.

Tilleke & Gibbins paid the new judges a courtesy visit and congratulated them on their positions. During the visit, discussions were held regarding their plans and possible new developments for the court system. Instead of rotating the Chief Judge and Deputies every year, a proposal is being considered to extend

the rotation to two or three years in order to increase the effectiveness in managing and developing the court system. The Chief Judge is also attempting to increase the number of judges in order to improve the time frame in which court procedures are carried out. ♦

Nuttaphol Arammuang, Attorney-at-Law  
Intellectual Property

## A NEW YEAR BRINGS NEW HEADLINES IN IP

by Wiramrudee Mookhavesa and Sukontip Jitmongkolthong

January 2009 was full of events in the intellectual property field in Thailand due to the policies and actions supported by the newly formed government of Prime Minister Abhisit Vejjajiva.

On January 16, 2009, the Deputy Minister of Commerce, Mr. Alongkorn Pollabut, presided over a ceremony at Suvarnabhumi Airport in Bangkok (bottom picture, left). He announced that the Cabinet has now accepted his policy to set up a National Committee on Preventing and Suppressing the Infringement of Intellectual Property Rights in Thailand. The Prime Minister and Deputy Minister of Commerce will serve as the Chairperson and Vice-Chairperson of this Committee respectively.

The Deputy Minister of Commerce also announced new collaboration between the Department of Intellectual Property and Airports of Thailand Public Co., Ltd. in order to post signage at the airports warning both Thais and tourists that importing, exporting, and carrying counterfeit goods

to some European countries is a crime. Leaflets promoting this campaign are also being distributed to passengers.

The active policies of the government did not end there. On January 26, the Deputy Minister of Commerce informed the public about the results of raid actions that had been carried out in the main problem areas in Bangkok, such as Klongthom, Baanmoh, Tawanna, and Jatujak, during January 1-25, 2009 (bottom



Left: Wiramrudee Mookhavesa, Attorney-at-Law  
Right: Sukontip Jitmongkolthong, Attorney-at-Law  
Intellectual Property

picture, right). Raid actions also took place outside of Bangkok, such as in Nakornrajsima Province. It was reported that the police successfully conducted 74 raids resulting in the seizure of 128,000 items of copyright-infringing music and films (CDs, DVDs, and VCDs) with a total value of about THB 12.8 million. In terms of trademark infringement, 113 raid actions were carried out, resulting in the seizure of 26,037 items of clothes, wristwatches, bags, etc. amounting to a value of about THB 13 million.

The attention being paid to intellectual property issues by the new government should provide a reason for optimism with regard to additional positive developments that may be on the horizon in 2009. ♦



## UPDATE: THAILAND'S ACCESSION TO THE PATENT COOPERATION TREATY

by Darani Vachanavuttivong

After having become a party to the Paris Convention for the Protection of Industrial Property (Paris Convention) on August 2, 2008, Thailand has continued to proceed with the necessary actions to prepare itself for the Patent Cooperation Treaty (PCT) system.

The Department of Intellectual Property (DIP) has been actively involved in preparing the regulations concerned to facilitate the acceptance and forwarding of PCT applications to be entered into

Thailand or to be forwarded from Thailand. These regulations are currently being reviewed by the Council of State. It is expected that the Ministerial Regulations will be issued by mid-2009.

It is also expected that the Ministry of Foreign Affairs will be able to submit an Instrument of Accession for Patent Cooperation Treaty with the International Bureau of the World Intellectual Property Organization (WIPO) at some point during the middle of this year. Thailand will then

become a party to the PCT after 90 days from the date that WIPO has accepted and approved Thailand's Instrument of Accession.

The possibility therefore exists that the Thai DIP will be able to accept the first PCT application before the end of the year 2009. ♦



Darani Vachanavuttivong, Co-Managing Partner & Managing Director, Intellectual Property

## NEW MEMBER OF THE THAILAND IP TEAM



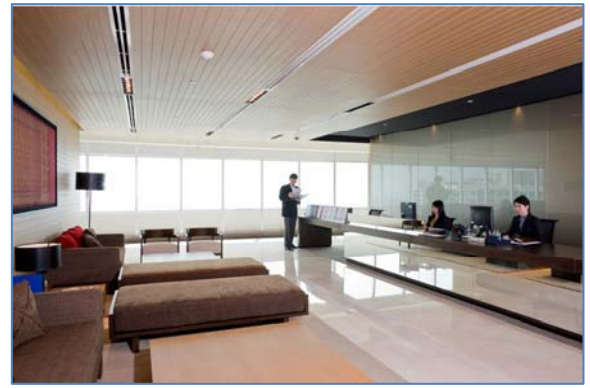
Vasan (Abe) Sun joined Tilleke & Gibbins in January 2009 as an Attorney-at-Law in the Intellectual Property Department. Before deciding to embark on a career in law, he completed a degree in electrical engineering at the University of Toronto and worked as an engineer in the telecommunication and aerospace industries in the US and Canada for over ten years. Abe then proceeded to obtain his law degree from the University of Western Ontario in London, Canada, his degree of Barrister-at-Law from the Law Society of Upper Canada, and his Court Certificate of Qualification to appear before the Court of Appeal and the Superior Court of Justice in the province of Ontario. He is a member in good standing of the Law Society of Upper Canada and thereby licensed to practice law as a barrister and a solicitor in the province of Ontario, and he is qualified as a notary public in the province of Ontario. Drawing on his significant engineering experience, Abe brings an extensive technical background to his legal practice of advising and assisting clients with the enforcement and prosecution of their intellectual property rights, particularly in regard to patent matters.

## GRAND OPENING OF T&G'S BANGKOK OFFICE

Tilleke & Gibbins will hold a reception on Tuesday, March 31, 2009, to formally celebrate the grand opening of its new offices.

Situated at the Supalai Grand Tower on Rama 3

Road, Tilleke & Gibbins' new home consists of seven floors of spacious state-of-the-art offices and facilities which include an auditorium, ten meeting rooms, the firm's famed Museum of Counterfeit Goods and History Showcase, and a staff lounge. The firm moved to Supalai Grand Tower in September 2008.



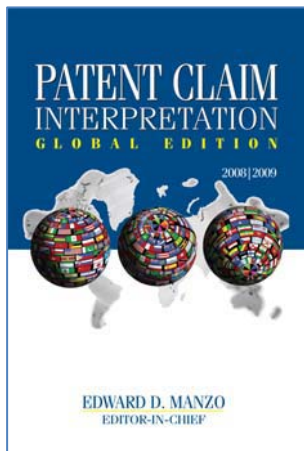
## PUBLISHED

Edward J. Kelly, Partner and Chief Client Relationship Officer in Tilleke & Gibbins' Intellectual Property Department, has participated in the drafting of the Thailand chapter of the book *Patent Claim Interpretation – Global Edition 2008-2009*. Edward was assisted by Radeemada Mungkarndee, Patent Agent, and Nuttaphol Arammuang, Attorney-at-Law. Thomas Treutler and Nguyen Thi Phi Nga from Tilleke & Gibbins'



Hanoi Office were responsible for drafting the Vietnam chapter.

*Patent Claim Interpretation – Global Edition 2008-2009* provides an in-depth understanding of how patent claims are interpreted in order to determine the scope of a patent. Through this book, the readers will better understand the risks of patent infringement and international licensing linked to these patent claims, which may arise in different countries with different cultures. The book has been published as a reference for judges, attorneys, and patent agents practicing in this area of the law. Authors from 21 countries including the United States, China, Japan, and India participated in



the preparation of this book under the supervision of Edward D. Manzo (attorney and founder of the Chicago-based law firm Cook Alex Ltd.), who also wrote the chapter on the United States.

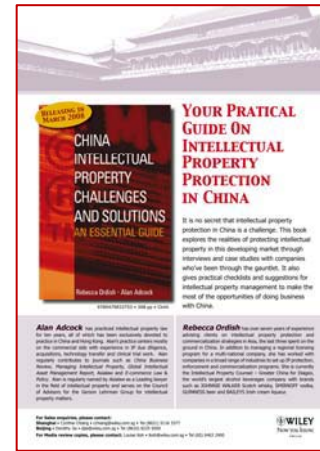
It is no secret that IP recognition and protection in China are challenges. Anyone wanting to do business in China is faced with the country's long-held perception that intellectual property is more a communal right than an individual one. Change is afoot, however, and as China creates more of its own technology and intellectual property, awareness of IP issues will increase and protection of IP rights will



continue to improve. For now, though, companies are advised to take responsibility for protecting their own IP in China rather than expecting Beijing to do so.

*China Intellectual Property Challenges and Solutions: An Essential Business Guide* explores the realities of protecting and commercializing valuable intellectual property in the Middle Kingdom. In addition to suggestions for IP management, it provides practical case studies and useful checklists based on the authors' experience dealing with countless multinationals in myriad businesses.

This book was written by



Rebecca Ordish, Senior IP Counsel, Asia-Pacific, Cadbury, and Alan Adcock, Deputy Director of the Intellectual Property Department of Tilleke & Gibbins, together totaling nearly 20 years of China IP experience.

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**Thailand: IP Developments** is intended to provide general information on intellectual property and recent developments in this area in Thailand. The contents do not constitute legal advice and should not be relied upon as such. If legal advice or other expert assistance is required, the services of competent professionals should be sought.

Editors: Andrew Stoutley and Marilyn Tinnakul