



# International—Asia

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## **Burden and Standard of Proof to Obtain Preliminary Injunction and Anton Piller Order in Patent Infringement Cases**

In Thailand, laws relating to the enforcement of patent rights mainly involve the Patent Act of 1979, as a substantive law, and the Act for the Establishment of and Procedure for the Intellectual Property and International Trade Court of 1996, as a procedural law. Those Acts contain provisions relating to patent enforcement, particularly the rules of obtaining evidence from the opposing party. These provisions of law make civil suits on patent infringement worth pursuing. Below we explore the burden and standard of proof aspect to determine the requirements that a patent holder must fulfill when a preliminary injunction and seizure order is sought from the Intellectual Property and International Trade Court (IP&IT Court).

### ***Patent Litigation at the IP&IT Court***

The IP&IT Court has the exclusive jurisdiction to adjudicate all disputed matters relating to intellectual property in Thailand. Founded in 1997, the IP&IT Court is staffed by judges with expertise in the intellectual property law, most of whom are high-profile jurists having received legal training abroad. Complementing them are associate judges specializing in dispute-related areas (in such fields as chemistry, biology, engineering, software, IT technology, entrepreneurship, etc.) who are appointed to hear cases as well.

The Act for the Establishment of the IP&IT Court also establishes proceedings for this specialized court. In 1997, the Rules for Intellectual Property and International Trade Cases B.E. 2540 (1997) were issued to further provide practical rules for court proceedings. These court rules are viewed by most legal practitioners as more flexible compared with the procedural rules used in an ordinary court. Since the inauguration of the IP&IT Court, statistics show that the number of civil suits concerning patent infringement cases has increased in recent years. A total of 32 cases concerning infringement of both patents and petty patents were filed in 2009 compared to 9 cases in 2002, showing that Thai patent law has progressed from rulings by the IP&IT Court or decisions by the Board of Patents for matters relating to patent prosecution to substantive law involving patent litigation. The rise in infringement cases is consistent with the steady increase in patent applications filed to the Patent Office each year—the higher the number of patents, the more frequent the commercialization and subsequent need to enforce such patent rights.

### ***The Burden and Standard of Proof to Obtain an Anton Piller Order***

In patent litigation, presentation of strong evidence proving infringement is always a difficult task for lawyers. One of the reasons is simply that much of the evidence rests in the defendant's possession and the defendant may elude seizure of evidence by discontinuing production or distribution of the infringing products. In this situation, the English Court,

in *Anton Piller KG v. Manufacturing Processes Ltd. (1976)*, allowed the plaintiff to enter the premises of the alleged infringer to search and inspect for relevant evidence and make copies or seize such evidence. This procedure is a powerful tool in most intellectual property litigation, commonly referred to by both common law and civil law jurisdictions as an Anton Piller order.

Thai law also provides the IP&IT Court the power to issue orders similar to an Anton Piller order. The requirements for issuing such orders are constituted under the Act for the Establishment of and Procedure for Intellectual Property and International Trade Court 1996 together with the Rules for Intellectual Property and International Trade Cases 1997. Under the law, an aggrieved intellectual property owner can request the order and thereby seize or confiscate the evidence either before or after a civil suit is filed.

In order to obtain the Court's order to seize or confiscate the evidence, the plaintiff must prove that: (1) if an action has not yet been instituted, there are grounds on which the plaintiff may take an action against the alleged patent infringer, (2) the evidence the plaintiff wishes to rely on in the future will otherwise be lost or become difficult to adduce, and (3) there is an emergency situation under which if the alleged infringer or related party is to be notified beforehand, the evidence will be damaged, lost, destroyed, or, for some reason or other, difficult to be adduced at later stage.

Anton Piller orders are rarely granted in Thailand. One of the very few reported cases is *GSI Group Inc. v. Almin Enterprise Co., Ltd. et al.* In this case, the plaintiff filed an application with the IP&IT Court for an order to seize or confiscate the evidence upon which the plaintiff wished to rely. Since the plaintiff already persuaded the Court that there were permissible grounds on which the plaintiff could

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take action against the alleged patent infringer in order to obtain the preliminary injunction, the plaintiff only had two remaining requirements to prove to the Court: possible loss of evidence and emergency situation. In doing so, the plaintiff brought forward a witness to present the fact that after the exhibition of agricultural trade equipment was over, all evidence proving the infringement would be brought back to another country or sold or destroyed. In such case, the plaintiff itself could not obtain the evidence as it would need to place an order with the alleged infringer in advance and the alleged infringing product was sold at a very high price. Based on the facts presented, the Court rendered the decision that “[a]s today [the day that the Court issued the order] is the last day of the exhibition, the evidence proving the infringement may be lost or difficult to produce at a later stage, and there is an emergency circumstance. The Court therefore grants the order to seize the evidence at the exhibition as requested by the plaintiff.”

### **Standard of Proof for Preliminary Injunction**

In 1999, policymakers amended Section 77 *bis* of the Thai Patent Act of 1979 to establish the right of the patent owner to request the Court to grant an injunction before commencing a lawsuit against an alleged patent infringer, commonly known as a preliminary injunction. The provision created the condition that the patent holder can request the Court to order the alleged infringer to stop or refrain from committing such alleged infringement if there is clear evidence that the alleged infringer is committing or about to commit any act of infringement.

To set forth the conditions for granting a preliminary injunction, the rules on consideration of an application requesting a preliminary injunction were also incorporated in the Rules for Intellectual Property

and International Trade Cases 1997 issued by the Chief Judge of the IP&IT Court. Apart from presenting clear evidence to the Court that a patent infringement is being committed or about to be committed, the prospective plaintiff needs to persuade the Court that: (1) there is a reasonable ground for the application and the filing of the application, as well as sufficient reasons for the Court to grant such application, and (2) the damage incurred by the prospective plaintiff, as the patent owner, cannot be restituted by monetary measures or any other form of indemnity, cannot be recouped from the prospective defendant, the alleged infringer, who is not in a position to compensate the prospective plaintiff for the damage, or is unlikely to be obtained given the difficulty of enforcing the judgment against the prospective defendant.

### **Legal Challenges**

Since the establishment of the IP&IT Court in 1997, few applications for preliminary injunctions for patent infringement claims have been filed with the Court. The Court generally is cautious in considering applications and granting preliminary injunctions, as it needs to maintain a balance between the protection of exclusive rights of the patent owner and prevention of abuse of exclusive rights in a patent. However, by presenting sufficient evidence and information to the Court, obtaining a preliminary injunction order is not beyond the reach of the patent owner.

A good example of a preliminary injunction granted by the IP&IT Court is *GSI Group Inc. v. Almin Enterprise Co., Ltd. et al.* Before the plaintiff initiated a civil suit against the defendants, the plaintiff filed an application for a preliminary injunction when the defendants were displaying their products at an exhibition in Bangkok, as the products were believed to infringe the plaintiff’s patent. In fulfilling the requirements set by the Patent Act

and the Rules, the plaintiff (then the prospective plaintiff) brought forward witnesses and evidence to explain to the Court how the prospective defendants’ products being displayed at the exhibition infringed the prospective plaintiff’s patent. The prospective plaintiff also contended that two of the prospective defendants were foreign entities incorporated in another country and another prospective defendant, which was a Thai company, could not compensate the prospective plaintiff on its own. In the end, the IP&IT Court rendered its decision, which is now the substantive case precedent in this regard, as follows:

The alleged infringing product has the same character as the product protected under the patent of the applicant [the plaintiff]; the applicant thus has the ground to file an action against the alleged infringers. Since the alleged infringing product is being sold at an exhibition by the alleged infringers, there is a reasonable ground for the application and sufficient reasons for the Court to grant such application. Furthermore, two of the alleged infringers are juristic persons incorporated in another country and another alleged infringer is merely a distributor of the product, although it is a Thai company; therefore, it might be difficult to enforce the judgment against the alleged infringers. The Court hereby orders the alleged infringers to stop or refrain from sale, possession for sale, offer for sale, or import into the country of the alleged infringing product.

The maxim “intellectual property if not used is useless” is unobjectionable. Although the system for patent enforcement in Thailand is merely in the early stages of its development, it shows clear signs of improvement

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and effectiveness. Patentees usually focus on patent enforcement where manufacturing takes place; because Thailand is a base country for parts manufacturing, especially for the computer and electronic industries, it is likely that the IP&IT Court will continue to hear challenging cases in this area.

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