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The First Case against Trademark Infringement under Thailand's Computer Crime Act

As the Thai government became increasingly aware of the exponential rise of online IP infringement, in 2017 the government amended the Computer Crime Act (CCA) to give IP owners the option of blocking websites containing IP-infringing content. In the years following this, however, no trademark owner relied on the website-blocking measures under the amended CCA, which are set out in section 20(3) of the law. This changed recently, when Tilleke & Gibbins assisted our clients in filing complaints under section 20(3) of the CCA against websites infringing trademarks online. This article will briefly discuss the legal measures under section 20(3) along with our firsthand experience in the first case to use this provision against online trademark infringement in Thailand.

Since this provision became effective, more than 90 cases have been brought to the Department of Intellectual Property (DIP) and more than 1,400 URLs from more than 50 websites have been successfully blocked. However, based on our knowledge, these cases were primarily brought for copyright infringement, especially in relation to the film and music industries. No trademark owner had ever brought a case to take action against online trademark infringement.

Our client, a Japanese multinational corporation specializing in cameras and optical technology, received complaints from customers about a website selling dashboard cameras bearing the client's trademark. With the aim of shutting down the infringing websites immediately, we assisted the client in sending cease-and-desist letters to the website operator, the website registrar, and the seller. Despite our

attempts to coordinate with the concerned parties, we did not receive any cooperation from them.

As time passed, several other similarly infringing websites came to our attention, and it appeared that traditional measures would not be the right approach to combat the ongoing infringement of our client's trademark. Therefore, we recommended to the client that they consider the applicable website-blocking measures under the CCA.

These measures were untested. While section 20(3) of the CCA allows trademark owners to request website blocking by filing a complaint with the concerned authorities, no one had previously taken advantage of this legal option. As a result, some concerns were raised by DIP officers as they had not previously used such a strategy in a trademark infringement case. After several consultations with the DIP officers, we finally filed a complaint for trademark infringement directly with the DIP on January 23, 2020, without the need to initiate a case with the police. This complaint was the first submitted directly to the DIP in relation to a trademark infringement matter.

After careful consideration, the director-general of the DIP agreed with us that the act of offering dashboard cameras bearing our client's trademark for sale without authorization constituted an infringement of our client's trademark under section 110(1), in combination with section 108, of 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 minister approved our case, the responsible MDES officer was able to file a complaint with the court requesting that the infringing websites be blocked. The court subsequently allowed the website blocking to proceed as requested, and this instance of online infringement of our client's trademark was stopped.

This first test case shows that the website-blocking measures under the CCA are actionable and effective for online trademark infringement cases in Thailand. This has implications not only for copyright and trademark owners but also for other IP owners looking to eliminate online infringement of their products or services, and protect their valuable brands and IP assets. This new tool in the IP enforcement toolkit offers effective and efficient new possibilities for those seeking to enforce their rights against online infringement—a positive development in the fight against an avenue of infringement that can sometimes be difficult to block. ⚖️