

THAILAND

Analysing the first website blocking case related to online trademark infringement

Tilleke & Gibbins

Bangkok



Sukontip Jitmongkolthong

Traditional IP enforcement measures are sometimes ill-equipped to deal with the rapidly evolving nature of internet resources in the digital era. Thailand has been responding to the exponential rise of online IP infringement on a rolling basis – most recently in 2017 when it amended the Computer Crime Act (CCA) to give IP owners the option of blocking websites that post IP-infringing content. This is set out in Section 20(3) of the law.

Since this provision took effect, more than 90 cases have been brought to the Department of Intellectual Property (DIP), and over 1,400 URLs from more than 50 websites have been blocked. However, most of the cases brought were for copyright infringement, especially in relation to the film and music industries, and until recently no trademark owner had taken action against online trademark infringement under the amended law. The first test case for doing so was in 2020, when a major Japanese manufacturer of imaging and optical products successfully used the website-blocking measures under Section 20(3) to fight online trademark infringement in Thailand.

Background

The company received customer complaints about a website selling dashboard cameras bearing its trademark. Hoping to shut down the infringing pages immediately, they had cease-and-desist letters sent to the website operator, the website registrar, and the seller to no avail. Despite repeated attempts to contact the concerned parties,

the pages remained online.

Meanwhile, several additional infringing websites surfaced. It appeared that in this case the long-accepted traditional measures would not be able to combat the sale of infringing content effectively in a timely manner. The legal team decided to turn to the website-blocking measures of the CCA. These measures were theoretically sound but were untested for enforcement against trademark infringement, as no trademark owner had previously attempted to use this legal option.

Obtaining the blocking order

As the DIP had also not previously encountered such a strategy for a trademark infringement matter, some officers had concerns, and discussions were crucial. After multiple consultations with the DIP officers, the Japanese company finally decided to file a trademark infringement complaint directly with the DIP in late January 2020, without needing to initiate a police case. This was the first complaint ever submitted directly to the DIP in relation to a trademark infringement matter.

The DIP director-general agreed that the offering for sale of dashboard cameras bearing our client's trademark without authorisation constituted infringement under the Trademark Act B.E. 2534 (1991). The DIP then forwarded the matter to the Ministry of Digital Economy and Society (MDES) for further action. After the case was approved, an MDES officer filed a complaint with the court requesting that the infringing websites be blocked. With the court's approval, the MDES officer then sent an official notice to the internet service providers (ISPs) and requested that they block access to the specified URLs. Before long, the ISPs complied fully with the court order.

Outlook

This test case, which was handled by Tilleke & Gibbins, successfully proved that the website-blocking measures under the CCA are ac-

tionable and effective for online trademark infringement cases in Thailand. This has important implications not only for copyright and trademark owners, but also for other IP owners, who can now consider pursuing this efficient option to eliminate online infringement of their products or services.