



VISITORS to the Museum of Counterfeit Products operated by Tilleke & Gibbins (T&G) law firm on Rama 3 Road in Bangkok are invariably shocked by the sheer number and variety of counterfeit goods available in Thailand. Items on display range from the obvious, such as wristwatches, T-shirts and bags sold mainly in tourist areas, to switches for air conditioners, ball bearings and brakes for the motor trade. Exhibits also include improperly prepared personal hygiene products like perfumes and shampoos that can cause injury

Even the most basic products are sometimes copied: staples, scotch tape and glue sold for between 12 and 40 baht.

Handling all intellectual property (IP) matters at T&G's IP department is senior associate Suebsiri Taweepon, who has been with the firm for 11 years. He oversees enforcement, education and





registration of trademarks, copyrights and patents.

“The IP department comprises nearly half of T&G’s business,” Mr Suebsiri said. “We are also a full service law firm and represent clients in all types of legal matters. We have offices in six countries – two branches in Vietnam and one each in Indonesia, Myanmar, Cambodia and Laos.

“We regularly work with the Thai authorities, mainly a special unit of the Royal Thai Police (RTP) called the Economic Crime Division. In



Suebsiri Taweepon

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some of our more complex cases we deal with the Department of Special Investigation (DSI), which is supervised by the Ministry of Justice. We also work closely with the Customs Department and prosecutors who litigate cases investigated by law enforcement organizations. The prosecutors argue cases before the Central Intellectual Property and International Trade Court,” Mr Suebsiri explained.

“Another component of our work in Thailand is collaborating with the Department of Intellectual Property, the major government organization responsible for handling all IP work,

such as registration of IP rights. We are also involved in public education. This includes organizing seminars.”

Counterfeiting on the rise

The nature of the violations has changed over the years, said Mr Suebsiri. Police units have been active in suppressing products sold by vendors or shops and the amount of pirated goods on the streets has decreased somewhat. But he believes that, overall, counterfeiting in Thailand is increasing. This is also the view of some RTP and DSI officers we contacted.

Certainly, when you walk around markets and shopping centers like MBK you can still see a wide variety of fakes on display. What’s more, the trade has branched out in the internet age. “Many IP-infringing products like movies, music and apparel are now offered for sale online, and sellers now use social media to facilitate communication with customers,” said Mr Suebsiri. “This makes it easier for the sellers, and also more difficult for IP owners and government authorities to track them down.”

He added that the brands his firm represents are foreign, but as time goes by Thai manufacturers are developing more valuable IP, and their brands are now also infringed on.

The lawyer explained that T&G’s foremost objective in opening the museum in 1989 was for educational purposes. “Students of law and law



enforcement need first-hand experience with counterfeit items – they need to see what they look like. But our visitors are not only students. They are also government officers, police, court and customs officials as well as tourists and media. CNN, BBC and NHK have all come, as well as local TV channels.

“The media and the general public are interested in hearing about in-depth investigations of counterfeit manufacturers. The counterfeit products can be very simple, such as clothes, but the investigation can be quite complicated. We might even send an investigator to pose as an employee of an unauthorized manufacturer for a period of time in order to gather intelligence.”

Memorable cases

“The museum has about 700 items on

FAKING IT

Some of the items on display at the museum

PRINTER cartridges, staples, staplers, glue sticks, cross pens, calculators, correction liquid, Scotch Tape, washing powder, baby milk, high gloss bleach, toothpaste, deodorants, baking powder, snacks, monosodium glutamate, coffee, cup noodles, chocolate, toys, mobile phones (plus parts and accessories), travel books, alcohol, cigarettes, bags, Starbucks cups, cosmetics, perfumes, fashion accessories, sparkplugs for engines, pencils, footwear, hair care products, raisins, sunglasses, car keys, medicines, alloy wheels, belts, wallets, wristwatches, car care, neon lights bulbs, batteries, switches for air conditioners, tool boxes, hand tools, voltmeters, welding equipment, ball bearings, scooters, automotive parts, car speakers, T-shirts, caps, pants, frying pans, guitars, antifreeze and coolants, car lubricants, compressors for cars, engines for electric generators, lamps, plugs, light bulb starters, and USB devices.

Note that museum shows some fake products along with genuine ones so that visitors can compare. The exhibits are marked with tags indicating whether they are genuine (g) or fake (f).

display and around 4,000 in storage. Among the most interesting exhibits are some guitars we seized years ago from a shop that manufactured the instruments. They would ask the customer what brand they wanted their guitar to look like. It's similar to shops in street markets like in Chinatown, where you can order a Blu-ray player and specify the brand. The seller puts the requested logo on the player,” said Mr Suebsiri.



“When you ask me about our most interesting cases, I would have to say they are those that deal with complex technological or legal issues, like when patent litigation is involved. In such cases the brand name may not be infringed on, but the technological process or know-how to create the product is copied.

“Four years ago we were representing a sportswear company and we seized over 100,000 clothing



items produced by the ex-licensee of the company. That was very interesting in terms of legal issues. The products were found by the court to be an infringement of our client's trademark because the offenders were using the same materials and processes, and even manpower as they had for the legitimate product.

"What happened was that our client authorized the manufacturer to produce the item in Thailand under a license for a certain period of time. But once the license agreement expired, the company continued to make exactly the same



product. This was a violation of IP rights. We had more than 20 lawyers and IP support staff working on the case.

"In fact, many cases involve manufacturers continuing to make a product after their license has expired. The volume of counterfeit goods produced is often very high. This applies not only to clothes, but many other products, for example automobile parts, including products crucial to public safety, like air bags and brakes.

"Another interesting case that comes to mind is when some shops were buying used cartridges for printers, with genuine packaging. They were cleaning the cartridges and refilling them with an unauthorized ink. Then they repackaged the cartridges and sold them as new. The police hesitated in taking action because both the cartridges and the packaging were genuine.

"We had to explain that even if everything else was genuine, the ink



was not. Therefore the product was counterfeit. We went along for the raid on their storage facility where a lot of cartridges were ready for distribution. They were all seized."

When asked about replica cars produced in Thailand, Mr Suebsiri said T&G had been involved in such cases. "We have to look first at what type of IP is being infringed on. Usually it is an infringement of the design which is protected under the design patent law in Thailand. If the offenders use the registered design it is a violation. Infringement can involve technology as well.

"The IP laws try to find a balance that is fair for the IP rights holder and the public by granting time-limited protection to the IP rights holder. Once the owner of a design files for protection of the design patent, it lasts for ten years. Let's say that someone copied an Italian sports car which was produced 20-30 years ago. The design protection would have expired after ten years and the design would be in the public domain."

The lawyer said a lot of manpower is needed when counterfeit products are seized in a warehouse. "We have many lawyers reviewing all the documents and going back and forth to the court for the purpose of obtaining an Anton Piller order (a court order that gives law

enforcement officers the right to search premises and seize evidence without prior warning so that evidence can't be destroyed). An Anton Piller order is equivalent to a search warrant but it's for civil cases. The lawyer, not the police, must request it from the court and it involves a lot of preparation before it is granted," said Mr Suebsiri.

"Lately we have seen a lot of patent litigation involving technology. For example, we have a case involving hard disc technology. Another case, which was one of the most complicated patent litigation disputes ever before the IP court, involved the technology used in producing indoor mirrors. We represented the defendant in that case.

"Our client was sued for using a similar technology as another mirror manufacturer, but eventually we succeeded in invalidating the plaintiff's patent rights claims because the technology is not that novel. In that single case there were more than 30 hearing dates."





What's real?

How can the average consumer identify whether, for example, a printer cartridge is genuine or refilled with inferior ink. He suggested that, as a rule of thumb, products which are sold at prices that seem too good to be true should be avoided, because they probably are. "If the product is too cheap, it is almost always a fake.

"Take perfumes: it is usually impossible to identify whether they are genuine or fake because you aren't allowed to open the nice package and smell the fragrance. Again, the price should be the gauge. Some perfumes are not just fakes – they are harmful to the consumer when applied to the skin. Similarly, there have been cases where bottles of a genuine whisky product have been filled with a bad product that is quite dangerous to drink.

"Another way to detect counterfeit items is to compare the instructions or manufacturer's specifications inside the box. For example, the lot number should be identical on the product and in the packaging. Another red flag for the consumer should be when the packaging is damaged or the colour is not right," Mr Suebsiri warned.

"As for penalties for IP infringers,



the court will usually reduce the fine, especially for first-time offenders who plead guilty. The infringers know this practice very well, so they keep changing sellers or employees. The thing is that you never catch the big guys. A defendant will almost never see the inside of a jail cell unless he or she cannot pay bail. Almost all defendants plead guilty and are given a fine or suspended jail sentence.

"T&G represents about 10,000 clients in IP matters and was named Asia's 'Firm of the Year 2015' and Vietnam's 'Firm of the Year 2015' at the 10th annual Managing IP Global Awards held in London on March 11," said Mr Suebsiri. "The awardees are selected by researchers and editors from Managing Intellectual Property magazine based on client feedback and the magazine's market research. We have been voted as the leading IP law firm in Thailand by numerous magazines for more than ten years."

