

## THAILAND

### Repetition of Copyright Royalty Collection in Sound Recordings and Musical Work

In dealing with copyright in music, questions frequently arise regarding the scope of limitations on the rights of songwriters and record companies. Specifically, how can we differentiate between the rights of songwriters and those of record companies? And what is the extent of their rights to seek benefit from the copyrighted music? The Thai Copyright Act simply prescribes the copyright proprietor's exclusive right to reproduce, modify, disseminate, license, etc. While this seems relatively straightforward, it does not address the question of how to deal with a copyrighted work that contains another copyrighted work. For instance, a sound recording or audiovisual work may contain a musical work within it. Would the law allow the royalty fee to be collected twice, by both the record company and the songwriter? In *Mr Tawechai Chariyaeam-udom v. Mr Chalearmpon Malakam*, the Central Intellectual Property and International Trade Court of Thailand (IP&IT Court) furnished an answer and explanation of how to delimit these rights.

The defendant in this case was the composer of lyrics and rhythms – a musical work. He licensed to the plaintiff the right to produce a sound recording and an audiovisual work based upon the plaintiff's musical work for distribution to the public. The plaintiff appointed Copyright Music Co to collect the royalty fee for dissemination of the music recorded onto the medium, while the defendant similarly appointed CTP Publishing Co to collect the royalty fee for dissemination of the musical work created by him.

Prior to the lawsuit, a substitute acting on behalf of CTP Publishing, operating in conjunction with the police, raided four karaoke operators that were displaying the audiovisual work produced by the plaintiff. These operators had obtained licenses from Copyright Music. The raids sparked a lawsuit in which the plaintiff claimed that such act of the defendant caused damage to the plaintiff because the plaintiff was unable to exercise his rights in disseminating the copyrighted music. On the basis of the existing license, the plaintiff consequently requested the IP&IT Court

to pronounce that the plaintiff was the exclusive proprietor of the copyrighted music and to force the defendant to refrain from interfering with the plaintiff in the distribution and dissemination of the copyrighted music.

In rendering its decision, the IP&IT Court first determined that it was necessary to draw a distinction between the rights of the different copyright owners: "With regard to the copyright in relation to music, it is necessary to set apart the rights of the proprietor of a copyrighted musical work (the creator of lyrics and rhythms) and the rights of a sound recording producer (who produces sound recording with the consent of the proprietor of the musical work)."

To distinguish between these rights, the Court reviewed the licensing agreement by which the plaintiff was recognised to possess the right to produce sound recording and audiovisual works, and to further distribute, advertise, and disseminate them. The IP&IT Court therefore acknowledged that whereas the defendant was the creator of the lyrics and rhythms and remained the proprietor of the copyrighted musical works, the plaintiff was separately the proprietor of the copyrighted sound recording and audiovisual works. The plaintiff had the right to benefit from the disputed sound recording and audiovisual work, as well as the right to impede or license the right to disseminate the copyrighted sound recording and audiovisual works produced by him.

It is undeniable that the copyright owner of a musical work has the right to exclude others from communicating his work to the public under the Copyright Act of Thailand. The Act, however, does not make clear whether such right still remains over the sound recording and audiovisual work media produced by those who obtain license from him. The IP&IT Court held that since the copyright owner had already benefited from the royalty given by the plaintiff, who was the producer of the sound recording and audiovisual work, the defendant's right to control his musical work subsisting in the sound recording and audiovisual work medium no longer existed. Consequently, the defendant cannot claim his right as the proprietor of the copyrighted musical work to collect royalty fee. Allowing such claim in this given circumstance would result in repetition of royalty collection.

In its decision, the IP&IT Court ordered the defendant or its representative to refrain from interfering with the plaintiff's



**Kavin Kanchanapiroj** is an attorney-at-law in the intellectual property department of Tilleke & Gibbins International. After receiving his bachelor's degree in law with

honors, he joined the firm's IP enforcement group in 2008. While his initial focus was on trademark matters, he has recently been transitioning into the firm's reputable IP litigation section, contributing to the litigation team's handling of both trademark and patent suits. Kanchanapiroj has represented local and international intellectual property rights owners in IP disputes that have occurred in Thailand and abroad.

dissemination of the disputed sound recording and audiovisual work. However, the court could not declare that the plaintiff was the exclusive proprietor of the copyrighted musical works because the plaintiff was merely the copyright proprietor of the sound recording and audiovisual work.

The judgment of the IP&IT Court appropriately interpreted the copyright law and ruled that the repetition of royalty collection in musical work and sound recording is not permissible. However, the court's order forbidding the defendant's action may be beyond the scope of the Thai procedural law. The defendant did not breach the licensing contract, infringe any right of the plaintiff, or prevent the plaintiff from disseminating the sound recording and audiovisual works; the defendant merely exercised his perceived rights. It therefore could be argued that the legal issue on whether the songwriter has the right to collect the royalty of his musical work should instead be considered in the context of the dispute between the songwriter and the karaoke operator.

## Tilleke & Gibbins

**Tilleke & Gibbins International Ltd**  
26/F Supalai Grand Tower,  
1011 Rama 3 Road, Chongnonsi,  
Yannawa, Bangkok 10120, Thailand  
T: +66 2 653 5555  
F: +66 2 653 5678  
E: [bangkok@tillekeandgibbins.com](mailto:bangkok@tillekeandgibbins.com)  
W: [www.tillekeandgibbins.com](http://www.tillekeandgibbins.com)