

Intellectual Property

Contacts: THAILAND

Darani Vachanavuttivong T: +66 2056 5888 E: darani.v@tilleke.com

Alan Adcock T: +66 2056 5871 E: alan.a@tilleke.com

VIETNAM

Thomas J. Treutler T: +84 4 3772 5633 E: thomas.t@tilleke.com

OVERVIEW

Tilleke & Gibbins is a one-stop center for all IP services, including [registration and enforcement](#), [commercialization](#), [litigation](#), [government relations](#), and [regulatory affairs](#). Our high-caliber practice is internationally recognized in anticounterfeiting, IP litigation, strategic filing advice, and commercial IP work.

We help creators strategically position, protect, and profit from intellectual assets in diverse markets worldwide. Our success on our clients' behalf has led to global recognition as a leading intellectual property practice by such surveys as *Asialaw Profiles*, *Chambers Asia Pacific*, *The Legal 500 Asia Pacific*, *Managing Intellectual Property*, *Practical Law Co.*, *World Trademark Review*, *Asia IP*, *Asian Legal Business*, and others.

We are versatile practitioners—well-educated in the overlapping fields of science, technology, and the law by top universities and real-world practice in one of the toughest IP regions in the world. In Bangkok, our IP group consists of 48 lawyers, including 7 litigators; 9 patent agents with backgrounds in chemistry, biology, computer science, food science, materials science, or physics; 10 trademark executives; 60 support personnel, including a government/police liaison and a private investigator; and 24 technical specialists in various scientific fields, on an as-needed basis. The Vietnam IP team consists of 15 members, including veteran IP practitioners and patent agents.

We are educators—our IP attorneys provide free lectures and tours of our [Museum of Counterfeit Goods](#) to students of all ages, clients, diplomats, intellectual property practitioners, Thai and foreign police, Interpol officers, judges, government officials, and business executives. The museum's collection is composed of more than 3,500 products in 14 broad categories of goods, many of which were used as evidence in court or seized in raids overseen by our firm. By viewing counterfeit goods alongside their genuine counterparts, museum visitors gain a new perspective on the extent and consequences of the counterfeiting of legitimate goods.

To learn more about our IP services and our achievements on behalf of our clients, please continue reading about our [IP Registration and Enforcement](#), [IP Commercialization](#), and [IP Litigation](#) practices.

IP Registration and Enforcement

Tilleke & Gibbins collaborates with clients to identify the true essence and unity of their inventions and the distinctiveness of their marks and to achieve durable legal recognition and protection of such intellectual property. We work tirelessly to ensure that our clients receive the protection they deserve, both regionally and internationally, by not only enforcing their rights against potential and existing infringers to the fullest extent allowable by law, but also by overcoming attacks on the validity of their registered rights.

Trademarks

With one of the largest trademark practices in Thailand and Vietnam, Tilleke & Gibbins regularly handles trademark searches, registration and prosecution of marks throughout Southeast Asia and in other countries, recordal of changes/assignments, oppositions, cancellations, renewals, registration of trademark and service mark license agreements, watch services, coexistences, and customs recordal.

Patents

The top-ranked Tilleke & Gibbins patent practice is comprised of patent experts armed with technical credentials and industry experience. The firm handles a full range of work in relation to patents, petty patents, and designs. This includes patent and design searches, registration and prosecution of patents, petty patents, and designs throughout Southeast Asia and in other countries, recordal of changes/assignments, annuity payments, oppositions, cancellations, watch services, infringement assessments, freedom-to-operate analyses, validity and invalidity assessments, and registration of patent license agreements.

Copyright

Our IP practice safeguards corporate technology, computer software, Internet content, and the arts, including music and film, by recording copyright ownership in Thailand, Vietnam, and other jurisdictions. We join forces with our dynamic [Technology, Media, and Telecommunications](#) group to create comprehensive strategies for effective copyright protection in the region and globally.

Enforcement

Tilleke & Gibbins continues to lead the way in developing new enforcement strategies. The firm's services in this area include investigation, staff training, market surveys, comprehensive turnkey anticounterfeiting and antipiracy campaigns, preventive strategies, civil and criminal action, police/excise/customs raids and seizure actions, negotiation and dispute resolution, mediation, arbitration, public relations/press management, government lobbying, law enforcement liaison, and cancellations.

We offer the following recent examples of our IP registration and enforcement activities and capabilities. **We successfully:**

- Advised an international insecticide technology company on patent drafting and filing. The matter involved freedom to operate searches, strategic reshaping and amending of the patent, and advising on an international filing plan.
- Handled a significant project for a major industrial group in Thailand involving the change in ownership of the firm's applications/patents. We verified 205 patents and filed recordals for 150 patents/applications pertaining to assignment, merger, change of legal entity, and change of name and address.
- Represented one of the biggest Korean consumer electronics and home appliance corporations in registering their trademarks as well-known marks with the Thai Department of Intellectual Property.
- Stopped the sale and manufacture of infringing racing apparel and equipment. The counterfeit products were being offered for sale on a motorcycle fan website. We served a warning notice and convinced the webmaster to remove all advertisements for the counterfeit products from the website and to block any new advertisements with keywords containing our client's mark. Our further investigation revealed a large importer and distributor of counterfeit products located in Chinatown. We conducted a raid of the premises, on our client's behalf, and seized several hundred counterfeit items.
- Represented a multinational pharmaceutical company in its cancellation petition against a registered trademark based on the mark's similarity to an International Nonproprietary Name (INN) issued by the World Health Organization (WHO). The Board of Trademarks withdrew the trademark.
- Discovered that a company was using our client's company name and trademark without authorization. We sent a cooperation letter to the infringing company asking it to cease using our company's name. Within one week of issuing the letter, the company agreed to change its name.
- Negotiated the transfer of websites to our client; the domain name of four websites incorporated our client's well-known brand, while the other websites sold watches that imitated our client's branded products.
- Identified the manufacturer of counterfeit Italian sport cars, which were being exported to Europe and Hollywood for sale, and stopped the Thai manufacturer from producing such vehicles bearing our client's branded name.
- Advised and assisted clients in seeking critical copyright recordation for their creative works, such as cartoon characters, software programs, books, and other artistic works.
- Responded in a timely and effective manner to news that a variation of our client's trade name and trademark would be used in a major concert and festival sponsored by parties in both the private and public sectors. With only two weeks' notice, we immediately commenced negotiations at all levels with the appropriate government agencies and the organizer. Our prompt and diligent actions were effective. Prior to the event, the hosts changed the name and mark of the event, and all advertisements were removed and corrected.
- Forced an infringing party to change the names of its stores, change all of its signage, and execute a Deed of Execution within one week of receipt of our cease-and-desist letter. The signage of the opposing party's coffee shop contained a device and text that was quite similar to our client's registered trademark.
- Represented a global healthcare innovator in cancelling the registration of a mark in Cambodia that was similar to our client's well-known mark for a pharmaceutical product.
- Developed and implemented a creative and cost-effective strategy to prevent infringement in Thailand of a 3D trademark registered in a foreign country. Although the client was unsuccessful in registering its 3D trademark in Thailand, the client nonetheless sought to prevent a competitor from importing into Thailand products that incorporated a similar 3D mark. We successfully collaborated with both Thai Customs and the Royal Thai Police and convinced Thai Customs to seize the infringing goods. The goods were confiscated and used as leverage to procure binding agreements from the opposing party to change the style of its product and satisfy other requirements.
- Managed the global trademark portfolio for one of Thailand's leading beverage producers. This involved management of

trademark registration, opposition, and cancellation on behalf of the client in 40 countries worldwide.

IP Commercialization

Tilleke & Gibbins develops comprehensive strategies for managing intellectual property portfolios and deriving profit from intellectual assets. For our pharmaceuticals and life sciences clients, for example, such strategies may take into consideration compulsory licenses, advertising and marketing, promotion to professionals, trade secrets and data protection, and product liability. In collaboration with our [Technology, Media, and Telecommunications](#) group, we provide services related to the clearance and licensing of intellectual property as it relates to film, television, radio, and Internet content.

Our practitioners have extensive experience in IP licensing and contracts, including agreements relating to franchising, licensing, distributorship, technology transfer, confidentiality, joint venture, and collaboration. In addition, the firm's expertise extends to IP due diligence issues, such as searches for infringement, audits to identify and protect IP assets including trade secrets, advice to avoid disputes when terminating dealers or distributors, consents and assignments for IP created by employees or contractors (work for hire), valuation of IP assets, IP risk assessments and management, and freedom-to-practice investigations.

We offer the following recent examples of our IP commercialization activities and capabilities. **We successfully:**

- Conducted global intellectual property due diligence and advised on the transactional elements of a US\$60 million equity participation by an international energy company in a U.S. company specializing in biobased chemicals. The collaboration will result in the establishment of bio-succinic acid production plants using natural raw feedstocks such as tapioca, cassava, maize, and other agricultural inputs for the downstream manufacturing of bio-based plastics.
- Acted as counsel to a major pharmaceutical company, which representation included liaising with the Thai FDA on marketing compliance issues, verifying that the client's marketing activities were in compliance with the complex regulations governing pharmaceutical practice in Thailand, and preventing and mitigating risk and loss.
- Acted on behalf of a major U.S.-based agrichemical manufacturer. The case involved termination of the client's distributor for breach of contract and IP (patent and trademark) infringement. In addition, we represented the client in re-registration of its full range of products with the Thai Ministry of Agriculture.
- Assisted a client with a multijurisdictional acquisition of a major corn and palm oil brand with a deal value of USD 6,000,000, including the review and acceptance of the letter bid, preliminary due diligence, review of the disclosure statement, and the drafting, negotiation, and execution of the main acquisition agreement. We also provided all post-completion follow-up including trademark assignment recordals in more than 50 jurisdictions, release of various title encumbrances, transitional arrangements, rebranding, certification and labeling regulatory advice, and subsequent new agreements for supply and distribution.
- Structured IP (patent and copyright) licensing framework for electronic banking and mobile phone services, including appropriate due diligence on licensees, royalty taxation advice, and IP registration services.
- Constructed a multifaceted strategy to ensure the broadest possible protection for a particular invention across Asia, Europe, and the Americas; conducted a freedom to operate study on behalf of the client to assist in the roll-out of the product.
- Advised a pharmaceutical client on various IP issues, such as product liability, government advocacy on new regulations, compulsory licenses, new laws (Patent Act, Drug Act), and trademark registration.
- Represented a multinational cosmetics manufacturer in negotiating a multi-million dollar tri-party agreement between the Department of Agriculture, a local Thai university, and the client to set up a joint research and development program for sourcing and uncovering botanical ingredients in Thailand for their new product range.
- Represented a leading pharmaceutical company on regulatory due diligence in its spin-off of high revenue product lines (over the counter antihistamines, cough relief syrups, tablets and elixirs) to another pharmaceutical company.

IP Litigation

Our IP litigation team, working in concert with our renowned [Dispute Resolution and Litigation](#) group, is comprised of trial and appellate attorneys that specialize in protecting IP rights in the Thai courts. We have combined the firepower of our litigation section with the specialized expertise of our IP section to create a practice that consistently prevails in high-stakes, high-technology matters.

The IP litigation team handles a full range of criminal and civil IP disputes, including disputes related to patents, trademarks, copyrights, trade secrets, trade names, infringement, invalidity, cancellation, appeals of decisions by the Board of Trademarks and Board of Patents, and other commercial disputes involving IP assets such as franchising and distributorship. Tilleke & Gibbins has successfully secured rare Anton Piller orders and emergency injunctions from Thailand's Intellectual Property and International Trade Court.

We offer the following recent examples of our IP litigation activities and capabilities. **We successfully:**

- Acted on behalf of our client before the IP&IT Court and obtained a very favorable settlement just prior to the rendering of judgment in what has been widely regarded as the largest and most complex patent infringement case in Thai history. In this multijurisdictional case, our team not only secured a rare Anton Piller order to seize infringing goods, which enabled us to successfully prove infringement, but also formulated extensive strategies for protecting the validity of our client's patent.
- Won a historic judgment for a global technology leader against former employees who misappropriated our client's tremendously valuable trade secret technology. In the IP&IT Court decision, our client was awarded an injunction against use and disclosure of its trade secret technologies, including machines, processes, and information. Our client also received substantial damages and recovery of legal fees. This was the first case that a trade secret owner has successfully enforced against trade secret misappropriation in Thailand.
- Protected the intellectual property rights of a famous drug company in regard to an osteoporosis drug product passed off by another pharmaceutical company. The Supreme Court ordered the cancellation of the infringing party's mark.
- Secured a trademark litigation victory for an agrichemical company against its former distributor, who was passing off our client's trademarks. Finding in favor of our client's better right, the IP&IT Court ordered the cancellation and withdrawal of 16 of the former distributor's trademarks containing logos and wording that infringed our client's mark and further ordered that use of the infringing marks cease.
- Represented the top U.S. direct sales company in Thailand against a Thai company that filed a criminal case and a civil case seeking damages for alleged wrongful acts and loss of reputation.
- Secured a victory for the top producer of welding electrodes in Thailand against a local infringer in a landmark passing-off case before the Supreme Court of Thailand. The client's resounding success may be attributed to the defensive strategy of using multiple separate trademark registrations to collectively cover the entire package design.
- Obtained a favorable Supreme Court judgment on behalf of a French electrical equipment and accessories company in a civil action under the law of passing off. Our litigation strategy was to present each discrete instance of infringement to demonstrate the defendant's bad faith by using similar packaging, product designs, trademarks, orange theme design, and motto in the trade dress of its circuit breakers. The Supreme Court ordered the defendant to cease using the products and awarded compensation to our client.
- Represented a multinational pharmaceutical company in patent infringement litigation against a local generic company. Managed a major pharmaceutical-related patent during a trial on patent infringement.
- Obtained a precedential judgment on behalf of a leading Japanese electrical appliances company. The civil case sought to reverse the Board of Patents' refusal to restore a Thai patent that had lapsed as the result of a failure to pay an annuity fee. We successfully proved that our client, as the inventor, would not intentionally neglect or avoid payments for annuity fees and would have wished to continuously secure protection under the law for both of its Thai patents. Therefore, the IP&IT Court rendered a judgment cancelling the Board's decision and ordering the Board to reimburse certain court fees and lawyer fees to our client. As a result of this case, the Board of Patents has become less strict in considering this type of request from patent owners.
- Secured a victory for a Thai healthcare products company before the Supreme Court in trademark litigation initiated by its former employee and authorized manufacturing company. The opposing party claimed to be the owner of our client's trademarks as well as the mechanism for the production of haemodialysis solutions. The client's resounding success may be attributed to the defensive strategy of introducing evidence that demonstrated the bad faith of the former employee in initiating the case.
- Represented a top Italian fashion design company in a case before the IP&IT Court. The IP&IT Court cancelled the defendants' 18 trademarks, awarded a substantial amount of compensation to the client, and issued a permanent injunction prohibiting the defendant from using marks similar to the client's trademarks and trade name.
- Obtained a favorable Supreme Court judgment on behalf of a French electrical equipment and accessories company in a civil action under the law of passing off. Our litigation strategy was to present each discrete instance of infringement to demonstrate the defendant's bad faith by using similar packaging, product designs, trademarks, orange theme design, and motto in the trade dress of its circuit breakers. The Supreme Court ordered the defendant to cease using the products and awarded compensation to our client.
- Secured a litigation victory for a multinational vaccine company. Due to our strong legal arguments and reliable evidence, the IP&IT Court determined that the goods identified by our client's trademark were different from the goods connected to a registered mark. The IP&IT Court ordered the Trademark Registrar to grant the registration of our client's trademark.
- Represented a leading U.K.-based sportswear and football equipment supplier in a civil case against its former Thai distributor. Obtained an Anton Piller order and seized a total of 96,000 counterfeit items that were produced in breach of the

defendant's contract with the client.

- Represented a leading Japanese electronics company in a patent infringement case against a Thai distributor which concluded in an amicable settlement through mediation in less than one year. The settlement included the seizure and disposal of existing counterfeit inventory, an agreement to stop the sale and marketing of counterfeit products, and a marketing awareness campaign educating the public on the differences between authentic and counterfeit products.