



Left | **Nandana Indananda** — Partner - nandana.i@tilleke.com

Center | **Sukontip Jitmongkolthong** — Partner - sukontip.j@tilleke.com

Right | **Piyawat Kayasit** — Attorney-at-Law - piyawat.k@tilleke.com

Landmark Victory in Design Patent Infringement Case

Tilleke & Gibbins is the main external counsel for intellectual property (IP) enforcement work for Honda Access Corporation, a developer, manufacturer, and seller of automotive and motorcycle parts and accessories, and a subsidiary of Honda Motor Co., Ltd. Our firm recently assisted the client in several related design patent infringement matters, which culminated in a civil suit filed with Thailand’s Central Intellectual Property and International Trade (IP&IT) Court against infringing Thai companies. Through the combined efforts of our IP litigation and enforcement lawyers, and our in-house investigation team, we secured a resounding victory for our client in the IP&IT Court in November 2017. In its landmark ruling, the Court awarded our client the largest civil lawsuit compensation amount to date for a design patent infringement case in Thailand at THB 68.65 million (about USD 2.11 million), plus interest, and attorney and court fees.

Previously, Honda Access Corporation claimed rights on four protected design patents for genuine spoilers, used in one of their parent company’s highly popular CITY 2014 model automobile, which were being infringed upon through similar products that were being manufactured and distributed for sale in the Thai market by several infringing companies. The automobile model for which the accessories were made is a valuable commercial product that is consistently ranked first in sales in its market segment in Thailand.

As an initial remedy, the Tilleke & Gibbins IP enforcement team sent warning letters to the infringers. Since the infringer did not respond or cease its infringement, we then proceeded with the case through the IP&IT Court, and successfully obtained a preliminary team, in collaboration with the execution officers, to inspect and seize the infringing goods at all locations that they could be found.

To execute the Court order, our firm’s in-house investigation team conducted an investigation to determine the location of the warehouse and/or factory of such infringing goods, and was able to lead authorities to seize 1,280 infringing car accessories at a warehouse. Later, the company that claimed to own the seized products filed a motion asking to join in the case, with the Court grant-

ing the motion and allowing the company to join as an interpleader. The preliminary measure that our team obtained enabled our client to disrupt the infringers’ activities without waiting for the entire time-consuming litigation process.

At the same time, our IP litigation team filed a civil lawsuit with the IP&IT Court requesting damages, including all of Honda Access Corporation’s legal and execution fees, from the infringers. After completion of the hearing of witnesses and waiting for judgment on the merits of the case, our client found that the defendants were still distributing their infringing goods in Thailand through another company. In response to this offense, our firm requested and obtained a preliminary injunction from the IP&IT Court to order the infringers to cease further manufacturing and distribution operations.

In considering the sound arguments and case presented by our lawyers, the substantial evidence gathered by our in-house investigation team, and the defendants’ continued infringement and seeming disregard for the law, the Court rendered a judgment in our client’s favor in November 2017 by deciding that the defendants had indeed infringed on our client’s design patents.

In the landmark ruling, the Court awarded Honda Access Corporation the largest civil lawsuit compensation amount to date for a design patent infringement case in Thailand at THB 68.65 million (about USD 2.11 million), plus 7.5 percent interest per year from September 2016 until the completion of the defendants’ and interpleader’s payments. The Court also ordered the defendants and interpleader to pay our client’s court fees and THB 500,000 (about USD 15,400) in attorney fees.

The Court further ruled that all infringing car accessories in the possession of the defendants and interpleader must be seized and destroyed, with the infringers paying for the destruction. The case marks one of the rare instances in Thai court proceedings in which court officials visited the infringers’ premises to inspect the seized products first-hand.

Tilleke & Gibbins’ efforts not only achieved a landmark ruling for Honda Access Corporation, but also prevented infringers from continuing to manufacture and distribute their design-infringing products, helping to protect our client’s genuine accessories and their strong market position in Thailand, as well as serving as a deterrent against other potential infringers in the future. 🏆



Design Patents No. 42733, 42734, 42735, and 45096.
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CITY 2014 Model