

Tilleke & Gibbins

# Thailand: IP Developments

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## MOVING TOWARD NEW STRATEGIES FOR IP ENFORCEMENT IN THAILAND

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With the techniques of intellectual property infringers and counterfeit goods traders in Thailand becoming more complex, and with the global economy proceeding toward a sluggish recovery, we have designed new strategies to help our clients handle enforcement of intellectual property rights ever more efficiently and cost-effectively. Our years of experience combating infringement and counterfeiting have taught us that brand owners must be proactive and take all reasonable precautions to ensure that their intellectual property rights are secured.

The precautionary measures we have adopted in the past few years focus mainly on border control and routine market surveys. We have built strong collaborative partnerships with customs and police authorities (both in

Thailand and in neighboring jurisdictions), working side-by-side to prevent counterfeit products from being transported and smuggled into the country, while at the same time monitoring and evaluating the counterfeit products in the domestic market. Although our joint activities with customs and the police have proven satisfactory to a degree, we see room for improvement. Our new strategies to increase the value of our relationships concentrate on strengthening all precautionary measures, including customs inspections, police surveillance, public alerts, and periodic market watches.

### **Relationship with customs**

Regarding border control, our revamped approach involves more intense educational programs for customs officers relating to intellectual

property violations, including product identification guidelines to increase their capability and confidence when conducting preliminary inspection of suspicious goods, courtesy visits by our lawyers to customs offices and ports throughout the country to establish a stronger collaborative network, and closer connections being forged as we repeatedly encourage customs to be vigilant in monitoring our clients' brands. In some cases, we are working to track down the overseas manufacturers and exporters of counterfeit goods with our allies, in particular investigation firms, adding a new dimension to our firm's approach in order to better attack the problem at its root.

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### Relationship with police

We have also taken steps to strengthen our relationship with the Royal Thai Police Department and the Department of Special Investigation. Besides seminars concerning intellectual property law and legal proceedings, we recently held meetings with officials to share information on client cases, helping to greater contextualize the situation on the ground as regards the battle against counterfeit goods. While in the past these activities were mainly focused in Bangkok, we are now expanding our coordination efforts with the police to other parts of Thailand. We have already visited local police in many major cities in every region of Thailand to discuss how to better support them, particularly in relation to their intellectual property enforcement duties. Their positive feedback includes telephone inquiries about the brand owners active in our anti-counterfeiting campaign and an increasing number of reports regarding police *ex officio* cases.

### Public awareness

As long as the buyers' demand for counterfeit and pirated goods exists, we will continue to see such products in the market. However, we believe that by raising public awareness of the abuses inherent in IP-infringing goods, we can diminish the demand for fakes. We are currently seeking permission from government agencies to post sandwich-board style advertisements in airports and at borders with neighboring countries warning people who enter and leave the Kingdom that carrying or transporting of counterfeit and pirated items is illegal and they could face serious consequences.

### In-house investigation team

As part of our duties to enforce our clients' intellectual property rights inside and outside Thailand, our investi-

gators regularly monitor key locations and obtain relevant information about suspicious manufacturers and traders. We are in the initial stages of significantly increasing market surveys, having instructed our investigators to visit the markets and areas where counterfeit goods are distributed and sold on a regular basis. This not only includes the traditional hotspots in Bangkok, but increasingly sees us coordinating investigations around border regions in northern Thailand where Chinese-made goods are often coming from. Our investigators have also been tasked with monitoring online marketplaces as well in an attempt to directly address the problem of overstaying foreigners and locals who trade counterfeit products online from Thailand. Clients who participate in our anti-counterfeiting campaign are receiving a confidential report on a quarterly basis containing data on counterfeiting and other infringement activities, such as unauthorized use of business enterprise names or confusingly similar packaging design, along with our legal analysis and recommendations. With this approach, we aim to increase our clients' recognition of infringement problems in Thailand and thereby encourage them to take appropriate actions before the damage becomes too difficult to control.

### Mediation – A new approach

In addition to these precautionary measures, it is necessary to take parallel actions to solve as fast as possible problems that have already occurred. Mediation or negotiation is becoming a more effective option for some clients when disputes take place. A few years ago, we started bringing cases into the mediation process of the Department of Intellectual Property, whose specialists in trademarks and patents have worked in concert with us to deliver satisfactory outcomes for our clients in many instances. Recently, the Central Intellectual Property and International

Trade Court has offered a mediation process to help parties settle disputes instead of filing lawsuits. We recommend both forms of mediation as worth exploring given their expediency and economy, and we have enjoyed marked success through these processes for several clients.

### Litigation – Don't be afraid to fight

However, if disputes cannot be settled out of court, litigation cannot be avoided, which often raises complex legal and technical issues. Experienced infringers know exactly how to play the game to keep themselves in business. Fortunately, our seasoned team of intellectual property litigation experts consistently create and execute new approaches to counter infringers' evasive tactics, including application of the Consumer Protection Act and Food and Drug Administration regulations. We recently managed to obtain several Anton Piller Orders—rarely granted in Thailand—which allowed our clients to secure evidence prior to pursuing their individual matters. Preliminary injunctions, however, remain difficult to obtain.

### Ongoing responsibilities

While many think that a case is complete when the final judgment is rendered or when lawyers reach a settlement, we at Tilleke & Gibbins view as ongoing our responsibilities as legal representatives. In fact, we have recently implemented a policy of following up on targets within two years after each case is closed to ensure that infringers have truly ceased committing their wrongful acts. If our investigators learn or suspect that the same targets are involved in infringement again, we notify our clients immediately.

For more information about these new enforcement strategies, please contact Titirat Wattanachewanopakorn at [titirat.w@tillekeandgibbins.com](mailto:titirat.w@tillekeandgibbins.com). ❖

## TRAINING FOR CUSTOMS AND POLICE OFFICERS

During the week of August 31, 2009, the Tilleke & Gibbins IP enforcement team and representatives from various brand owners held a series of training events for Royal Thai Customs Department and Royal Thai Police officers. The training seminars took place in Bangkok, Nongkhai Province (northern Thailand), and Phuket Province (southern Thailand). The purpose of the training was to familiarize officers with the appropriate procedures for handling IP cases and to provide preliminary information on how to identify the differences between genuine and counterfeit products.

