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Thailand: *IP Developments*

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Intellectual Property

Alternative Dispute Resolution through the Department of Intellectual Property

by Sukontip Jitmongkolthong and Siraprapha Rungpry

When faced with a dispute, the primary goal of most IP brand owners is to settle their case quickly, smoothly, and cost effectively. Although court procedures can provide an effective means of taking legal action against an infringer, litigation usually requires a significant investment of both time and money in order to see it through to its conclusion. Brand owners who wish to seek a quick solution to a problem may consider alternative mediation methods to settle the dispute before going to trial.

Traditionally, brand owners interested in pursuing a mediated settlement have relied on the mediation procedures that are offered through the Central Intellectual Property and International Trade Court. Recently, however, the Department of Intellectual Property (DIP)'s Office of Settlement and Dispute Prevention of Intellectual Property (the Office) has been emphasizing the availability and effectiveness of its mediation procedure, which provides a feasible remedy for dealing with intellectual property issues including infringement of trademarks, copyright, patent, and trade secrets. Indeed, the DIP has begun to hold seminars to widely promote this process among potentially interested parties throughout the country.

The DIP's mediation procedure is very simple. The entire process usually takes only two or three months. In addition, there is no fee for the DIP. Mediation before the DIP can be initiated by either party to an IP-related dispute by completing a request form in person at the Office or sending a formal letter to the DIP requesting that the dispute be submitted to the Office for mediation. The DIP will forward the letter to the Office to initiate the mediation procedure. When the Office receives the letter, they will review all of the issues involved in the case. If the letter does not clearly specify the disputed issues and the IP owner's demands, the responsible officer will ask the IP owner to come in for a meeting to clarify the claims and the demands. (If the IP owner's letter is clear, this initial meeting would not be necessary.) The officer will then contact the opposing party (i.e. the infringer). If the infringer agrees to negotiate, the officer will have a meeting with the infringer to discuss the issues involved. After the infringer acknowledges the IP owner's claims, the Director of the Office and the responsible officer will invite both sides to a mediation session. If the parties are able to reach an agreement, the Office will prepare a settlement agreement, the contents of which have been agreed to by both parties. After execution of the agreement, it will be binding upon both parties.

Some global IP owners have successfully exploited this method to stop infringements in Thailand. For instance, one of the world's leading luxury car brands has been rather successful in negotiating with local infringers through the DIP. During 2006-2007, DIP-assisted negotiations with unauthorized dealers and service centers in Thailand resulted in seven infringers (from a total of 13 infringers) agreeing to stop using the brand owner's trademarks, including taking down signage/advertisement boards which contained the trademarks and changing decorations within their business premises. In addition, there was a significant patent case in which the IP owner had attempted to negotiate with the infringer for over a year without success. Finally, the IP owner sought assistance from the DIP by submitting the dispute for mediation and the case was settled within six months.

According to DIP data (see table below), the vast majority of disputes that have been brought before the Office in recent years have involved copyright, which make up 79% of the total cases. Excluding ongoing cases, settlements have been reached in 55% of the total cases that have been mediated by the Office from December 2002 until August 2008. Settlements are most frequently reached in copyright cases (62%), while they are somewhat less frequent in trademark cases (38%), and relatively rare in patent cases (11%).

The statistics below indicate that the mediation procedure before the DIP can provide effective results in many cases. Moreover, the participation of the DIP in the process allows for the intervention of government officials without taking the further step of involving enforcement officials and/or the court. This can frequently elicit participation from a party to a dispute who has otherwise been unwilling to cooperate in seeking a solution. Based on the settlement success rate, the relatively low cost involved in mediation procedures, and the increasing awareness of the Office's mediation mechanism, the number of disputes brought before the Office for mediation is likely to increase in the coming years. ♦

Mediation before the DIP, December 2002-August 31, 2008

Type of IP	Ongoing Cases	Settlements	Termination of Mediation	Total
Copyright	9	136	82	227
Trademark	0	15	24	39
Patent	3	2	16	21
Trade Secrets	0	0	2	2
Total	**12**	**153**	**124**	**289**

Source: The Department of Intellectual Property's Office of Settlement and Dispute Prevention of Intellectual Property, as of August 31, 2008. Further information can be obtained by contacting the Office at telephone number (66) 2537-5191.

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IP&IT Court Decisions on the Limits of Board of Trademarks' Authority

by Rungroj Kobkitwattanakul

Rungroj Kobkitwattanakul, Attorney-at-Law
Intellectual Property

The issue of the authority and duty of the Board of Trademarks (the Board) has been widely discussed within the Thai legal profession. At the heart of this discussion is the fact that the Board often uses its discretion to render decisions based on grounds and facts that were neither raised in the Registrar's original order nor contested by the appellant. In Thailand, the Supreme Court's decision would normally be cited to resolve this type of legal issue; unfortunately, there are no precedent Supreme Court cases to be cited for this issue. However, the IP&IT Court (the Court) has recently rendered two relevant decisions as briefed below.

IP&IT Court's Decision No. IP.92/2550

In the case, the plaintiff applied for registration of the mark "ยามเช้า" (transliterated as "YAM CHAO"), and the third defendant exercised his rights according to Section 35 of the Trademark Act by lodging an opposition claiming that he had a better right to the mark "YAM CHAO" than the plaintiff. The Registrar rendered the order that the plaintiff had the better right to the mark "YAM CHAO" than the third defendant, and this order was appealed by the third defendant.

According to Section 96(1) of the Trademark Act, the Board has the authority and duty to decide an appeal, order, or decision of the Registrar under the Trademark Act, which means that the Board must decide the issue that the appellant raised against the Registrar's order only. The Board has no authority to decide an issue that the Registrar did not order, nor does the Board have the authority to decide an issue that the Registrar ordered but which was not challenged by the appellant.

Therefore, in this case, the Board had the authority to consider only whether the plaintiff had the better right to the mark "YAM CHAO" than the third defendant. Instead of focusing on this issue, however, the Board decided that the plaintiff had previously been a director of the third defendant's company and applied to register the mark "YAM CHAO" in bad faith to imitate the third defendant's trademark. Since this act was contrary to public policy, the Board found that the mark "YAM CHAO" was prohibited for registration according to Section 8(9) of the Trademark Act. The Court ruled that this decision was not related to the issue decided by the Registrar, and the Board did not have the authority to make such a decision. Thus, the Board's decision was overturned.

IP&IT Court's Decision No. IP.162/2550

The issue to be considered by the Court in this case was whether the Board had the authority to adjudicate that the plaintiff's trademark was non-distinctive for registration, as the non-distinctiveness issue was not raised by the Registrar (the Registrar rejected the plaintiff's trademark on similarity grounds). The Court stated that the second paragraph of Section 101 of the Trademark Act stipulates that the procedure

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Watch Out - Your Famous Mark Could Be Rejected!

by Supatra Watanavorakitkul

Supatra Watanavorakitkul, Deputy Director
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Trademark owners are frequently surprised by a particular approach used by the Board of Trademarks which has now become entrenched in its practice. Over the past several years, the Board has maintained its decision-making trend regarding marks which consist of a distinctive word or well-known housemark combined with other descriptive or non-distinctive words, in which the Trademark Registrar initially required the disclaimer of such descriptive/non-distinctive words. The applicants of such trademarks, who disagreed with the disclaimer requirement and appealed the disclaimer requirement with the Board of Trademarks, usually ended up losing their mark as a whole. This is because the Board not only rejects the contested disclaimer requirement; its decision extends to rejecting the mark in its entirety without mentioning the remaining distinctive word/housemark incorporated in the mark.

This practice can best be illustrated through the use of examples. In a recent case, the Registrar required the disclaimer of the word "GLIDELOCK" in the mark "ROLEX GLIDELOCK". Rolex S.A., the applicant for this mark, appealed the disclaimer instruction to the Board of Trademarks. In rendering a decision, the Board did not limit its consideration to the issue of whether or not a disclaimer was appropriate. Instead, the Board deemed that the mark as a whole was non-distinctive, without regard to the inclusion of the famous housemark "ROLEX". Similarly, in an appeal of the Registrar's disclaimer for the words "EXPRESS SAVER", the mark "UPS EXPRESS SAVER" as a whole was rejected by the Board, which ignored the famous brand "UPS" that formed part of the mark.

Indeed, it has become common for the Board to exercise its discretion beyond the subject matter at issue in an appeal on matters such as confusing similarity between two marks, the applicant's disagreement with trademark association, appealing the Registrar's decision on an opposition with the Board, etc. Instead of limiting its focus to the matter at issue, particularly in an opposition proceeding where most of the arguments concerning the trademark rights are presented in the appeal petition, the Board has gone over other issues and rendered its decision by rejecting registration of the mark on the basis that that particular mark is descriptive.

However, even when a mark is found to be descriptive and non-registrable, on most occasions, the Board issues a notification allowing the submission of additional

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TREATY UPDATES

by Darani Vachanavuttivong

Darani Vachanavuttivong, Managing Director
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Thailand's Adhesion to Patent Cooperation Treaty – Update

Thailand successfully became a party to the Paris Convention on August 2, 2008 and will become a member of the Patent Cooperation Treaty (PCT) in the near future. Thailand is carrying out the legal proceedings for the accession process to obtain PCT membership. It is generally expected that adhesion to the PCT will occur in 2009.

Madrid Protocol – Additional International Cooperation and Harmonization

The Director General of the Department of Intellectual Property (DIP) has announced that Thailand is expected to join the Madrid Protocol by 2010 or, at the latest, by 2015. The DIP has now engaged a famous institute to conduct an analysis of the impact this move would have on Thailand's current trademark system and the advantages and disadvantages for all interested parties.

IP&IT COURT DECISIONS *(from page 2)*

for deciding appeals and petitions for cancellation of trademarks under the first paragraph shall be as prescribed by the Board.

The Board accordingly issued "The Board of Trademarks' Regulation on the Procedure for Deciding Appeals and Petitions for Cancellation of Trademarks B.E.2545" (the Regulation). Number 18 of the said Regulation prescribes that the Board has the authority to review the Registrar's order, both in factual and legal issues, and can review and render the decision based on other reasons apart from the ones appearing in the Registrar's order.

In this case, the plaintiff filed the appeal only on the ground that the plaintiff had a better right to the applied trademark "POWER-D", but the Board withdrew the Registrar's rejection on similarity grounds by reasoning that the plaintiff's trademark was non-distinctive for registration. Although this issue was not raised by the Registrar, the Court held that the Board's decision was duly rendered in accordance with the authority provided in the Regulation. Therefore, the Board's rejection of the plaintiff's trademark on non-distinctiveness grounds, rather than similarity grounds as per the Registrar's order, was duly made and there was no reason for the Court to cancel the Board's decision.

Discussion

Both decisions by the IP&IT Court are legally correct, but they were decided using different legal bases. The key question is which legal basis is the most correct according to the law. When this issue is raised, one side will claim that the Board has full authority to review and revise the Registrar's order and can render the decision based on whatever reasons it chooses, regardless of the content of the Registrar's order, based on the authority granted by the Regulation that was issued according to the Trademark Act. Meanwhile, the other side will rebut that although the Trademark Act allows the Board to prescribe the procedure for deciding appeals and petitions for cancellation of trademarks, the procedure must not be contrary to or expand its authority and duties beyond the scope of deciding appeals, orders, or decisions of the Registrar under the Trademark Act as provided in Section 96(1), which should prevail over the content of the Regulation. Although the cited decisions cannot provide a definite answer to this issue, these decisions represent developments that seem likely to be finalized by a Supreme Court decision in the future. ♦

WATCH OUT! *(from page 2)*

evidence to justify its arguable finding. Notwithstanding this allowance for filing additional evidence, successful cases in which the additional evidence or explanations have actually swayed the Board's consideration appear to be almost nonexistent. The cases conclude with the Board finally issuing its decision denying the registration of the mark on the basis that "the evidence submitted is inadequate to prove that the mark has been widely used and recognized in Thailand."

Given the ongoing situation, trademark owners are therefore strongly encouraged to agree to accept the disclaimer requested by the Registrar at the registration stage to avoid the possible rejection of the whole mark, rather than seeking to overcome the disclaimer requirement by filing an appeal petition with the Board of Trademarks. Those who have opted to contest the disclaimer requirement by filing an appeal petition with the Board and lost the mark in its entirety have stopped short of filing a civil suit with the Central Intellectual Property and International Trade Court to overturn the Board's decision. This is because the majority of trademark owners are quite concerned with the high costs involved in a court action and the time frame, which would take about one-and-a-half to two years before they receive the Court's judgment, before facing the further possibility of an appeal to the Supreme Court. Therefore, the costs and time involved in a court case act as a significant disincentive to the idea of filing a civil action since filing a new application and accepting the disclaimer requirement at the Registrar's stage is much more cost-effective and less time-consuming. It is difficult to blame these trademark owners for their preference, since filing a new application is easier and a more straightforward process. Given the absence of civil suits, however, the trend of potential court judgments in relation to the Board's ill-grounded decision has never been established.

Unless the Board of Trademarks alters this current practice and decides to concentrate just on the disputed issues, trademark owners must be prepared for the eventuality that appeal petitions on specific issues could result in the undesirable outcome of the rejection of their mark as a whole. Trademark owners need to take note of this idiosyncrasy in the Thai trademark registration process when considering the possibility of filing appeal petitions. Armed with the knowledge of this practice, trademark owners can decide on the course of action that would be in their best interest if their trademark applications are faced with the aforesaid circumstances. ♦

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DIFFERENT APPROACHES IN EVALUATING CONFUSING SIMILARITY

by Srila Thongklang and Parichart Monaiyakul

Left: Srila Thongklang, Partner
Right: Parichart Monaiyakul, Attorney-at-Law Intellectual Property

When evaluating two possibly similar marks, the Registrar and the Board of Trademarks have a tendency to focus on specific elements of the marks that may be deemed similar. Usually, this means focusing primarily on certain aspects of appearance and pronunciation, while deemphasizing other important issues such as actual use of the mark in trade or the intent of the parties in seeking registration. This approach can be contrasted with the method employed by Thai courts, which consider a wide variety of factors in rendering their judgments. This contrast is particularly apparent in the following case study.

On August 29, 2002, S.A. Corman submitted Application No. 496464 to the Department of Intellectual Property (DIP) for registration of its trademark "CORMAN" to cover "*anhydrous milk fat and butter ghee including butter and dry spreads being mixes of vegetables and milk grease*" in Class 29.

CORMAN

The Trademark Registrar rejected the application, citing it for confusing similarity to the prior registered trademark "Colman's & Goat Device" under Registration No. TM60631, which had been filed on June 12, 1987 for the goods *"meat, fish (dead), poultry (dead), game (dead), meat extracts, preserved fruits, dried fruits, cooked fruits, preserved vegetables, dried vegetables, cooked vegetables, jellies, jam, butter, cheese, eggs, drinking yogurts, milk, milk-based food products, edible oils, edible fats, butter-based food products used as bread spread, fermented fruits, and fermented foods*" in Class 29.

S.A. Corman filed an appeal with the Board of Trademarks and the Board upheld the Registrar's decision by finding that S.A. Corman's trademark was similar to the prior trademark Registration No. TM60631. The Board further held that registration of the "CORMAN" trademark would cause confusion among the public as to the proprietor or the origin of the goods. Therefore, according to Section 13 of the Thai Trademark Act, the trademark "CORMAN" could not be accepted for registration.

In response to this rejection, S.A. Corman filed a complaint against the DIP with the Central Intellectual Property and International Trade Court (IP&IT Court). The complaint was filed on the basis that the mark "CORMAN" was not similar to the prior registered trademark in terms of appearance and pronunciation and that the mark "CORMAN" had been used before the prior registered mark "Colman's & Goat Device" was filed for registration in 1987.

Ruling in favor of the plaintiff, the IP&IT Court ordered the cancellation of the decisions that had been made by the Trademark Registrar and the Board of Trademarks for the mark "CORMAN". The DIP appealed this decision to the Thai Supreme (Dika) Court.

In considering whether the mark is similar and could cause confusion among the public, the Dika Court ruled that the entire mark should be considered, not only some elements thereof. After comparing the appearance of the disputed trademarks, the Dika Court found that S.A. Corman's trademark consisted of all uppercase letters with no stylization, while the prior registered mark consisted primarily of lower case letters which were designed to be curved above the face of a goat in a wreath. It is clear that the goat face design and wreath were not included in S.A. Corman's mark, which should distinguish the marks. Further, even though the marks shared five letters in common, there were two different letters and the prior registered mark contained the apostrophe and letter "s" at the end of the word. The overall aspects of the marks were therefore different.

In addition, S.A. Corman's mark has been used with the goods "butter", while the prior mark was registered for the goods "mustard". The relevant group of consumers should be familiar with the Roman letters and the goods involved. As a result, the similar pronunciation of the mark was not a sufficient element to cause the marks to be considered confusingly similar, nor should it prevent the registration of the mark. Furthermore, the owner of the prior registered mark also consented to S.A. Corman's registration of its mark in Thailand. Finally, S.A. Corman's mark was derived from part of its company name.

Based on the foregoing, the Dika Court, under Case No. 977/2551, found that there was no bad faith intention to benefit from the prior registered mark. Therefore, there was no reason to refuse the Application No. 496464. The Dika Court affirmed the IP&IT Court's ruling and withdrew the decisions of the Trademark Registrar and the Board of Trademarks rejecting the trademark application for "CORMAN".

This decision demonstrates the wide range of criteria used by the Dika Court in making its decision to accept registration of the mark. Whereas the Registrar and the Board seemed to focus largely on the similarity of the pronunciation of the marks, the Court considered all aspects of the marks' appearance, the goods involved, and the intent of the applicant in seeking registration. Since the courts frequently reverse this type of decision by the Registrar and the Board, applicants whose marks have been rejected based on confusing similarity may therefore consider the option of challenging such refusals. ♦

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Consumer Case Procedure Act Takes Effect

by Siraprapha Rungpry

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Until recently Thailand did not have a specific law which governed court proceedings in respect of disputes between consumers and business operators. The newly adopted Consumer Case Procedure Act 2551 (2008) is truly one of a kind. Despite being designated as procedural law, the Act contains both procedural and substantive provisions. The new law took effect on August 23, 2008 and already, the media has reported numerous complaints filed by consumers against business operators for various types of violations.

Clearly, the Consumer Case Procedure Act is designed to benefit consumers. The Act simplifies and expedites the legal process for consumers to seek redress when they are injured or have sustained damage. The Act even allows consumers to file complaints orally, by having the Case Officer arrange for the recording of details of the complaint and ask the plaintiff to sign. Moreover, to ensure access to legal remedies for all, the Act waives court fees for consumers who wish to file an action (although restrictions apply).

The court is also given considerable discretion under the Act to conduct the proceedings and to make sure that consumers receive fair treatment. Among many pro-consumer provisions implemented, Section 11 of the Act, which gives rise to a cause of action in the case where a seller makes a promise to a consumer but fails to deliver, would most likely lead to a rapid upsurge in lawsuits against business operators. Section 11 specifically states that where a business operator, through notice, advertisement, warranty, or any other actions, leads the consumer to understand that the business operator agrees to provide certain things to the consumer in addition to those concluded in the contract, then such statements, actions, or promises made by the business operator will be deemed as part of the contract concluded, even though such terms are not in writing.

While the Consumer Case Procedure Act provides a new hope for injured consumers, companies on the other hand have to face considerable risks of liability which may frustrate the business or even put the entire operation in jeopardy. Potential costs for companies to defend consumer lawsuits alone could be substantial. Moreover, the court may award punitive damages in addition to the actual damages granted if the court finds that the business operator has deliberately taken advantage of or intentionally caused damage to consumers, or has committed gross negligence. Therefore, it is very important for companies to be more careful with the marketing and sale of their products, and to start considering *ex ante* measures to minimize the risks of liability and avoid unnecessary lawsuits. ♦

Computer Crimes Update

by John Fotiadis and Yingyong Karnchanapayap

Left: John Fotiadis, Consultant
Right: Yingyong Karnchanapayap, Attorney-at-Law
Corporate and Commercial

Thailand's new Computer Crimes Act (CCA) came into force on July 19, 2007. The CCA was divided into two sections. The first dealt with criminal matters involving computer hacking, anonymous spam mail, etc. The second section introduced data retention requirements for service providers.

CCA Section 26 made data retention mandatory for all "Service Providers" who would be required to keep records of their users' e-mail, chat, and internet usage and personal identification for a minimum of 90 days. The details of this mandatory data retention were left to the discretion of the Ministry of Information and Communications Technology (MICT).

On August 23, 2007, the MICT issued a Notification detailing the data records to be retained as well as explaining which Service Providers are affected. The requirements of this new Notification became universally effective on August 23, 2008.

Under the CCA, Section 3, a Service Provider is defined as either (a) a person who provides internet access or computer communications to other persons, or (b) a person who provides data storage services to another person.

At first blush, the definition of "Service Provider" appears intended to apply to operators who offer internet or email services to the public at large. However, the MICT is taking a very broad interpretation of the CCA's language, interpreting the phrase "other persons" to include services rendered by an operator to its own staff/representatives.

Based on such interpretation, the MICT is stating that all entities within Thailand which offer internet access, computer communication, or data storage to their staff, fall within the CCA's data retention requirements. This is to say that nearly any party which uses a computer is required to log all data traffic and maintain personal data identifying users for 90 days or be subject to a criminal fine of up to THB 500,000. By analogy, there is no similar requirement under Thai law for private operators to maintain logs of telephone usage or facsimile usage.

Due to the expanded interpretation of "Service Providers" by the MICT, many persons may still mistakenly believe that the data retention requirements are only applicable to public service providers.

Under US, UK, and EU laws, there is no enforcement of data retention to the extent suggested by the MICT's Notification. Current US law only provides for "data preservation" as opposed to data retention. This means that ISPs need only preserve data once they have been formally requested to do so by government enforcement authorities in a particular investigation. The US has no universal requirement for all operators to maintain such records. Attempts to introduce mandatory data retention laws in

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New Film and Video Act 2008

by Clemence Gautier

Clemence Gautier, Consultant Intellectual Property

"Bangkok: It's corrupt, dirty, and dense." With these words, Joe London, a hit man portrayed by Nicolas Cage in *Bangkok Dangerous*, defines the City of Angels upon his arrival in Thailand. But Thailand is more than just the place depicted in this 2008 movie. From its congested capital to its luxuriant jungles to its turquoise waters juxtaposed with white sand beaches, Thailand is now the scene where numerous movies, both Thai and foreign, are shot.

After more than 77 years under the previous legislation of 1930, a new Film and Video Act replacing its predecessor finally entered into force in Thailand on June 4, 2008. The new Act has considerable consequences for foreign producers shooting films in the Kingdom as well as for foreign films intended to be screened in the country. Thailand is also unfortunately well known for the large number of pirated videos being sold on its streets. This new Act thus integrates certain provisions which may provide useful new options for sanctioning those selling such counterfeit products.

Board of Film and Video Censors

The Board of Film and Video Censors is responsible for a host of duties including inspecting and rating movies to be screened, rented, exchanged, or sold in Thailand; permitting the projection, exchange, rental, or sale of movies and videos; authorizing the advertisements of motion pictures; approving their exportation outside Thailand; and controlling foreign movies shot in Thailand. Because of its ability to engage in censorship, the Board has broad powers in determining the content of viewable films, which should be counterbalanced by the new rating system.

A New Ratings System

The new Act establishes for the first time in Thailand a rating system for films and videos. The Act creates seven categories:

- General audience (no age restriction)
- 13-year-olds and above
- 15-year-olds and above
- 18-year-olds and above
- 20-year-olds and above
- Banned films
- Educational films

In spite of the creation of these classifications by the Act, no ratings have been set up as yet pending the promulgation of Ministerial Regulations which will determine the criteria to be taken into consideration for each rating category. A draft has recently been finalized by the Ministry of Culture and submitted to the National Video and Film Committee and the Cabinet for approval. The draft regulation states that since ratings will be implemented based on age categories, the cutting of scenes or censorship will no longer be necessary. The draft apparently considers that films which do not contain sex scenes, strong language, or violence may obtain the rating "general audience". Films authorized for viewers who are 20 years old and above may include sexual activity but still cannot include any explicit scenes, any scenes where a person is committing a crime, or any scenes involving drug use.

It is mandatory to file an application for inspection by the Board in order to obtain the necessary approval for screening, renting, and selling movies in Thailand. The criteria, procedures, and conditions of the application and approval will be determined by the Board and published in the Government Gazette. However, foreign movies which are screened in a film festival in Thailand may not be required to obtain approval from the Board.

Foreign Films

The new Act states that directors who are planning to shoot foreign films in Thailand shall first file an application containing the screenplay, the plot, and a short description of the movie to the Office of Tourism Development for approval by the Board and the governmental agencies in charge of the locations used for the shootings. The criteria, procedures, and conditions of the application shall be described by the Board and are to be published in the Government Gazette. Even if the film is intended to be screened only overseas and not in Thailand, the approval from the Board is mandatory.

Piracy

The new Act does not directly refer to the piracy of movies in Thailand. Nevertheless, two sections can be used against those who sell, exchange, or rent fake DVDs or VCDs. Indeed, any business renting, exchanging, or selling videos should request a license from the Registrar. The conditions to be granted such license will be provided in ministerial regulations. Non-compliance may lead to an initial fine of up to Baht 500,000 and additional fines of Baht 10,000 per day for each day the violation continues.

Moreover, each video rented, exchanged, or sold in these stores shall contain on their packages a regulated label, which will define the type of motion picture and indicate the code number. All videos also need to pass the same type of inspection as motion pictures, which should include the rating on each movie. Non-compliance by any licensed store may result in a fine of up to Baht 100,000.

Overall, the new Act includes various measures that attempt to deal with the current issues faced by the film industry, including the increase in the number of foreign and Thai movies shot and screened in Thailand, the upsurge in piracy, and the need for an established ratings system. ♦

Computer Crimes *(from page 5)*

the US have been opposed by public advocates who fear government invasion of privacy.

Even under EU and UK laws where data retention is mandated, such laws are limited to "public" service providers only--i.e. entities that provide services to the general public, and not to every entity that uses the internet or provides email in its business operations.

It is also noteworthy that the CCA provides expressly at Section 17 that the law has extraterritorial application to (a) any Thai citizen operating outside Thailand, and (b) any non-Thai citizen who operates outside of Thailand but whose conduct impacts either the Thai Government or any person within Thailand. By implication therefore, even foreign operators which are subject to the CCA by virtue of its extraterritorial application, are equally liable to the MICT's expansive data retention requirements.

In sum, Thailand now has one of the most expansive mandatory data retention requirements in the entire world. ♦

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PATENT INFRINGEMENT CASES IN THAILAND 2000-2008

by Yuwadee Thean-ngarm

Yuwadee Thean-ngarm, Attorney-at-Law
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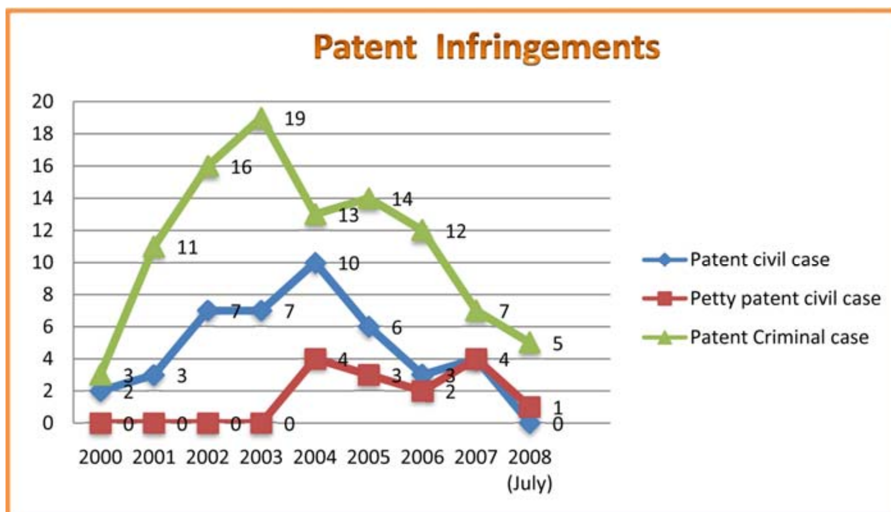
Each year, many civil and criminal cases involving IP infringement are tried before the Central Intellectual Property and International Trade Court (IP&IT Court). From 2000 through July 2008, a total of 40,823 actions involving infringement of trademarks, copyright, patent, and petty patent were filed. Surprisingly, only 155 of these cases centered on issues of patent and petty patent infringement.

The table below presents details of the civil and criminal suits regarding patent and petty patent infringement in the IP&IT Court during this period.

According to these statistics, no petty patent infringement civil cases were filed from 2000 to 2003, while 4 cases were filed with the Court in 2004. This number slightly decreased in 2005 and 2006 before rising again in 2007 to return to the peak 2004 level. Thus far this year, however, only 1 case has been filed.

In terms of patent infringement civil cases, there was a continual increase from 2 cases in 2000, through 7 cases in 2003, until reaching a high of 10 civil cases in 2004. Since then, the number declined to 6 and 3 in 2005 and 2006 respectively, before rising to 4 in 2007. To date, no patent infringement cases have been filed in 2008.

With respect to patent criminal cases, a high of 19 cases was reached in 2003, which represents a remarkable increase from 3 cases in 2000, 11 in 2001, and 16 and 2002. The number of patent criminal cases then dropped to 13 into 2004 and remained fairly steady at 14 in 2005 and 12 in 2006. Since then, the number dropped in consecutive years to 7 in 2007 and 5 in 2008.



All of the foregoing statistics seem to share a similar trend. In each category, the number of cases filed at the IP&IT Court rose steadily from 2000 through 2003 or 2004, after which the filings began to continually decrease from 2005 through July 2008. This decrease can be explained primarily by the level of complexity involved in pursuing patent infringement cases and the difficulty in obtaining successful outcomes. With regard specifically to the number of criminal cases filed, one explanation for the dramatic reduction in cases could be related to the fact that the IP&IT Court has become increasingly stringent in issuing the search warrants that are necessary to proceed with criminal actions. The Court has repeatedly expressed the view that patent infringement matters are best dealt with through civil, rather than criminal, litigation. Patent owners are sometimes hesitant to proceed in this manner, however, due to the high costs involved in civil cases and the limited remedies that they can expect to receive. As Thai patent law continues to evolve based on expected future accession to the Patent Cooperation Treaty, these trends warrant close observation. ♦

T&G VIETNAM ASSISTS IN WORLD BANK "BEYOND WTO PROGRAM"

On July 4, 2008, Thomas J. Treutler, Senior Foreign Consultant of Tilleke & Gibbins' Hanoi Office, gave a presentation on suggested improvements to Vietnam's intellectual property laws at a seminar organized by the World Bank and Vietnam's Ministry of Trade and Industry, and sponsored by AUSAID and DFID. The seminar was the conclusion of the World Bank's "Beyond WTO Program", in which experts in twelve fields ranging from finance, agriculture, and infrastructure to intellectual property, prepared detailed reports on the impact of WTO Accession and commented on action plans and made suggestions to the relevant Ministries for best practices going forward. Mr. Treutler was selected to prepare the report for intellectual property. Dr. Pham Dinh Chuong, the former Director General of Vietnam's National Office of Intellectual Property, represented the Vietnamese authorities in delivering a counterpart presentation on intellectual property at the seminar. Pictured right is Dr. Chuong with Mr. Treutler at the seminar.

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T&G Bangkok Office Relocation

T&G's Bangkok Office has moved to:

Supalai Grand Tower, 26th Floor
1011 Rama 3 Road
Chongnonsi, Yannawa
Bangkok 10120, Thailand
Tel: +66 2653 5555
Fax: +66 2653 5678

T&G Hanoi and Ho Chi Minh City Offices: New Phone/Fax Numbers

Effective October 5, 2008, the telephone and fax numbers of T&G Hanoi and T&G Ho Chi Minh City have been extended to 8 digits by adding the number "3" in front of the existing numbers.

Hanoi
Tel: +84-4 3772-6688
Fax: +84-4 3772-5568

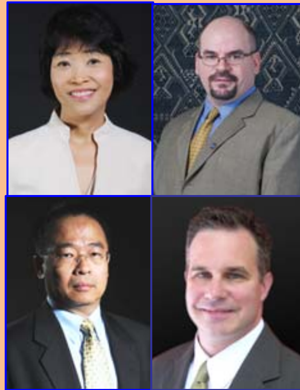
Ho Chi Minh City
Tel: +84-8 3825-1645, 3825-1695
Fax: +84-8 3824-2226

Asian Legal Business Survey: T&G One of Top 5 IP Firms

Tilleke & Gibbins is one of the top 5 firms for IP work in Thailand in the latest survey conducted by Asian Legal Business (ALB) in the Asia-Pacific region. In preparing the report, ALB's editorial team both conducted telephone interviews with and invited submissions from in-house counsel throughout the region. This is the first appearance for T&G in ALB's list. For many years, T&G has consistently been the top IP firm in Thailand in both AsiaLaw's and Managing Intellectual Property's surveys, and a year ago achieved the same distinction from Asian-Counsel for IP work. Congratulations to T&G's IP team for keeping T&G the frontrunner for IP work in Thailand.

Chambers Asia "Leaders in their Field"

Four T&G members have been recommended as "Leaders in their Field" for Chambers Asia 2009: Darani Vachanavuttivong and Edward Kelly in Intellectual Property (Thailand), Thawat Damsa-ard in Dispute Resolution (Thailand), and Thomas Treutler in Intellectual Property: Foreign (Vietnam). Tilleke & Gibbins is ranked as a firm in Dispute Resolution and Intellectual Property (Thailand) and Intellectual Property: Foreign (Vietnam).



PLC Which Lawyer? Survey

In a survey conducted by the research team of Practical Law Company (PLC) Which Lawyer? Edward Kelly and Paul Russell have been identified by clients and peers as prominent practitioners in the Life Sciences field. They will be featured in the PLC Cross-Border Life Sciences Handbook 2008-09.

New Title for Alan Adcock

Alan Adcock, who joined Tilleke & Gibbins in March this year, now carries the title of Deputy Director, Intellectual Property Department. Since joining T&G, Alan has been spending most of his time in the Patent Group learning about Thai patent law and overseeing infringement analysis and freedom to operate reports. He has been working closely with the IP partners (Mrs. Darani Vachanavuttivong, Mr. Edward Kelly and Mr. Srila Thongklang) and looks forward to working with another joiner in the IP Department, former IP & IT Court judge, Mr. Nandana Indananda who now serves Of-Counsel in the IP Department.

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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.

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