

( 3 ) その他資料 ( カントリーレポート原本・訪タイ報告書 )

**Research on the Dispute Settlement of the Courts Related to  
Industrial Property in East Asia: Thailand**

**Jumpol Pinyosinwat  
The Central Intellectual Property  
and International Trade Court,  
Thailand**

**I. Intellectual Property in Thailand**

**A. Intellectual Property Dispute Settlement: Judicial and Administrative System**

On 25<sup>th</sup> October 1996, Thailand promulgated the “Act for the Establishment of and Procedure for Intellectual Property and International Trade Court 1996 (IP&IT Act)” and established the “Central Intellectual Property and Intellectual Trade Court (CIPIT Court)” on 1<sup>st</sup> December 1997. The CIPIT Court has jurisdiction throughout Bangkok Metropolis and other 5 provinces and discretion to take cases arising outside these areas. The IP&IT Act also prepared to establish the regional intellectual property and international trade court by an Act which shall also specify its jurisdiction and location.<sup>1</sup> Nevertheless, up to present, no regional intellectual property and international trade court has been established. The CIPIT Court, therefore, has jurisdiction throughout the country.<sup>2</sup>

In a civil case, the plaintiff may file a complaint with the provincial court where the defendant domiciles or with the provincial court where the cause of action occurred. In a criminal case, the plaintiff may file a charge with the provincial court where the offence was committed, alleged, or believed to be committed, or where the accused domiciles or was arrested or where the inquiry official has interrogated the accused. The provincial court shall then notify the CIPIT Court of the matter, then the CIPIT Court will accept the case for adjudication.

The Department of Intellectual Property (DIP), on the other hand, is an administrative structure of the intellectual property matters and is part of the Ministry of Commerce, the Executive Branch. The patent office and the trademark office in the DIP are government units and the personnel working on the examination and the registration of patents and trademarks are government officials. The fees are fixed by subordinated law and may be adjusted, reduced, or waived by Ministerial Regulations which must be published in the Government Gazette.<sup>3</sup>

The main task of the patent office is to receive and to examine applications for patents of invention, patent of design, and petty patent. During the registration process, it may have to consider the oppositions to registration from any interested persons.

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<sup>1</sup> See The Act for the Establishment of and Procedure for Intellectual Property and International Trade Court, Section 6 (Thailand)

<sup>2</sup> See *id.* Section 47

<sup>3</sup> See World Intellectual Property Organization, Background Reading Material on the Intellectual Property System of Thailand, WIPO Publication No 686/TH(E) 97 (1993).

Similar to the patent office, the trademark office's major task is to receive applications for trademark registration and to consider whether a trademark should be accepted for registration or be declined. The trademark office will publish the application if it considers the trademark is qualified for registration. The other important duty for the office is the availability of trademark searches. The public or interested person could make a search before he files his application in order to find out if the trademark he is interested is identical or similar to other registered marks.<sup>4</sup> Under Section 6(3) and 8(10) of the Trademark Act 1991, being the same as or similar to a trademark registered by another person is the ground for refusing or revocation of the application trademark.<sup>5</sup>

The decisions or orders with respect to applications for the registration of patents or trademarks may be appealed to the Patent Board or the Trademark Board, as the case may be. Both boards generally function as reviewing bodies in the administrative structure. The Patent Board composed of the Secretary-General of the Ministry of Commerce as Chair-person, and not more than twelve qualified members in the fields of science, engineering, industry, industrial design, agriculture, pharmacy, economics and law appointed by the Cabinet. At least six qualified members shall be from the private sector.<sup>6</sup> Whereas, the Trademark Board composed of the Director-General of the Department of Intellectual Property as chairman, the Secretary General of the Juridical Council or his representative, the Attorney-General or his representative and no fewer than eight nor more than twelve other qualified persons in the fields of law or commerce with the experience in intellectual property or trademarks appointed by the Council of Ministers as members. At least, one third of those qualified person members shall be appointed from members of the private sector.<sup>7</sup>

The order and ruling of the Patent Board or the Trademark Board could be appealed to the court—the CIPIIT Court. The final judgment will bind the DIP and registration authorities.

## **B. Judge and Associate Judge**

The Remark attached to the IP&IT Act states;

“[W]hereas the intellectual property and international trade case has a particular character different from other general criminal and civil cases. If they are tried by the judges who, with having participated by the competent outsiders, possess competent knowledge in the matters relating to intellectual property and international trade, the proceedings will be more expeditious and appropriate...”

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<sup>4</sup> See *id.* 97-99

<sup>5</sup> See the Trademark Act 1991 (B.E. 2534) (Thail)

“Section 6 To be registrable, a trademark must

- (1) be distinctive;
- (2) not be prohibited under this Act; and
- (3) not be the same as or similar to a trademark registered by another person”

“Section 8 Trademark of the following description shall not be registrable:-

...

(10) a mark which is the same as a generally famous mark, registered or not, or so similar thereto that the public might be confused as to the proprietor or origin of the goods;

...”

<sup>6</sup> See the Patent Act 1979 (B.E. 2522) Section 66 (Thail)

<sup>7</sup> See the Trademark Act 1991 (B.E. 2534) Section 94 (Thail)

With regard to part of the purpose of the IP&IT Act, there are two types of judges in the CIPIT Court, the judges and associate judges. Currently, there are 29 judges and 127 associated judges in the CIPIT Court.<sup>8</sup> The judge or career judge shall be appointed by the King from the judicial officials under the law on Judicial Service who possess competent knowledge of the matters relating to intellectual property or international trade. In practice, the Judicial Service Commission prepares and decides the list of judge transfer, including the number of judges in the CIPIT Court.

Similar to the career judges, the associate judges shall be appointed by the King from intellectual property or international trade professions selected by the Judicial Service Commission under the law on Judicial Service. An associate judge shall have Thai nationality, being not less than thirty years of age, having been trained in the purposes of the intellectual property and international trade court and on judicial duties in accordance with the rules and methods prescribed in the Regulation, and having knowledge and expertise in intellectual property or international trade.<sup>9</sup> On the other hand, the associate judges shall not have any of the prohibited characteristics specified in Section 15(5) to (9) of the IP&IT Act; for example, being a political official, a committee member or staff of any political party, a member of the National Assembly, an administrator or a member of the Bangkok Metropolitan Assembly, a local administrator or a member of any local council, a public prosecutor, a police officer or an attorney.

Prior to taking office, associate judges shall make a solemn declaration before the Chief Judge of the CIPIT Court that they shall impartially perform their duties and preserve official secrets. They may hold office term of five years, but may be reappointed to hold office for a successive term. An associate judge who hears any case shall sit in that case until it is disposed of, unless he is unable to perform his duties because of illness or other necessity. In such a case, the Chief Judge of the CIPIT Court shall call on another associate judge to replace him or her.

A quorum is composed of three judges, two of whom must be career judges. The third may be an associate judge with expertise in the topic. Judgment or order of the CIPIT Court shall require a majority vote.<sup>10</sup>

### **C. Lawyer**

In general, the qualification of person who practices law in Thailand is under the Lawyers Act 1985 which defines a lawyer as “a person who has been registered as a lawyer and a license has been issued to him or her by the Law Society of Thailand.” The lawyers are not divided into barristers and solicitors, nor are they required to pass a bar examination as they would be in Japan or in the United States. The Law Society of Thailand, legally established in 1985 and has operated to promote, educate, and supervise its members. To become a member of the Law Society of Thailand, an applicant must meet certain educational requirements and be a lawyer as defined in the Lawyers Act. Educational requirements for membership in the Law Society of Thailand are that an applicant must have obtained a Bachelor’s Degree in law (LL.B) or

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<sup>8</sup> See The Central Intellectual Property and Intellectual Property Court, *Judges*, (visited 2 December 2005)

[http://www.geocities.com/cipit\\_ejournal/organization/judges/jus-en.HTML](http://www.geocities.com/cipit_ejournal/organization/judges/jus-en.HTML)

<sup>9</sup> See The Act for the Establishment of and Procedure for Intellectual Property and International Trade Court, Section 15 (Thail).

<sup>10</sup> See *id.* Section 19

an Associate Degree in law or a certificate in law equivalent to a Bachelor's. To be registered and to obtain a lawyer's license from the Law Society of Thailand, in most cases the candidate must complete training in professional ethics and the basic principles of advocacy and the legal profession. The training course is usually divided into two terms. In the first term, the candidate has to learn the theory of case conduct and professional ethics for not less than 90 hours. In the second term, he/she must practice working in a qualified law office for at least six months. An exception to the training course is given to candidates who have been an apprentice in a law firm for over a year and have passed an examination specified by the Board of Governors of the Law Society of Thailand.<sup>11</sup> There is no specific license for lawyer in Thailand, neither patent license nor intellectual property license. In practice, however, several law firms aim and practice particularly in the intellectual property area.

The patent and trademark law do not require an applicant to appoint the patent or trademark agent to act on behalf of the applicant. As a matter of fact, the applicant may file the registration application by himself. Nonetheless, to facilitate the process of patent acquisition and maintenance of rights, DIP has issued the announcement on the registration of patent agents. The qualifications of patent agent required by the announcement are as follow;<sup>12</sup>

(1) being a graduate holding not lower than a Bachelor Degree or equivalent in Science, Engineering, Architecture, Law or other Bachelor Degrees requiring the study of Science as basic courses of not less than 12 credits and

(2) having passed the training and workshop on patent law as prescribed by the DIP

#### **D. Intellectual Property Litigation**

From the CIPIT Court's statistics, the three most important intellectual property right (IPR) litigations are trademark, copyright, and patent. For copyright, the infringement is directly to the exclusive rights of the owner of copyright. Generally, infringement occurs when each or all of the exclusive rights are exercised by other persons without permission from the copyright owner. The Copyright Act 1994 provides two levels of infringement—primary infringement (Section 27-30) and secondary infringement (Section 31).<sup>13</sup> Primary infringement is an act with respect to a protected work by an unauthorized person in the same manner as the exercise of exclusive rights by the owner of the copyright. The general provision of primary infringement is Section 27.<sup>14</sup> On the contrary, the secondary infringement takes place when certain acts are committed with the materials which derive from primary infringement—Section 31.<sup>15</sup>

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<sup>11</sup> See Charumun Sathitsuksomboon, *Thailand's Legal System: Requirements, Practice, and Ethical Conduct* (visited 30 November 2005) [http://www.tillekeandgibbins.com/Publications/pdf/thailand\\_legal\\_system.pdf](http://www.tillekeandgibbins.com/Publications/pdf/thailand_legal_system.pdf)

<sup>12</sup> See Dhajjai Subhapholsiri, *Intellectual Property System of Thailand*, 168 (2001).

<sup>13</sup> World Intellectual Property Organization, *supra* note 3, at 82.

<sup>14</sup> See the Copyright Act 1993 (B.E. 2537), Section 27 (Thail)

“Any of the following acts against a copyright work by virtue of this Act without authorization in accordance with Section 15(5) is deemed an infringement of copyright:

(1) reproduction or adaptation;

(2) communication to public.”

<sup>15</sup> See *id.* Section 31

For trademark, the holder of registered trademark and well-known trademark generally can take action against the infringer and could petition for the following remedies: civil damages, no further use of the trademark by the infringers, or seizing the goods bearing the infringed mark. In addition, the trademark holders may file action for removal of the trademark or mark if it was registered by another person for another class of goods. For the criminal sanction, there are two laws which impose punishment on the offender with respect to trademark—the Trademark Act 1991 and the Criminal Code.<sup>16</sup> The proprietor of non-registered mark could also take civil action if his or her trademark is used by another person in a passing-off manner.

Similar to copyright and trademark litigation, the enforcement of patent rights in Thailand can institute either criminal action or civil action, or both. The civil remedies provided by the law include damages, the order to stop the infringement and the order to prohibit further infringement. In the same time, unauthorized acts against the exclusive rights in a patent are criminal offenses. The unauthorized producing, using, selling, having in the possession for sale or importing the patented product shall be subject to criminal punishment of imprisonment not exceeding two years or a fine not exceeding 400,000 baht, or both.<sup>17</sup>

According to the current IP system in Thailand, there are three types of remedies which are available. First of all, the IPR holder can take civil litigation to seek civil redress. He is also entitled to seek urgent

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“Any person who knows or should have known that a work is made by infringing the copyright of another person and commits any of the following acts against the work for profit is deemed to infringe the copyright:

- (1) selling, occupying for sale, offering for sale, letting for hire, offering for letting for hire, selling by hire purchase or offering for hire purchase;
- (2) communication to public;
- (3) distribution in the manner which may affect prejudicially the owner of copyright;
- (4) self-importation or importation by order into the Kingdom”

<sup>16</sup> See World Intellectual Property Organization, Background Reading Material on the Intellectual Property System of Thailand WIPO Publication No 686/TH(E) 1993, p.54-55.

The most important provisions related to the criminal offenses in the Trademark Act 1991 are Section 108-110, as follow, “Section 108 Any person who counterfeits a trademark, service mark, certification mark or collective mark registered in Thailand by another person shall be liable to imprisonment not exceeding four years or a fine of not exceeding four hundred thousand baht or both.

Section 109 Any person who imitates a trademark, service mark, certification mark or collective mark registered in the Kingdom by another person in order to mislead the public into believing that it is the trademark, service mark, certification mark or collective mark of such other person shall be liable to imprisonment not exceeding two years or a fine of not exceeding two hundred thousand baht or both.

Section 110 Any person who:

- (1) imports, distributes, offers for distribution or has in possession for distribution goods bearing a counterfeit trademark, service mark, certification mark or collective mark under Section 108 or an imitation trademark, service mark, certification mark or collective mark under Section 109, or

- (2) gives or offers a service under a counterfeit service mark, certification mark or collective mark under Section 108 or an imitation service mark, certification mark or collective mark under Section 109, shall be liable to the penalties provided in those Sections.”

<sup>17</sup> See The Patent Act 1979, Section 85 (Thail).

remedy from an interim injunction granted by the CIPIT Court. Furthermore, he could take criminal action against the infringement, by himself or through the public prosecutor.

### **(1) Civil Litigation**

The IPR holder can bring the civil case to the CIPIT Court, due to the IP infringement constituted by the Copyright Act 1994, the Trademark Act 1991, the Patent Act 1979, or other IP laws. The remedies which the court in a civil action usually grants to the plaintiff are damages proved by the plaintiff or an order to stop the infringement.

### **(2) Interim Injunction**

Interim or preventive injunction, akin to the *Anton Piller Order*, is one of the most important remedies for infringement of IPR. The applicant can seek a court order to prevent the perpetrator from infringement under Section 65 of the Copyright Act 1994, Section 116 of the Trademark Act 1991, Section 77 bis of the Patent Act 1979, or other IP laws. The applicant shall state the facts establishing a *prima facie* case and the reasons sufficient for the court to believe that it is appropriate to grant such order. The application shall also include a statement confirming the facts of a person who witnessed the cause of the application, in order to substantiate such application.<sup>18</sup>

In considering such application, the CIPIT Court shall grant the application if it satisfied that there is reasonable ground for the application and the time the application is filed, as well as sufficient reasons for the court to grant such application. In addition, the court will examine the nature of the damage incurred by the applicant is such that the damage cannot be restituted by monetary measures or any other form of indemnity, or the prospective defendant is not in a position to compensate the applicant for his damage, or it might be difficult to enforce the judgment against the prospective defendant afterwards.<sup>19</sup>

### **(3) Criminal Prosecution**

All IP laws in Thailand include criminal sanction as part of the enforcement. To enforce criminal sanctions, the IPR holder may either file a lawsuit in the CIPIT Court himself or report the IPR infringement to the police. In the latter case, the police may make the investigation and forward the case to the public prosecutor. During the investigation process, the police may decide to arrest the accused person and search for and seize the illegal works or product. At present, copyright infringement is deemed to a compoundable offense, meaning that a settlement to abandon the case can be reached any time before the final judgment. Consequently, the copyright holder must file his criminal action or notify the police with three months from the day the offense and the offender become known to him. However, if the holder has notified the police, the period for bringing an action to court becomes five years as from the date of the offense.<sup>20</sup>

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<sup>18</sup> See Rules for Intellectual Property and International Trade Cases 1997, Rule 12 (Thail).

<sup>19</sup> See *id.* Rule 13 (Thail).

<sup>20</sup> See The Criminal Code, Section 95 (Thail).

## E. Statistics and Ratio

There are several considerations favoring civil proceeding in enforcing IPR; for example<sup>21</sup>,

### (1) Burden of Proof

Similar to those in other countries, criminal prosecution in Thailand requires the burden of proof beyond a reasonable doubt. Unlike the civil plaintiff, the public prosecutor or plaintiff in criminal prosecution must establish the validity and infringement of IPR beyond a reasonable doubt of every fact necessary to constitute the offense, for example, the issue of willfulness. To fulfill the standard of criminal proof, the prosecutor must prove not only the infringer knew that the work or goods in issue was the subject of a valid IPR and he was copying or infringing without the permission, but the prosecutor must also prove that the defendant knew that his act constituted IPR infringement or, at least, knew that there was a high probability that his acts constituted IPR infringement. As a result of criminal standard of proof, the requirement of evidence, and the lack of human resources, most IPR infringers who are prosecuted in Thailand, usually are the low-level infringers.

### (2) Cost of Prosecution

The cost of IPR criminal prosecution usually is high because of the issues of high standard of proof, high evidentiary requirement, and high technical requirement. The shift from civil litigation by the IPR holders to the criminal prosecution will move all investigation and litigation costs to the government.

### (3) Lose of Control

Once IPR holders choose the criminal proceeding by public prosecutors, they will lose the case control. Public prosecutor might decline to take the case. There are many reasons that public prosecutor should use to determine whether to take a case, for example, limited resources, the higher standard of proof, lack of *prima facie* evidence, a wariness of being manipulated by companies in a civil dispute. Therefore, he might make a different decision from the IPR holders. The loss of control will also cause other problems, for example, the secrecy of the information. Most areas of IPR include secrecy of information, especially for the area of trade secret, know-how. In criminal trial, IPR holders may have to disclose the information in the investigation and trial processes. Due to the higher standard of proof and criminal defendant's right, the duty to disclose information relevant to the defendant's defense will be required during the trial. In practice, this drawback might be one main disadvantage of IPR holders' stand.

Nevertheless, among civil litigation, interim injunction, and criminal prosecution, IPR holders in Thailand trend to mainly enforce criminal sanction. The most influential reason of such practices came from the promotion and advertising by DIP. DIP, a department in the Ministry of Commerce, has believed that criminal sanction would be the only effective tool to combat IP infringing and DIP has spent years to promote the widespread use of criminal sanction in Thai IPR enforcement system. As a result, the number of IP criminal cases in Thailand is very high, compare to that in other countries. Specifically, the number of criminal prosecutions in the CIPIT Court has been around 95% of all IP cases each year, from 1998-2005.

From the statistics on Table 1 and 2, Table 1 shows the increasing number of IP cases, from 1,733 cases filed in the year 1998 to more than 5,000 cases filed in the year 2005.<sup>22</sup> It also shows the number of

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<sup>21</sup> See Jumpol Pinyosinwat, *Criminal Enforcement of IPR: The Problem of "Over-Criminalization"?*, The IP&IT Law Forum: Special Issues 2003, 60-91 (2003).

civil and criminal cases of copyright, trademark, and patent lawsuits which the numbers of criminal cases are much higher than the number of civil litigation. Copyright and Trademark disputes are the major part of the CIPIT Court caseload. The number of trademark cases filed used to be the highest number of the IPR cases, but the number of copyright cases has been increasing and has become the highest number of cases filed in year 2004 and 2005. Compare to copyright and trademark, the number of patent case has been very low, both civil and criminal cases. Table 2 shows number of civil and criminal cases of all IPR lawsuits, including trade secret, licensing agreement, IRP offenses under the Criminal Code. It also shows the ratio of civil cases filed and criminal case filed in the CIPIT Court.

**Table I Statistics of IP case filed (Category)**

| Year                        | 1997-2004 | 2002  | 2003  | 2004  | 2005(Jan-Nov) |
|-----------------------------|-----------|-------|-------|-------|---------------|
| <b>All IP Cases</b>         | 22,806    | 3,739 | 4,174 | 5,566 | 5,287         |
| <b>Copyright (Civil)</b>    | 157       | 23    | 19    | 29    | 34            |
| <b>Copyright (Criminal)</b> | 9,083     | 1,214 | 1,846 | 2,793 | 2,709         |
| <b>Trademark (Civil)</b>    | 560       | 83    | 99    | 83    | 84            |
| <b>Trademark (Criminal)</b> | 12,682    | 2,350 | 2,134 | 2,545 | 2,385         |
| <b>Patent (Civil)</b>       | 105       | 28    | 7     | 35    | 22            |
| <b>Patent (Criminal)</b>    | 74        | 18    | 19    | 13    | 12            |

**Table 2 Statistics of IP case filed (Ratio)**

| Year                 | All IP Cases | Civil Cases | Criminal Cases | Ratio of Criminal Cases |
|----------------------|--------------|-------------|----------------|-------------------------|
| <b>1998</b>          | 1,733        | 90          | 1,643          | 94.81 %                 |
| <b>1999</b>          | 1,791        | 70          | 1,721          | 96.09 %                 |
| <b>2000</b>          | 2,243        | 102         | 2,141          | 95.45 %                 |
| <b>2001</b>          | 3,390        | 138         | 3,252          | 95.93 %                 |
| <b>2002</b>          | 3,739        | 157         | 3,582          | 95.80 %                 |
| <b>2003</b>          | 4,174        | 173         | 4,001          | 95.86 %                 |
| <b>2004</b>          | 5,566        | 212         | 5,354          | 96.19 %                 |
| <b>2005(Jan-Nov)</b> | 5,287        | 174         | 5,113          | 96.71 %                 |

## **II. Contemporary Issues on IPR Enforcement**

### **A. Civil Damages**

In civil case, the plaintiff in an IPR infringement case usually asks for a specific amount of damages. The court will award a reasonable amount of damages if the plaintiff can prove his case or as the court deems appropriate on a case by case basis. The civil damages are furnished in specific IP laws which include the compensation of the loss of benefit and expenses necessary to execute the plaintiff's right.

The Copyright Act 1994, Section 64 provides.

“In the case of infringement of copyright or performer's rights, the court has the authority to order the infringer to compensate the owner of copyright or performer's rights with damages the amount which the Court considers appropriate by taking into account the gravity of injury, including the loss of benefits and the expenses necessary for the enforcement of the right of the owner of copyright or performer's rights.”

The Patent Act 1979, Section 77 ter, provides

“In case of an infringement of the rights of the owner of a patent or petty patent under Section 36, 63 or Sections 65 decies and 36, the court shall have the power to order the infringer to pay the owner of the patent or petty patent damages in an amount deemed appropriate by the court, taking into consideration the gravity of the injury including the loss of benefits and expenses necessary to enforce the rights of the owner of the patent or petty patent.”

In practice, the difficulty of assessing the amount of damages in the IPR infringing case is the lack of damage proof, especially by the plaintiff. Typically, the claim will specify the certain amount of damage claim, but the lawyer does not provide any sufficient evidence to prove the damage claim. In some cases, the party might hesitant to disclose his financial or marketing information to be examined by the court. In the absence of complete evidence, the court has to calculate and set the amount of damages which the court thinks it is appropriated. As a result, the party has to realize the necessity of providing proof, especially for the assessing of the damages.

### **B. Invalidation of Patent and Cancellation of Trademark**

Any patent or patent application that does not meet all requirements shall be regarded invalid. Any person may raise such invalidation in any situation or an interested person or a public prosecutor may petition to the court to cancel such patent. For the invalidation claim of patent, the Patent Act 1979, Section 54 provides

“Any patent granted not in compliance with the provisions of Section 5, 9, 10, 11 or Section 14 shall be invalid.

The invalidity of a patent may be challenged by any person. A petition to cancel an invalid patent may be submitted to the Court by any interested person or the public prosecutor.”

The CIPIT Court may hear different kinds of patent cases, including appeals against adverse decisions made by administrative bodies in the application process, the full range of patent office decisions

during an application, petitions by individuals for revocation or cancellation of the patent, or appeals against administrative cancellation of the patent after grant.<sup>23</sup>

For trademark, the registration may be cancelled by each of the three authorities, the Registrar, the Trademark Committee, and the court, subject to specific conditions. Section 66 and 67 of the Trademark Act 1991 provides two main types of cancellation through the court, which are

(1) an interested person or the Registrar may petition the court to cancel a registered trademark by showing that at the time of filing the legal action the trademark had become common to the trade for certain kinds or classes of goods to the extent that to the business circle or the public regards the trademark in question had lost its meaning as a trademark.<sup>24</sup>

(2) within five years from the date of the Registrar's order to register a trademark, an interested person may petition the court to cancel a trademark registration by showing that he has a better title in the trademark than the person registered as its owner.<sup>25</sup>

There are a number of cases that the better title in trademark claim by plaintiff has been confirmed on the ground that the plaintiff is the owner of the mark and has used such mark before the defendant registered the same or similar mark.<sup>26</sup>

### C. Distinctiveness of Trademark

The distinctiveness of trademark is one of the three elements of trademark under the Trademark Act 1991, Section 6 which the further definition in Section 7.<sup>27</sup> It is generally established that there are two types of distinctiveness in a trademark—inherent distinctiveness and distinctiveness acquired through use.

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<sup>23</sup> See Patrick Keyzer, *Intellectual Property Rights, Comparative notes on law and practice in Thailand*, 43 (1999).

<sup>24</sup> See The Trademark Act 1991, Section 66 (Thailand).

<sup>25</sup> See The Trademark Act 1991, Section 67 Paragraph 1 (Thailand).

<sup>26</sup> Subhapholsiri, *supra* note 12, at 77. Also see Supreme Court Decision No 6765/2003, (visited 2 December 2005)

[http://www.21coe-win-cls.org/rcip/db/search\\_detail.php?cfid=86](http://www.21coe-win-cls.org/rcip/db/search_detail.php?cfid=86), Supreme Court Decision No 2108/1995 (visited 2 December 2005) [http://www.21coe-win-cls.org/rcip/db/search\\_detail.php?cfid=13](http://www.21coe-win-cls.org/rcip/db/search_detail.php?cfid=13)

<sup>27</sup> See The Trademark Act 1991, Section 6 and 7 (Thailand).

**“Section 6** To be registrable, a trademark must

- (1) be distinctive;
- (2) not be prohibited under this Act;
- (3) not be the same as or similar to a trademark registered by another person.

**Section 7** A distinctive trademark is one which enables the public or users to distinguish the goods with which the trademark is used from other goods.

A trademark having or consisting of any one of the following essential characteristics shall be deemed distinctive:-

- (1) a personal name, a surname not being such according to its ordinary signification, a name of juristic person or tradename represented in a special manner;
- (2) a word or words having no direct reference to the character or quality of the goods and not being a geographical name prescribed by the Minister in the Ministerial Notifications;
- (3) a combination of colors represented in a special manner, stylized letters, numerals or invented word;
- (4) the signature of the applicant for registration or some predecessor in his business or the signature of another person with his or her permission;

Inherent distinctiveness originally exists when the trademark is made. Due to the inherent distinctiveness, the trademark can distinguish the goods that bear such marks from other goods in the market. On the other hand, distinctiveness acquired through use is another type of distinctiveness which is obtained later through actual use of trademark.

The Trademark Act includes both types of distinctiveness in its provision. Section 7 Paragraph 2 enlists the elements that are deemed to make a trademark inherently distinctive. Section 7 Paragraph 3 further defines the rule for distinctiveness acquired through use. Names, words, or statements which do not having the characteristics of inherent distinctiveness may be regarded distinctive if used as trademarks with goods which have been widely sold or advertised in accordance with the rules prescribed by the Minister by notification and if it is proved that the rules have been duly met shall be deemed distinctive.

#### **D. New Copyright Bill**

DIP has proposed two drafts of new copyright bills and both are currently in the consideration of the Council of State. There are several issues in these new laws that should be considered and some are the criminal penalty, collecting society, and FTA obligations.

The criminal penalty is one of the most important issues of these bills and still in debates. Some proposals support the concept of re-grouping the criminal penalty, following the scale of infringement in TRIPS, Article 61 and the US laws. In this conception, large scale infringement should be given hard penalty, but small scale infringement should obtain more lenient punishment. Some proposals reinforce the severe criminal sanction in all levels of infringement, including to the small scale of infringement.

Setting up the collecting society system has been one consideration of DIP. In point of fact, DIP made a preliminary study of a desirable collecting society in Thailand. The study supports a specific law governing the rights and duties of the collecting society to set a balance between its power and the user's reasonable interest. This new law should deal with the collection of royalties for the use of copyright works and also for the use of performer's rights according to the current copyright law.<sup>28</sup> This is a major task that DIP has to consider with the fair perception and decent understanding in order to design a fair and balance system for all interested groups and public.

Furthermore, there are numerous issues related to the Free Trade Agreement (FTA) which Thailand has concluded and is negotiating with several countries, for example, the custom measures, issues related to IPR enforcement.

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(5) a representation of the applicant or of another person with his or her permission or of a dead person with the permission of his or her ascendants, descendants and spouse, if any;

(6) an invented device.

Names and words not having the characteristics under (1) or (2) if used as trademarks with goods which have been widely sold or advertised in accordance with the rules prescribed by the Minister by notification and if it is proved that the rules have been duly met shall be deemed distinctive.”

<sup>28</sup>

Subhapholsiri, *supra* note 12, at 167.

## E. Considerations for the Japanese Associate

To participate in judicial process related to IP disputes in Thailand, there are some considerations for Japanese parties.

First of all, find qualified lawyer who is specialized in IP matters. Given that Thailand does not have specific license for IP lawyer which we have already mentioned in the topic I.C above and the proceedings in the CIPIT Court are different from those in other courts, it is very important for the interested party to choose and assign a qualified lawyer who is competence in IP litigation.

Secondly, the CIPIT Court is a specialized court and has some advantages in the court proceedings. For example, all judges and associated judges have a profound background and are trained in the area of either intellectual property or international trade, as mentioned in the topic I. B, the CIPIT Court proceedings are speedier and more efficiency by the provisions of the Court Rule. In most cases, those advantages provide an effective and efficiency result to interested parties. Furthermore, the CIPIT Court has expanded international co-operations with several international organizations and universities to share and exchange information in order to harmonize the IPR enforcement system. Some significant programs include the English database of IP dispute cases in Asian Project. The project was initiated by the Research Center for the Legal System of Intellectual Property (RCLIP), join with the Waseda University, Tokyo.<sup>29</sup> The other leading project is the IP Research Center which has been established in 2004, the cooperation between the European Patent Office and the CIPIT Court, focusing on sharing the IPR enforcement information through international seminars, discussions, and symposiums. All specialized features and programs provide a better atmosphere for all parties to understand and utilize the fair proceedings of the court.

Thirdly, the difference approaches of IPR enforcement. As mention in the topic I D, E, and II A, B, and C, the IPR holders in Thailand have applied the criminal sanction as the main part of IPR enforcement. The practices might cause some confusing proceedings to the Japanese party and other Western parties. Nonetheless, the laws for civil enforcement and damage claims are activated and prompt. Each party could utilize the civil litigation for the better and more effective results. The issue of the lack of damage proof in the topic II. A should be concerned. Moreover, the interim or preventive injunction, akin to the *Anton Piller Order*, is another important remedies for infringement of IPR that has been already pointed out in the topic I. D. The party who are familiar with the interim injunction order, especially from the US or UK, can apply the injunction order as one of the effective tool to enforce the IPR.

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The Project is aimed to develop an English database of IP dispute cases (precedents) in Asian regions including Japan. The project requires relations with scholars and practitioners in the respective Asian nations to collaborate on cases and translate them into English. You can reach the IP database through the Internet and the website address is [http://www.21coe-win-cls.org/rclip/db/search\\_form.php](http://www.21coe-win-cls.org/rclip/db/search_form.php)