

Trademark infringement enforcement procedures

on luxury items and in Thailand

For the past few years, tourists traveling to some of the European countries have been warned that they could be fined or jailed for buying counterfeit designer goods. Not only could those who produce or sell counterfeit goods face penalties, but also those who buy them.

In Thailand, however, there is no law prohibiting buying of counterfeit goods. On the other hand, it is illegal to produce and sell counterfeit products. Thai trademark law has been imposed in accordance with minimum standards of protection set out in international treaties; nonetheless, it does not seem to be effective in terms of enforcement of rights. Trademark infringement has been a renowned unsolved problem in Thailand for a long time although enormous effort has been put from the relevant bodies. Lady Gaga's tweet about buying a fake Rolex watch is one of the proofs. Even in the heart of Bangkok, you can find widespread open sales of counterfeit designer goods of almost all high-end brands. According to statistics of the Central Intellectual Property and International Trade Court (IP&IT Court), approximately 4,090 and 4,130 trademark infringement criminal cases had been brought into the court based on the Trademark Act B.E.2534 (A.D. 1991) in 2012 and 2013, respectively. Further, as in previous years, Thailand remains on US Priority Watch List for intellectual property right violations and insufficient protection.

With a growing number of trademark infringement cases, it is of paramount importance to trademark owners to know how to cope with this problem. Generally speaking, Thai laws afford protection to both registered and unregistered trademarks; however, in comparison with registered trademarks, the unregistered

receive rather thin protection. Thus, it is a good practice for trademark owners to register their trademarks with the Department of Intellectual Property.

If unauthorized use of a trademark occurs, there are essentially two options available to take action against trademark infringers: criminal action and civil action.

Criminal Prosecution

Trademark owners may start with gathering relevant evidence and filing a complaint with the police officer based on trademark infringement. The police officer will then proceed with investigation and request



a search warrant from the IP&IT Court in order to conduct a raid. Since infringement of a registered trademark is considered the non-compoundable offence, the police officer together with the public prosecutor will pursue the criminal charge against the infringer until the case is final.

In addition to filing a complaint with the police officer, trademark owners may use border measures in order to prohibit the importation or exportation of counterfeit goods. That is, trademark owners can seek assistance from the Department of Intellectual Property and the Customs Department by filing a request to include their registered trademarks in the Customs

watch list, and that Customs officials can be authorized to detain shipment suspected of containing counterfeit goods.

Civil Enforcement

Trademark owners may also initiate civil action against an infringer by filing a complaint with the IP&IT Court. Generally, this option has been shown to be not so cost-effective due to the fact that the Thai courts only awards damages based on actual loss basis. Punitive damages are not available in trademark infringement cases in Thailand.

To solve the country's trademark infringement problem for the long term, legislation alone is not enough; building and promoting public awareness on the importance of intellectual property right is also the key. In addition, intellectual property education needs to start at a young age to fix the nation's problem at the root.

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