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Countering IP Infringement on the Internet: Online Monitoring

The rise of mobile technology—from laptops to smart phones to tablets—has ushered in a shift among consumers away from shopping at brick-and-mortar stores toward purchasing products online. Brand owners, in response, have moved huge resources toward online sales strategies. So it should be no surprise that counterfeiters, too, have mobilized to take advantage of the growing

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market for products on the Internet. As more and more commerce occurs on the Web, the number of fakes being sold online has also drastically risen.

In addition to this global trend, local events here in Thailand may also be exacerbating the online infringement situation. Thailand has been mired in political unrest since November 2013, leaving the police with less time to devote to intellectual property infringement matters. There has been a notable decrease in the number of intellectual property raid actions and Customs cases that have been initiated since the political unrest began.

In this context, intellectual property owners need to consider what actions they can take—at their own initiative—to remain vigilant in their struggle against counterfeiting, while waiting for the political situation in Thailand to stabilize. One tactic that can reap immediate rewards is to redeploy resources to counter online infringement.

To assist brand owners in these efforts, Tilleke & Gibbins has a dedicated investigation team focused on identifying and disrupting IP infringement online. Our team focuses on the two core elements of online infringement:

1. Cybersquatting, where infringers use a registered trademark belonging to another party as their domain name or part of their domain name; and
2. The sale of fake goods via specific websites.

Our investigation process uncovers detailed information about the infringer and the nature of the infringement. With this evidence in hand, we work with the brand owner

to send a cease-and-desist letter to the infringer, ordering them to immediately stop their infringing activities.

For high-value targets, a warning letter may not be sufficient. Using advanced investigative techniques, we collaborate with the IP owner to unearth detailed information about the infringer in order to learn more about the source of the goods. This type of investigation can help to trace online supply chains, leading to the discovery of hubs for the distribution of fake goods.

While these investigative techniques are important, we also encourage IP owners to pursue an integrated approach toward stopping online infringement. This can be most effective when actions aren't limited to relying solely on intellectual property law, but instead bring together a range of legal options to disrupt infringers' activities.

The sale of illegal medical devices online provides a good example of how such an approach can be successful. Through our investigation team's routine monitoring of online infringement activities, we became aware that a large number of medical devices were being promoted on the Internet as legitimately certified in Thailand, when, in fact, they have only been certified in other countries. Such a claim is not a violation of intellectual property law, but it does open the door to other types of actions under other laws. To address this issue, the legitimate intellectual property owner can pursue a claim of regulatory infringement by taking action against the seller for advertising the sale of food, medicine, and medical equipment using untrue information that is deceptive to consumers. This approach can be supported by the findings of Red Case Sor. 33/2554, in which the court deemed that such an act constitutes an offense under Thailand's Act on Computer Crimes and found the defendant guilty.

This combined legal and regulatory approach can be easily replicated across a wide range of tightly regulated products, including food, drugs, agrichemicals, and more, in order to provide new opportunities for IP owners to

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defend their rights. A well-coordinated online-monitoring campaign—one that bridges the gap between intellectual property law and other regulatory options—can be a very cost-effective strategy for brand owners to uncover and prevent intellectual property infringement on the Internet. 🏠

The Tilleke & Gibbins investigation unit actively monitors online infringement activities and reports suspicious activity to many large IP owners. If you would like Tilleke & Gibbins to monitor your brand, please contact Wiramrudee (Pink) Mokkhavesa at wiramrudee.m@tilleke.com.