

**PROVISIONAL MEASURES : A STUDY OF THE IMPACT OF TRIPs ON
REMEDIAL MEASURES IN THAI LAW**

*Thesis submitted in accordance with the requirements of the University of
Liverpool for the degree of Doctor in Philosophy by Chaiyos Oranonsiri*

May 2001

Author : Chaiyos Oranonsiri

Title : Provisional Measures : A Study of the Impact of TRIPs on Remedial Measures in Thai Law

ABSTRACT

This research aims to examine the impact of TRIPs on remedial measures in Thai law. Remedial measures, particularly provisional measures, are selected for the study because they relate directly to law enforcement. Regarding the TRIPs' aim of protecting intellectual property rights, a hypothesis of this research is that intellectual property rights' owners will be appropriately protected when provisional measures are enforced. A review of literature and an empirical survey are undertaken throughout the study.

Although provisional measures were introduced into Thai law for a decade, a few cases involving provisional measures have been reported. At the same time, the situation of intellectual property rights infringement, according to the statistics, has not dramatically changed. Therefore, it is difficult to accept that intellectual property rights' owners are protected appropriately since provisional measures came into force. Nevertheless, it does not imply that provisional measures are ineffective either.

From the study, it seems that the major obstacle of the enforcement of provisional measures is the attitude of persons who closely deal with these measures, not the law as such. At present, Thai society does not consider the situation of intellectual property rights infringement as a serious issue. Thus, a mere amendment of the law, particularly an increase of punishment, is not an ideal resolution. Society should be educated about the concept of intellectual property law. If society accept the global change, it can be expected that the situation of intellectual property rights infringement in Thailand will be effectively solved in a long term.

Judges will play a significant role in strengthening the enforcement of provisional measures since they can indicate how the enforcement of these measures should be, and encourage lawyers' confidence on the said measures. It is believed that if the judicial role is well performed, provisional measures will be enforced efficiently. As a result, the TRIPs' aim of providing effective and adequate protection for intellectual property rights' owners will be achieved.

ACKNOWLEDGEMENTS

This research has been undertaken for years. It would not be completed were it not be supported by several persons. A list of these persons cannot be comprehensive, however, the following deserve special mention. First of all, I would like to express my gratitude to the Mahithom Kreeb Krairiskh Foundation for funding my study. I am also indebted to the Ministry of Justice, the Royal Thai Government, for permitting my study leave.

My special thanks are due to Fiona Beveridge, my supervisor, who patiently read and made helpful, constructive comments on the draft. Furthermore, I would like to thank the whole judges in the Central Intellectual Property and International Trade Court for spending their precious time to fill the questionnaires. I am also grateful to Judge Somsak Viturat, Judge Punya Thanomrod, Judge Prinya Deepadung, Mr.Santi Rattanasuwan (the Deputy Director General of the Department of Intellectual Property), Mr.Sunthorn Chantararak of Tilleke & Gibbins, Mr.Chavalit Uttasart of International Legal Counsellors Thailand (Russin & Vecchi), Mr.Pomchai Manas-siripen of the Thai Law Society, Mr.Pravit Mangklatanakul of Baker and McKenzies, and Mr.Chalemphong Jitkuntivong of Domnem, Somkiat & Boonma for their courtesy. Finally, I would like to thank my parents for their support and encouragement throughout my study.

LIST OF ABBREVIATIONS

A.C.	Appeal Cases
AFTA	ASEAN Free Trade Area
ASEAN	Association of South East Asian Nations
B.E.	Buddhist Era
Ch. (C.A.)	Chancery Appeal Cases
Ch.D.	Chancery Division
CMLR	Common Market Law Review
De. G. F. & J.	De Gex Fishers & Jones
D.L.R.	Dominion Law Report
DSB	Dispute Settlement Body
DSU	Dispute Settlement Understanding
EC	European Community
EFTA	European Free Trade Area
F.Supp.	Federal Supplement
F.S.R.	Fleet Street Reports
GATT	General Agreement on Tariffs and Trade
GSP	Generalized System of Preference
IMF	International Monetary Fund
I.R.L.R.	Industrial Relations Law Reports
ITO	International Trade Organization
LJ	Lord Justice
L.R. Eq.	Equity Cases
MFN	Most-Favoured-Nation
M.R.	Master of the Rolls
MTO	Multilateral Trade Organization
NAFTA	North American Free Trade Area
NICs	Newly Industrial Countries
OECD	Organization for Economic Co-operation and Development
PMA	Pharmaceutical Manufacturers Association
R.P.C.	Report of Patent, Design and Trade Mark Cases

S.Ct.	Supreme Court
TPRB	Trade Policy Review Body
TPRM	Trade Policy Review Mechanism
TRIPs	Agreement on Trade-Related Aspects of Intellectual Property Rights
UCC	Universal Copyright Convention
UNCTAD	United Nations Conference on Trade and Development
UNESCO	United Nations Educational, Scientific and Cultural Organization
USTR	United States Trade Representative
WIPO	World Intellectual Property Organization
W.L.R.	Weekly Law Reports
WTO	World Trade Organization

TABLE OF CONTENTS

ABSTRACT.....	1
ACKNOWLEDGEMENTS.....	2
LIST OF ABBREVIATIONS.....	3
TABLE OF FIGURES.....	10
CHAPTER 1 : INTRODUCTION.....	11
1.1 Significance of the study.....	11
1.2 Purposes of the study.....	15
1.3 Scope of the study.....	19
1.4 Methodology.....	21
CHAPTER 2 : REMEDIAL MEASURES FOR INTELLECTUAL PROPERTY CASES.....	24
2.1 Introduction.....	24
2.2 What is intellectual property?.....	25
2.2.1 Is intellectual property 'property'?.....	29
2.2.2 Why should intellectual property be protected?.....	31
2.2.3 Why is intellectual property infringed?.....	36
2.2.4 How intellectual property is infringed?.....	39
2.3 Remedial measures.....	43
2.4 The international organizations and remedial measures.....	46
2.4.1 What is WIPO?.....	47
2.4.1.1 WIPO and remedial measures.....	50
2.4.1.2 WIPO as a failure.....	51
2.4.2 What is GATT?.....	56
2.4.2.1 GATT as an appropriate forum.....	57
2.4.2.2 GATT v WIPO.....	58
2.4.2.3 GATT as a global stream.....	61

2.4.3 Remedial measures in TRIPs.....	63
CHAPTER 3 : TRIPs AND REMEDIAL MEASURES.....	65
3.1 Introduction.....	65
3.2 What is TRIPs?.....	66
3.2.1 The TRIPs' principles.....	71
3.2.2 Why is TRIPs needed?.....	74
3.2.3 The impact of TRIPs.....	81
3.2.4 Intellectual property rights under TRIPs.....	82
3.2.4.1 Copyright and related rights.....	83
3.2.4.2 Trade marks.....	84
3.2.4.3 Geographical indications.....	86
3.2.4.4 Industrial designs.....	87
3.2.4.5 Patents.....	88
3.2.4.6 Layout designs (topographies) of integrated circuits.....	91
3.2.4.7 Undisclosed information.....	91
3.3 The World Trade Organization.....	92
3.3.1 The functions of the WTO.....	95
3.3.2 The scope of the WTO.....	96
3.3.3 The structure of the WTO.....	97
3.3.4 The council for TRIPs.....	98
3.3.5 The dispute settlement process.....	99
3.3.5.1 The evolution of the rule-oriented method.....	102
3.4 Enforcement in TRIPs.....	114
3.5 Remedial measures in TRIPs.....	117
3.5.1 Injunctions.....	120
3.5.2 Damages.....	122
3.5.3 Orders of disposal or destruction.....	126
3.5.4 Right of information.....	129
3.5.5 Provisional measures.....	130
3.5.6 Border measures.....	132

3.5.7 Criminal sanctions.....	135
CHAPTER 4 : INTELLECTUAL PROPERTY LAW IN THAILAND.....	138
4.1 Introduction.....	138
4.2 Copyright law.....	139
4.2.1 The Copyright Act B.E.2521.....	142
4.2.2 The Copyright Act B.E.2537.....	144
4.3 Patent law.....	153
4.3.1 The Patent Act B.E.2522.....	154
4.4 Trade mark law.....	160
4.4.1 The Trade Mark Act B.E.2474.....	161
4.4.2 The Trade Mark Act B.E.2534.....	162
4.5 International obligations.....	164
4.6 The attitude of Thai society on intellectual property law.....	175
4.7 The change of intellectual property rights protection.....	178
4.8 The Intellectual Property and International Trade Court.....	186
CHAPTER 5 : PROVISIONAL MEASURES IN THAI LAW.....	193
5.1 Introduction.....	193
5.2 Provisional measures in Thai law.....	194
5.3 The stage of applying for an order.....	197
5.3.1 The court to which an application will be submitted.....	198
5.3.1.1 Interim injunctions.....	199
5.3.1.2 An order to preserve evidence in advance.....	202
5.3.2 The conditions to be satisfied in an application.....	203
5.3.2.1 Interim injunctions.....	204
5.3.2.2 An order to preserve evidence in advance.....	208
5.4 The stage of granting an order.....	210
5.4.1 The process of granting an order.....	211
5.4.1.1 Interim injunctions.....	211
5.4.1.2 An order to preserve evidence in advance.....	216

5.4.2	The conditions for granting an order.....	217
5.4.2.1	Interim injunctions.....	217
5.4.2.1.1	Reasonable ground for the application.....	218
5.4.2.1.2	Sufficient reason to grant an order.....	219
5.4.2.1.3	The condition of 'irreparable harm'.....	220
5.4.2.1.4	The condition of 'balance of convenience'.....	226
5.4.2.2	An order to preserve evidence in advance.....	229
5.5	The stage of executing an order.....	229
5.5.1	Interim injunctions.....	229
5.5.2	An order to preserve evidence in advance.....	238
CHAPTER 6 : THE JUDICIAL ATTITUDE ON PROVISIONAL MEASURES.....		244
6.1	Introduction.....	244
6.2	The situation of intellectual property rights infringement.....	245
6.3	Have IP rights' owners been appropriately remedied?.....	250
6.4	Why have provisional measures not been sought?.....	252
6.4.1	The absence of evidence.....	254
6.4.2	The doubtfulness of provisional measures.....	255
6.4.3	Are criminal sanctions more appropriate than these measures?.....	258
6.4.4	Judicial attitude regarding provisional measures.....	260
6.5	Is there a need for more participation from judges?.....	261
6.5.1	Judicial qualifications.....	262
6.5.2	Judicial attitude.....	270
6.5.3	The judges' qualifications and their attitude.....	279
6.5.4	The judicial role.....	281
CHAPTER 7 : SUMMARY AND SUGGESTIONS.....		292
7.1	Summary.....	292
7.2	Suggestions.....	297
7.3	Proposals for improvement.....	301

APPENDICES.....	304
APPENDIX I : The translation of questionnaires.....	304
APPENDIX II : Tables of questionnaires.....	310
BIBLIOGRAPHY.....	319

TABLE OF FIGURES

<u>Figure 1</u> Number of lawyers and law firms in Thailand (at July 24, 1998).....	20
<u>Figure 2</u> GDP and population of Indonesia, Malaysia, and Thailand in 1991.....	81
<u>Figure 3</u> Number of cases investigated by the police (1994-March 1998).....	245
<u>Figure 4</u> Number of items being seized by the police (1994-March 1998).....	246
<u>Figure 5</u> Number of registered trade marks and granted patents (1992-1997)...	247
<u>Figure 6</u> Number of cases in the Courts of First Instance (1990-1994).....	248
<u>Figure 7</u> Number of cases in the Courts of First Instance (1995-1997)	249
<u>Figure 8</u> Number of cases in the Central Intellectual Property and International Trade Court (1997-April 1998)	250
<u>Figure 9</u> Number of judges attending seminars concerning the laws of trade marks, patents, and copyright.....	264
<u>Figure 10</u> Number of judges attending seminars concerning intellectual property law.....	265
<u>Figure 11</u> Number of judges attending training courses concerning intellectual property law	265
<u>Figure 12</u> Number of male and female judges and judge trainees.....	268
<u>Figure 13</u> Number of domestic and foreign registered trade marks (1992-1997)	276
<u>Figure 14</u> Number of domestic and foreign granted patent (1992-1997)	277

CHAPTER 1 : INTRODUCTION

1.1 SIGNIFICANCE OF THE STUDY

The protection of intellectual property rights has been a major topic of discussion in international fora for a long time. It seems that, nowadays, intellectual property rights are infringed in every part of the world. These infringements occur in both western and eastern countries, both developed and developing ones. Many countries have been repeatedly criticized for not providing adequate and appropriate protection for intellectual property rights' owners. Thailand is one such country. It has faced trade sanctions from western countries, the United States of America in particular, from time to time.¹

This issue has been long debated between developed and developing countries. It seems that they hold different points of view when discussing the issue of intellectual property rights protection. While developed countries appear to regard intellectual property as private property, developing countries still insist that intellectual property should be considered from the public perspective. Nevertheless, intellectual property rights protection has in recent times been treated as a trade-related issue. As a result, this issue was also discussed in the trade forum, i.e. General Agreement on Tariffs and Trade (GATT), instead of merely the specific forum under the auspices of the World Intellectual Property Organization (WIPO).

¹ Thailand has been complained for providing inadequate and ineffective protection to intellectual property. As a result, Thailand has been placed on the Priority Watch List and Priority List since 1994. Even today, it is claimed that "IPR piracy continues to be one of the leading trade issues between the United States (of America) and Thailand. See USTR. National Trade Estimate Report on Foreign Trade Barriers. Report on Thailand. This report is available in internet.

An agreement involving the protection of intellectual property rights was reached and became binding for members of the World Trade Organization (WTO). It is the *Agreements on Trade-Related Aspects of Intellectual Property Rights (TRIPs)*. This agreement contains several measures for protecting intellectual property rights. As a result, it is believed that this agreement will be the cornerstone for changes in intellectual property rights protection.

It is unlikely that any country, especially a developing one, could oppose this change since intellectual property, nowadays, is significant and regarded as a valuable asset. The idea of giving strict protection to intellectual property rights' owners seems like flowing water, i.e. it flows naturally from an upper level to a lower one. So, there is little chance for developing countries to question why it flows in this direction or to obstruct this global current. Developing countries have to accept that every country, including their own, will benefit from the said protection. If they oppose this concept, they may face retaliation until appropriate protection is finally provided. Furthermore, any country which decides to ignore TRIPs will probably be isolated from the international trade scheme under the WTO.

Thailand, as a member of the WTO, has to implement TRIPs.² This implementation is expected to bring Thai law to an international standard of the intellectual property rights protection. However, Thailand, as a developing country, is still sceptical about this improvement. A prime concern, at present, of the Royal Thai Government, therefore, is whether its obligation to comply with TRIPs have already been achieved. Concern has been expressed that Thailand may face retaliation unless the situation regarding

² According to TRIPs Article 65 (2), Thailand, as a developing country, is obliged to implement TRIPs by the year 2000.

intellectual property rights' infringements is improved. For a developing country like Thailand, a long period of trade sanctions would be unbearable.

To examine whether TRIPs has already been implemented, remedial measures are chosen for this study. These measures have been selected primarily because of their importance in protecting intellectual property rights' owners.³ In practice, it may be too naive to assume that absolute protection is achievable since it is almost impossible to deter a person from committing intellectual property rights' infringements. The practical way should be to accept that intellectual property may be infringed, but to permit as few such infringements as possible. It is expected that, according to TRIPs, intellectual property rights' owners will be appropriately remedied under these measures.

Furthermore, these measures are chosen because they relate closely to enforcement on the law.⁴ It is believed that the aim of TRIPs is to provide intellectual property rights' owners effective protection. Therefore, TRIPs does not merely require members of the WTO to provide the said remedial measures in their domestic laws, enforcement on the law should also be strengthened.

Enforcement must be strengthened in both civil and criminal cases. In Thailand, remedial measures *per se* have from time to time been criticized mostly about its

³ The first paragraph of TRIPs states that "Desiring to reduce distortions and impediments to international trade, and taking into account the need to promote effective and adequate protection of intellectual property rights, and to ensure that measures and procedures to enforce intellectual property rights do not themselves become barriers to legitimate trade;"

⁴ This is also a major aim of TRIPs. Article 41 1 states clearly that "Members shall ensure that enforcement procedures as specified in this Part are available under their law so as to permit effective action against any act of infringement of intellectual property rights covered by this Agreement, including expeditious remedies to prevent infringements and remedies which constitute a deterrent to further infringements."

inefficient law enforcement.⁵ Regarding remedial measures, criminal sanctions, for instance, have been claimed as too lenient and unable to deter anyone from committing infringements. Thailand may, perhaps, face trade sanctions unless it provides protection for intellectual property rights at an 'acceptable' level.

It should be remembered that an intellectual property rights' owner can proceed both civil and criminal litigations to seek remedies. In civil case, an intellectual property rights' owner who his right has been infringed can submit his claim by filing a plaint in writing with the Court of First Instance.⁶ A summons to answer, with a copy of the plaint, will be issued and served on the defendant.⁷ Subsequently, the defendant will file an answer in writing with the court.⁸ He may, in his answer, make a counter-claim, regarding that the counter-claim must have reasonable connection with the original plaint.⁹ In that case, the plaintiff has to file with the court an answer to the counter - claim.¹⁰ In order to facilitate the trial of the case, the court will issue an order fixing a day for a settlement of issues.¹¹ If there is a question of either fact or law, which is raised by one party and not admitted by the opposite party, the court will set it down as an issue in dispute (and impose the burden of proof).¹² Consequently, both parties are entitled to adduce their evidence to the court.¹³ A witness will be examined, cross-examined, and re-examined in open court.¹⁴ After all the necessary evidence has been taken, the court will fix the date for the

⁵ See "U.S. Urged Thailand to Protect Copyright," in *Thai Daily Mails* (Saturday) August 15, 1998. p.10.

⁶ The Civil Procedure Code Sections 55 and 172

⁷ The Civil Procedure Code Section 173

⁸ The Civil Procedure Code Section 177 para.1

⁹ The Civil Procedure Code Section 177 para.3.

¹⁰ The Civil Procedure Code Section 178

¹¹ The Civil Procedure Code Section 182.

¹² The Civil Procedure Code Section 183.

¹³ The Civil Procedure Code Section 185.

¹⁴ The Civil Procedure Code Sections 36 and 117.

pronouncement of judgment.¹⁵ A party who disagrees with the judgment can appeal his case to the Court of Appeal and the Supreme Court consecutively.¹⁶

In criminal case, generally, the public prosecutor will bring an alleged offender to court and file a written plaint.¹⁷ An injured person may associate himself as a co - plaintiff,¹⁸ or decide to file his own case.¹⁹ If a case is brought to court by an injured person, a preliminary hearing will be held by the court to ascertain that there is a *prima facie* case to compel the defendant to appear in court and to proceed with trial.²⁰ The court will consequently issue a summons or a warrant of arrest on the accused if the court is of the opinion that there is a *prima facie* case.²¹ The trial will be held in open court.²² The witness will be examined, cross-examined, and re-examined.²³ Judgment of conviction can be delivered only when the court is fully satisfied that an offence has actually been perpetrated and that the accused has committed that offence.²⁴ Appeal against judgment of the Court of First Instance can be made to the higher courts.²⁵

1.2 PURPOSES OF THE STUDY

The prime objective of this study is to examine the impact of TRIPs on remedial

¹⁵ The Civil Procedure Code Sections 133 and 187.

¹⁶ The Civil Procedure Code Sections 223 and 247.

¹⁷ The Criminal Procedure Code Section 165 para.1.

¹⁸ The Criminal Procedure Code Section 30.

¹⁹ The Criminal Procedure Code Section 28.

²⁰ The Criminal Procedure Code Section 165 para.3.

²¹ The Criminal Procedure Code Section 169.

²² The Criminal Procedure Code Section 172.

²³ The Criminal Procedure Code Section 15 and the Civil Procedure Code Section 117.

²⁴ The Criminal Procedure Code Section 227.

²⁵ The Criminal Procedure Code Sections 193 and 216.

measures in Thai law.²⁶ The study is expected to reveal the change of the said measures in the Thai legal system, particularly since TRIPs was concluded. This concerns the question of whether intellectual property rights' owners in Thailand are appropriately remedied through these measures.

The law *per se* is regarded as having a direct impact. It is clear that members of the WTO have an obligation to comply with TRIPs.²⁷ If they do not fulfil their obligation, they may be forced to comply with it regardless of the state of protection in their countries. Since TRIPs cannot be directly enforced in Thailand, domestic laws are required to implement TRIPs. It is the responsibility of Parliament, as the legislative body, to pass the said laws to conform with TRIPs.

The attitude of society should be considered as having an indirect impact. To some extent, this issue may be more important than the law as such since it closely involves enforcement on the law. It is rather significant since the law itself cannot survive without support from society. Unless society agrees with the law, it may not be enforced properly. Moreover, the said law may even be opposed if society regards it as unjust.

It seems impossible to examine all types of remedial measures at one time. Provisional measures, therefore, are selected for this study. These measures are picked

²⁶ Although Thailand is obliged to implement TRIPs by the year of 2000, Thailand had revised its intellectual property laws, from time to time, even before TRIPs was concluded. Provisional measures, for instance, were first introduced in 1991. To some extent, it seems that intellectual property laws have been improved not only to conform with a foreseeable obligation under TRIPs, but also to protect Thai trade from trade sanctions. It can be argued that such revisions have been undertaken primarily in order to meet the US demand, judging from some activities such as the establishment of the Intellectual Property and International Trade Court which is not the obligation of Thailand under TRIPs. Recently, there are some studies concerning a trade related conflict between Thailand and the United States of America and advantages or disadvantages of Thailand in complying with the US demand. On the other hand, a study concerning direct impact of TRIPs on Thai laws has not yet been reported. Such a study is necessary, since it will help Thailand to realize what Thailand is really required by TRIPs, and how Thailand should improve its laws, and its attitude, in the future.

²⁷ TRIPs Article 1.

primarily because they have been enforced in Thailand only for intellectual property disputes. Consequently, provisional measures can be claimed as the most noticeable impact of TRIPs in Thai law.

Moreover, since these measures have been introduced recently, their effectiveness can be found by comparing the situation before and after their introduction. It seems difficult to find explicit changes in other measures, such as damages or criminal sanctions, since they have been available for a long time. The change may be less significant and difficult to detect.

This study expects to indicate how effective provisional measures are. The current situation of provisional measures will be examined. The trend of the said measures will be analysed too. This study is significant in that it will help the authorities to consider what the circumstances may be in the year 2001. As a result, some amendments, if they are required, may be undertaken appropriately.

The hypothesis of this research, therefore, is that an intellectual property rights' owner will be appropriately protected when provisional measures are enforced. This relies on the assumption that TRIPs aim is to protect intellectual property rights' owners. Since provisional measures have also been provided to achieve this objective, intellectual property rights' owners should be appropriately protected when these measures are enforced. If not, the impact of TRIPs on remedial measures in Thai law will be doubtful.

Regarding the issue of provisional measures, it has been suggested that Thailand has already implemented remedial measures as provided for in TRIPs.²⁸ The question, therefore, is not how to implement TRIPs. It is a question as to whether or not TRIPs provisions have already been complied with.

²⁸ The Report of the Sub-Committee for the Law Enforcement Issue.

Enforcement on the law should also be considered, that is to say, how effective these measures have been since they came into force. To some extent, this issue may be treated as the main objective of the study. At present, Thailand has been criticized for providing ineffective protection for intellectual property rights' owners, notwithstanding the existence of provisional measures.

The study will examine the practice of provisional measures at a domestic level. Generally, it is unlikely that an intellectual property rights' owner can take action directly against a country in which his rights have been infringed since TRIPs is an agreement between states. However, subject to TRIPs provisions, this may be the first step for a country to institute action against another country.

Authorities involved with law enforcement will play significant roles in this issue. Judges, for instance, play one of the main parts in remedying intellectual property rights' owners. The judicial attitude regarding provisional measures will be examined since the law may not be efficiently enforced unless they feel that intellectual property rights' owners will benefit from these measures. Additionally, the judicial role seems important because it can make international agreements become more effective at the national level.²⁹

²⁹ See Hilf M, "The Role of National Courts in International Trade Relations," *Michigan Journal of International Law* 18 (1997)2 p.347. This article bases on a thesis that independent domestic courts would offer the best guarantee of protecting the interests and rights of individual operators, thus making the entire GATT system more effective. See p. 348.

1.3 SCOPE OF THE STUDY

The study will mainly focus on provisional measures in Thai law. Other remedial measures may occasionally be referred to, however, for comparative purposes. Such comparisons will help determine the enforcement of remedial measures in Thailand. This may clarify the general view of TRIPs' impact on Thai law.

Provisional measures will be scrutinized in three main areas. The first concerns the law as such. The Copyright Act B.E.2537 (1994), the Patent Act B.E.2522 (1979), the Trade Mark Act B.E.2534 (1991), the Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539 (1996), and the Rules for Intellectual Property and International Trade Cases B.E.2540 (1997) will be studied. Moreover, several laws which are also relevant to these measures such as the Civil Procedure Code and the Criminal Procedure Code, will be under consideration too.

Secondly, the study will focus on the enforcement of provisional measures in the Thai legal system. The study will concentrate on the trial process which can be divided into three steps. They are the process of applying for an order, the process of granting an order, and the process of executing an order. In fact, there are other elements concerning law enforcement too, such as budgets, equipment, personnel, value of goods being infringed, etc. However, they are not regarded, in this study, as results of the impact from TRIPs.

Finally, the attitude of Thai society toward provisional measures will be discussed. The study, nevertheless, does not attempt to find out how the whole society considers these measures. The limitation of knowledge regarding provisional measures of some members in the society, particularly those not closely involved in these measures, may cause a problem for the study. It is unlikely that the attitude of the whole society can

explain why provisional measures are enforced in the present direction. On the other hand, various opinions may confuse the result of the study, and subsequently lead to a wrong conclusion. Therefore, a target group has been selected for the study.

The target group of the study is those who are involved with provisional measures in practice, for instance, judges and lawyers. The main target group is judges in the Central Intellectual Property and International Trade Court. They play a significant role in this issue since they are empowered to consider and grant these measures.

Lawyers are another target group of this study. They also play a major part in this enforcement. They may persuade their clients to use, or not to use, provisional measures. Moreover, provisional measures are normally initiated by them. Since there are many law firms and lawyers in Thailand,³⁰ some of them are selected to represent this group. Also, such a selection is needed because intellectual property law is regarded as a special law, and not every law firm and lawyer deals with intellectual property cases. The study, then, focuses on those law firms which are involved with the said cases. Consequently, lawyers who have handled intellectual property cases for these law firms have been picked.

Senior officials in the Department of Intellectual Property, Ministry of Commerce will be included because this Department has responsibility for dealing with intellectual property law and also law enforcement in Thailand. In addition, there are some groups who are included for the study, namely public prosecutors and lecturers. It is because

³⁰ According to statistics collected July 24, 1998 by the Law Society, there are 33,384 lawyers and 8,840 law firms in Thailand.

	Bangkok	Other provinces	Total
Lawyers	19,860	13,524	33,384
Law firms	3,540	5,300	8,840

figure.1 The statistics of lawyers and law firms in Thailand.

public prosecutors also deal with crime enforcement while lecturers are the persons who educate law students who will apply these measures in future.

1.4 METHODOLOGY

Two methods will be used in the study. They are a review of literature and an empirical survey. For the first method relevant mostly this information was several documents, such as statutes, texts, articles, etc. This information also includes statistics which have already been collected by some government agencies.

This information can be accessed from many sources. Mostly, useful information is expected to be found in libraries, particularly university libraries. Furthermore, some information, especially statistics, can only be gathered from government offices such as the Ministry of Commerce, or the Ministry of Justice. In addition, a certain amount of information, nowadays, is stored in computerized data bases. As a result, some information will be collected through this channel.

The 'literature review' method was carried out to discover more about the current situation of intellectual property rights infringement and protection. It also revealed further information about how remedial measures, particularly provisional measures, are enforced. The said information was also significant in helping the study, also Thai authorities, to compare and contrast critically the situation of intellectual property rights protection in Thailand and other countries. This assisted in drawing up conclusions regarding appropriate practice for Thai society.

The advantage of this method is that the information does not seem difficult to analyse since it has already been organized, and sometimes analysed, by writers, or compilers, etc. Furthermore, it appears to be convenient to acquire information through this method. At present, using sophisticated technology, an enormous amount of

information can be accessed via computer. This way, further references can be discovered, and consequently several ideas may be added to the study.

On the other hand, there are disadvantages to this method of a review of literature. It was discovered, later, that a lot of the information is not closely relevant to the study. Therefore, it could not be used to answer questions in this study directly. Sometimes, such information is obsolete too. Furthermore, this method is time-consuming. Since a great deal of information was gathered regarding the study, a lot of time is required to read through it. Moreover, some information is not as easily accessed as expected, because it is regarded as confidential, for instance, parliamentary reports on the Drafts of intellectual property law. Additionally, there is not much information concerning provisional measures in Thailand since the said issue is rather new. Finally, the data collection systems in some government agencies are not well organized. As a result, some information relevant to the area of the study was missing or incomplete.

These disadvantages were to an extent overcome by the use of another method, namely empirical survey. Generally, this method was adopted to enable the researcher to create directly relevant and up-to-date information within a short period of time. Furthermore, a further benefit was the reliability of the evidence collected on this way, due to its sources.

This empirical survey was undertaken by an interview method. Two approaches will be used for the study, namely an oral interview and a questionnaire. The oral interview will be carried out to access information involving the general concept of and practice of provisional measures. It is expected that this approach will allow interviewees to express their knowledge and experience. Therefore, experts are selected to be interviewed primarily to receive quality information. In this case, significant idea concerning the issue and the way how to solve the problem, in practice, may be discovered.

The questionnaire approach is used in this study mainly to find out the attitude of judges in the Central Intellectual Property and International Trade Court. To certain extent, the study intends to evaluate opinion of judges who directly deal with an issuance of provisional measures. Therefore, all judges in this court are participated in the study. This questionnaire approach is selected since all these judges are expected to answer the same questions. Therefore, time can be saved by asking them to fill in questionnaires. The said questions are not so complicated and the information appears to be not so difficult to collect.

However, there are some flaws in this method too. First, for the oral interviews, a lot of time has been spent on appointments, travelling, and interviews. Interview via telephone has had to be adapted. Secondly, the answers may be inaccurate since interviewees may respond to the question from what they have in their mind at that moment. They may not have much time to arrange their answers properly. Moreover, with regard to questionnaires, the interviewees may not understand the questions clearly which may cause them to answer mistakenly. In addition, the answers may be limited since, normally, interviewees are unlikely to answer, or explain, more than they are asked.

The results of the study will be presented in chapters. It will be divided into seven chapters. First is the introduction. In chapter two, the study will explain the principles of intellectual property law. Then, the objectives of TRIPs will be discussed in Chapter three. Intellectual property law in Thailand will be presented in chapter four. Later, the study will consider provisional measures and the attitude of judges in the Central Intellectual Property and International Trade Court in chapters five and six respectively. Finally, a summary and suggestions will be expressed for chapter seven.

CHAPTER 2 : REMEDIAL MEASURES FOR INTELLECTUAL PROPERTY CASES

2.1 INTRODUCTION

The significance of intellectual property can hardly be denied. Generally, intellectual property relates to every step in the circle of human lives. It provides knowledge, entertainment, convenience, and other sorts of quality lives. Specifically, intellectual property is regarded as one of the most valuable assets, alongside land and labour. It concerns a large sum of money being circulated globally in the forms of trade, investment, or technology transfer.

Because of its significance, intellectual property has been *infringed everywhere* in the world. This situation is gradually unbearable since it has become obstacles to trade, investment, technology transfer, and international relations. Legal protection and remedial measures, however, have been inappropriately provided in some countries. One reason could be because of different perspectives on this issue, for example the importance of intellectual property. How can two countries provide the same level of remedy to intellectual property rights' owners when they view the importance of intellectual property as at different levels? Consequently, a goal of providing appropriate remedies throughout the world, by requiring similar rules in all countries, will not be achieved unless such rules have been based on a common understanding as to the value of intellectual property. Therefore, it is vital to consider the term of intellectual property and how significant it is. This will help in considering why intellectual property should be protected and remedial measures are needed.

2.2 WHAT IS INTELLECTUAL PROPERTY?

Even though the term 'Intellectual property' has been known for a long period of time, few are ready, or even able, to explain clearly what intellectual property is. Although there have been many attempts to define the meaning of this term, all have found that it is not an easy task to do so. This is because the term is closely related to the human mind. No one would challenge the fact that the most complex thing in the world is the human brain. Until now, scientists have not been able to explain precisely how the brain works. Different backgrounds and environments may hugely affect each person's way of thinking.

In addition, the terms 'intellectual property' and 'economic development' are nowadays bound together.³¹ Economists endeavour to explain intellectual property by economic theories with which they are familiar. At present, intellectual property is not a mere legal issue any more and it has been concurrently analysed from an economic perspective.³² The concept of intellectual property inevitably changes from time to time.

Thus, a possible and appropriate way to find out the meaning of intellectual property is first to accept that no meaning can be permanent. Even though there are vital elements which are permanent in this term, it is not a fixed idea and is slightly changeable, according to time or particular circumstances. The enquiry will therefore

³¹ Intellectual property has been regarded as the mechanism for redressing trade deficits and for maintaining a competitive edge in global markets. See R. Gana, "Has Creativity Died in the Third World? Some Implications of the Internationalization of Intellectual Property," Denver Journal of International Law and Policy 24(1995) p.119.

³² This idea may be supported by the issue of 'moral right' in the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs). It may be argued that moral right was exempted, according to Article 9, mainly because common law countries, particularly the United States of America, are afraid that such a right would undermine negotiating power of an intellectual property right's owner.

shift from 'what intellectual property is' to 'what a suitable and commonly accepted definition of intellectual property is'.

The scope of what can be termed 'intellectual property' varies from country to country.³³ This term was once used to describe copyright and to distinguish it from industrial rights.³⁴ Nowadays, such a dichotomy is diluted and the term of intellectual property is expanded to cover both copyright and industrial rights.³⁵ In developed countries such as the United States of America, intellectual property also includes works of high technology, for instance, semi-conductor chips. Recently, it has been generally agreed that intellectual property should include copyright and related rights, trade marks, geographical indications, industrial designs, patents, layout design of integrated circuits, and undisclosed information.³⁶

At present, intellectual property is literally interpreted as relating to something which is derived from the human brain. A natural phenomenon such as the sound of a blowing wind, or a work produced by an animal such as a picture painted by a monkey, even though it may be very pleasant, will not be regarded as a product in the context of intellectual property. Moreover, intellectual property rights should be worth enough to be protected. In other words, there should be an element that makes intellectual property

³³

There have been many attempts to harmonize the scope of intellectual property in international level. TRIPs is regarded as one major attempt. However, it has to be accepted that even today the scope of intellectual property among countries is still different. Indeed, members of TRIPs and countries which intend to become TRIPs' members have to revise their laws to conform with TRIPs. Others do not show their intention to do so.

³⁴ Intellectual property and industrial property are governed by separate international Conventions, namely, the Berne Convention for the Protection of Literary and Artistic Works 1886, and the Paris Convention for the Protection of Industrial Property 1883 respectively.

³⁵ Copyright includes literary, musical, artistic, photographic and audiovisual works while industrial property consists of inventions, trade marks, trade secrets, industrial designs, service marks, and appellations of origin. See WIPO, General Information (Geneva : WIPO, 1995) p.8.

³⁶ The GATT Agreement on Trade-Related Aspects of Intellectual Property rights. J.L.M. 33(1994) p.1197.

different from a common idea or common knowledge already known in society. Originality or novelty, for example, are required for a copyright or patent respectively. A common idea or knowledge which has existed in the world for a long time and has been regarded as a natural resource is free for everyone to access. No one should be allowed to claim a privilege for an idea or knowledge that he just discovers. That is the reason why the formula of $e=mc^2$ is not regarded nowadays as intellectual property, while a comic strip in daily newspapers is.

Furthermore, intellectual property is focused upon the rights of what the mind produces, rather than upon the product *per se*. According to this element, intellectual property does not exist in a tangible physical form. However, expression is still important. This should be because intellectual property protection is a social reward for a person who creates something useful in society.³⁷ Therefore, this person should not be rewarded for what he keeps for self interest, regardless of how important and valuable. Registration is normally required, for instance, for patent and trade mark. In the case of copyright, such an idea must be expressed in some kind of form,³⁸ for instance, writing, recording, giving a speech or a sermon, etc.

This requirement has been frequently questioned. A trade secret, information which is concealed by nature, has long ago been recognized and protected by the common law and is now regarded worldwide as a kind of intellectual property. It is hard to argue that keeping such information in secret is useful to society. On the other hand, there has been an attempt to give copyright protection not only for expression, but also for ideas. American Courts seemed to be ready to protect the idea behind an expression, judging

³⁷ See E. Hettinger, "Justifying Intellectual Property," *Philosophy & Public Affairs* 18(1989) p.36.

³⁸ Even though a 'fixation' is not required in some countries, such as Thai Copyright Act B.E.2537 (1994), an expression is still needed. See D. Subhapholsiri, *Copyright* (Bangkok : Nititham Publishing, 1996) p.97.

from many computer program cases.³⁹ This is a good example to show that, when particular circumstances have been brought into consideration, the term intellectual property has been flexibly interpreted. The principle of public interest is diluted to the same level, it may be argued, as private incentive.

According to the concept that intellectual property should be worth protecting, there have been attempts to add 'commercial value' to the definition of intellectual property.⁴⁰ This idea is partly true in patent or trade mark issues which concern industrial or trade transactions. However, it is hard to conclude that commercial value is an essential element in copyright. Some artistic works are priceless today, but were not at the time when they were created. Commercial value may never subsist in artistic work which is little better than "a single straight line drawn with the aid of the ruler".⁴¹ Nor does it attach to information of a purely personal or secret nature. Even though commercial value is an important factor in deciding whether intellectual property should be produced or not, it cannot be regarded as an element of intellectual property *per se*.

There is also a suggestion that intellectual property should contain an element of legal protection. In other words, invention and creative expression plus protection equals intellectual property.⁴² This definition is too rigid and circular. It is true that intellectual property is legally protected. Legal protection itself, however, cannot make an idea become intellectual property. It should be the result which comes about only

³⁹ See *Whelan Associates Inc. v Jaslow Dental Laboratory Inc.* 797 F2d 1222, 3rd Cir 1986, *Digital Communications Associates v Softklone Distributing Corpn.* 659 F Supp 449, ND Ga 1987.

⁴⁰ 'Intellectual property' is defined as information with commercial value. See National Consumer Council, *Intellectual Property - the Consumer View of Patents, Copyright, Trade Marks and Allied Rights* (London : National Consumer Council, 1991) p.2.

⁴¹ This phrase was made by Megarry J. in *British Northrop Ltd. v. Texteam Blackburn Ltd.* [1974] R.P.C.57 at 68.

⁴² R. Sherwood, *Intellectual Property and Economic Development* (Colorado : Westview Press, 1990) p. 12.

after intellectual property already exists. In Thailand, where an obscene object, for instance, is regarded as immoral and against public order,⁴³ it is not practical for the court to point out that an obscene movie is not regarded as intellectual property because the movie as such is not protected by law. It is more understandable for a trial judge to decide that, since it is against the law, such a movie is not regarded as intellectual property, and consequently is not protected.

2.2.1 IS INTELLECTUAL PROPERTY 'PROPERTY'?

This question does not really intend to challenge the value of intellectual property. It is asked just to examine whether intellectual property is 'private' property. In the past, there was a strong concept of 'public' property that everyone in society should be allowed to use intellectual property. While the interests of society are regarded as paramount, intellectual property seemed to be public domain. The economic rights of an individual author, inevitably, become less valuable. The Soviet copyright law once declared that any works in science, literature, music, and art were recognized as state property.⁴⁴

The other idea supporting the 'public property' concept viewed intellectual property as a natural outcome. Ancient Chinese philosophers regarded intellectual property as a product imitated from nature by human beings, not a product created or invented by them.⁴⁵ Therefore, others should not be excluded from 'the common heritage of all civilized persons'.

⁴³ The Thai Supreme Court judgment no.3705/2530 (1987).

⁴⁴ Decree of 26 November 1917.

⁴⁵ J. Chaves, "The Legacy of Ts'ang Chieh : The Written Word as Magic," *Oriental Art* 22(1977) p.203.

Today, it is no wonder that many jurists regard intellectual property as one kind of property,⁴⁶ alongside land and personal property. Theorists have endeavoured to analyse many theories such as Locke's 'Labour' property theory or Personality theory in order to support the view that intellectual property is a kind of property.⁴⁷ A few may still resist this idea, only because it seems too extreme to say that intellectual property is property in a similar way to land or chattels.⁴⁸ The American courts once regarded intellectual property as 'absolute property',⁴⁹ however, they have adapted their attitude and later granted limited protection to intellectual property.⁵⁰ The reasons are because, first of all, intellectual property seems different from 'normal' property since it is intangible. Secondly, intellectual property is distinct from other kinds of property. The life cycle of both natural resources and man-made products normally depends on use while intellectual property is not bound directly to the use of a right holder. A trade mark, for instance, is infinitely renewable. On the other hand, other kinds of intellectual property such as copyrights and patents have self-defined expiration.

Thirdly, an intellectual property owner can license his right to another while still being able to use such a right himself. In other words, the possession or use of intellectual property by one person does not preclude others from possessing or using it and it is

⁴⁶ W. Cornish, "The International Relations of Intellectual Property," Cambridge Law Journal 52(1993) p.47. Also S. Pramoj, Copyright of the Author (Bangkok : Sivapom, 1968) p.4.

⁴⁷ See J. Hughes, "The Philosophy of Intellectual Property," Georgetown Law Journal 77(1988) pp.287-366.

⁴⁸ See J. Phillips, and A. Firth, Introduction to Intellectual Property Law (London : Butterworths, 1995) pp.125-127. Hettinger. *op cit* . p.35. D. Vaver, "Intellectual Property Today : Of Myths and Paradoxes," Canadian Bar Review 69 (1990) p.125.

⁴⁹ *Derninger v. Plate* 29 Cal.292 (1865); *Kidd v. Johnson* 100 US 617 (1879).

⁵⁰ *France Milling Co.,Inc. v. Washburn - Crosby Co.,Inc.* 7 F.2d 304 (2d Cir.1925); *Peabody v. Norfolk* 98 Mass. 452 (1868). For details, see K. Vandevelde, "The New Property of the Nineteenth Century : The Development of the Modern Concept of Property," Buffalo Law Review 29 (1980) pp.341-354.

not consumed by their use. This results in criminal cases where an infringer reproduces imitation goods while the genuine one is still in the owner's possession. Under criminal jurisdiction, intellectual property cannot be stolen.⁵¹ In addition, certain traditional concepts concerning property, such as 'usucapion', cannot be applied to intellectual property.⁵² Strongly influenced by the concept of property, the United States of America and England, for instance, are reluctant to support the notion of 'moral right'.

By these reasons, intellectual property should be regarded as property, however, in a different manner from other properties. All rights and obligations concerning intellectual property should be provided in intellectual property laws. General principles for normal property may be applied to intellectual property only when they are allowed by such *sui generis* laws. In other words, intellectual property is protected as 'property' provided in intellectual property laws, not as normal property defined in general laws. Such protection may be even tougher than 'normal' property protection since intellectual property infringement is nowadays viewed more seriously than other types of property infringement.

2.2.2 WHY SHOULD INTELLECTUAL PROPERTY BE PROTECTED?

Most countries have already granted protection to intellectual property rights' owners. Previously, such protection was limited by the influence of the 'public interest' concept.⁵³

⁵¹ See *Oxford v. Moss* (1978) 68 Cr App R 183, *Rank Film Distributors Ltd. v. Video Information Centre* [1982] AC 380, *Stewart v. Queen* (1988) 50 D.L.R.(4th)1.

⁵² *The Thai Supreme Court judgment no.677/2532 (1989) and 846/2534 (1991)*

⁵³

It is argued that a modern version of the 'public interest' concept is the 'consumer politics' concept. See B. Sopido, *Piracy and Counterfeiting: GATT, TRIPs and Developing Countries* (London: Kluwer Law International, 1997) p.1. This concept is explained as 'it is in the public interest to provide similar products at cheaper prices; particularly to poorer consumers and poorer nations.' To some extent, this idea is slightly different from the original idea of the 'public interest' concept. While the 'public interest' concept stresses that intellectual property is public domain and is

Intellectual property rights protection has been gradually required since intellectual property was considered as private property. Many reasons have been given to support this requirement such as the moral approach, or the economic approach.⁵⁴ These are frequently mentioned to justify the existence of intellectual property and its protection. However, there are many sceptics who have explicitly shown their doubts about these approaches.⁵⁵ They directly attack the core of this argument, namely, the justification for intellectual property. The existence of intellectual property rights protection in many countries, especially developing countries, does not prove that such countries totally agree with the idea of intellectual property rights protection *per se*.

Many flaws have been pointed out when looking at the moral approach. This approach is commonly used to justify intellectual property as an intrinsic right. This does not seem justifiable. Historically, China, the country which first invented paper, was not influenced by this approach. Ancient laws concerning what is called copyright today seemed to give authorities a right of censorship, rather than protection for an author.⁵⁶

This moral approach coincided with an idea in the western part of the world. In England, for instance, a patent was granted to a person who brought foreign knowledge

free for every one to enjoy it, it seems that intellectual property is recognized by the 'consumer politics' concept as private property but the public should be able to enjoy it at low cost.

⁵⁴ See S. Breyer, "The Uneasy Case for Copyright: A Study of Copyright in Books, Photocopies, and Computer Programs," *Harvard Law Review* 84(1970) p.284. Also Sapiro. *op.cit.* p.51.

⁵⁵ See G. Hammond, "The Legal Protection of Ideas," *Osgoode Hall Law Journal* 29(1991) pp.93-125. Also Breyer. *op.cit.*, R. Merges, "Commercial Success and Patent Standards: Economic Perspectives on Innovation," *California Law Review* 76(1988) pp.805-876, Hettinger. *op.cit.* and Vaver. *op.cit.*

⁵⁶ There is evidence that, in A.D.835, unauthorized reproduction of calendars was prohibited on the basis that they might be used, by other persons apart from court astronomers, to predict the dynasty's downfall. See W. Alford, *To Steal a Book Is an Elegant Offense Intellectual Property Law in Chinese Civilization* (California: Stanford University Press, 1995) p.13

to the country, no matter who the real creator was.⁵⁷ In addition, suspicions were raised by the fact that where the intrinsic right of an author or an inventor was said to be worthy of protection, such protection was often enjoyed by the company who employed such author or inventor, or stationer, or publisher, rather than the author or inventor him/herself.⁵⁸ Even today, certain kinds of intellectual property, pharmaceutical products in particular, are regarded in many developing countries as public property.

The moral approach seems weak in the context of 'duration' issues. Intellectual property rights protection is limited in both time and space. If it is moral to protect an intrinsic right, it should be perpetual. Furthermore, this approach is unable to render a clear solution in a case where more than one person creates the same thing at the same time.

Common law system countries, such as England and the United States of America, pay less attention to this approach and concentrate more on the economic value of intellectual property. It is argued that intellectual property is a reward that society grants to an author or an inventor for a creation which benefits society. At the same time, such reward is also an incentive to an author or an inventor to create his own work. The benefit eventually returns to society. The former reason has been frequently raised to justify intellectual property rights protection. By this utilitarian concept, it is assumed that protection should be granted for a work which benefits society.

At present, protection is granted regardless of whether society receives any benefit. A lot of works have been created merely for the benefit of their creators. Society does

⁵⁷ See C. MacLeod, *Inventing the Industrial Revolution: The English Patent System 1660-1800* (Cambridge : Cambndge University Press, 1988) p.10.

⁵⁸ See B. Kaplan, *An Unhurried View of Copyright* (New York : Oxford University Press, 1968) citing Donaldson v. Becket [1774] H.L. Also J. Feather, "Authors, Publishers, and Politicians : The History of Copyright and the Book Trade," *EIPR* (1988) pp.377-380.

not even realize the existence of such work because, for example, it is confidential. What is the value to society in allowing an author to invoke intellectual property rights over work which remains unpublished?

As for patents, the idea of granting full protection to a patentee has been opposed by many countries, in particular developing countries. In practice, a patentee registers his invention in some countries merely to prevent other persons from utilizing his invention. In other word, a patentee does not really intend to do anything concerning 'research and development' in those countries. Instead, importation of goods has been regarded as the use of his/her invention. Consequently, those countries cannot receive any benefit from granted patent within a period of protection. Meanwhile, compulsory licensing, regarded as a legal remedy for this situation, is seemingly allowed to exploit narrowly. Moreover, a patentee endeavours to draft his claim in such a way that he discloses as little useful information as possible, while broadening the scope of the claim as wide as possible.⁵⁹ The justification of social benefit is, then, used merely to persuade countries to grant protection to an author or an inventor. In the past, economists have hardly been able to argue that the patent system conferred benefit upon society.⁶⁰

The other argument referred to above is that unless intellectual property is protected, an author or an inventor has no incentive to create his work. This argument is also under attack from many scholars. There is no strong evidence to prove that a person stops creating as soon as the authorities stop granting protection. Several great authors in ancient Greece and Rome were believed to write to achieve fame and recognition,

⁵⁹ See *Brenner v. Manson* 383 US 519 (1966) at p.534.

⁶⁰ See F. Machlup, An Economic Review of the Patent System, Study of the Subcommittee on Patents, Trade Marks and Copyrights of the Committee of the Judiciary (Washington : U.S. Government Printing Office, 1958).

rather than to earn a living. Van Gough produced a lot of priceless paintings without showing that protection was unique.

It was also clear in the oriental concept that such incentive was not essential. Scholars should produce their work for educational and moral renewal, rather than profit. A famous Chinese aphorism states, "Genuine scholars let the later world discover their work [rather than promulgate and profit from it themselves]."⁶¹ The reaction of a famous author to the forging of his work was simple, "If my poems and paintings, which are only small efforts to me, should prove to be of some aid to the forgers, what is there for me to grudge about?"⁶² At present, it is believed that, apart from merely intellectual property rights protection, a lot of creative work have been produced in response to other incentives. Also employees are not much concerned about such protection since they receive no direct benefit from it.

Accordingly, it seems that the economic reason is the main justification for intellectual property rights protection. Today, advanced technology in particular is growing rapidly. The computer, for instance, has become a common product and a household word everywhere. One reason for this is that communication has linked all countries around the globe together. A person living in Asia is able to access the same information at the same time as another who lives in Europe. This inevitably involves a huge amount of money, in terms of both profit and investment. Dramatic increases in the research and development costs of such advanced technology lead to the requirement of appropriate protection. Intellectual property has played an important role in expanding the economies of developed countries.

⁶¹ Alford. *op.cit* . p.29.

⁶² Wen Fong, "The Problem of Forgeries in Chinese Painting," *Artibus Asiae* 25(1962) p.100.

The strict policy of the United States of America concerning intellectual property protection all over the world, for instance, is not intended to encourage an author or an inventor to create his work. Nor is it a reward for what an author or an inventor has done for society, especially for other societies. The main reason for protection is that intellectual property is regarded as property which, according to the American Constitution, is regarded as vital as life and liberty. Furthermore, the United States of America clearly aims to strengthen its economic power in the world. Technological dominance can be said to determine economic power,⁶³ since it has a crucial role in both domestic and foreign investment, apart from capital, resource and labour. A vast international market has been seen as necessary to cope with the enormous 'research and development' costs. The United States of America is a world leader in this field and it is of huge American advantage to retain this position. In order to do so, efficient protection is a must.

2.2.3 WHY IS INTELLECTUAL PROPERTY INFRINGED?

Intellectual property rights' infringers should be divided into two groups, namely the group that infringe intellectual property purely for economic reasons, and the group that infringe because of other reasons. For the first group, it is not so complicated to understand their desire. What is worth protecting is worth copying. As mentioned above, an intellectual property rights' owner requires protection for his intellectual property for economic reasons since he deals with large sums of money. A person infringes intellectual property for the same reasons. A slightly different one is that an infringer needs less investment, yet more profit. The more profit involved the greater the

⁶³ T. Mesevage, "The Carrot and the Stick : Protecting U.S. Intellectual Property in Developing Countries," Rutgers Computer and Technology Law Journal 17(1991) p.421.

opportunity for infringement of intellectual property rights. By means of advanced technology, ironically, an infringer is able to produce a great number of imitation goods within a day. It means that an infringer may become a millionaire just over a short period of time. This seduces people into such illegal business.

When looking at the macro economic level, it is well accepted that, at present, the economic development of many countries is based mainly upon intellectual property. Developing countries therefore require knowledge and advanced technology to strengthen their economies. From experience, since advanced technology was very expensive, developing countries could merely afford 'second rate' technology. Consequently, they could not catch up with developed countries and had to rely upon that technology. Some of them, then, choose a short way to achieve this goal with fewer costs by not strictly restraining their citizens from infringing such intellectual property. This illegal activity, has been condemned by researchers as unsuitable as a long term strategy. Many researches have strongly indicated that intellectual property protection eventually benefits society.⁶⁴ The development of certain Newly Industrial Countries (NICs), such as Korea, Singapore, or even Japan were raised as illustrations. Researchers have noted that 'piracy' was not the secret of Japan's remarkable success and have argued that Korea could have done even better had it had a strong system of intellectual property protection earlier.⁶⁵ Unsurprisingly, many developing countries seem to look at NICs from a different perspective. Infringement is not viewed as the way for developing countries to attain the same standard, but is viewed as a springboard or

⁶⁴ See Mesavage. *op.cit.*

⁶⁵ Sherwood. *op.cit.* pp.177-178. A. Gutterman, "The North-South Debate Regarding the Protection of Intellectual Property Rights," Wake Forest Law Review 28(1993) p.137.

step on the way. It has indeed resulted in economic progress for some countries.⁶⁶ After economic development, they are not able, or do not want, to cope with intellectual property infringement because it turns out to be a vital source of their economic growth.⁶⁷ In Thailand, for instance, the problem of dealing with intellectual property rights infringement inevitably has an effect on the stability of the government, therefore, successive governments have been reluctant to deal with it.⁶⁸

Other reasons for infringing intellectual property are varied. Primarily, such infringements have been carried out by persons who do not think that they do something 'wrong'. The concept of 'public property' has been used as an excuse.⁶⁹ A dispute over pharmaceutical product is a good illustration. Developing countries have taken the view that public health is more important than private rights. Their citizens are so poor that they cannot afford to pay for expensive drugs, so that the need for pharmaceutical companies to receive their 'research and development' costs is regarded as less vital than human lives.

Furthermore, intellectual property rights infringement is sometimes regarded as a mere breach of contract or other kind of 'wrong doing' in business and, hence, many people do not consider it 'immoral' to infringe intellectual property. Copying has long

⁶⁶ T. N. O'Neill III, "Intellectual Property Protection in Thailand : Asia's Young Tiger and America's "Growing" Concern," University of Pennsylvania Journal of International Business Law 11(1990) p.604.

⁶⁷ It was remarked that counterfeiting, for some developing countries, has become a *de facto* national industrial development strategy. See J. S. Jennings, "Trademark Counterfeiting : An Unpunished Crime," Journal of Criminal Law & Criminology 80(1989) p.819.

⁶⁸ The Thai Government and also the Parliament were once dissolved after a critical dispute over unpopular proposed copyright legislation. See Bangkok Post April 30, 1988. p.1.

⁶⁹ See C. Braga, "The Economics of Intellectual Property Rights and the GATT : A view from the South," Vanderbilt Journal of Transnational Law 22(1989) pp.251-253. Also T. Stewart, The GATT Uruguay Round : A Negotiating History (1986-1992) Volume II : Commentary (Deventer : Kluwer Law and Taxation Publishers, 1993) p.2255.

been considered as an accepted form of praise in the Orient. In Ancient China, it was claimed as a vital means of circulating, and perpetuating, treasured masterpieces of calligraphy and painting.⁷⁰

Additionally, intellectual property rights protection is interpreted by some as an attempt to deprive developing countries of the benefits of technological advance.⁷¹ It is accepted that intellectual property is expensive because of the costs of 'research and development' or investment. However, certain products, such as computer software or music, are disproportionately dear. The idea of strong protection upsets developing countries since many developed countries, such as Japan or even the United States of America, also used to infringe the intellectual property rights of other countries in the past.

2.2.4 HOW IS INTELLECTUAL PROPERTY INFRINGED?

Intellectual property has been infringed for a long period of time. It is defined as making a copy of such property without the authorization or consent of the owner. This illegal action, in general, also includes other forms such as adaptation, renting, performing, broadcasting, transmitting, import, export, etc. Not many countries paid much attention to intellectual property rights infringement in the past since it dealt with a small volume of money and was regarded as private loss. Nowadays, as technology has developed, the infringing process has become very sophisticated and, subsequently, deals with a huge volume of private loss. By using such advanced technology, an infringer may use just a couple of days in making millions of replicas. Such infringement

⁷⁰ Wen Fong, *op.cit.* p.95.

⁷¹ W. E. Siebeck, Strengthening Protection of Intellectual Property in Developing Countries : A Survey of the Literature (Washington : World Bank, 1994) p.1.

is inevitably spread out across boundaries and becomes an international transaction, occasionally named counterfeiting or piracy.

The terms counterfeiting and piracy have a long and varied history.⁷² Many countries have decided to construe such terms according to their own experience. Consequently, counterfeiting and piracy have been used as synonyms. Sometimes these terms have been even defined as similar to infringement. There have been some attempts to deliberately define both counterfeiting and piracy since both terms have been frequently used to refer to illegal activities occurring internationally.⁷³ However, the definition of these terms has remained inconclusive especially when the issue of counterfeiting and piracy has been debated internationally. This has led to the decline of the importance of these terms.⁷⁴

Counterfeiting, to some extent, is linked to trade mark infringement. The word 'counterfeit' and 'trade mark' are bound together in all the U.S. International Trade Commission,⁷⁵ the European Communities,⁷⁶ and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs).⁷⁷ Typically, it is defined as the making of

⁷² For details, see M. Levin, "What Is the Meaning of Counterfeiting?," *IIC* 18(1987) pp.435-456.

⁷³ There are many documents concerning 'counterfeit goods', for instance, Agreement on Measures to Discourage the Importation of Counterfeit Goods, U/4817, 07/31/79 ; Trade in Counterfeit Goods, U/5758, 11/30/84.

⁷⁴ The phrase 'including trade in counterfeit goods' was deleted from the title of the TRIPs Agreement. See A. Porges, "Introductory note on General Agreement on Tariffs and Trade : Multilateral Trade Negotiation Final Act Embodying the Results of the Uruguay Round of Trade Negotiation," *I.L.M.* 33(1994) p.1128.

⁷⁵ It is defined as "the unauthorized use of a registered trade mark on a product that is identical or similar to the product for which the trade mark is registered and used". See The U.S. International Trade Commission, The Effects of Foreign Product Counterfeiting on U.S. Industry (1984) p.vii.

⁷⁶ See Council Regulation (EC) No 3295/94 of 22 December 1994 : laying down measures to prohibit the release for free circulation, export, re-export or entry for a suspensive procedure of counterfeit and pirated goods, Article 1 2(a).

⁷⁷ See the Agreement footnote 14 (a).

a copy without authority or right and with a view to deceiving or defrauding by passing off the copy as original or genuine.⁷⁸

This definition seems to consist of two crucial elements, namely, the intentional exploitation of another's right without authorization, and with the purpose of deception. The World Intellectual Property Organization (WIPO) once broadened the definition of this term, albeit making it more obscure, by regarding counterfeiting as an act which results in the making of counterfeit goods or dealing in counterfeit goods.⁷⁹

It is worth noting that the element of deception was not mentioned in this definition. It may be because nowadays consumers are seldom confused about the origin of goods. On many occasions, they can immediately identify infringing goods among genuine ones by the price. A counterfeiter, at the same time, does not endeavour to conceal this truth and even reminds his consumers of it.

This odd circumstance happens because some consumers merely want to enjoy the status of a prestigious label. They cannot afford, or do not intend, to pay for genuinely high quality products. The process of counterfeiting goods therefore satisfies certain consumer desires.⁸⁰ Consequently, it is argued that counterfeiting may benefit consumers, both in developed and developing countries, in as much as consumers are well informed about such products.⁸¹

⁷⁸ H C Black. *Black's Law Dictionary* (Minnesota : West Publishing, 1990), p.349.

⁷⁹ WIPO Committee of Experts on the Protection Against Counterfeiting : *First Session PAC/CE/1/2* (Geneva : WIPO, 1986) p.10.

⁸⁰ G. M. Grossman, and C. Shapiro, "Foreign Counterfeiting of Status Goods," *Quarterly Journal of Economics* 103 (1988) p.98. Also Sopido. *op.cit.* p..152.

⁸¹ It is important that consumers must not be deceived about the origin and the quality of goods. Therefore, it is their own choice whether or not to take risks and buy counterfeit goods. However, this situation will not be regarded as an excuse. Even a counterfeiter who reveals the truth concerning his goods, is still regarded as doing wrong. On the one hand, he diminishes quality of goods in order to decrease his cost. On the other hand, he takes advantage illegally

The term 'piracy' has been in use to describe illegal activity concerning copyright for nearly 200 years. It has been found in many English cases since the nineteenth century.⁸² There is a close relation between this word and copyright.⁸³ However, piracy was defined as a generic concept which also covered counterfeiting. Piracy generally means the appropriation and reproduction without authority of an invention or work of another for one's own profit. The WIPO/UNESCO Committee of Governmental Experts limited the scope of this definition to "the unauthorized commercial manufacture and the subsequent sale or other distribution of copies of works and other products protected by copyright and/or neighboring rights".⁸⁴

At present, the importance of the terms 'counterfeit' and 'piracy' has slightly decreased for two main reasons. One is ambiguity, the narrowness of such terms is another. The definition of such terms is still unclear since it depends on who is defining these terms and for what purposes they are being defined. In addition, both private and public organizations are agreed that legal protection for patents should also be a consideration. It is, however, not a good idea either to include patents in these terms, or to extend such terms to cover patents. Doing so, will inevitably make such ambiguous terms more confused.

Many countries are now aware of the risks from such infringements. Since a person chooses to infringe on the basis that it is profitable within a short period of time, he does

from other's business. In fact, the ego of consumers should be changed instead of providing counterfeit goods to reach their desire.

⁸² Wood v.Boosey [1867] LR3 QB229. Pike v.Nicholas [1869] LR5 Ch 251. Ladbroke (football) Ltd v.William Hill (football) Ltd.[1964] 1 WLR 291.

⁸³ See Council Regulation (EC) No 3295/94. *op.cit.* Article 1 2(b); TRIPs footnote 14 (b).

⁸⁴ The Committee of Experts, "Audiovisual Works and Phonograms : Preparatory Document for and Report of the WIPO/UNESCO Committee of Governmental Experts," Copyright 7/8 (1986) p.222.

not usually consider the result of such illegal activities. An infringer does not incur many costs and pays no attention to repeat customers. He tries to keep his infringing goods as cheap as possible by reducing quality, safety, and cleanliness. This results in a low quality of product and can present a danger to health and safety. Today, it is argued that confidence in genuine products, such as vehicle parts, is threatened by accidents caused due to defective counterfeit products.⁸⁵ Furthermore, since it seems that there are more incentives to counterfeit or pirate than to create or invent products or processes, this leads to a lack of creativity and monetary investment. Many countries lose profits through these illegal activities. It was estimated that in 1988 alone, American companies suffered aggregate worldwide losses of not less than \$40 billion due to inadequate intellectual property protection.⁸⁶ Reductions in revenue and losses or jobs were reported as a result of counterfeiting and piracy.⁸⁷

2.3 REMEDIAL MEASURES

There have been many attempts to cope with these intellectual property rights infringements because they have created chronic problems not only on a regional level but also in the context of international economic relations.⁸⁸ Huge losses have been

⁸⁵ R. Rowell, Counterfeiting and Forgery (London : Butterworths, 1986) p.151.

⁸⁶ T. Davis, "Combating Piracy of Intellectual Property in International Markets : A Proposed Modification of the Special 301 Action," Vanderbilt Journal of Transnational Law 24 (1991) p.508.

⁸⁷ G. Hoffman, Curbing International Piracy of Intellectual Property : Policy Options for a Major Exporting Country (Washington : American Enterprise Institute, 1989) p.6. See also Subcommittee on Oversight and Investigation, House Committee on Energy and Commerce, 98th Cong., 2D Sess., Unfair Foreign Trade Practices : Stealing American Intellectual Property : Limitation is not Flattery. 46 (Comm. Printed 98-v) (1984)

⁸⁸ It is even argued that counterfeiting is no longer merely a global problem, as the pirates expand into the universe. See J. Arsic, "Combating Trade in Counterfeit Goods, the GATT and the EC Approaches," World Competition Law and Economic Review 18(1995) p.75.

reported in businesses which were under threat from counterfeiting and piracy. However, it is too naive for an owner of intellectual property to assume that absolute protection is achievable since it is almost impossible to deter a person from such lucrative business. Recently, the outcry from developed countries concerning counterfeiting and piracy is primarily based on losses of export advantages or profits. This controversy may be relieved if developed countries are confident that they are entitled to adequate and effective remedies for their would-be losses. A practical way is to accept that intellectual property will be infringed, but to demand that such infringement should be allowed as little as possible and, at the same time, to provide that the owner can be compensated to the extent of his loss.

Remedial measures are a legal mechanism granted by the authorities, i.e. judges, to remedy illegal infringement. Normally they are sought in consequence of such infringement. They may be sometimes sought even before an illegal act is committed, for example the '*quia timef*' injunction. In general, remedial measures are divided into two broad categories, namely, civil remedies and criminal sanctions. One of the common civil remedies is damages. It is a judgment that an intellectual property owner is entitled to money from an infringer. The other is an injunction, an order to an infringer to refrain from the wrongful conduct. Criminal sanctions normally include monetary fines and imprisonment. Seizures or destruction of infringing goods may be provided in some countries.

These types of remedial measures vary from country to country. Damages, for instance, may be allowed for actual loss only, or may include a concept of an account of profits.⁸⁹ This is because remedial measures have been viewed in different

⁸⁹ For instance, the English Patents Act 1977 Section 61 (2).

perspectives. These measures are used for several purposes such as putting an injured person back into the situation he was in before such infringement was occurred, or protecting such a person from further harm. They are also used to deter any person from committing illegal acts which will possibly harm an intellectual property rights' owner.

The 'classic' purposes have not been an ideal solution for an intellectual property rights' owner since they could not solve the core of the problem, i.e. the existence of an infringement. The injured person has had to suffer from such infringement first and, worse, received inappropriate compensation later. Frequently, due to trial delays, the person was placed in such a situation that remedies such as damages were not adequate to meet his loss.

The deterrent approach has been inserted into the remedial concept and has provided the important and necessary dimension to combat these illegal activities. Remedial measures are currently used to deter any person from committing illegal acts by not allowing him to benefit from his illegal act. This approach coincides with an equitable concept in the Common Law system. The interim injunction is very efficient in deterring any person from committing an infringement. The deterrent concept is very important, especially in practice, when a judge makes a decision regarding appropriate damages or a proportionate term of imprisonment in an intellectual property case. If this concept is not persuasive, judges may not grant sufficiently punitive damages or a sufficiently severe term of imprisonment. Remedial measures *per se* inevitably lose the vital effect.

Nevertheless, this legal mechanism must be aimed at rendering justice to society as a whole. The said justice should be impartial for all parties. If it constitutes an injustice to an intellectual property rights' owner, he will search for justice in his own way, and society will definitely be chaotic. On the contrary, there have been many examples

where an owner of intellectual property rights found loopholes in the law and enforced his rights in order to get rid of business competitors.⁹⁰

Since intellectual property rights infringement today concerns international transactions, society here should be construed as world society. It is, thus, not up to each country to manipulate these mechanisms through their own perspectives. Remedial measures should be pointed in the same direction. Every country, both developed and developing, must now realize that sincere cooperation is needed to cope with the problem. They have to lay down their selfish interests, or even pride, and be ready to face the fact that their attitude will have to change, and their perception of what is of benefit to them may also change in the future. A compromise may be inevitable in order to sort out this mutual problem. This leads to the next discussion of how to guide remedial measures for each country in the same direction, and which measures are acceptable.

2.4 THE INTERNATIONAL ORGANIZATIONS AND REMEDIAL MEASURES

There have been many international organizations dealing with intellectual property such as the United Nations Educational, Scientific and Cultural Organization (UNESCO), the United Nations Conference on Trade and Development (UNCTAD), the World Intellectual Property Organization (WIPO), and the General Agreement on Tariffs and Trade (GATT).⁹¹ Even though UNESCO administers one of the major copyright convention, the Universal Copyright Convention (UCC), it does not play a vital role in

⁹⁰ There is a case where a party unreasonably prolonged litigation for the purpose of collecting disproportionately large statutory damages and attorney's fees. See *Wamer Bros. Inc. v. Dae Rim Trading Inc.* 677 F.Supp. 745,773 (S.D.N.Y. 1988).

⁹¹ By the Final Act signed at Marrakesh on 15th April 1994, GATT was transferred into the World Trade Organization (WTO).

intellectual property rights protection, especially in remedial issue. Ironically, UCC was established as an attempt to assimilate members of Pan American copyright conventions with the Berne Convention. The Significance of the UCC was sharply declined soon after the United States of America left this Convention and joined the Berne Convention.

Also, UNCTAD is an another organization which aims to promote international trade between countries at different stages of economic development and the formulation of principles and policies on international trade and the related question of economic development. Due to this aim, UNCTAD has frequently concerned an intellectual property issue in developing countries, particularly the issue of transfer of technology to these countries. UNCTAD, however, has hardly received full support from developed countries since it was viewed as the forum established by the support of developing countries.⁹²

On the other hand, the other two organizations, namely WIPO and GATT, play the crucial roles in giving protection to an owner of intellectual property rights. Furthermore, they have endeavoured to introduce appropriate remedial measures to their member countries.

2.4.1 WHAT IS WIPO?

The World Intellectual Property Organization (WIPO), the main organization dealing with intellectual property rights protection, is a specialized agency set up under the

⁹² UNCTAD was created by the United Nations through the attempt of the Group of 77, a permanent political bloc of developing countries, to be its international economic forum.

auspices of the United Nations and established by a Convention signed at Stockholm in 1967. At present, it administers several unions and treaties including the Berne Union (for the protection of literary and artistic works), the Paris Union (for the protection of industrial property), the Rome Convention (for the protection of performers, producers of Phonograms and broadcasting organizations), and the Madrid Agreement (for the repression of false or deceptive indications of source on goods).

The main objectives of WIPO are to promote the protection of intellectual property rights throughout the world through cooperation among countries where appropriate, in collaboration with other international organizations and to ensure administrative cooperation among the intellectual property Unions. According to these objectives, certain obligations have been established for member countries to prevent and repress counterfeiting activities. Article 10 *ter* (1) of the Paris Convention (1883) for the Protection of Industrial Property, for instance, provides that

“... countries of the Union undertake to assure to nationals of the other countries of the Union appropriate legal remedies effectively to repress all acts referred to in the Article 9, 10 and 10 *bis*.”

Remedial measures are not specified here but, according to the General Director of WIPO, are construed as seizure, injunctions ordering the stopping of unlawful affixation, prohibition of importation or sale of counterfeit goods, destruction of counterfeit goods, payment of damages, and criminal sanctions of fine and/or imprisonment.⁹³ The Madrid Agreement (1891) for the Repression of False or Deceptive Indications of Source on Goods is another example of a measure which provides that all goods bearing a false

⁹³ A. Bogsch, “The First Hundred Years of the Paris Convention for the Protection of Industrial Property” *Industrial Property* July/August 1983. p.209.

or deceptive indication of source, by which one of the contracting countries, or a place situated therein, is directly or indirectly indicated as being the country or place of origin, will be seized on importation. It provides further that such importation will be prohibited, or other actions and sanctions will be applied in connection with such importation.⁹⁴ It is, however, worth noting that the Berne Convention, which establishes international norms for copyright protection, does not provide any remedial measures for copyright infringement.

Apart from these main objectives, WIPO is also continually observing all changes in international industrial, trade, and cultural relations that seem to call for adaptation of the treaties administered by WIPO and preparing model provisions for national laws which would give more efficient protection against the counterfeiting of goods. Several meetings have been held to consider these problems.⁹⁵ Furthermore, several Committees of Experts have been convened in both the fields of counterfeiting and piracy, namely, the Committee of Experts on the Protection Against Counterfeiting (First Session (1986) and Second Session (1987)), the Committee of Experts on Audiovisual Works and Phonograms, and the Committee of Experts on The Printed Word for piracy in 1986 and 1987. Since measures for combating counterfeiting and piracy are rather similar, WIPO has also convened a Committee of Experts to consider questions of counterfeiting and piracy together in 1988.

⁹⁴ WIPO. *op.cit.* p.23.

⁹⁵ For example, the Worldwide Forum on the Piracy of Sound and Audiovisual Recording in 1981, and the Worldwide Forum on the Piracy of Broadcasts and of the Printed Word in 1983.

2.4.1.1 WIPO AND REMEDIAL MEASURES

Model provisions concerning remedial measures were once introduced to member countries of the Paris Convention.⁹⁶ This attempt was made in the hope that such measures would be incorporated in members' legislation in order to combat counterfeiting problems more effectively.

The first provision of these model laws defined counterfeit acts as covering the following manufacturing, importation, sale, rental, lending or free distribution, and offering for sale, rental, lending or free distribution. Moreover, counterfeit goods might look exactly the same (slavish imitation) or be very similar (near-slavish imitation) to the protected trade mark.

The second provision dealt with conservatory measures. It was designed to freeze or conserve a situation as it was found at the time by a competent authority. Two objectives of this measure were to prevent the commission or the continuation of the commission of acts of counterfeiting, and to secure evidence as to the identity, quality and location of goods. This measure included many acts such as seizure or impounding of the goods; sealing of the premises where, for example, the goods were manufactured; impounding the tools which might be used for the manufacturing of the goods; and ordering that manufacturing, importation, etc., stopped. It was, however, different from an injunctive measure provided in a common law jurisdiction since the conservation measure seemed to be carried out by the authorities, rather than by an intellectual property rights' owner himself.

⁹⁶ Model Provisions for National Laws on the Prevention and Sanctioning of Counterfeiting. Appeared in the paper of Committee of Experts on the Protection Against Counterfeiting (First Session) PAC/CE/1/2 pp.9-21.

The third provision provided for civil remedies, namely damages, an order of destruction, and an order to restrain a person from prohibited acts. It was clear that the order of destruction of goods and tools, was favoured, rather than the other measures such as confiscation, because of its drastic deterrent effect.

The fourth provision concerned criminal sanctions. Monetary fines and imprisonment were provided. Furthermore, this provision also allowed the authorities to apply civil remedies, namely, an order of destruction and an order to restrain a person from prohibited acts in a criminal proceeding.

These remedial measures are clearly intended to combat counterfeiting. One of the major purposes is to remedy current damage to an injured person. The provision for civil remedies provides that an injured person will be entitled to damages for the prejudice suffered by him as a consequence of the act of counterfeiting. An additional objective is to stop an infringement which has already been committed or prevent one which will be committed in the future. Many measures are introduced for this purpose such as seizure of goods or tools, destruction of goods or tools, and an order to restrain a person from prohibited acts. Finally, these measures are aimed at deterring any person from committing counterfeit acts by criminal sanctions or by depriving an infringer of economic profits.

2.4.1.2 WIPO AS A FAILURE

Due to the recent situation, WIPO was not looked on favourably by many countries. Some countries which had already joined WIPO, such as former European colonies, doubted whether their interests were being well served. Developed countries, in particular, immensely worried about the protection they received from WIPO. New subject matters such as computer programs were good illustrations. While developed

countries were anxious about losses in their businesses, WIPO was more concerned with whether or not computer programs fell under the definition of literary work. Furthermore, the attempts of WIPO in combating international counterfeiting and piracy have not been very impressive to them. Developed countries argued that there was no major evidence that remedial measures under WIPO have been successful. On the contrary, the situation seemed to indicate that WIPO could not deal with this issue effectively.

Looking at this severe situation, it is not difficult to understand why developed countries needed to discuss this issue in another forum. It is because WIPO does not respond well to their desire. Trade deficits caused by intellectual property rights infringements are the vital and urgent problems with which developed countries need to deal as soon as possible, rather than the problem concerning intellectual property *per se*. WIPO cannot serve their needs appropriately due to two reasons. One is the nature of WIPO itself. WIPO mainly requires co-operation from member countries, instead of forcing member countries to concur with its decision. Therefore, WIPO provides general principles and, at the same time, gives technical assistance to member countries, hoping that they will voluntarily adapt their domestic laws to the similar direction. This eventually results in a high standard of intellectual property rights protection. But this method of proceeding takes such a long time that it is inadequate response to the present crisis of developed countries.

Model provisions, for example, were merely intended to indicate directions to national legislators to strengthen their protective and remedial measures against counterfeiting and piracy. Thus, there were few effective sanctions for member countries which did not

protect intellectual property rights properly.⁹⁷ Even though WIPO contained provisions that established certain obligations for member countries to combat counterfeiting and piracy, the national legislature of each member country was still free to adapt model provisions to their own legal systems,⁹⁸ and domestic courts were also free to interpret such provisions through their own constitutional and private international laws.⁹⁹

Developed countries also challenge WIPO's main principles, especially the principle of national treatment. This principle had been criticized as providing a loophole in intellectual property rights protection. If a member country decided not to give protection to its citizens, foreigners could not receive the protection either. Although minimum standards of protection and enforcement were added to this principle in order to solve this conflict, the principle of national treatment was still given priority in the Intellectual Property Conventions, particularly the Berne Convention.¹⁰⁰ This challenge, however, may be opposed by an idea that the principle of national treatment, although important, should not be enforced rigidly. Doing so may be regarded as an unwarranted intervention in member countries' sovereignty.

⁹⁷ In 1988, the Asia-Pacific Council of America evaluated some Asian countries and found that Singapore, for instance, had adequate protection in the three areas of legislation, enforcement, and governmental 'good faith' efforts while Thailand needed improvement in all three areas. See F. W. Rushing, and C. G. Brown, Intellectual Property Rights in Science, Technology, and Economic Performance (Colorado : Westview Press, 1990) p.173.

⁹⁸ It was found that although Argentina acceded to the Paris Convention in 1966, it has made no adjustments to its existing law in order to conform to international obligations under the Convention. See M. R. Gadbow, and T. J. Richards, Intellectual Property rights : Global Consensus, Global Conflict? (Colorado : Westview Press, 1988) p.125.

⁹⁹ P. E. Geller, "Intellectual Property in the Global Marketplace : Impact of TRIPs Dispute Settlement?" p.10.

¹⁰⁰ R. Dhanjee, and De Chazournes, "Trade Related Aspects of Intellectual Property Rights (TRIPS) : Objectives, Approaches and Basic Principles of the GATT and of Intellectual Property Conventions," Journal of World Trade Law 24(1990) p.6.

Moreover, a possible way to settle any disputes over intellectual property rights infringement was by way of the International Court of Justice.¹⁰¹ This has proved to be impractical since the process was regarded as both complex and time consuming. Furthermore, it was argued that judgment, once obtained, could never be enforced since this action might be interpreted as an unfriendly act by the infringing country.¹⁰²

Developed countries also found that they could not guide WIPO in the direction they needed. There are some evidence showing that this is the most important reason for developed countries. They insisted on discuss in this issue in other fora even though dispute settlement measures, for instance, have now been introduced by WIPO. It is also worth noting that persons who required international protection were not creators but mostly businessmen who had influence on national governments or legislation and could therefore on occasion effect trade or foreign policies. Private groups in some countries, especially the United States of America, considered that they were inadequately protected by WIPO measures and wished to apply stricter measures of enforcement.¹⁰³ Therefore, it was putting increasing pressure on the American government to find an effective solution to this problem. Since the United States of America had just only become a member of the Berne Convention in the last decade, it was hard for the United States of America to do anything effectively in this forum.

Additionally, they found that some 'offending' countries did not join any Conventions under WIPO or only joined partly additional acts or special protocols.¹⁰⁴ The former

¹⁰¹ See Article 33. However, paragraph (2) of this Article *per se* provides the condition that such dispute settlement will not apply to member countries.

¹⁰² M. L. Cordray, "GATT v. WIPO," Journal of the Patent and Trade Mark Office Society 76(1994) p.131.

¹⁰³ G. R. Winham, The Evolution of International Trade Agreement (Toronto : University of Toronto Press, 1992) p.93.

¹⁰⁴ Thailand is an example that it chose to be a member of the Berne Convention for the Protection of Literary and Artistic Works by acceding to the Berlin revision, the Berne Additional Protocol of 1914, and the administrative part of

countries not being obliged to adhere to WIPO conventions might ignore them at will and the latter could choose to follow provisions selectively.¹⁰⁵ These countries continued to apply insufficient measures to remedy infringement of intellectual property.¹⁰⁶

For member countries, some of them were not interested in intellectual property problems. Indeed, it was argued that such countries enjoyed taking advantage of these illegal activities while others showed little interest as their citizens did not appear to have suffered a loss. The Brussels Convention (1974) Relating to the Distribution of Programme-Carrying Signals Transmitted by Satellite, for example, had drawn support only from member countries whose satellite broadcasts were in danger of being intercepted by pirates.¹⁰⁷

Developed countries also viewed that it was difficult for them to strengthen measures through WIPO as a voting block of developing countries, always the majority group in WIPO, frequently obstructed improvement of international intellectual property negotiations. Even worse there had been attempts to reduce international standards of intellectual property rights protection through WIPO.¹⁰⁸

For these reasons, developed countries do not intend to prolong the discussion of this issue in WIPO. Albeit there have been doubts whether more than one international organization will oversee intellectual property issue, these considerations inevitably led

the Paris Act 1971 only. It was in 1995 that Thailand extended the effects of its accession to other parts of the Paris Act 1971. (Berne Notification no.167, June 2, 1995.)

¹⁰⁵ S. Ricketson, *The Berne Convention for the Protection of Literary and Artistic Works : 1886-1986* (London : Sweet & Maxwell, 1987) p.921.

¹⁰⁶ There was an evidence that a country would be able to join the Paris Convention without even improving its level of protection to achieve international standard. See Gadbow and Richards, *op.cit* p.49.

¹⁰⁷ Phillips and Firth. *op.cit* . p.385.

¹⁰⁸ H. P. Kunz - Hallstein, "The United States Proposal for a GATT Agreement on Intellectual Property and the Paris Convention for the Protection of Industrial Property," *Vanderbilt Journal of Transnational Law* 22(1989) p.266.

to discussion of the intellectual property rights protection during the General Agreement on Tariffs and Trade (GATT).

2.4.2 WHAT IS GATT?

The General Agreement on Tariffs and Trade (GATT) is a multilateral agreement to which more than a hundred countries subscribe.¹⁰⁹ The Agreement was first reached in 1947 after a discussion between the United States of America and the United Kingdom. Its objectives were to end the use of quantitative restrictions or instruments of protection and it endeavoured to establish a liberal and competitive trade system thus contributing to economic growth and development in world markets. Success in reducing tariff barriers among countries has led contracting parties to redirect their efforts to other obstacles in the world's markets such as non tariff barriers to trade.

The United States of America, with support from both European countries and Japan, brought the Trade-Related Aspects to Intellectual Property Rights (TRIPs) into consideration as a non tariff barrier to trade. It was argued that protective measures and enforcement under GATT were both suitable and appropriate while the measures under WIPO were considered uncertain and the use of bilateral mechanisms to secure intellectual property rights protection was limited.¹¹⁰ Worldwide networks of counterfeiting or piracy made developed countries realize that it was not an effective strategy to deal with other countries individually.

¹⁰⁹ The Final Act of the Uruguay Round was formally signed by 111 participating nations. For the list of these nations, see I.L.M. 33(1994) p.1131.

¹¹⁰ R. Kastenmeier, and D. Beier, "International Trade and Intellectual Property : Promise, Risks, and Reality," Vanderbilt Journal of Transnational Law 22(1989) p.290, and also Hoffman. *op.cit* . p.18.

2.4.2.1 GATT AS AN APPROPRIATE FORUM

GATT has been regarded by developed countries as an appropriate forum to cope with intellectual property rights infringement,¹¹¹ even though many countries were afraid that a complete change in the understanding of intellectual property might be implied by GATT.¹¹² First of all, the intellectual property issue has implicitly become a trade or economic problem, rather than a strictly legal one. Inadequate protection of intellectual property was considered as an obstacle which undermined the goal of free trade and led to trade distortions. The United States of America, for example, was seriously concerned with this issue because intellectual property-based industries have become one of the fastest growing sectors of the American economy.¹¹³ The estimate of losses from inadequate protection abroad has risen regularly to billions of Dollars.¹¹⁴

Secondly, it is not uncommon to discuss intellectual property issue, due to its 'trade-related' nature, in an international trade forum. Certain bilateral intellectual property agreements before the Berne Convention were often part of, or linked to, treaties on trade or commerce. Historically, GATT had endeavoured to deal with counterfeiting or piracy before the Agreement on Trade-Related Aspects of Intellectual Property Rights were raised in negotiations during the Uruguay Round. The issue had been reflected in previous statutes such as the 1958 recommendation on marks of origin, the Customs

¹¹¹ A provision related to intellectual property already existed in GATT (1947). See Article XX (d).

¹¹² F. Beier, and G. Schricker, "GATT or WIPO?" *IIC* (1989) p.33.

¹¹³ M. R. Gadbow, "Intellectual Property and International Trade : Merger or Marriage of Convenience?", *Vanderbilt Journal of Transnational Law* 22(1989) p.243.

¹¹⁴ A. Winberg, "Secure Protection of Your Intellectual Property Abroad," *Journal of the Patent and Trademark Office Society* (August 1992) p.603.

Valuation Code, and the Standards Code negotiated during the Tokyo Round. In 1982, a Draft Agreement on Measures to Discourage the Importation of Counterfeit Goods was drawn up. It was intended to urge contracting parties to discourage trade in counterfeit goods and deter international trade in such goods. Unfortunately, there were many questions to be answered, especially regarding the deterrent effect, of this draft.¹¹⁵ As a result, no further action was ever taken. GATT established a Group of Experts in 1984 to study the trade aspects of commercial counterfeiting. Although this group could not reach a final decision, its deliberations led to the inclusion of the TRIPs Agreement in the Uruguay Round.¹¹⁶

In addition, there was no contradiction, in theory, between WIPO and GATT. Member countries of the Berne Convention or the Paris Convention, for instance, were able to adhere to special agreements for intellectual property rights protection in so far as these agreements did not contravene such Conventions.¹¹⁷ GATT has also dealt with this question carefully.¹¹⁸

2.4.2.2 GATT v WIPO

Developed countries believed that GATT would respond well to their desires. In other words, their needs could be accomplished through negotiations in this forum. It was

¹¹⁵ See S. D. Olenick, "Draft International Anticounterfeiting Code : Neo-Realism as a Vehicle for Analyzing the Effect of Nonsignatories' Perceptions on the Development of an Anticounterfeiting Norm," Vanderbilt Journal of Transnational Law 15(1982) pp.803-862.

¹¹⁶ Braga. *op.cit.* p.247.

¹¹⁷ Articles 20 and 19 respectively.

¹¹⁸ The TRIPs Agreement Article 2.2 provides that "Nothing in Parts I to IV of this Agreement shall derogate from existing obligations that Member may have to each other under the Paris Convention, the Berne Convention, the Rome Convention and the Treaty on Intellectual Property in Respect of Integrated Circuits."

more appropriate to provide minimum standards of intellectual property rights protection in GATT, than in WIPO. GATT was intended to establish a fair and liberal trade system, and has laid down fairly rigorous standards by which contracting parties have to abide. WIPO, on the other hand, has allowed member countries to adapt measures to their domestic laws as they thought fit.

Second, they realized that, although they were outnumbered by developing countries, they gained the upper hand in the global trade negotiation. In other words, they possessed more bargaining power than developing countries, so that they were able to indicate the negotiation.¹¹⁹ In WIPO, they did not possess such power and developing countries could easily direct the negotiation by the majority of votes.

Third, a voting block of developing countries was not a serious problem in GATT. This was because the decision-making process of the GATT tended to be one of negotiation and consensus, rather than majority of votes.¹²⁰ Moreover, the negotiating environment in GATT mainly depended upon the trade subject. This brought about changing coalitions among developed and developing countries, such as the Cairns Group in agricultural negotiation.¹²¹ Additionally, different political orientations and trade strategies among developing countries have given rise to a wide range of negotiating priorities. This inevitably eroded the unity of the developing bloc. Many Asian countries, for instance, have increasingly relied upon exports to stimulate growth and

¹¹⁹ Developed countries made it clear that they considered intellectual property rights protection a fundamental part of a bundle of rights which they had negotiated with other countries. The American legislature, for instance, has enforced the Trade Act of 1984 (particularly the determination of the eligibility for the Generalized System of Preferences (GSP)) to link trade and intellectual property rights protection.

¹²⁰ See J. Jackson, *World Trade and the Law of GATT* (Indianapolis : Bobbs-Merril, 1969) pp.122-124. Also K. Watkins, *Fixing the Rules : North-South Issues in International Trade and the GATT Uruguay Round* (Nottingham : CIIR, 1992) p.36.

¹²¹ See T. Cottier, "The Prospect for Intellectual property in GATT," *CMLR* 28(1991) p.388.

attract capital needed for economic development. They had to focus on their own trade interests and contemplate their own benefit first. Their interests increasingly departed from developing countries in other areas.

A dispute settlement mechanism for contracting parties is another major reason to support GATT. This mechanism was regarded as one of the cornerstones of the Agreement. It was the crucial subject of discussions in the Tokyo Round and led to the adoption of an Understanding on Dispute Settlement,¹²² a confirmed procedure used for dispute settlement. This mechanism has been designed for the settlement of international trade disputes, aiming to provide security and predictability to the multilateral trading system.¹²³ A contracting party which is dissatisfied with another contracting party's actions is able to bring the issue into the dispute settlement procedure.¹²⁴

However, since GATT basically was a negotiating forum, and not intended to be an organization dealing directly with trade, there were merely a few provisions concerning dispute settlement, namely, Articles XXII and XXIII and no actual organ ruling on disputes. This inevitably resulted in confusion with regard to both the purpose and the practice of such a mechanism. It has therefore not been made clear whether the goal of GATT dispute settlement was oriented more towards 'rule integrity' (in other words procedures with judicial-like decisions), or towards 'conciliation and negotiation' (procedures with negotiated settlement through conciliation).¹²⁵ Furthermore, it was

¹²² Understanding on Rules and Procedures Governing the Settlement of Disputes. GATT Doc.MTN/FA II-A2.

¹²³ Article 3.2.

¹²⁴ For the dispute settlement procedures, see P. Pescatore, "The GATT Dispute Settlement Mechanism : Its Present Situation and Its Prospects," Journal of World Trade Law 27(1993) pp.5-20.

¹²⁵ See OECD. Dispute Settlement in the WTO (Paris : OECD; 1995) p.6.

argued that this mechanism was not so effective particularly when it concerned a powerful country. Trade embargoes exploited by the United States of America and England on Nicaragua and Argentina respectively were explicitly violated the GATT rules but the latter could do nothing to overturn such acts. Vice versa, enforcement machinery and implementation of a solution has mainly been based on the voluntary response of a contracting party. Such a powerful party, might simply choose to disregard a ruling since no effective retaliatory action would take place.¹²⁶

Nevertheless, this mechanism has, to some extent, been considered as successful.¹²⁷ It led to a friendly settlement of disputes and this could be useful since trade relations require practical and flexible solutions, rather than immediate compliance with a ruling which could have negative results that harm international trade.¹²⁸ However, the new mechanism of the new organization, the World Trade Organization (WTO), dispute settlement will be more effective in solving disputes than the GATT system. The Dispute Settlement Body, for instance, is created to administer dispute settlement and a contracting party is able to appeal against a decision to an Appellate Body. Strict timetables are provided to handle dispute settlement procedures.

2.4.2.3 GATT AS A GLOBAL STREAM

The idea of giving strict protection to an intellectual property rights' owner seems like flowing water. It naturally flows from an upper level to a lower one. There is little chance

¹²⁶ S. Golt, The GATT Negotiations 1986 - 90 : Origins, Issues & Prospects (London : Contemprint, 1988) p.48.

¹²⁷ It is claimed that this mechanism has worked better than those of the World Court. See J. H. Jackson, Restructuring the GATT System (London : Pinter Publishers, 1990) p.59.

¹²⁸ J. Kasto, The Function and Future of the World Trade Organization : International Law Between GATT and WTO (Hounslow : Kall Kwik Centre, 1996) p.60.

for developing countries to suspect why it flows in this direction or to obstruct and change a direction of this global current. In the past, this global tide might be low, i.e. intellectual property rights infringement was implicitly acceptable or strict protection for an intellectual property was not a must. Today, in the twentieth century, the tide is at its peak and intellectual property rights infringement is regarded as unbearable.

Developing countries, therefore, have to accept this truth and adjust themselves to cope with it. They have to be optimistic and patiently wait to reap the fruitful harvest in the future. This issue concerns a world economic power, not a world majority power, and developing countries, two thirds of nations in the world, cannot resist. For example, some developing countries such as Brunei Darussalam or Myanmar, which have not joined any WIPO conventions, did have to join the TRIPs Agreement to secure their economic interests.¹²⁹

Developed countries, particularly the United States of America, made it clear that they would permit technology transfer and technical assistance only to countries which joined the GATT.¹³⁰ Moreover, the American government has undertaken an intense program, coupled with the threat and use of economic sanctions, to improve foreign protection for American intellectual property rights' owners. If there was a country which did not comply with its will, such country would be 'rehabilitated'.

In this context, there was the infamous example that, when Brazil did not satisfy the demands made by the Pharmaceutical Manufacturers Association (PMA), the United

¹²⁹ Information as at November 17, 1995.

¹³⁰ See the U.S. Framework Proposal to GATT Concerning Intellectual Property Rights International Trade Report (BNA) November 4, 1987, p.1372.

States of America increased *ad valorem* tariff rates to 100% on important goods imported from Brazil.¹³¹ The rest of the developing world has been warned by such treatment that they had most to lose if the GATT system came unravelled. It then reached a conclusion that GATT was the appropriate forum for the discussion. The questions of how to guide remedial measures of each countries to the same direction, also which measures are acceptable, were inevitably solved.

2.4.3 REMEDIAL MEASURES IN TRIPs

The American Proposal for the Negotiations on Trade-Related Aspects of Intellectual Property Rights was introduced soon after TRIPs was included in the 1986 Ministerial Declaration.¹³² Two main objectives of this Proposal were to reduce distortions and impediments to legitimate trade in goods and services caused by deficient levels of protection and enforcement of intellectual property rights, and to persuade all countries to join the agreement in order to resolve disputes under a multilateral settlement mechanism. It proposed that an intellectual property rights' owner should be entitled to lodge an application to prevent importation of infringing goods. Other remedies should include preliminary and final injunctions, damages, seizure and destruction of infringing goods, as well as criminal sanctions. Such remedial measures should, according to the American proposal, be considered for both trade-based remedies and those under intellectual property laws.

¹³¹ See J. Nogues, "Patent and Pharmaceutical Drugs : Understanding the Pressures on Developing Countries," Journal of World Trade Law 24(1990) p.85.

¹³² See the United States for Achieving the Negotiating Objective. GATT-Doc.MTN.GNG/NG11/W/14 (20 October 1987). Reprinted in Beier and Schricker. *op.cit* . p.182.

The European Community and Japan also introduced their own proposals and they mainly accorded with the American Proposal. Ironically, these guide-lines had an important role in supporting the American Proposal to ensure that intellectual property rights protection would be discussed as an international trade issue in GATT, not in WIPO as argued by developing countries. However, there are some differences among these guide-lines, for instance, with regard to procedures relating to border measures. While the American Proposal stressed importation, the European Community guidelines were aimed at customs procedure in general such as import, export, and so forth.¹³³ Moreover, the former simply defined appropriate deterrent penalties such as imprisonment and monetary fines while the latter did not make explicit provision for penalties merely suggesting large fines and prison sentences as possible sanctions.¹³⁴

¹³³ Guidelines Proposed by the European Community for the Negotiations on Trade-Related Aspects of Intellectual Property Rights. GATT-Doc.MTN.GNG/NG11/W/16 (20 November 1987). Reprinted in Beier and Schriker. *op.cit.* p.205.

¹³⁴ *Ibid.* .p.210.

CHAPTER 3 : TRIPs AND REMEDIAL MEASURES

3.1 INTRODUCTION

When the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs) came into effect, it seemed to be a turning point in the protection of modern intellectual property rights. This agreement concerned many significant issues. For example, TRIPs clarified whether certain controversial subjects, such as computer programs, would be protected as intellectual property. Likewise, from the time of its enforcement, intellectual property rights owners could expect that their rights would be appropriately protected throughout the world as several measures in the Agreement dealt with intellectual property rights infringement.

Success in linking intellectual property to multilateral trade negotiations was also remarkable. It became manifest that, although intellectual property (a creation derived from a human's brain) itself is regarded as important and worth protecting, the economic value of intellectual property (a benefit derived from a business concerning intellectual property) is regarded as more important and in need of protection.¹³⁵ Infringement of intellectual property rights would no longer be tolerated.

The history of the TRIPs' negotiations shows that it took a long time to reach a final conclusion. Every country, both developed and developing countries, intended to protect their own interests rather than protect intellectual property *per se*. As a result, a conflict arose not merely between developed and developing countries, but also among

¹³⁵ A leader of the American pharmaceutical industry was quoted as saying that, "We must also work to get more broadly based economic organizations, such as the OECD or the GATT, to develop intellectual property rules, because intellectual property is essential for the continued development of international trade and investment." Per E. Pratt, "Intellectual Property : Safeguarding America's Competitive Edge," U.S. Council for International Business, Focus on Issues (1984) p.4.

developed countries themselves. Additionally, while some developing countries vehemently opposed these negotiations, others subtly supported them. The world has gradually been convinced that the Agreement would benefit both developed and developing countries, even though TRIPs started out as a 'North' initiative. Such contentious argument may be over, yet controversy is still anticipated. This time, it is not about TRIPs as such, but about enforcement of TRIPs throughout the world.

3.2 WHAT IS TRIPs?

TRIPs is a multilateral agreement concluded in the Uruguay Round under the auspices of GATT, together with 13 Multilateral Agreements on Trade in Goods,¹³⁶ General Agreement on Trade in Services, Understanding on Rules and Procedures Governing the Settlement of Disputes, Trade Policy Review Mechanism, and Plurilateral Trade Agreements.¹³⁷ It contains seven parts which concern : 1) general provisions and basic principles, 2) standards concerning the availability, scope and use of intellectual property rights, 3) enforcement of intellectual property rights, 4) acquisition and maintenance of intellectual property rights and related *inter parte* procedures, 5)

¹³⁶ The Multilateral Agreements on Trade in Goods are General Agreement on Tariffs and Trade 1994, Agreement on Agriculture, Agreement on the Application of Sanitary and Phytosanitary Measures, Agreement on Textiles and Clothing, Agreement on Technical Barriers to Trade, Agreement on Trade-Related Investment Measures, Agreement on Implementation of Article VI of the General Agreement on Tariffs and Trade 1994, Agreement on Implementation of Article VII of the General Agreement on Tariffs and Trade 1994, Agreement on Preshipment Inspection, Agreement on Rules of Origin, Agreement on Import Licensing Procedures, Agreement on Subsidies and Countervailing Measures, Agreement on Safeguards.

¹³⁷ The Plurilateral Trade Agreements include Agreement on Trade in Civil Aircraft, Agreement on Government Procurement, International Dairy Agreement, and International Bovine Meat Agreement. For the full texts of the Final Act Embodying the Results of the Uruguay Round of Multilateral Trade Negotiations (GATT 1994), Marrakesh, 15 April 1994, with a list of Annexes, see I.L.M. 33(1994) p.1143.

dispute prevention and settlement, 6) transitional arrangements, and 7) institutional arrangements : final provisions.

Obviously, members have been obliged to comply with TRIPs since 1 January 1996.¹³⁸ However, developing countries benefit from a transitional period of four more years,¹³⁹ but have to comply with TRIPs by 1 January 2000.¹⁴⁰ The least developed countries were given six more years to implement TRIPs.¹⁴¹

It has been argued that there is no conflict between TRIPs and other intellectual property conventions under the patronage of the WIPO since TRIPs primarily concentrates on trade related to intellectual property rights, not intellectual property *per se* . Not many, if any, will regard TRIPs as an international agreement which deals with all aspects of intellectual property, including trade related aspects.¹⁴² This is supported by the TRIPs' aims which are intended to reduce distortions and impediments to international trade. In particular, they are intended to promote effective and adequate protection of intellectual property rights, and to ensure that measures and procedures to enforce intellectual property rights do not themselves become barriers to legitimate trade.¹⁴³

¹³⁸ TRIPs Article 65 (1).

¹³⁹ TRIPs Article 65 (2).

¹⁴⁰ See also TRIPs Article 3, 4, 5, 70 (8).

¹⁴¹ TRIPs Article 66 (1).

¹⁴² See F. Emmert, "Intellectual Property in the Uruguay Round - Negotiating Strategies of the Western Industrialized Countries," Michigan Journal of International Law 11(1990) p.1345.

¹⁴³ The Preamble of TRIPs.

The history of the TRIPs' negotiations reveals this argument.¹⁴⁴ An initial effort started in the late 1970s when the International Anti-Counterfeiting Coalition was formed to study the counterfeiting problem and to assist in drafting the proposed Code.¹⁴⁵ This Coalition was an organization comprised of multinational corporations such as Levi Strauss & Co., Walt Disney Production, Cartier of France, Puma, etc.¹⁴⁶ The Agreement on Measures to Discourage the Importation of Counterfeit Goods was produced,¹⁴⁷ as a mechanism to assist contracting parties in (a) the interception of counterfeit merchandise at international borders, and (b) the disposal of such merchandise outside the channels of commerce. This initial effort solely concerned counterfeit trade mark goods.

Subsequently, the United States of America proposed a comprehensive scheme for intellectual property rights protection, instead of merely protecting trade mark goods. It was not a great surprise that the United States of America sought a negotiation for the comprehensive scheme since there were many infringements in other areas apart from counterfeit trade mark goods, such as pharmaceutical patents, and copyrights.¹⁴⁸ Many transnational companies found their operations threatened not just by the well known practice of counterfeiting, but through problems relating more generally to inadequate or ineffective protection of intellectual property. They considered improved rules on the protection of intellectual property essential for ensuring that legitimate trade

¹⁴⁴ For this issue, see D. Gervais, The TRIPs Agreement: Drafting History and Analysis (London: Sweet & Maxwell, 1998)

¹⁴⁵ W. Walker, "A Program to Combat Commercial Counterfeiting," Trade Mark Report 70(1980) p.21.

¹⁴⁶ For more information, see Olenick. *op.cit.* pp.803-862.

¹⁴⁷ GATT Doc.No.L/4817 (31 July 1979).

¹⁴⁸ See United States International Trade Commission, Economic Effects of Intellectual Property Right Infringement Investigation No.332-245, 1988, reprinted in Journal of World Trade Law 4(1988) pp.101-114.

was protected from unfair competition.¹⁴⁹ Likewise, other intellectual property aspects had already been considered by the Preparatory Committee under the topic of trade in high-technology goods.¹⁵⁰ The phrase 'including trade in counterfeit goods' was finally deleted from the title of TRIPs simply because it had become purely of historical interest.¹⁵¹

A compromise proposal was created during the sessions and was later submitted to the Preparatory Committee.¹⁵² This proposal eventually served as the basis for the Ministerial Declaration of 1986. TRIPs was, therefore, included as one of the items on the agenda for future negotiation on international trade in the Uruguay Round.¹⁵³ Later, an agreed framework of TRIPs was reached and the Ministers agreed that the scope of the future intellectual property negotiations would also cover the provision of effective and appropriate means for the enforcement of trade-related intellectual property rights.¹⁵⁴

However, it seems that the content of TRIPs overlaps with WIPO's responsibility.¹⁵⁵ With regard to its title, TRIPs should deal with 'intellectual property rights' only in so far as there exist 'trade-related' aspects.¹⁵⁶ However, it is apparent that TRIPs, from its

¹⁴⁹ GATT Activities 1989 (June 1989) p.49.

¹⁵⁰ See A. Bradley, "Intellectual Property Rights, Investment, and Trade in Services in the Uruguay Round : Laying the Foundations," Stanford Journal of International Law 23(1987) p.66.

¹⁵¹ See I.L.M. 33(1994) p.1128.

¹⁵² GATT Doc.No.PREP.COM (86) SR/9 (Aug. 26,1986).

¹⁵³ See Ministerial Declaration on the Uruguay Round, GATT.Doc.No. MIN.DEC (Sept.20,1986).

¹⁵⁴ See Mid-Term Meeting, GATT Doc.No.MTN.TNC/11 (Apr.21,1989) p.21.

¹⁵⁵ For a comment on this issue, see P. Demaret, "The Metamorphoses of the GATT : From the Havana Charter to the World Trade Organization," Columbia Journal of Transnational Law 34(1995) p.162.

¹⁵⁶ It is suggested that there is no direct relationship between intellectual property rights themselves and international trade. In addition, intellectual property rights are based upon the principle of protection while the GATT's one is free trade. See Kuanpoj. *op.cit.* p.131. Furthermore, it is said that the phrase 'trade related' was coined to justify the

content, deals not only with intellectual property rights as such, but also with an issue of what should be regarded as intellectual property rights.¹⁵⁷ According to TRIPs, computer programs, whether in source or object code, will be protected as intellectual property rights,¹⁵⁸ and so should plant varieties.¹⁵⁹ These issues are still controversial among some members of the Berne and the Paris Conventions who question whether or not computer programs should be protected as literary works, and whether or not plant varieties should be patentable.

This may be a question of interpretation of the phrase 'trade-related'. On the one hand, it is apparent that this phrase should be interpreted in a narrow sense, i.e. TRIPs should only deal with the intellectual property aspects which directly relate to trade, such as counterfeiting or piracy.¹⁶⁰ The other aspects of intellectual property could be dealt with in the international forum under the auspices of WIPO. From this perspective, it seems that the linkage between 'what intellectual property is' and 'trade' is absent.

On the other hand, the phrase 'trade-related' is so ambiguous that it could be construed in another way. It is possible, in a broad sense, to define the aspect of 'what intellectual property is' as a trade-related issue since the substantive content could influence the condition of trade and competition. According to this idea, anything that

consideration of intellectual property rights in a trade organization. M. Blakeney, Trade Related Aspects of Intellectual Property Rights : A Concise Guide to the TRIPs Agreement (London : Sweet & Maxwell, 1996) p.11.

¹⁵⁷

To some extent, TRIPs is regarded as a major change in the history of intellectual property since "it has linked intellectual property and trade disciplines, and provided a mechanism multilaterally to address inter-state disputes on intellectual property." See C. Correa, "Implementation of the TRIPs Agreement in Latin America and the Caribbean" *EIPR* 8 (1997) p.435.

¹⁵⁸ TRIPs Article 10 (1).

¹⁵⁹ TRIPs Article 27 (3)(b).

¹⁶⁰ See *Statement of Brazil to the Negotiating Group on Trade-Related Aspects of Intellectual Property Rights, Including Trade in Counterfeit Goods*, (March 25, 1987), p.1. Also C. Braga, "The Economics of Intellectual Property Rights and the GATT : A View From the South," Vanderbilt Journal of Transnational Law 22(1989) p.250.

obstructs the fair trade, i.e. 'an undistorted trade and equal competitive opportunities of goods irrespective of their origin' is 'trade-related'.¹⁶¹ This interpretation seems to be more practical in solving international trade problems since it will allow 'trade' to relate to several issues. This idea coincides with ideas to connect environmental,¹⁶² and labour issues to trade. According to this perspective, it is possible that lists of prohibited plants, and the age of child labour may be determined as 'trade-related' aspects of such issues.

The meaning of the phrase 'trade related' is therefore crucial and should be construed appropriately since it is the key phrase underlying all measures which are undertaken in TRIPs. If it is interpreted in a narrow approach, the scope of TRIPs will be limited and TRIPs' success will be undermined inevitably. On the other hand, a broad approach may expand the scope of TRIPs, which developing countries are apprehensive about,¹⁶³ and jeopardize the transfer of technology.¹⁶⁴

3.2.1 THE TRIPs' PRINCIPLES

There are two major principles provided for in TRIPs, namely, the national treatment principle,¹⁶⁵ and the most-favoured-nation treatment principle.¹⁶⁶ The principle of

¹⁶¹ W. Meng, "GATT and intellectual property rights - The International Law Framework," in G. Sacerdoti, (ed.), Liberlization of Service and intellectual property in the Uruguay Round of GATT (Fribourg : 1990) p.63.

¹⁶² Some environmentalists, however, still believe that environmental issues need to be handled by a specific organization, not in the WTO, because environmental policy is different from trade policy. See K. Von Moltke, "The World Trade Organization : Its Implication for Sustainable Development," Journal of Environment and Development 9 (1994) p.51.

¹⁶³ See M. Kostecki, "Sharing Intellectual Property Between the Rich and the Poor," EIPR 8(1997) p.272.

¹⁶⁴ This is also one of TRIPs' objectives. See TRIPs Article 7.

¹⁶⁵ TRIPs Article 3 (1).

¹⁶⁶ TRIPs Article 4.

national treatment requires that a member has to treat other members' citizens in the similar way as it treats its own nationals. It is worth noting that minimum standards for protection and enforcement are also required to ensure that an intellectual property rights holder will be protected no less than the TRIPs' criteria stipulate.¹⁶⁷ Members may limit their obligations, subject to the exceptions already provided in certain Conventions concerning intellectual property.¹⁶⁸ However, such exceptions should neither conflict with TRIPs nor constitute a trade restriction.¹⁶⁹ Similarly, members are not obliged to apply this principle to the procedures related to the acquisition or maintenance of intellectual property rights provided in the Conventions under the auspices of the WIPO.¹⁷⁰

The principle of most-favoured-nation (MFN) treatment is generally regarded as a cornerstone of the international trade agreement. It aims to expand fairness in global trade. This principle requires a member to unconditionally grant to the nationals of all other members any advantage, favour, privilege, or immunity already granted to the nationals of any other country.¹⁷¹ Nevertheless, members are exempted from the obligations under this principle in several circumstances, *inter alia*, an obligation to grant any advantage, favour, privilege, or immunity which :

a) derives from international agreements on judicial assistance or law enforcement in general,

¹⁶⁷ TRIPs Articles 1 (2) (3) and 2. For the definition of 'protection', see TRIPs footnote 3.

¹⁶⁸ TRIPs Article 3 (1).

¹⁶⁹ TRIPs Article 3 (2).

¹⁷⁰ TRIPs Article 5. It is argued that "[T]he logic of TRIPS Agreement is to follow existing intellectual property conventions as closely as possible, adding the necessary elements where necessary to update the international legal framework." See Gervais. *op.cit.* p.48.

¹⁷¹ TRIPs Article 4.

b) is granted in accordance with the provisions of the Berne Convention (1971) or the Rome Convention authorizing that the treatment accorded be a function not of national treatment but of the treatment accorded in another country,

c) is not provided in TRIPs, in respect of the rights of performers, producers of the phonograms and broadcasting organizations,

d) derives from international agreements related to the protection of intellectual property which came into force before the WTO Agreement.¹⁷²

Additionally, members are not obliged to apply this principle to the procedures related to the acquisition or maintenance of intellectual property rights provided in the Conventions under the auspices of the WIPO.¹⁷³

It is understood that the principle of reciprocity is also encompassed, even though it is not explicitly provided in TRIPs. This principle is vital in maintaining a balance of fair trade in the international area.¹⁷⁴ It is evidenced by the WTO's aim which requires reciprocal arrangement to reduce any barriers to trade and to eliminate discriminatory treatment in international trade relations.¹⁷⁵

However, it is likely that the principle of reciprocity may not apply in certain situations. There are some areas of TRIPs where it is left up to the member's discretion whether or not to provide certain procedures in their domestic laws, such as criminal sanctions for

¹⁷² TRIPs Article 4 (a).

¹⁷³ TRIPs Article 5.

¹⁷⁴ See O. Long, Law and Its Limitations in the GATT Multilateral Trade System (Dordrecht : Martinus Nijhoff Publishers, 1987) p.11.

¹⁷⁵ The Preamble of the WTO Agreement.

some infringements of intellectual property rights.¹⁷⁶ Under the circumstances, a member is not obliged to provide such remedies to protect other members' nationals.

The principle of transparency is also included in TRIPs. This principle is essential in the international trade relations. It will assure a member that the rules and procedures provided and enforced by other members are fair and equitable. This principle explicitly appears in Part V (Dispute Prevention and Settlement),¹⁷⁷ and is implicit in other parts such as Part III (Enforcement of Intellectual Property Rights).¹⁷⁸

3.2.2. WHY WAS TRIPs NEEDED?

Frustrated by an increase of piracy and counterfeiting of intellectual property rights and inadequate protection from WIPO, developed countries sought alternative ways to protect their intellectual property rights. The United States of America, in particular, decided to enforce its law, the Trade Act of 1974,¹⁷⁹ through bilateral agreements as an alternative. Whereas this was, indeed, an effective way, it was not an ideal strategy. It inevitably caused severe tension between the United States of America and its allies, such as Canada, and trade partners such as Thailand. In the Certain Automotive Spring Assemblies conflict, the United States of America excluded Canadian products from importation, on the basis that the Canadian companies infringed the US patent. Consequently, Canada requested consultations with the United States of America. It was the first time that an intellectual property issue was brought formally before the

¹⁷⁶ See TRIPs Article 61.

¹⁷⁷ See TRIPs Article 63.

¹⁷⁸ See TRIPs Article 41 (4).

¹⁷⁹ The Trade and Tariff Act of 1974, Pub.L.No. 93-618, 88 Stat.2041. (1984).

GATT.¹⁸⁰ In Thailand, a demonstration was held in Bangkok because there was a feeling that Thailand had been unduly forced to protect intellectual property rights by the United States of America.¹⁸¹

Above all, while the United States of America was condemned throughout the world, other developed countries gained some benefits as 'free riders' (this term describes a situation where one country claims a right/benefit from another country while the latter has no obligation to grant such a right/benefit in return).¹⁸² These crucial reasons led the United States of America to bring the intellectual property issue to the GATT for consideration.

It has been suggested that developing countries were not totally satisfied with the success of the TRIPs negotiation. Nevertheless, they seemed to be optimistic about this result, rather than feel that they were losers. There were a number of reasons for this reaction. First of all, the Draft Final Act was tailored as a package of the whole Uruguay Round negotiation. It was based upon a 'take all or leave all' basis. From this Draft, it seemed that every country gained and lost some of its benefits. Developing countries, for instance, had to be bound to these new stringent rules while benefiting from an incredibly long transitional period to comply with such obligations.

Secondly, even though developing countries dissented from TRIPs because they believed that strong intellectual property rights protection would widen the gap between

¹⁸⁰ See United States - Imports of Certain Automotive Spring Assemblies, GATT 30th Supp.BISD (1984) p.107.

¹⁸¹ The Nation, November 24, 1987, p.1. For some critiques, see E. Uphoff, Intellectual Property and US Relations with Indonesia, Malaysia, Singapore, and Thailand (New York : Cornell Southeast Asia Program, 1991), D. MacLeod, "U.S. Trade Pressure and the Developing Intellectual Property Law of Thailand, Malaysia and Indonesia," University of British Columbia Law Review 26(1992) pp.343-374.

¹⁸² Even today, the United States of America still considers that other countries "free ride" on American efforts to open up the world for international trade. See M. Stutchbury, "US - Sino Spats Could Turn into Something Nasty," The Financial Review June 21, 1996. p. 21.

them and developed countries,¹⁸³ they had to accept this agreement as inevitable. If they were to benefit from other trade areas, they had to come to terms with a new dimension of intellectual property rights protection.¹⁸⁴ The American stance on this issue was firm that "no GATT is better than a bad GATT".¹⁸⁵ The United States of America made it clear that it would only be satisfied with a proper standard of intellectual property rights protection. If this was not settled, there was no other option but to have recourse to its own tough measures. The stringent unilateral strategy of the United States of America was, and will be, a measure against which other countries all over the world have to be on their guard. Thus, it was more beneficial for countries to defend their interests in a multilateral system, even though they did not have bargaining power, rather than being exposed to unilateral determination.¹⁸⁶

Besides, not every developing country obstructed the negotiations. Some of them joined the negotiations in order to protect their other interests. Thailand, for instance, preferred to adhere to the obligations under the GATT to comply with an American demand.¹⁸⁷ In the Thai cigarettes dispute,¹⁸⁸ the Thai representative was quoted as

¹⁸³ See Kostecki. *op.cit.* p.272.

¹⁸⁴

This idea was indirectly presented by a Thai official when he indicated that the law to protect trade secrets must be provided for in Thailand. See P. Payakkanithi, "Trade Secret Law : Thais or Foreigners will be benefit?" Thai Post December 6, 1999. P.11. As a result, many developing countries, particularly ones in the South East Asia region, have revised their laws, or have introduced new laws, to conform with TRIPs. For more information, See M. Blakeney, "The Impact of the TRIPs Agreement in the Asia Pacific Region" EIPR 18 (1996) pp.544-554.

¹⁸⁵ See The Washington Post, January 29, 1993. p.1.

¹⁸⁶

In this case, it is hoped that this situation will be improved since TRIPs will ensure a high level of intellectual property rights' protection. Unilateral sanctions will soon be eliminated and every countries will be benefit through international co-operation. See Correa. *op.cit.* p.443.

¹⁸⁷ See S. Chirathivat, "Managing Thai Trade Policy to Better Access Developed Countries' Market," ASEAN Economic Bulletin 8(1991) p.79.

¹⁸⁸ Thailand - Restrictions on Importation of and Internal Taxes on Cigarettes, DS 10/R, adopted on November 7, 1991, 37S/200. reprinted in I.L.M. 30(1991) p.1122. In this case, Thailand prohibited imports of cigarettes on the

saying that Thailand intended to abide by its GATT obligations and wanted to ensure that it would not be forced to accept conditions imposed above and beyond such obligations.¹⁸⁹ In addition, some countries had already amended their intellectual property laws to concur with TRIPs even before they had to comply with it.¹⁹⁰

Furthermore, it was discovered that the 'North-North' conflict was the real obstacle for the negotiations of intellectual property rights protection, rather than the 'North-South' one. There were a lot of 'disagreements' among developed countries over the issues of intellectual property rights protection, such as the issue of moral rights,¹⁹¹ and rental rights.¹⁹² Moreover, there was a conflict in another crucial area, namely agriculture, which nearly caused the breakdown of the whole negotiations of the Uruguay Round.¹⁹³

It is also noteworthy that it was practically up to only two trading powers, the United States of America and the then European Community, to decide the future of the trade negotiations. It was considered undesirable, however, for developing countries to be left

ground of the necessity to protect human health (GATT exception, Article XX (b)). For more information, see T. McDorman, "U.S.-Thailand Trade Disputes : Applying Section 301 to Cigarettes and Intellectual Property," Michigan Journal of International Law 14(1992) pp.90-119, and S. Thaveechaiyagam, "Current Developments : The Section 301 Cigarette Case Against Thailand - A Thai Perspective," Law and Policy in International Business 21(1990) pp.367-389.
¹⁸⁹ C/M/246, November 23, 1990. cited in GATT, Analytical Index : Guide to GATT Law and Practice (Geneva : 1994) p.525.

¹⁹⁰ See Zheng Chengsi, "TRIPs and Intellectual Property Protection in China," EIPR 19(1997) pp.243-246.

¹⁹¹ While other countries, in their proposals, agreed to provide the protection of moral rights in TRIPs, the American proposal referred merely to the economic rights provided in the Berne Convention. The United States of America insisted that it was unnecessary to adopt Article 6bis of the Berne Convention in TRIPs. See Draft Agreement on the Trade-Related Aspects of Intellectual Property Rights, Communication from the United States, GATT Doc.No.MTN.GNG./NG11/W/70 (May 11,1990) Article 1.

¹⁹² The American industry preferred an absolute right to prohibit commercial rental of its works, while, under the Japanese law, it had a right to ban rentals during the first year. For more detail, see Stewart T. *op.cit* . p. 2281.

¹⁹³ Stewart T. *op.cit* . p.1931.

out of the negotiations although they did not have a vital role in the negotiations. If this had happened, developed countries would have been allowed to continue the negotiations totally in their own ways and developing countries would probably have gained nothing from the global trade negotiations.

From Thailand's perspective, there are many reasons which keep Thailand in a weak position when negotiating in the GATT. First of all, The United States of America, not the GATT Agreement, is of the greatest concern to Thailand since it is the biggest importer of Thai goods. In 1995, for instance, the volume of exported goods to the United States of America was US \$ 11.4 billion.¹⁹⁴ It is suggested that the remarkable growth of the Thai economy during this decade has come about mostly as a result of the American market. Thailand is, therefore, inevitably forced to do anything to keep this market, in order to retain its economic growth. As a consequence, many efforts, such as the establishment of specific courts or offices in several departments, have been made to deal with intellectual property rights protection primarily because of pressure from the United States of America. These steps have been taken not as a result of an intention to implement the GATT Agreement since there is no international obligation to do so.

A second reason which keeps Thailand in a weak negotiating position is that a developing country such as Thailand plays a very small role in the GATT. Thailand failed to utilize the negotiations on intellectual property at the GATT's forum to solve the problem of intellectual property rights infringements because the United States of America had forced Thailand to reform its own intellectual property laws to match the

¹⁹⁴ USTR, 1996 National Trade Estimate : Thailand p.1. available on the internet.

American-determined standards, rather than to come into line with existing obligations under multilateral agreements or international intellectual property conventions.¹⁹⁵

Several questions have been raised regarding the role of both the Association of Southeast Asian Nations (ASEAN) and Thailand in GATT's negotiations. ASEAN is a regional organization set up in 1967 by countries in the South East Asia, namely, Indonesia, Malaysia, the Philippines, Singapore and Thailand. Among its principle objectives were the acceleration of economic growth, social progress and cultural development in the region through joint endeavours in the spirit of equality and partnership in order to strengthen the foundation for a prosperous and peaceful community of South East Asian Nations.¹⁹⁶ Brunei Darussalam and Vietnam later joined this organization. It has been regarded as the most successful regional organization outside Europe in recent decades. To some extent, therefore, ASEAN should possess a bargaining power when negotiating with its trade counterparts. Similarly, Thailand, with support from ASEAN, should also possess a bargaining power on the international stage.

Although ASEAN has been established for a long period of time and cooperation among these countries is progressing steadily, it has failed to define its precise goals and its future role.¹⁹⁷ Historically, ASEAN was mainly formed because of political and security threats.¹⁹⁸ Economic growth was not the real objective of the organization. Consequently, ASEAN has not had an important role in global economy. Differences in

¹⁹⁵ Macleod. *op.cit.* p.353.

¹⁹⁶ See the Bangkok Declaration, August 8, 1967, signed by the Foreign Ministers of such countries in Bangkok, Thailand.

¹⁹⁷ H. Deborah, "Out of Others' Shadows : ASEAN Moves Toward Greater Regional Cooperation in the Face of the EC and NAFTA," The American University Journal of International Law and Policy 9(1994) p.812.

¹⁹⁸ See the Preamble of the Bangkok Declaration.

both size and level of economic development between members seem to make it difficult for ASEAN to cooperate effectively.¹⁹⁹

In addition, each member still prefers to follow its own economic path to serve its own interests. Since each member benefits by trading with countries outside the Organization instead of carrying out intra-ASEAN trade, individual members prefer GATT's free trade approach to the concept of a regional trade bloc. In other words, trading under the GATT rules far outweighs the burden to comply with the restricted protection of intellectual property, which they have eventually had to accept. Any success of member states in ASEAN has, therefore, been considered to be a success due to individual efforts, rather than a result of the ASEAN membership. In sum, although ASEAN is the only regional free trade organization outside Europe which has survived for a long period of time, its success is not considered to be due to ASEAN practice as such.

It is difficult for Thailand to receive strong support from other members. They produce similar products for the same global markets and, as a result, frequently become business rivals. It is for this reason that each of them has to protect and consider its own benefit first. This is also the reason why Thailand has not received strong support from other countries in its negotiations with the United States of America. Investment from the United States of America in Indonesia or Malaysia, for instance, is substantially greater than investment in Thailand. In 1988, American foreign investment in Indonesia and in Malaysia amounted to US\$ 758 million and US\$ 491 million respectively, as compared

¹⁹⁹ In 1993, GNP per capita of Singapore, Malaysia, Thailand, the Philippines, and Indonesia were US\$ 19850, 3140, 2110, 850, and 740 respectively. See Asian Development Bank, Key Indicators of Developing Asian and Pacific Countries 1995.

with US\$ 217 million in Thailand.²⁰⁰ The two countries are, therefore, more susceptible to American pressure than Thailand.²⁰¹

3.2.3 THE IMPACT OF TRIPs

It is worth noting that there are some GATT (1947) provisions which relate to intellectual property. Article IX, for instance, deals with marks of origin. The purpose of this provision, however, is primarily to ensure that the adoption or enforcement of laws and regulations relating to such marks should not become barriers to trade, with regard to the necessity of consumer protection. Patents, trade marks, and copyrights are referred to in Article XII (3)(c)(iii) and Article XVIII (10). According to these provisions, contracting parties are not allowed to apply restrictions which would prevent the importation of commercial samples or to prevent compliance with such rights. In addition, Article XX (d), which is an exception to the General Agreement,²⁰² provides that the adoption or enforcement of measures necessary to secure the protection of patents, trade marks, and copyrights is regarded as one of the exceptions. In other

²⁰⁰ S. Guisinger, "Foreign Direct Investment Flows in East and Southeast Asia," ASEAN Business Bulletin 8(1991) p.29.

²⁰¹ International Financial Statistics of 1991, by IMF.

	GDP : US \$ Billion	Population : Million
Indonesia	128.17	182.94
Malaysia	48.136	18.33
Thailand	98.25	56.57

Figure 2 GDP and population.

²⁰² The Panel Report on "Canada - Administration of the Foreign Investment Review Act". L/5504, adopted on February 7, 1984, 30S/140, para.5.20, cited in GATT. Analytical Index. *op.cit.* . p.519.

words, Article XX (d) would be applicable to the above measures if the basic regulations are not conflict with the GATT's provisions.²⁰³

Apparently, the protection of intellectual property rights under GATT (1947) was insufficient. This is why TRIPs is expected to set a new standard of protection for intellectual property rights. Under the TRIPs regime, there are four remarkable impacts on the protection of intellectual property rights. First of all, subject matters to be protected are specified. Secondly, the operation of TRIPs is monitored by an institution under the new trade organization. The third is the process of dispute resolution. Finally, the effective enforcement of intellectual property rights is provided.

3.2.4 INTELLECTUAL PROPERTY RIGHTS UNDER TRIPs

The intellectual property rights to be protected under TRIPs are provided for in Part II. They are 1) copyright and related rights, 2) trade marks, 3) geographical indications, 4) industrial designs, 5) patents, 6) layout designs (topographies) of integrated circuits, and 7) undisclosed information. Generally, these rights are not new, neither were they invented by TRIPs. They are rights which have already existed and have been acknowledged in several intellectual property conventions under the auspices of WIPO, namely, the Berne Convention, the Paris Convention, the Rome Convention, and the Treaty on intellectual property in Respect of Integrated Circuits.²⁰⁴ However, TRIPs makes it clear that these rights, such as computer programs,²⁰⁵ or layout designs of

²⁰³ The Working Party on 'The Haitian Tobacco Monopoly'. U/454, adopted on November 22, 1955, 4S/38, para.6, cited in GATT. Analytical Index. *op.cit.* p.519.

²⁰⁴ For references to these Conventions, see TRIPs footnote 2.

²⁰⁵ TRIPs Article 10 (1).

integrated circuits,²⁰⁶ are protected as intellectual property rights. Moreover, TRIPs ensures that these rights will be protected, particularly in their trade-related aspects, notwithstanding the fact that its members are under no obligation to comply with the above Conventions.

3.2.4.1 COPYRIGHT AND RELATED RIGHTS

Apart from computer programs and compilations of data,²⁰⁷ other types of copyright and related rights are not explicitly provided for. Nevertheless, it is understood that these rights concern the literary and artistic works and neighbouring rights provided for in the Berne Convention and the Rome Convention respectively.

For the literary and artistic works, they are :

"... every production in the literary, scientific and artistic domain, whatever may be the mode or form of its expression, such as books, pamphlets and other writings; lectures, addresses, sermons and other works of the same nature; dramatic or dramatico-musical works; choreographic works and entertainments in dumb shows; musical compositions with or without words; cinematographic works to which are assimilated works expressed by a process analogous to cinematography; works of drawing, painting, architecture, sculpture, engraving and lithography; photographic works to which are assimilated works expressed by a process analogous to photography; works of applied art; illustrations, maps, plans, sketches and three-dimensional works relative to geography, topography, architecture or science",²⁰⁸

²⁰⁶ TRIPs Article 35.

²⁰⁷ TRIPs Article 10 (1) and (2).

²⁰⁸ The Berne Convention (1971) Article 2 (1).

Similarly, they concern performer's rights, phonogram producer's rights, and broadcasting organization's rights, within the meaning of the neighbouring rights.²⁰⁹

Although members are obliged to comply with the Berne Convention, they are not required to provide moral rights for the authors.²¹⁰ On the other hand, members are required to comply with the rental rights, particularly for computer programs and cinematographic works.²¹¹ It should be noted that the copyright and related rights which already existed before TRIPs came into effect will be protected subject to the conditions of TRIPs Article 70 (1)-(5).

3.2.4.2 TRADE MARKS

A trade mark is defined as "any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings".²¹² It is obvious that the issue of trade marks in TRIPs was influenced by the Paris Convention (1967). The Paris Convention Article 6*bis*, for instance, will apply in TRIPs *mutatis mutandis*.²¹³ Furthermore, any registrations of marks under the definition in TRIPs Article 15 (1) would be refused if such marks are prohibited by the provisions of the Paris Convention (1967), such as the use without an authorization of armorial bearings, flags or other state emblems.²¹⁴

²⁰⁹ The Rome Convention (1961) Articles 7, 10, 13. See also TRIPs Article 14 (1),(2),(3).

²¹⁰ TRIPs Article 9 (1) and The Berne Convention (1971) Article 6 *bis*.

²¹¹ TRIPs Article 11.

²¹² TRIPs Article 15 (1). It should be noted that the protection of service marks is not mandatory under the Paris Convention (1967) Article 6 *sexies*.

²¹³ TRIPs Article 16 (2),(3).

²¹⁴ See the Paris Convention (1967) Article 6 *ter* (1).

Generally, a registered trade mark owner has an exclusive right to prevent other persons from using identical or similar signs : 1) in trade, 2) without the owner's consent, 3) for goods or services which are identical or similar to those of which the trade mark is registered, and 4) if they are likely to cause confusion.²¹⁵

This exclusive right will be protected indefinitely,²¹⁶ subject to the requirement of use.²¹⁷ Nevertheless, actual use should not be required as a registered condition.²¹⁸ Similarly, this right may be assigned with or without the transfer of the business to which the trade mark belongs.²¹⁹ Furthermore, this exclusive right should not be restricted by compulsory licensing.²²⁰ However, an exclusive right will not prejudice any existing prior rights, nor affect the availability of an unregistered trade mark.²²¹

²¹⁵ TRIPs Article 16 (1). It is presumed that there is a likelihood of confusion when an identical sign is used for identical goods or services.

²¹⁶ The term of protection is not less than seven years and indefinitely renewable. TRIPs Article 18.

²¹⁷ TRIPs Article 19.

²¹⁸ TRIPs Article 15 (3).

²¹⁹ TRIPs Article 21.

²²⁰ *Ibid* .

²²¹ TRIPs Article 16 (1).

3.2.4.3 GEOGRAPHICAL INDICATIONS

The significance of the protection of geographical indications, particularly for wines and spirits, is emphasized in TRIPs, even though this issue has been less attractive recently.²²² Members, for instance, have been urged to enter into negotiations which will increase such protection.²²³ Likewise, the protection of these rights has been reviewed by the Council for TRIPs.²²⁴ In addition, members are obliged not to diminish the protection which already exists for such rights.²²⁵

Generally, geographical indications are indications which identify a good as originating in a certain territory, region or locality in such a territory, on condition that a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.²²⁶ The purpose of this protection is to prevent the use of indications which mislead the public over the geographical origin of the good,²²⁷ notwithstanding that the territorial indication is literally true,²²⁸ or even where the true origin is indicated,²²⁹ or such indication is used in translation or accompanied by certain expressions like 'kind', 'type', 'style', or 'imitation'.²³⁰ This protection also

²²² There were seventeen signatories up to 1 January 1996 for the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration (1958) in which the protection of these rights is provided for. See WIPO, General Information (Geneva : WIPO, 1996) p.37.

²²³ TRIPs Article 24 (1).

²²⁴ TRIPs Article 24 (2).

²²⁵ TRIPs Article 24 (3).

²²⁶ TRIPs Article 22 (1).

²²⁷ TRIPs Article 22 (2) (a).

²²⁸ TRIPs Article 22 (4).

²²⁹ TRIPs Article 23 (1).

²³⁰ *ibid.*

prevents any use which constitutes an act of unfair competition, subject to the meaning provided in the Paris Convention (1967) Article 10 *bis*.²³¹

With regard to the issuing of a trade mark, registration of a trade mark will be denied if such a mark contains or consists of geographical indications with respect to goods not originating in the territory indicated and if the proposed trade mark might mislead the public as to the true place of origin.²³² The specific condition is provided for in the case of a trade mark concerning wines and spirits.²³³

There are some exceptions to these exclusive rights. The first is the use of such indications in good faith.²³⁴ The other exception is the geographical indication which is identical to the term in a common language used as the common name for goods or services in a certain territory.²³⁵ Similarly, the names of people in business,²³⁶ the indication of which have ceased to be protected, or are disused,²³⁷ are excepted from the TRIPs' protection.

3.2.4.4 INDUSTRIAL DESIGNS

The definition of an industrial design is not explicit. Apparently, an industrial design is the ornamental aspect of a useful article. It may be composed of lines, designs, or colours, or any three dimensional form.²³⁸ Members are obliged to protect industrial

²³¹ TRIPs Article 22 (2) (b).

²³² TRIPs Article 22 (3).

²³³ TRIPs Article 23 (2).

²³⁴ TRIPs Article 24 (4), (5).

²³⁵ TRIPs Article 24 (6).

²³⁶ TRIPs Article 24 (8).

²³⁷ TRIPs Article 24 (9).

²³⁸ See WIPO. General Information. *op.cit.* p.15.

designs which are new or original.²³⁹ The condition of 'new or original' is described as the significant difference between these designs and the known designs or combinations of known design features.²⁴⁰ However, members may exclude the protection of these rights from automobile spare parts.²⁴¹

An owner of industrial designs is empowered to prevent other persons from : 1) making, selling, or importing articles bearing or embodying a design which is a copy, or substantially a copy, of the protected design, 2) without the owner's consent, and 3) if such acts are undertaken for commercial purposes.²⁴²

Members, however, may provide limited exceptions to the protection of these designs, subject to the normal exploitation, and the legitimate interests of the designs' owner.²⁴³

3.2.4.5 PATENTS

This right will be conferred on any inventions, in all fields of technology, which are novelty, involve an inventive step, and are capable of industrial application.²⁴⁴ Such inventions could be either products or processes.²⁴⁵ In the case of a product, a patent owner is empowered to prevent other persons from the acts of making, using, offering

²³⁹ TRIPs Article 25 (1).

²⁴⁰ *Ibid* .

²⁴¹ *Ibid* . "... designs dictated essentially by technical or functional considerations". See J. Reinbothe, *et al.*, "The State of Play in Negotiations on Trips (GATT/Uruguay Round)," *EIPR* 5(1995) p.162.

²⁴² TRIPs Article 26 (1).

²⁴³ TRIPs Article 26 (2).

²⁴⁴ TRIPs Article 27 (1). For more information, see C. Correa, "The GATT Agreement on Trade-related Aspects of Intellectual Property Rights : New Standards for Patent Protection," *EIPR* 8 (1994) pp.327-335.

²⁴⁵ *Ibid* .

for sale, selling, or importing the product without his consent.²⁴⁶ In the case of a process, an exclusive right is obtained to prevent other persons from the act of using the process, and the acts of using, offering for sale, selling, or importing the product obtained directly by that process without the owner's consent.²⁴⁷ Likewise, the patent owner has the right to assign, transfer, and license his patent.²⁴⁸ These exclusive rights may be limited subject to a normal exploitation of the patent, and the legitimated interests of the patent owner.²⁴⁹

Members are allowed to exclude some inventions from being patentable for the necessity of protecting public order, morality, human, animal or plant life or health, or to avoid serious prejudice to the environment.²⁵⁰ In addition, the exclusion may include :

“(a) diagnostic, therapeutic and surgical methods for the treatment of humans or animals

(b) plants and animals other than micro-organisms, and essentially biological processes for the production of plants or animals other than non-biological and micro-biological processes”.²⁵¹

There are three remarkable issues concerning patent which are provided in TRIPs. Firstly, compulsory licensing is acknowledged,²⁵² whereas several conditions are

²⁴⁶ TRIPs Article 28 (1) (a).

²⁴⁷ TRIPs Article 28 (1) (b).

²⁴⁸ TRIPs Article 28 (2).

²⁴⁹ TRIPs Article 30.

²⁵⁰ TRIPs Article 27 (2).

²⁵¹ TRIPs Article 27 (3).

²⁵² A compulsory license is a measure that a country uses to encourage a patentee to exploit his monopoly right. Under the circumstances, the patentee may be forced, by the authorities, to grant a license, if it is found that he has abused his monopoly right.

required to ensure that a patent owner will be treated properly.²⁵³ Secondly, the term of protection is provided for twenty years from the filing date.²⁵⁴ The term of protection is more significant in the case of existing pharmaceutical and agricultural chemical products. In such cases, so called 'pipeline protection' is provided.²⁵⁵ Under such protection, a member has to provide protection and exclusive rights for pharmaceutical and agricultural chemical products since TRIPs came into effect, especially if such protection does not yet exist in the member's domestic laws. The criteria for patentability are as laid down in TRIPs Article 27 and such a product should be patented and marketed in other members.²⁵⁶ The term of protection will be five years after obtaining marketing approval in the member or until the patent for such a product is granted or rejected, whichever period is shorter.²⁵⁷

The third issue is the burden of proof.²⁵⁸ It is difficult for a plaintiff to prove that the process to obtain an identical product is the same as the patented process. This is why the onus shifts to the defendant. In civil proceedings, it is possible to make a presumption in the plaintiff's favour. In such a case, it will be deemed that such an identical product was produced through the patented process, unless the defendant can prove otherwise. This presumption arises when the plaintiff can prove that the disputed product is new, and/or that there is a substantial likelihood that such a product

²⁵³ TRIPs Article 31.

²⁵⁴ TRIPs Article 33.

²⁵⁵ TRIPs Article 70 (8),(9). This is sometimes called a 'mail-box' or 'black-box' protection. See I.C.C. *op.cit.* p.72.

²⁵⁶ TRIPs Article 70 (9).

²⁵⁷ *Ibid.*

²⁵⁸ TRIPs Article 34.

was made by the patented process even though plaintiff is unable to determine the process actually used.²⁵⁹

3.2.4.6 LAYOUT DESIGNS (TOPOGRAPHIES) OF INTEGRATED CIRCUITS

It is understood that the protection of these rights in TRIPs will accord with the Treaty on Intellectual Property in Respect of Integrated Circuits.²⁶⁰ Such exclusive rights will prevent other persons, without the authorization of the right holder, from importing, selling, or distributing for commercial purposes a layout design, an integrated circuit in which a protected layout design is incorporated, or an article incorporating such an integrated circuit only in so far as it continues to contain an unlawfully reproduced layout design.²⁶¹ The term of protection is ten years from the filing date,²⁶² or the date of the first commercial exploitation.²⁶³ Members may provide that the term of protection is fifteen years from the date of the creation of the layout design.²⁶⁴

3.2.4.7 UNDISCLOSED INFORMATION

The information will be protected if it :

- 1) is a secret
- 2) has commercial value
- 3) has been subjected to reasonable steps to keep it secret,²⁶⁵

²⁵⁹ TRIPs Article 34.

²⁶⁰ TRIPs Article 35.

²⁶¹ TRIPs Article 36.

²⁶² TRIPs Article 38 (1).

²⁶³ TRIPs Article 38 (2).

²⁶⁴ TRIPs Article 38 (3).

²⁶⁵ TRIPs Article 39 (2).

The protection will prevent other persons from disclosing, acquiring, or using such information in a manner contrary to honest commercial practices without the consent of the person to whom information lawfully belongs.²⁶⁶ Under such protection, data concerning pharmaceutical and agricultural chemical products which has been submitted to governments or governmental agencies will be protected against unfair commercial use.²⁶⁷

3.3 THE WORLD TRADE ORGANIZATION

TRIPs is overseen by the new institution, namely, the World Trade Organization (WTO). This organization is regarded as the first international trade institution in history. It was established by the Agreement Establishing the World Trade Organization,²⁶⁸ which was an integral part of the Final Act Embodying the Results of the Uruguay Round of Multilateral Trade Negotiations (the Final Act).

The idea of an international trade institution is not novel. It began fifty years ago when global economic reconstruction was required. Fierce economic measures, such as import quotas or export subsidies, were blamed as some of the reasons that brought about the Second World War.²⁶⁹

To avoid a repetition of such events, three specialized institutions were set up to maintain economic stability and to ensure that unfair strategies would not be introduced again. They were the International Trade Organization (ITO), the International Bank for

²⁶⁶ TRIPs Article 39 (2).

²⁶⁷ TRIPs Article 39 (3).

²⁶⁸ The WTO Agreement, *I.L.M.* 33(1994) p.1144.

²⁶⁹ See Stewart. *op.cit.* p.1896.

Reconstruction and Development (the World Bank),²⁷⁰ and the International Monetary Fund (IMF).²⁷¹ The ITO was expected to govern the conduct of world trade. Unfortunately, the establishment of the ITO collapsed after the Havana Conference,²⁷² due to the lack of support from the United States of America.²⁷³

Nevertheless, this period marks the beginning of the feeling that such an international trade institution was essential. Recently, global trade has been intensified by the idea of an integrated multinational economic system. Regional trade blocs have been formed in many parts of the world, such as European Free Trade Area (EFTA), North American Free Trade Area (NAFTA), and ASEAN Free Trade Area (AFTA). This idea inevitably has a self-protective effect in the global trade, i.e. it provides different trade measures to countries outside the bloc. For example, by forming NAFTA, it seemed as if the United States of America was ready to move away from the multilateral system to regional preference.²⁷⁴ This gave the impression that international trade relied more on bilateral, rather than multilateral agreements. Therefore, the new organization was needed to lead world trade in the right direction before the concept of protectionism would spread all over the world.

Moreover, it was the time to establish a 'real' international institution to administer the international trade agreements. Whereas the GATT was regarded as a successful forum for multilateral trade, the GATT *per se* lacked an institutional framework to enforce its

²⁷⁰ The World Bank was created to assist countries to reconstruct their economies.

²⁷¹ The IMF was created to facilitate trade and help countries to stabilize their domestic monetary systems.

²⁷² Final Act and Related Documents, United Nations Conference on Trade and Employment, Havana, Cuba, 21 November 1947 to 24 March 1948, U.N.Doc.ICITO/1/4 (1948).

²⁷³ The United States of America announced its decision not to resubmit the Havana Charter to Congress. See GATT/CP/86, December 7, 1950. For more detail, see Stewart. *op.cit* . p.1899.

²⁷⁴ Demaret. *op.cit* . p.132.

rules. Historically, the GATT was drafted as a multilateral treaty to be appended and administered by a separate organization.²⁷⁵ In other words, GATT's effectiveness was limited by inadequate enforcement. The dispute settlement process was a critical example in that a contracting party was allowed to disobey a panel recommendation.²⁷⁶ The Nicaragua sugar dispute is an illustration.²⁷⁷ In this case, the United States of America embargoed the importation of sugar from Nicaragua on the basis of national security.²⁷⁸ The United States of America reiterated that the GATT had no role in such a dispute and refrained from lifting the embargo until 1990 when there was a political change in Nicaragua.²⁷⁹

Furthermore, there have been many trade issues to deal with, apart from custom tariffs. During the Tokyo Round, several agreements were made and contracting parties were given the choice to join these agreements or not.²⁸⁰ The so called 'a la carte' situation undermined the principle of most-favoured-nation since a contracting party which did not join a particular agreement could gain a privilege provided by other contracting parties as a 'free rider'. This practice also eroded contracting parties'

²⁷⁵ T. Stewart, *op.cit.* p.1901, J. Bliss, "GATT Dispute Settlement Reform in the Uruguay Round : Problems and Prospects," Stanford Journal of International Law (1987) P.33. However, It was argued that, even though the GATT forfeited its institutional status by an international political reason, the GATT *per se* was *de facto* an organization. This idea was supported by several factors, such as its own staff, budgets, and internal rules. See A. Lowenfeld, "Remedies Along With Rights : Institutional Reform in the New GATT," American Journal of International Law 88(1994) p.478, and R. Brand, "Private Parties and GATT Dispute Resolution : Implications of the Panel Report on Section 337 of the US Tariff Act of 1930," Journal of World Trade Law 24(1990) p.8.

²⁷⁶ T. Stewart, *op.cit.* p.2669.

²⁷⁷ L/5607, March 2, 1984, BISD 31st Supp. (1985), p.67.

²⁷⁸ GATT (1947) Article XXI.

²⁷⁹ C/M/240 Meeting April 3, 1990.

²⁸⁰ Demaret. *op.cit.* p.128.

incentive to join such agreements. In addition, world trade has become far more complex and correlated with other issues, *inter alia*, environmental issues.²⁸¹

It is worth noting that the idea to establish the international trade institution arose during the negotiations in the Uruguay Round, not from the beginning in the Ministerial Declaration of Punta Del Este.²⁸² The idea of the WTO was created by the then Italian Trade Minister,²⁸³ and was proposed by the Canadian Ambassador to the meeting of Trade Ministers at Puerto Vallarta, Mexico.²⁸⁴ Subsequently, the European Community submitted the idea of another international trade institution, namely the Multilateral Trade Organization (MTO), to administer the GATT agreements.²⁸⁵ By the end of the negotiation, the latter appeared in Section A (3) of the Dunkel Draft. Eventually, the idea of the WTO was considered to be more favourable than the MTO.

3.3.1 THE FUNCTIONS OF THE WTO

The WTO was established to administer several GATT agreements, including TRIPs, the Understanding on Rules and Procedures Governing the Settlement of Disputes (The 'Dispute Settlement Understanding' or 'DSU'),²⁸⁶ and the Trade Policy Review Mechanism (TPRM).²⁸⁷ It will facilitate and provide the framework to operate and to

²⁸¹ For an argument concerning this issue, see, for example, S. Charnovitz, "The World Trade Organization and Social Issues," *Journal of World Trade Law* 28(1994) pp.17-33.

²⁸² G. Aldonas, "The World Trade Organization : Revolution in International Trade Dispute Settlements," *Dispute Resolution Journal* 50(1995) p.74. Also R. Hudec, *Enforcing International Trade Law : The Evolution of the Modern GATT Legal System* (New Hampshire : Butterworth Legal Publishing, 1993) p. 238.

²⁸³ Mr. Renato Ruggiero, the present Director General of the WTO.

²⁸⁴ *International Trade Rep.* (BNA) 7(1990) p.548.

²⁸⁵ Communication from the European Community, GATT Doc.No.MTN/GNG/NG14/W/42 (July 1, 1990).

²⁸⁶ The WTO Agreement Article III (3).

²⁸⁷ The WTO Agreement Article III (4).

implement these Agreements.²⁸⁸ Furthermore, the WTO will become a new forum for trade negotiations among members.²⁸⁹ Additionally, it will co-operate with the World Bank and the IMF regarding the achievement of greater coherence in world economic policy-making.²⁹⁰

3.3.2 THE SCOPE OF THE WTO

The scope of the WTO seems to be broad, judging from the provisions of the Agreement itself and the recent negotiations in the GATT. According to Article II of the WTO Agreement, the WTO is "to provide the common framework for the conduct of trade relations among members in matters relating to the agreements and associated legal instruments included in the Annexes to this Agreement". Literally, the WTO could deal with any aspects which 'relate' to trade. There have been attempts, for example, to put environmental and labour issues in trade negotiations under the WTO.²⁹¹ Having been initially discussed in the GATT Working Group on Environmental Measures and International Trade, a work program on trade and the environment was proposed and subsequently adopted by the WTO Committee on Trade and the Environment.²⁹²

The issue of the environment was once implicitly acknowledged in the 'Tuna/Dolphin Dispute'.²⁹³ This is what happened when the European Community and the

²⁸⁸ The WTO Agreement Article III (1).

²⁸⁹ The WTO Agreement Article III (2).

²⁹⁰ The WTO Agreement Article III (5).

²⁹¹ See H. Ward, "Common but Differentiated Debates : Environment, Labour and the World Trade Organization," International and Comparative Law Quarterly 45(1996) pp.592 - 632.

²⁹² The Final Act. Reprinted in I.L.M. 33(1994) p.1126.

²⁹³ Report of the Panel, United States - Restrictions on Imports of Tuna, GATT Doc.DS29/R, June 1994, reprinted in I.L.M. 33(1994) p.839. (Hereinafter 'the Tuna 1994 Report'.)

Netherlands complained against the American practice which prohibits the importation of certain tuna products. The Panel concluded that :

"... [it] noted that the objective of sustainable development, which includes the protection and preservation of the environment, has been widely recognized by the contracting parties to the General Agreement."²⁹⁴

3.3.3 THE STRUCTURE OF THE WTO

The WTO's structure consists of a Ministerial Conference, a General Council, and several other Councils, namely a Council for Trade in Goods, a Council for Trade in Services, and a Council for Trade-Related Aspects of Intellectual Property Rights.²⁹⁵ The Ministerial Conference is composed of representatives of all members. It will meet at least once every two years to carry out the functions of the WTO and take actions necessary to this effect.²⁹⁶ The Ministerial Conference has the authority to establish a Committee on Trade and Development, a Committee on Balance-of-Payments Restrictions, a Committee on Budget, Finance and Administration, and additional Committees with such functions as it may deem appropriate.²⁹⁷ Above all, it has the authority to take decisions on all matters under the agreements.

The General Council, which is a replacement of the GATT Council, is also composed of representatives of all members. It will carry out the functions of the Ministerial Conference and meet as appropriate in the intervals between the meetings of the

²⁹⁴ The Tuna 1994 Report. p.898.

²⁹⁵ The WTO Agreement Article IV.

²⁹⁶ The WTO Agreement Article IV (1).

²⁹⁷ The WTO Agreement Article IV (7).

Ministerial Conference.²⁹⁸ They will convene as appropriate to discharge the responsibilities of the Dispute Settlement Body (DSB),²⁹⁹ and the Trade Policy Review Body (TPRB).³⁰⁰ It also bears the responsibility for making appropriate arrangements with non-governmental and other intergovernmental organizations whose mandates overlap with that of the WTO.³⁰¹

3.3.4 THE COUNCIL FOR TRIPs

Generally, like other Councils, membership of the Council for Trade-Related Aspects of Intellectual Property Rights is open to representatives of all members. Meetings will be held when necessary to carry out its functions.³⁰² The Council for TRIPs has the authority to create subordinate organizations.³⁰³ It will establish rules of procedure for itself and its subordinates under the guidance of the General Council.³⁰⁴

Specifically the Council for TRIPs will monitor the operation of TRIPs.³⁰⁵ Members could support TRIPs by notifying required information to it.³⁰⁶ The other function of the Council for TRIPs is to grant extension of a transitional period to the least developed country in the case of a request from such a country.³⁰⁷ Furthermore, it will review the

²⁹⁸ The WTO Agreement Article IV (2).

²⁹⁹ The WTO Agreement Article IV (3).

³⁰⁰ The WTO Agreement Article IV (4).

³⁰¹ The WTO Agreement Article V.

³⁰² The WTO Agreement Article IV (5).

³⁰³ The WTO Agreement Article IV (6).

³⁰⁴ The WTO Agreement Article IV (5).

³⁰⁵ TRIPs Article 68 and the WTO Agreement Article IV (5).

³⁰⁶ TRIPs Articles 1 (2), 3 (1), 4 (d), 63 (2).

³⁰⁷ TRIPs Article 66.

implementation of TRIPs after the year 2000,³⁰⁸ and may refer a requirement for amending TRIPs to the Ministerial Conference.³⁰⁹ Such an amendment should be done only to achieve a higher level of protection of intellectual property rights. For the protection of geographical indications, particularly for wines and spirits, the Council for TRIPs will undertake negotiations in order to establish a multilateral system of notification and registration for such protection.³¹⁰ These negotiations will be reviewed from time to time.³¹¹

Members are able to consult the Council for TRIPs on matters relating to the trade-related aspects of intellectual property rights.³¹² Similarly, the Council for TRIPs will carry out other responsibilities as assigned to it by members.³¹³ In addition, the Council for TRIPs will examine the situation of dispute settlements concerning TRIPs and submit its recommendations to the Ministerial Conference for approval.³¹⁴

3.3.5 THE DISPUTE SETTLEMENT PROCESS

There were a few controversies regarding dispute settlement during the negotiations in the Uruguay Round.³¹⁵ Despite being regarded as one of the GATT's

³⁰⁸ TRIPs Article 71.

³⁰⁹ TRIPs Article 71 (2) and the WTO Agreement Article X (6).

³¹⁰ TRIPs Article 23 (4).

³¹¹ TRIPs Article 24 (2).

³¹² For example, see TRIPs Articles 1, 3, 4, and 23.

³¹³ TRIPs Article 68.

³¹⁴ TRIPs Article 64.

³¹⁵ It was claimed that the text for dispute settlement was one of the agreements which finished on time, and parts of the text were adopted and applied, on a trial basis, during the remaining years of the negotiations. Aldonas. *op.cit.* p. 75.

achievements, the dispute settlement mechanism was, to a certain extent, not so effective. This is because GATT's dispute settlement was traditionally operated on a consensus basis.³¹⁶ As a result, this process could, in practice, be blocked and delayed at any stage. The American DISC dispute is an example.³¹⁷ It concerned an American law, the Domestic International Sales Corporation law, which granted special tax benefits to the local exporters.³¹⁸ The European Community complained that this law violated the GATT Article XVI (4), which prohibits export subsidies. Essentially a DISC was set up to buy goods from exporters and resell them to buyers abroad. The profits of the corporation were distributed back to the exporters. One half of such profits was required to be subjected to income taxes whereas tax liability on the other half was 'indefinitely' deferred. The complaint was made in 1973 and the members of the Panel were appointed in 1976. Subsequently, the Panel report held in the complainant's favour. However, adoption of the report was blocked by the United States of America.³¹⁹

Moreover, there was no effective measure to enforce a panel report.³²⁰ In other words, even a successful party could do nothing when the other party refused to comply with a panel's decision. A recent example is the EC banana dispute.³²¹ In this case, the European Community had provided the privilege of tariff quotas on bananas to certain countries, subject to the Lome Convention. The Panel held that such a privilege was

³¹⁶ This practice is acknowledged in the WTO Agreement Article IX (1).

³¹⁷ L/4422, November 2, 1976, BISD 23 rd Supp. 1977, p.98.

³¹⁸ Revenue Act of 1971, Pub.L.No.92-178, 85 Stat.535 (1971) Ss.501-507.

³¹⁹ See GATT Council Annual Reports, L/4594, November 18, 1977.

³²⁰ D. Leebron, "An Overview of the Uruguay Round Results," Columbia Journal of Transnational Law 34(1995) p.14.

³²¹ GATT Dispute Settlement Panel Report on the European Economic Community - Import Regime for Banana, I.L.M. 34(1994) p.177.

inconsistent with GATT's rule (Article I). However, the Panel did not deny the Lome Convention's objectives. As a result, the European Community was allowed to seek a waiver through Article XXV (5) of GATT (1947). Consequently, that privilege has remained intact.

The new dispute settlement mechanism under the WTO, which applies to TRIPs through DSU Article 1 (1) and TRIPs Article 64, is enforced through the Understanding on Rules and Procedures Governing the Settlement of Disputes. The DSU offers significant amelioration over the previous GATT dispute settlement system and solve many of its shortcomings. Firstly, the DSU creates a unified system which overcomes the problem of uncertainty in determining which procedures should be applied. Several Agreements under the GATT possessed their own dispute settlement mechanisms, even though they were based on the general procedure that had been developed within the GATT's framework.³²²

Secondly, it establishes a new organ, the Appellate Body,³²³ to review legal issues decided by the panel. Thirdly, decisions of both the Panels and the Appellate Body, will be strengthened through the adoption of a process of reverse or inverted consensus.³²⁴ This means that once a member country requests the appointment of a dispute settlement panel, only a consensus on the Dispute Settlement Body (DSB) can block the establishment of that panel. Similarly, when the panel issues its report, the report will be deemed to have been adopted by the DSB unless there is a consensus not

³²² For example, Article IV (5). (6) of International Dairy Arrangement, BISD 26th Supp. (1980) p.91, Article 8 of Agreement on Trade in Civil Aircraft, BISD 26th Supp. (1980) p.162.

³²³ The Dispute Settlement Understanding Articles 17 (1)

³²⁴ The Dispute Settlement Understanding Article 17 (14). See T. Dillons, "The World Trade Organization : A New Legal Order for World Trade?," Michigan Journal of International Law 16(1995) p.373.

to do so.³²⁵ This mechanism will retain the concept of consensus and, at the same time, strengthen the certainty of the report. The only way the report can be changed is by persuading the successful country to vote against the report.

Fourthly, strict time limits are imposed throughout the process. This will prevent the delay which used to occur in any stage.³²⁶ The Panel, for instance, has to follow a proposed timetable.³²⁷ It will ensure that, unless there are exceptional circumstances, the entire process should last in a proper period of time. Additionally, a sanction is applied soon after the panel report is adopted. If a member found in violation of its obligation does not bring its practice into compliance within a reasonable period of time, or offer satisfactory compensation, then the aggrieved member may request authorization from the DSB to suspend concessions equivalent to the level of the nullification or impairment of its benefits under the relevant WTO Agreement.³²⁸

3.3.5.1 THE EVOLUTION OF THE RULE-ORIENTED METHOD

The new dispute settlement mechanism is seen as a victory for international trade legalists.³²⁹ A legal/diplomatic dichotomy has long been chronically debated over the principle underlying this mechanism.³³⁰ It is believed that the dispute settlement

³²⁵ The Dispute Settlement Understanding Articles 6 (1), 16 (4).

³²⁶ See the Dispute Settlement Understanding Articles 4, 5, 7, 8, 12, 16, 17, and 21.

³²⁷ See the Dispute Settlement Understanding Appendix III (12).

³²⁸ The Dispute Settlement Understanding Articles 22 (4).

³²⁹ R. Shell, "Trade Legalism and International Relations Theory : An Analysis of the World Trade Organization," Duke Law Journal 44(1995) p.833.

³³⁰ For a critical comment, see R. Hudec, "The GATT Legal System : A Diplomat's Jurisprudence " Journal of World Trade Law 4(1970). p.665.

mechanism has gradually evolved into a rule-oriented method.³³¹ This view is supported by the extensive reforms of enforceable rules and remedies in the dispute settlement mechanism.³³²

Dispute settlement has been regarded for a long time as a diplomatic tool. Its aim was to reach a positive, mutual, and acceptable solution. In other words, this mechanism intended to promote compromise and to reduce tensions among contracting parties. It, therefore, does not tend to provide strict legal effect in order to force contracting parties to obey the decision, or even to accept any step of the dispute settlement process.

This so called 'pragmatic' approach has gained support from many trade experts. It has been suggested that the GATT system was founded on an economic basis, not a legal one. The primary objective, thus, is "not to decide who is right and who is wrong, or to determine a State's responsibility in the matter, but to proceed in such a way that even important violations are only temporary and are terminated as quickly as possible".³³³ According to this perspective, lawyers (judges in particular) are unlikely to be appropriate persons to deal with this issue since they do not realize the reality of the business life. It was argued that lawyers tended to reach their decisions through rigid rules of laws, which were not suitable for trade or business and, at the same time, failed to understand the need for compromise in these matters.³³⁴ The ultimate goal of this approach is to stimulate international trade transaction, rather than to control parties'

³³¹ Shell. *op.cit.* p.840. Also Lowenfeld. *op.cit.* p.481.

³³² See the Dispute Settlement Understanding, for instance, Articles 17, 18, 21, and 22.

³³³ G. Malinverni, *Le Règlement des Différends dans les Organisations Internationales Economiques* (Geneve : 1974) p.106, interpreted and cited in Long. *op.cit.* p.71.

³³⁴ See Hudec. The GATT Legal System. *op.cit.* p.619.

activities. Therefore, "it is better to have a flexible, imperfect system that protects the major principles than a system so disciplined that it provokes violation and defiance".³³⁵

Nevertheless, it seems acceptable that the dispute settlement mechanism contains the rule-oriented method. First, this will make a panel report or a DSB decision 'secure and predictable'.³³⁶ These features will possibly help members to realize the world trade rules. Since the WTO is now a new forum of fortune, it is inevitable that members will reap and protect their benefits in this forum. A diplomatic method might not work well when a conflict involves a huge amount of money. Besides, members will find that it is hard to accept any decisions which are against their will and cost them a great loss. A firm and foreseeable measure is therefore essential. The Tuna/Dolphin disputes are illustrations. The United States of America prohibited the importation of tuna products which concerned fishing technology that resulted in excessive incidental takings of marine mammals (the use of purse-seine nets), which was subject to the Marine Mammal Protection Act of 1972.³³⁷ In the first Report, it was found that such prohibition was not justified by the GATT's rules since a contracting party could not restrict imports of a product merely because it originated in a country with environmental policies different from its own.³³⁸ The second Report reached the same solution, although the environmental concept was implicitly acknowledged.³³⁹ Apparently, these secure and

³³⁵ Lowenfeld. *op.cit.* p.481.

³³⁶ The Dispute Settlement Understanding Article 3 (2).

³³⁷ 16 U.S.C.1361 ff. Pub.L.No.92-522, 86 Stat.1027.

³³⁸ The 1991 Report.

³³⁹ The 1994 Report.

predictable measures will benefit 'less powerful' countries, such as developing countries, since it seems that every country will receive the same decision.

The second advantage is that the dispute settlement could possibly be enforced in an active approach. Its enforceable rules and remedies will introduce a deterrent effect to trade negotiations.³⁴⁰ Instead of taking a risk for a subsequent result, which is varied from case to case and time to time, members will be aware of what is going to happen if they breach a rule. In other words, they can anticipate that the dispute settlement process will cause subsequent retaliation when they do not comply with the rules.

To some extent, the rule-oriented method may not be as rigid as it has been suggested. Seemingly, this situation has already evolved. Nowadays, lawyers, or even judges, seem to be more liberal and know the basic principles of economies from either their educational background or their experience.³⁴¹ They may be able to interpret trade rules with proper perspectives. A process of selecting DSB's members is likely to ascertain that an appropriate person is selected to do this job.³⁴²

However, this rule-oriented method has irritated some countries more than was expected. It has been feared that the national freedom of economic policy might be restricted by the Panel report or the DSB decision. This is a crucial aspect which may ruin an effectiveness of the dispute settlement mechanism. The United States of America

³⁴⁰ A. Otten, "The Implications of the TRIPs Agreement for the Protection of Pharmaceutical Inventions," WHO Drug Information 11(1997) p.16.

³⁴¹ It is reported that judges in England, for instance, have a variety of educational backgrounds. Of the top ten law lords, at least four have either mixed or non-law degree from their universities. R. Earis, "A Broad Entry to Legal Profession," The Times May 30, 1995. p.33.

³⁴² The Dispute Settlement Understanding Article 17 (3).

failed to ratify the Havana Charter to establish the ITO and the attempt to establish such an international trade organization was aborted primarily because of this issue.³⁴³

It is obvious that the United States of America required a change in the dispute settlement mechanism and preferred this rule-oriented method.³⁴⁴ However, it is the United States of America, ironically, that explicitly expressed its dissatisfaction upon the sovereignty issue. For instance, it was quoted in the American media that "the WTO would become an all – powerful bureaucracy, able to undercut American sovereignty".³⁴⁵ The American apprehension is also stimulated by an idea that a state is going to lose its freedom in an interdependent world economy, and that "international economic integration, influenced by a multitude of uncontrollable actors, entails a loss of sovereignty".³⁴⁶ The previous reports of the Panels, such as the Tuna/Dolphin dispute,³⁴⁷ are good examples for the sceptics to prove that the American policy would be affected by the multilateral institutional decision.

Regarding this apprehension, it is suggested that the dispute settlement mechanism, and the WTO as such, retains no direct enforcement to forfeit members' sovereignty.³⁴⁸ This mechanism, to some extent, lacks many characteristics necessary to transform

³⁴³ S. Hainsworth, "Sovereignty, Economic Integration, and the World Trade Organization," Osgoode Hall Law Journal 33(1995) p.594.

³⁴⁴ Brand. *op.cit.* p.12, Lowenfeld. *op.cit.* p.479, Shell. *op.cit.* p.845. However, Shell suspected the American intention in making this requirement.

³⁴⁵ See D. Sanger, "Senate Approves Pact to Ease Trade Curbs : A Victory for Clinton," The New York Times December 2, 1994. p.22.

³⁴⁶ M. Hilf, "Settlement of Disputes in International Economic Organization : Comparative Analysis and Proposals for Strengthening the GATT Dispute Settlement Procedures," in E. Petersmann, *et al.* (ed.) The New GATT Round of Multilateral Trade Negotiations : Legal and Economic Problem (1988) pp. 285, 321.

³⁴⁷ The 1991 Report.

³⁴⁸ Dillon. *op.cit.* p. 376.

itself to the international trade court.³⁴⁹ Moreover, it was suggested that "the WTO has no more real power than that which existed for the GATT under the previous agreements".³⁵⁰

Furthermore, it does not seem possible that this mechanism will be enforced against the American will. Political will is regarded as a crucial factor for the effectiveness of the dispute settlement mechanism.³⁵¹ Thus, it is up to members, particularly the powerful ones, to decide how the dispute settlement should be enforced. The EC Banana dispute was cited to exemplify the present situation that "international dispute settlements are the result of political maneuvering, rather than a genuine concern for improving the conditions of international trade".³⁵²

Additionally, it was stated that the WTO could not change an American law and nothing could be imposed on the United States of America without its consent.³⁵³ This statement is supported by the fact that there has been no major sign that the United States of America will revise its laws, even though these laws were found to be inconsistent with GATT.³⁵⁴ Furthermore, a plan has been prepared for the United States

³⁴⁹ Hainsworth. *op.cit.* p.619.

³⁵⁰ J. Jackson, "Uruguay Round Legislation," Hearings Before the Senate Finance Committee 103d Cong., 2d Sess. 195(1994) p. 197.

³⁵¹ I. Bael, "The GATT Dispute Settlement Procedure," Journal of World Trade Law 22(1988) p.76. Also Bliss. *op.cit.* p.50.

³⁵² A. Khansari, "Searching for the Perfect Solution : International Dispute Resolution and the New World Trade Organization," Hastings International and Comparative Law Review 20(1996) pp.183-203.

³⁵³ M. Getlan, "TRIPs and the Future of Section 301 : A Comparative Study in Trade Dispute Resolution," Columbia Journal of Transnational Law 34(1995) p.216.

³⁵⁴ In the Brazil pharmaceutical dispute (L/6386), the United States of America responded by challenging that Brazil could bring a complaint if and when retaliation was taken, even though it seemed clear that the American action had violated GATT rules. See Hudec. Enforcing International Trade Law *op.cit.* p. 229.

of America to withdraw from the WTO.³⁵⁵ It is apparently true that "the GATT's contracting parties have the dispute settlement process they deserve. It works surprisingly well in most places where they want it to work, and does not work where they do not want it to".³⁵⁶

Every country, as a member of the world society, has to abide by the rules of the society. Its rights, freedoms, or even sovereignty might, to a certain extent, be affected by these rules. The word 'sovereignty' may have been misinterpreted,³⁵⁷ intentionally or unintentionally, merely to oppose the dispute settlement mechanism, or the WTO as a whole. Besides, the concept of absolute sovereignty might not be appropriate in the current situation.³⁵⁸

The other aspect of sovereignty regards an issue of harmonization. The issue of sovereignty may be raised again if there is concrete evidence that TRIPs attempts to harmonize members' domestic laws. The concept of harmonization is not promising and it is unlikely that TRIPs tends to do so. It is important to remember that TRIPs aims to reach an ultimate result, i.e. effective enforcement, whichever 'methods' are used.³⁵⁹

³⁵⁵ There is a plan to appoint a commission to review the Panel's decisions which affect the United States of America. If the commission finds that the Panel exceeds its authority or acts arbitrarily 3 times within 5 years, any Congress member can initiate a withdrawal vote. See P. Behr, "Dole Joins President on GATT, Senate GOP Leader Gets "Escape Hatch" on Trade Arbitration," Washington Post November 24, 1994. p.1. For more detail, see G. Horlick, "WTO Dispute Settlement and the Dole Commission," Journal of World Trade 29(1995) pp.45-48.

³⁵⁶ R. Plank, "An Unofficial Description of How a GATT Panel Works and Does Not," Journal of International Arbitration 4(1987) p.101.

³⁵⁷ See S. Croley, *et al*, "WTO Dispute Procedures, Standard of Review, and Deference to National Governments," American Journal of International Law 90(1996) p.211.

³⁵⁸ See L. Henkin, "The Mythology of Sovereignty," ASIL Newsletter (March - May 1993) p.1.

³⁵⁹ TRIPs Article 1 (1).

This could be supported by the Panel report on the American Section 337 dispute.³⁶⁰ A contracting party was not asked to change its substantive law, or even the level of enforcement of that law. However, the contracting party was required to obtain the level of enforcement which was consistent with the GATT provisions.³⁶¹

To the contrary, it has been suggested that TRIPs is the largest and most ambitious attempt to harmonize intellectual property rights on a world scale.³⁶² This may be true if the meaning of 'harmonization' is construed in a broad sense. Since one of the TRIPs' aims is to set minimum standards of protection in members' domestic laws, it is inevitable that it will have some effect.

It seems clear that TRIPs intends to guide such domestic laws in the same direction and finally produce similar results. This, to some extent, should affect society's perspectives. If a law is regarded as a product of a social norm, societies with similar norms should produce similar laws. It may, then, be argued that similar laws will be a factor in an attempt to bring one society's perspective into conformity with that of another. This assumption, if it really exists, is unpleasant since it is the first step toward penetrating other country's sovereignty and it will bring the world to a new era of colonialism. It may create a situation where developing countries' perspectives are undermined through the concept of 'one law throughout the world'.

The rule-oriented method has also been viewed optimistically in that it may reduce the risk of unilateral action.³⁶³ One reason is that retaliation has never been an ideal for dispute settlement. It is generally believed that the termination of offending measures,

³⁶⁰ L/6439, adopted on November 7, 1989. 36S/345,392.

³⁶¹ *Ibid* . Paragraph 5.26. cited in GATT. Analytical Index. *op.cit* . p.538.

³⁶² Demaret. *op.cit* . p.162.

³⁶³ Demaret. *op.cit* . p.136.

rather than retaliation, is the aim of such a process.³⁶⁴ Statistics show that retaliation has only once been authorized in the context of the dispute settlement under the GATT.³⁶⁵ The other reason is that a member which seeks redress will be bound by the rules and will not be allowed to decide by itself that a violation has occurred.³⁶⁶ This rule will prohibit the member from taking justice into its own hands.³⁶⁷

As for the process of sanction, generally the prevailing party should first seek to suspend concessions or other obligations with respect to the same sectors as that in which the panel or the Appellate Body has found a violation or other nullification or impairment. If the party considers that it is not practicable or effective to do so, it may seek to suspend concessions or other obligations in other sectors under the same agreement. If the party considers that the circumstances are serious enough, it may seek cross retaliation, i.e. to suspend concessions or other obligations under another covered agreement.³⁶⁸

However, the reasons which support the idea that a unilateral action will be limited have not been persuasive. On the contrary, the cross retaliation, in particular, has been viewed as a reproduction of Section 301 of the American Trade Act of 1974. This is not overstated. It is apparent that, unless the intellectual property rights are 'appropriately'

³⁶⁴ One of the GATT (1947) purposes is to limit the retaliatory action, through the process of consultation and dispute settlement. See a comment of the GATT Director General in EPCT/A/PV/6, p.4. cited in GATT. Analytical Index. *op.cit.* p.645.

³⁶⁵ The U.S. Dairy Quotas Case : The Netherlands Action Under Article XXIII:2 to Suspend Obligations to the United States, GATT (November 8, 1952), BISD, 1st supp., 1953, p.32.

³⁶⁶ The Dispute Settlement Understanding Article 23.

³⁶⁷ *Leebron. op.cit.* p.17, *Lowenfeld. op.cit.* p.481, *Shell. op.cit.* p.852.

³⁶⁸ The Dispute Settlement Understanding Articles 22 (3).

protected certain countries, such as the United States of America, will not be reluctant to enforce trade sanctions in order to acquire the appropriate protection.

It is assumed that the United States of America will not hesitate to seek a resolution through the dispute settlement process. Although the fact that only one authorized sanction was allowed under GATT was impressive, statistics show that, during 1948-1989, the United States of America was a complainant in over a third of all cases.³⁶⁹ Having played a vital role in forcing the American Government to use Section 301, private actors are likely to persuade the Government to bring more cases, especially in the area of intellectual property rights protection, to the dispute settlement process.³⁷⁰ As mentioned earlier, conflict in the intellectual property field was previously regarded as conflict in principle between the 'North' and the 'South'. Such an issue was so delicate that it was difficult to examine which side was right and which one was wrong. This conflict hardly exists today since it was settled in TRIPs. The controversy, if any, will possibly concern the issue of enforcement. As a result, members will be ready to bring their cases to the dispute settlement process.³⁷¹

Furthermore, cross retaliation seems to be the gist of the American scheme for dispute resolution. In unifying dispute settlement in the GATT, it will allow trade sanctions to be enforced in the area of the new agreements, such as TRIPs. An American delegation overlooked an idea to set up a dispute settlement mechanism in the WIPO

³⁶⁹ The figures showed that, of 207 cases, the United States of America was a complainant in 72 cases. See Hudec, *Enforcing International Trade Law. op.cit.* pp.590-608.

³⁷⁰ It was believed that more cases would be taken into the WTO dispute settlement. See *International Trade Reporter* 11(1994) p.30. See also Aldonas. *op.cit.* p.79.

³⁷¹ A research was undertaken and it was found that of 18 complaints which developed countries made against developing countries, 10 were put forward by the United States of America. 2 of them concerned patent protection. See Table 11 in P. Kuruvila, "Developing Countries and the GATT/WTO Dispute Settlement Mechanism," *Journal of World Trade* 31(1996) p.187.

conventions primarily because there was no need for a separate agreement on the dispute settlement in the WIPO conventions.³⁷² It is unlikely that the United States of America will allow any unnecessary rules to undermine the effectiveness of this cross retaliation. Apparently, the benefits derived from intellectual property of other countries are regarded as insignificant when compared with those of the United States of America.³⁷³ That is why it seems to be more practicable and effective to retaliate against a developing country, such as Thailand, in a major trade area of agriculture, or textile, rather than in an intellectual property area as such.

The attitude of developed countries on this issue is another reason that makes developing countries worry about such retaliation. It appears that trade liberalization is the goal for developed countries, particularly the United States of America, which they will do everything to achieve. The use of Section 301 was justified as the proper strategy in bringing other contracting parties to the GATT negotiations.³⁷⁴ Moreover, it was suggested that, to some extent, breaking GATT rules by enforcing Section 301 to achieve this aim, was better than doing nothing and leaving global trade in chaos.³⁷⁵ At present, no one can be assured that other members will act reasonably under the TRIP's rules. As a result, dispute settlement and retaliation will inevitably be sought. If

³⁷² International Bureau of WIPO, Committee of Experts on the Settlement of Intellectual Property Disputes Between States, 7th Sess. WIPO Doc.SD/CE/II/8 (June 2, 1995).

³⁷³ See F. Abbott, "The Future of the Multilateral Trading System in the Context of TRIPs," Hastings International and Comparative Law Review 20(1996) p.674.

³⁷⁴ C. Taylor, "The Limits of Economic Power : Section 301 and the World Trade Organization Dispute Settlement System," Vanderbilt Journal of Transnational Law 30(1997) p.222. It was claimed that the purpose in using Section 301 was to force other countries to accept a more reliable dispute settlement mechanism. See Aldonas. *op.cit* . p.74.

³⁷⁵ R. Hudec, "Thinking about the New Section 301 : Beyond Good and Evil," in J. Bhagwati, *et al* . (ed.) Aggressive Unilateralism : America's 301 Trade Policy and the World Trading System (Michigan : University of Michigan Press, 1990) p.151.

the free trade concept cannot be achieved through this process, due to the American perspective, it is likely that the United States of America will decide to 'play its own game' again.

It has been argued that there is no conflict between Section 301 and Article 23 of DSU. Of the sixteen American complaints to GATT between 1975 and 1985, eleven started from the investigation under Section 301.³⁷⁶ It has also been suggested that there are fundamental similarities between Section 301 and DSU, *inter alia*, the idea that retaliation is a last resort.³⁷⁷ By this view, the United States of America merely needs to adjust its timetable to conform to the timetable of dispute settlement under the WTO, awaiting the results of those procedures before making any determinations or imposing any sanctions.³⁷⁸

The argument that both measures share a similar nature, to a certain extent, seems to be true since they provide legal sanctions, notwithstanding no rule has been violated.³⁷⁹ Section 301 allows the United States of America to sanction other countries which do not provide appropriate protection to its intellectual property rights, even when their laws conform to their international obligations.³⁸⁰ In the Brazil pharmaceutical dispute, the United States of America imposed sanctions against imports from Brazil on the ground that Brazil had failed to afford patent protection for American pharmaceuticals, even though it seemed that Brazil had not violated the GATT's

³⁷⁶ USITC, Pub.No.1793, Review of the Effectiveness of Trade Dispute Settlement Under the GATT and the Tokyo Round Agreements, Report to the Committee on Finance, US Senate, on Investigation No.332-212 Under S.332 (G) of the Tariff Act of 1930, (1985) pp.49-51.

³⁷⁷ Getlan *op.cit.* p.205.

³⁷⁸ See Leebron. *op.cit.* p.17.

³⁷⁹ See Taylor. *op.cit.* pp.209-348.

³⁸⁰ Braga. *op.cit.* p.259.

rules.³⁸¹ According to an interpretation of the phrase 'nullification and impairment', ironically also derived from the American proposal,³⁸² a member may seek authority to retaliate against other members even when TRIPs rules have not been violated yet.³⁸³ It is enough for a member to seek a sanction for an action with which has interfered with the attainment of some benefit the member could reasonably have expected to obtain from TRIPs. The member may contend either that TRIPs has not been complied with, or that effective enforcement and remedies have not been provided.

3.4 ENFORCEMENT IN TRIPs

It appears that the issue of enforcement concerning intellectual property rights is a major part of TRIPs.³⁸⁴ Unless enforcement is efficient, TRIPs' success will inevitably be undermined. This success will be determined through the achievement of the TRIPs' goals i.e. to reduce distortions and impediments to international trade.³⁸⁵

To accomplish this goal, effective action must be provided against any intellectual property rights infringements.³⁸⁶ This includes expeditious remedies to prevent infringements, and remedies which constitute a deterrent to further infringements.³⁸⁷

³⁸¹ GATT complaint L/6386. See Hudec. *op.cit.* . p.571.

³⁸² US Department of State, Pub.No.2411, Commercial Policy Series 79, Proposals for Expansion of the World Trade and Employment, (1945) p.24.

³⁸³ The GATT (1994) Article XXIII (1)(b), the Dispute Settlement Understanding Article 26 (1). See also Hudec. Enforcing International Trade Law. *op.cit.* . p.6.

³⁸⁴ It has been argued that "... future development of the WTO system not only must improve the dispute settlement procedures, but should first concentrate on improving national procedures for protecting individual rights and interests." See Hilf. The Role of National Courts in International Trade Relations *op. cit.* p. 356.

³⁸⁵ See TRIPs' Preamble.

³⁸⁶ TRIPs Article 41 (1).

³⁸⁷ TRIPs Article 41 (1).

Likewise, enforcement must not be unnecessarily complicated or costly, neither should it entail unreasonable time-limits or unwarranted delays.³⁸⁸ Moreover, it must be fair and equitable.³⁸⁹

'Fair and equitable' enforcement is exemplified, in civil procedures and remedies, such as the defendant's right to written notice,³⁹⁰ the right to be represented by independent legal counsel,³⁹¹ the right not to have imposed overly burdensome requirements concerning mandatory personal appearances,³⁹² and the right to an opportunity to substantiate the claims and to present all relevant evidence.³⁹³

Additionally, such procedures and remedies must be transparent. This qualification is the basic principle of international trade which allows members to understand, and to be able to inspect, such procedures and remedies. This will ensure that such procedures and remedies are fair and equitable. In this respect, decisions are required to be made in writing and reasoned.³⁹⁴ They must be based only on evidence in respect of which parties were offered the opportunity to be heard.³⁹⁵ Similarly, such procedures and remedies must be made available to the parties without undue delay.³⁹⁶ An opportunity for a judicial review should also be provided.³⁹⁷

388 TRIPs Article 41 (2).

389 *Ibid* .

390 TRIPs Article 42.

391 *Ibid* .

392 TRIPs Article 42.

393 *Ibid* .

394 TRIPs Article 41 (3).

395 *Ibid* .

396 TRIPs Article 41 (3).

397 TRIPs Article 41 (4).

Generally, several approaches have been used in enforcing remedial measures. One of them is the preventive approach. It is intended, for instance, to deter a person from an infringement.³⁹⁸ Next is an approach to deter a person from committing the illegal activity. This approach provides the effect both before and after an infringement is committed. The effect before the infringement is committed tends to deter a person from planning to infringe an intellectual property right. This approach makes the person fear the consequence, such as criminal sanctions.³⁹⁹ This should be an ultimate goal for TRIPs since it will protect intellectual property rights from being infringed. The effect after the infringement is committed tends to minimize an injured person's damage by deterring further infringement, for example, by stopping infringing goods from circulating into the market.⁴⁰⁰ The other approach is restoration. This approach puts an injured person back to the position he was in before an infringement occurred, for instance by compensating him in damages.⁴⁰¹

To a certain extent, the issue of enforcement could be regarded as the ultimate goal of the decade-long negotiation. Unless such enforcement exists under the TRIPs regime, the United States of America will sanction other countries with Section 301 again.⁴⁰² Furthermore, it seems unbelievable that an intellectual property rights' owner will be

³⁹⁸ TRIPs Article 44.

³⁹⁹ TRIPs Article 61.

⁴⁰⁰ TRIPs Article 51.

⁴⁰¹ TRIPs Article 45.

⁴⁰² In 1994 it was stated that Section 301 remained exactly today as it always had been, and that the United States of America would still be able to retaliate unilaterally against other countries. See 'USTR Says Accord Preserves Section 301 : Gephard Pledges Support for GATT Deal'. *International Trade Rep.* 11(BNA)1, January 5, 1994, p.30. This study found that the United States of America still identified countries that had been failing to meet TRIPs obligation or otherwise failing to protect intellectual property rights properly every year. 37 and 34 countries were identified in 1995 and 1996 respectively. See Taylor. *op.cit.* p.235.

satisfied with the fact that all countries have already provided 'acceptable' enforcement and remedies in their domestic laws. What he is concerned with is the actual remedy he will receive, not remedial measures provided in a statute.

A mere appropriate law cannot provide appropriate remedy, unless such a law is appropriately enforced. This idea seems to be supported by the TRIPs' concept which aims at the accomplishment of intellectual property rights protection, whichever method is used.⁴⁰³ The next question, therefore, regards how to enforce such remedial measures in an 'acceptable' way.

3.5 REMEDIAL MEASURES IN TRIPs

Several proposals were submitted during the negotiations in order to express the concern of contracting parties on this issue. The American Proposal for the Negotiations on Trade-Related Aspects of Intellectual Property Rights,⁴⁰⁴ for instance, was introduced soon after TRIPs was included in the 1986 Ministerial Declaration. This proposal stressed the need for the creation of an effective economic deterrent to the infringement of intellectual property rights protection through the implementation of border measures.⁴⁰⁵ Two main objectives of this Proposal were, firstly, to reduce distortions and impediments to legitimate trade in goods and services caused by deficient levels of protection and enforcement of intellectual property rights, and, secondly, to persuade all countries to join the agreement in order to resolve disputes

⁴⁰³ According to Article 1 (1), member countries are free to determine the appropriate method of implementing the provisions of TRIPs within their own legal system and practice.

⁴⁰⁴ The United States for Achieving the Negotiating Objective. GATT-Doc.MTN.GNG/NG11/W/14 (20 October 1987). Reprinted in Beier and Schriker. (Hereinafter the American Proposal)

⁴⁰⁵ The American Proposal. *op.cit.* p.182.

under a multilateral settlement mechanism. It proposed that an intellectual property rights' owner should be entitled to lodge an application to prevent importation of infringing goods. Other remedies should include preliminary and final injunctions, damages, seizure and destruction of infringing goods, as well as criminal sanctions. Such remedial measures would, according to the American proposal, be considered for both trade-based remedies and those under intellectual property laws.⁴⁰⁶ The European Community and Japan introduced their own proposals and, in the main, accorded with the American Proposal.⁴⁰⁷ These guidelines seemed to support the American Proposal in ensuring that intellectual property rights protection would be discussed as an international trade issue in GATT.

However, there were some differences between the American proposal and the EC Guidelines. While the American Proposal stressed importation, for instance, the EC guidelines aimed at customs procedure in general such as import, export, and so forth.⁴⁰⁸ Moreover, the former simply defined appropriate deterrent penalties such as imprisonment and monetary fines while the latter did not make explicit provision for penalties. They merely suggested that large fines and prison sentences should be considered as possible sanctions.⁴⁰⁹

Subsequently, the Basic Framework of GATT Provisions on Intellectual Property (incorporating the views of the European, Japanese and United States Business

⁴⁰⁶ The American Proposal. *op.cit.* p.185.

⁴⁰⁷ Guidelines Proposed by the European Community for the Negotiations on Trade-Related Aspects of Intellectual Property Rights. GATT-Doc.MTN.GNG/NG11/W/16 (20 November 1987). Reprinted in Beier and Schriker. (Hereinafter the EC Guidelines) Suggestion by Japan for Achieving the Negotiating Objectives. GATT.Doc.No.MTN.GNG/NG11/W/17 (November 23, 1987).

⁴⁰⁸ The EC Guidelines. *op.cit.* p.205.

⁴⁰⁹ The EC Guidelines. *op.cit.* p.210.

Communities) was produced. This Basic Framework also concurred with the American Proposal and stressed international trade. Border measures, for example, were interpreted as measures to isolate significant infringements or importations from countries whose inadequate laws and enforcement procedures permit infringements and other misappropriations of intellectual property, by cutting off exporters from their main foreign markets.⁴¹⁰

It should be noted that contention on remedial issues was scarcely noticeable when compared with that on other issues, such as the basic principles or the scope of intellectual property rights. This was probably because there were not many conflicts concerning the remedial concepts among the contracting parties. Even though the legal backgrounds between common law and civil law systems are different, they could manage to overcome these differences and form compromise measures. It has been argued that the experience of internal negotiations on the basis of the European Community Draft successfully helped in promoting these global negotiations.⁴¹¹

Remedial measures in TRIPs are divided into four parts, namely,

- civil remedies
 - Injunctions
 - Damages
 - Orders of disposal or destruction
 - Order of information
- provisional measures

⁴¹⁰ The Basic Framework of GATT Provisions on Intellectual Property - Statement of views of the European, Japanese and United States Business Communities, June 1988. Reprinted in Beier and Schriker. *op.cit.* p.367.

⁴¹¹ See T. Cottier, "The Prospects for Intellectual Property in GATT," *CMLR* 28(1991) p.410. See also Draft Agreement on Trade-Related Aspects of Intellectual Property Rights. MTN.GNG/NG11/W/68 (29 March 1990).

- border measures
- criminal sanctions

3.5.1 INJUNCTIONS

The purpose of this measure is to prevent and to deter imported goods which are involved in the infringements of intellectual property rights (hereinafter the infringements) from entering into the markets, immediately after customs clearance of such goods. The judicial authorities should have the power to order a party to desist from the infringements.⁴¹² Members, however, are not obliged to provide for this measure to protect subject matter which was acquired or ordered without knowledge of, or reasonable grounds to know, the infringing nature of such goods.⁴¹³ Remuneration might be provided as an alternative remedy in a case of use, or authorization, by a government.⁴¹⁴ Similarly, in a case where this measure is inconsistent with members' laws, declaratory judgments and adequate compensation will be the alternatives.⁴¹⁵

Normally, injunctions are regarded as a common law - remedy since they are claimed as a creation of the courts of equity.⁴¹⁶ They are defined as orders either prohibiting a person from doing some specific act, called a prohibitive injunction, or commanding a person to undo some wrong or injury, called a mandatory injunction. According to this concept, it is likely that injunctions will be enforced in a rather broad sense.⁴¹⁷ In other

⁴¹² TRIPs Article 44.

⁴¹³ TRIPs Article 44 (1).

⁴¹⁴ TRIPs Article 44 (2).

⁴¹⁵ TRIPs Article 44 (2).

⁴¹⁶ L. A. Sheridan, Injunction in General (Chichester : Barry Rose Law Publishing, 1994) p.4.

⁴¹⁷ The English Court of Appeal held in a recent case that the civil remedy could even be sought, in aid of the criminal law, to uphold the public policy of ensuring that a criminal did not retain profit derived directly from the

words, it is suggested that this measure is discretionary and based on equitable principles. To a certain extent, this measure seems flexible enough to allow a judge to provide an effective remedy to an intellectual property right holder from an early stage and the *status quo* is restored in order to protect the right holder from further harm.

However, it is not clear that injunctions in Article 44 will be enforced exactly the same way as they are in English or any other common law system. The significant question is whether injunctions will be granted only where legal remedies such as damages would provide an inadequate remedy.⁴¹⁸ This traditional rule stems from the equitable concept which provides that "equity follows the law".⁴¹⁹

It is unlikely that this rule will be regarded as the major condition in granting injunctions under Article 44, since this rule does not appear in this provision. Besides, members which are not familiar with the equitable procedures might be reluctant to follow this rule. It seems to be more appropriate to take the availability of other remedial measures as one of the elements to be considered in determining the application of this remedial measure. The more restrictive approach identified above might be regarded as an obstacle to access to an effective remedy and it could become a barrier to trade.

commission of his crime. *Attorney General v. Blake* (December 16, 1997). reported in The Times December 22, 1997. p.40. In this case, the defendant, a former member of the Secret Intelligence Services, had revealed some information in his autobiography without any permission or approval from the Government. The Attorney General sought an action against him from profiting from publication of his autobiography.

⁴¹⁸ R. J. Sharpe, Injunctions and Specific Performance (Toronto : Canada Law Book, 1983) p.5.

⁴¹⁹ See P. Parker, et al. (ed), Snell's Equity (London : Sweet & Maxwell, 1990) p.27.

3.5.2 DAMAGES

This measure is provided for in Article 45 of TRIPs. Adequate damages should be available to compensate an injured person when

1. an infringer engaged in an infringing act or acts, and
2. an infringer knowingly, or with reasonable grounds to know, did so.

Expenses of the action, which may include appropriate attorney's fees, should also be available.

The judicial authorities should have a discretionary power to order recovery of profits and/or payment of pre-established damages even where the infringer did not knowingly, or with reasonable grounds to know, engage in an infringing activity.⁴²⁰

Apart from the purpose of restoration, these measures may tend to prevent an infringing act and/or to deter a further infringement. The phrase 'damages adequate to compensate for the injury the right holder has suffered' seems to hint at an endorsement of the restorative approach. However, 'adequate damages' could be used for the preventive and deterrent approaches too. This idea is based on an assumption that if there is no profit in such infringements, no one would engage in these illegal activities. It is apparent that intellectual property rights have been infringed because there is a huge profit in these illegal activities. Such motivation is wrong and should be discouraged.

Arguably, the idea of using orders for damages for preventive or deterrent approaches is supported by the provisions of TRIPs *per se*. A broad interpretation of Article 41 will possibly allow the judge to use damages as the means to deter further infringements committed by the infringer, or other persons. The order of recovery of

⁴²⁰ TRIPs Article 45 (2).

profits or pre-established damages also gives support to this idea.⁴²¹ This concept is likely to discourage intellectual property rights infringements. No one should gain any profit from an illegal activity even when he does not commit it intentionally.⁴²²

Generally, it seems that this idea has not been pursued sufficiently in many countries. The seriousness of injury is one major aspect. In other words, the amounts of damages are obviously inadequate to prevent or deter further infringements. There are no explicit criteria for assessing the level of seriousness of injury, so it is decided on a 'case by case' basis. It is possible that, for instance, an infringement of a large quantity of goods which involves a large amount of profits will be regarded as serious. However, in some countries, an infringement of luxury goods might not be regarded as severe.⁴²³ Decisions may vary even in the same court because they are mainly based on the individual background and knowledge of each judge. Different cultures and economic structures are the other factors.

The other reason why the deterrent approach is not effective is that it seems rather difficult to determine adequate damages. Compensation required by an injured person is sometimes overestimated.⁴²⁴ A judge, therefore, has to decide moderate damages

⁴²¹ TRIPs Article 45. See L. Bently, "Accounting for Profits Gained by Infringement of Copyright : When Does It End?," *EIPR* 1(1991) pp.5-15.

⁴²² See Hall T, *The Infringement of Patent for Inventions, Not Designs* (Cincinnati : 1893) p.224. However, this deterrent approach may be limited merely to discourage the infringements, not to punish the infringers. See *My Kinda Town v. Soll* [1982] F.S.R. p.156 per Slade J.

⁴²³ Luxury goods such as clothes, leather bags, or jewellery watches are, from time to time, regarded as less important than necessary goods such as agricultural or pharmaceutical products. See M. Kosteci, "Sharing Intellectual Property Between the Rich and the Poor," *EIPR* 8(1991) p.271.

⁴²⁴ In one patent case, the plaintiffs sought damages for a total of 9,355,600 Baht (approximately 200,000 Pounds). The Thai Supreme Court, however, found that the adequate damages were 5,022,400 Baht (approximately 100,000 Pounds). The Supreme Court Judgment 2379/2537 (1994 A.D.). Regarding an exchange rate between Thai and English currencies, the Thai Baht has been affected by the current situation, particularly in 1997-1998. It has

for the injured person, which may be less than the actual damages. In such a case, the remedy has a small effect and does not deter an infringer. A reasonable royalty method to compensate the injured person,⁴²⁵ particularly in a patent case, might be a relevant option.

The situation will be more complicated when there is no explicit injury which the injured person has suffered. Damage to reputation is an example. The infringer may not have received any benefit from an infringement and/or the injured person may have suffered no actual loss. The judge may conclude that there is no actual damage that the infringer has to compensate in the case. Even when the infringer is ordered to pay expenses, this order, in some countries, hardly delivers any deterrent effect to discourage his wrongful motivation.⁴²⁶ In such cases, an award of statutory damages seems to be an appropriate resolution. This is an amount of compensation fixed by law that the injured person may elect to recover instead of actual damages.⁴²⁷

In this situation, the 'value of use' test was adopted in one of the American cases to compensate the plaintiff in a case where the defendant earned no profits and the plaintiff lost no prospective sales. The court held that the defendant could reduce its own

fluctuated between 40 Baht (per 1 Pound) and 92 Baht (per 1 Pound). For this research, nevertheless, this exchange rate is not so significant. Therefore, the rate of 40 Baht per 1 Pound is used throughout the study.

⁴²⁵ This damage is equal to the amount which the infringer would have had to pay had he had a license upon the terms normally granted by the patentee. See *Catnic Components v. Hill & Smith Ltd.*, [1983] F.S.R.518. Also *Meters Ltd. v. Metropolitan Gas Meters Ltd.* (1911) 28 R.P.C. p.164.

⁴²⁶ The maximum court fees for a civil case in Thai law is 200,000 Baht (approximately 4,000 Pounds). The Civil Procedure Code, Table II.

⁴²⁷ This method is available in many countries' domestic laws, for instance, Article 88 of the Republic of China Copyright Law, translated and reprinted in N. Trop, and L. Chen, "A Bold New Awakening? The New Taiwanese Copyright Law," *Journal of the Patent and Trademark Office Society* 74(1992) p.856.

campaign costs by paying no royalty to the copyright owner for the infringing material.⁴²⁸

The other significant aspect of damages is expenses. Certain expenses, particularly attorney's fees, have been regarded as the necessary expenses which an injured person had to assume in order to find redress against the infringement of his intellectual property rights.⁴²⁹ An order covering expenses will ensure that "all litigants have equal access to the court to vindicate their statutory rights and also prevent [the] infringements from going unchallenged".⁴³⁰ It is obvious that such expenses are considerably high in many countries.⁴³¹ It will become a barrier for an intellectual property right holders to seek justice unless they can cope with such costly expenses. It should, therefore, be acceptable to place this burden on the infringer since such responsibility will discourage other persons from infringing intellectual property rights.

Members are not obliged to provide for attorney's fees in their domestic laws. It is worth noting that TRIPs merely concerns 'appropriate' attorney's fees,⁴³² not the full actual fees. Even though these fees could serve in the deterrent approach,⁴³³ this method may be corruptly used by the injured person. Several American cases could be

⁴²⁸ *Deltak Inc. v. Advanced Systems Inc.*, 767 F.2d 357 (7th Cir.1985)

⁴²⁹ Committee of Experts on Measures Against Counterfeiting and Piracy, "WIPO Meetings," *Industrial Property* 9 (1988) p.340.

⁴³⁰ See *Quinto v. Legal Times of Wash.Inc.*, 511 F.Supp.579,581 (D.D.C.1981)

⁴³¹ In one American decision, attorney's fees of over US\$ 1.4 million were awarded to the plaintiff. See *Refac Int'l v. Hitachi Ltd.*, 921 F.2d 1247(Fed.Cir.1990)

⁴³² In the United States of America, a reasonable fee is considered as a 'moderate' amount which is frequently less than such a fee would be if property fixed between the client and his attorney. See *Key West Hand Pnnt Fabrcs Inc. v. Serbin Inc.*, 269 F.Supp.605 (S.D.Fla.1965)

⁴³³ In the United States of America, the reason for awarding attorney's fees is sometimes to penalise the losing party. See *Rose v. Bourne*, 176 F.Supp.605 (S.D.N.Y. 1959)

raised to demonstrate this anxiety. In one case, a party tried to make a profit in payment of attorney's fees over and above the amount that the client actually paid to the attorney.⁴³⁴ In another case, a party unreasonably prolonged litigation for the purpose of collecting disproportionately large statutory damages and the attorney's fees.⁴³⁵

3.5.3 ORDERS OF DISPOSAL OR DESTRUCTION

According to Article 46 of TRIPs, members have to endow the judicial authorities with the power to order that infringing goods be disposed of outside the channels of commerce, or be destroyed (subject to the constitutional restrictions), to avoid any harm caused to the right holder. Likewise, the judicial authorities have the power to order that materials and implements predominantly used for infringement purposes be disposed of outside the channels of commerce so as to minimize the risk of further infringements. Such orders will be made without compensation of any sort. In considering a disposal request, the judicial authorities will consider the issue of 'proportionality' as between the seriousness of the infringement and the remedies ordered in addition to the interests of third parties.

It appears that this measure is intended to deter infringements. The drastic result of this measure is that infringing goods will be removed from the market permanently. In the case of trade marks, it is provided that the mere removal of an infringing trade mark from goods will not usually be sufficient to permit the release of counterfeit trade mark goods into the market.⁴³⁶

⁴³⁴ Jewish Employment & Vocational Serv. Inc. v. Pleasantville Educ. Supply Corp., 601 F.Supp.224,223 U.S.P.Q.783 (E.D.Pa.1983)

⁴³⁵ Warner Bros. Inc. v. Dae Rim Trading Inc., 677 F.Supp.745,773 (S.D.N.Y.1988)

⁴³⁶ TRIPs Article 46.

It has been argued that orders for destruction should not be placed among civil remedies, since the purpose of civil remedies was to cause the wrongful act to stop, not to inflict punishment.⁴³⁷ A significant effect when this measure is regarded as a civil remedy, rather than a criminal one, relates to the interpretation of the law. The law can be broadly interpreted and flexibly enforced within the scope of the civil law. This differs from the area of criminal law, where all measures are strictly interpreted and enforced.

The interpretation of the concept of 'goods', 'materials' or 'implements' is an illustration. Since this measure concentrates on an 'object', rather than a 'person', it is likely that all objects 'that have been found to be infringing' could be disposed of or destroyed. It possibly brings about a problem when there is concrete evidence that such goods belong to a third person who knows nothing concerning any infringement.⁴³⁸ Although it is provided that the interests of third parties should be taken into account when considering any request for such a measure,⁴³⁹ the innocent person has already been placed in an insecure position.⁴⁴⁰

Moreover, these words might be broadly interpreted to include tools, equipment, and components, and might even be construed to cover 'legitimate' goods in order to deter an infringer from committing such infringement in future. This might arise, for instance, where 'legitimate' goods are imported without the consent of a right holder. This is the

⁴³⁷ Committee of Experts on the Protection Against Counterfeiting, "WIPO Meetings," Industrial Property 10(1987) p.366.

⁴³⁸ It may be sufficient to prove merely that the goods were found in the infringer's possession. See J. Bornkamm, "An Overview of the Actions and Remedies for Dealing with Infringement of Intellectual Property Rights," WIPO ASEAN Regional Colloquium on Intellectual Property for the Judiciary WIPO/IP/JU/BKK/95/2 p.12.

⁴³⁹ TRIPs Article 46.

⁴⁴⁰ The American court once held that the remedy of forfeiture and destruction is not available as against an innocent third party who acquires infringing goods, but does not himself engage in any act of infringement. See *Applied Innovations Inc. v. Regents of the Univ. of Minn.*, 876 F.2d 626,637-8 (8th Cir.1989).

concept of 'parallel imports' which, to some extent, is legally acknowledged.⁴⁴¹ The judgments of the European Court of Justice that 'a patentee has to accept the possibility of parallel imports' are raised to support this situation.⁴⁴² The concept of 'exhaustion of rights' is likely to support this situation too.⁴⁴³ Such 'parallel import' goods are obviously competitive since they are similar goods but cheaper than those in the imported markets. This inevitably affects the market prices of the right holder's goods. Under these circumstances, the right holder is probably dissatisfied with the situation, and regards it as an infringing act.⁴⁴⁴ Consequently, the order of disposal or destruction might be sought.

⁴⁴¹ This is a situation when the goods were legally circulated in one country by, or the consent of, a right holder. Such goods were later imported into another country without authorization of the right holder.

⁴⁴² Joined cases, *Merck v. Primecrown* (c-267/95) and *Beecham v. Europharm* (c-268/95) [1997] 1 *CMLR* p.83.

⁴⁴³ TRIPs Article 6. Obviously, once a goods is sold, a right holder has no right o prevent a purchaser from reselling.

⁴⁴⁴ The right holder, especially in the patent case, could argue that he has a right to prevent other persons from importing a patented product or a product obtained directly by the patented process. See TRIPs Article 28 (1).

3.5.4 RIGHT OF INFORMATION

The right of information is another type of civil remedies. It tends to enable an intellectual property rights' owner to obtain knowledge of sources and distribution channels of the goods that infringe his rights. This measure is an option that members may incorporate in their domestic laws.

This measure also aims to prevent an infringement and to deter a further infringement. In doing so, it will cut off the infringing act both upstream, at the source, and downstream, at the various commercial outlets.⁴⁴⁵ An infringer will be ordered to inform the right holder of the identity of third persons involved in the production and distribution of the infringing goods or services, and of their channels of distribution.

However, it is likely that this measure penetrates an individual right of self-incrimination. This conflict arises when the infringer declines to comply with the order. Normally, he is entitled to the privilege against self-incrimination,⁴⁴⁶ i.e. the right of an accused or an offender to remain silent and refrain from answering any question which might tend to incriminate him. This privilege comes from the fundamental right that no person will be compelled in any criminal case to be a witness against himself. It tends to maintain a good balance between personal rights and state power to enforce the criminal law.

Since modern society has evolved from the time the right of self-incrimination was created, the concept of this right apparently has been undermined. There is also a sign

⁴⁴⁵ See Committee of Experts on Measures Against Counterfeiting and Piracy. *op.cit.* p.338.

⁴⁴⁶ For more explanation, see D. Walk, The Oxford Companion to Law (Oxford : Oxford University Press, 1980) p.1129.

that the scope of this right has been narrowed.⁴⁴⁷ In England, for instance, after a crucial decision that a defendant was entitled to the privilege against self - incrimination,⁴⁴⁸ the Supreme Court Act 1981 Section 72 was amended to clarify that such privilege would not be available to a person in civil proceedings that related to infringement of intellectual property rights.⁴⁴⁹ Such a statement, however, would not be admissible in criminal proceedings for a related offence. Nowadays, it seems that the aim of combating the infringements is more important than the old idea of protecting individual liberties.

3.5.5 PROVISIONAL MEASURES

The judicial authorities should have the power to order prompt and effective provisional measure :

1. to prevent the infringing activity, or the entry of infringing goods, and
2. to preserve relevant evidence in regard to the alleged infringement.⁴⁵⁰

An applicant is required to give reasonably evidence to prove that he is a right holder, and his right is being infringed or the infringement is imminent.⁴⁵¹ Furthermore, he may be required to give other information necessary for identifying such illegal goods.⁴⁵²

⁴⁴⁷ See M. Berger, Taking the Fifth (Toronto : Canada Law Book, 1980) p.163.

⁴⁴⁸ Rank Film Distributor Ltd. v. Video Information Centre [1982] A.C.380 (H.L.)

⁴⁴⁹ 1981.c.54.

⁴⁵⁰ Article 50 (1).

⁴⁵¹ Article 50 (3).

⁴⁵² Article 50 (5).

This measure seems to be similar to the one of the equitable remedies called an interim injunction. It is a type of injunction. The most well known interim injunction is the 'Anton Piller' order. This comes from the decision of the same name of the Court of Appeal.⁴⁵³ The aim of this injunction is to preserve evidence that may otherwise be destroyed by a defendant. It is a mandatory injunction in the sense that it requires a defendant to permit the search of his premises and the seizure of goods for inspection.⁴⁵⁴ Apparently, the interim injunction has been enforced successfully, particularly in England. To some extent, it is said that the majority of illegal activities have been dealt with by such injunctions before infringers have been put on trial leading to early settlement of cases.⁴⁵⁵ They are regarded as flexible and effective remedial measures especially in the context of the intellectual property rights infringement.

Generally, one of the important elements in granting this measure is the factor whether an intellectual property right has been infringed or such infringement is imminent. This could help a right holder in finding a quick remedy. However, there is uncertainty regarding the meaning of the phrase 'such infringement is imminent'. It is not clear whether it could be compared to an attempt or preparatory acts in criminal law. In other words, it is a question of the difference in the meaning between 'do' and 'about to do'.⁴⁵⁶

⁴⁵³ Anton Piller KG v. Manufacturing Processes Ltd. [1976] Ch.55.

⁴⁵⁴ L. A. Sheridan, Chancery Procedure & Anton Piller Orders (Chichester : Barry Rose Law Publishing, 1994) p.28.

⁴⁵⁵ " ... Nearly always, ..., these cases do not go to trial. The parties accept the *prima facie* view of the court or settle the case. At any rate, in 99 cases out of 100 it goes no further". Per Lord Denning in *Fellowes & Son v Fisher* [1976] QB 122 (C.A.) p.129. Also M. Fysh, " The Action for Infringement of Intellectual Property Rights," Regional Forum and the Judiciary and the Intellectual Property System (Geneva:1987) p.174.

⁴⁵⁶ In general, the basis of an injunction is the threat, actual or implied, on the part of the defendant that he is about to do an act which is in violation of the plaintiff's right. See D. Young, *et al.* (ed.) Terrell on the Law of Patents (London : Sweet & Maxwell, 1994) p.441.

Under TRIPs, the defendant will enjoy several forms of protection. Firstly, a security, or equivalent assurance, maybe required in order to protect the defendant's position.⁴⁵⁷ Secondly, a notice of the order should be given to him without delay, so that he could decide how to deal with this measure appropriately.⁴⁵⁸ Next, if proceedings are not initiated within a reasonable period, the order must be revoked.⁴⁵⁹ In addition, the applicant will be ordered to compensate the defendant where there is no final determination of the infringement.⁴⁶⁰

3.5.6 BORDER MEASURES

Border measures enable a right holder to lodge an application with the competent authorities for the suspension of the release of counterfeit or pirated goods into free circulation.⁴⁶¹ WTO members are required to adopted measures to permit right holders to instigate the use of border measures. The right holder should have valid grounds for suspecting that the importation of such goods may take place and he must provide adequate evidence that his right is infringed, under the laws of the country of importation.⁴⁶² A sufficiently detailed description of the goods is also required.⁴⁶³ If the suspension is allowed, both the applicant and the importer will be informed. Such goods will be released unless the proceedings are continued.⁴⁶⁴

⁴⁵⁷ Article 50 (3).

⁴⁵⁸ Article 50 (4).

⁴⁵⁹ Article 50 (6).

⁴⁶⁰ Article 50 (7).

⁴⁶¹ Article 51.

⁴⁶² Article 52.

⁴⁶³ *Ibid.*

⁴⁶⁴ Article 55.

Border measures are regarded as crucial since they effectively deter and prevent infringing goods from circulating into the market. They tend to deprive the importer of the economic benefits of the transaction and deter him from further importation of such goods.⁴⁶⁵ Such illegal goods will be dealt with from an early stage since they move across members' borders. It is unlikely that the right holder could stop or seize such goods successfully once they have been put onto the market. To ensure the effectiveness of border measures, competent authorities may be allowed to initiate the process to suspend the release of goods.⁴⁶⁶ Furthermore, competent authorities should also be given the power, subject to judicial review, to order the destruction or disposal of such goods.⁴⁶⁷ Competent authorities, may also be given authority to provide the right holder with information concerning the consignor, the consignee, the importer, and the goods.⁴⁶⁸ In addition, it is worth noting that there is no exception in enforcing this measure even where infringing goods are in possession of an innocent person.⁴⁶⁹

Apparently, these measures are emphasized in the importation of counterfeit trademark and pirated copyright goods.⁴⁷⁰ TRIPs leaves it as an option for member countries that border measures involving exportation or infringements of other

⁴⁶⁵ Renoue. *op.cit.* p.239. See also J. Sweeney, *et al.*, "Heading Them Off at the Pass – Can Counterfeit Goods of Foreign Origin Be Stopped at the Counterfeiter's Border?" Trademark Reporter 84 pp.477-494. In practice, these measures rely on correct and adequate information, normally via computerized system. In many countries, particularly developing ones, the computerized system is still not in use effectively. Therefore, officials always ask for information from intellectual property right's owners.

⁴⁶⁶ Article 58. It may be very helpful in a case where a right holder is unknown.

⁴⁶⁷ Article 59.

⁴⁶⁸ Article 57.

⁴⁶⁹ It is noted that the American authorities are able to award an order of seizure, forfeiture, and destruction even when such imported infringing goods are in possession of a noninfringer. See Nimmer. *op.cit.* p.14-121.

⁴⁷⁰ For the definition of 'counterfeit trademark goods' and 'pirated copyright goods', see TRIPs footnote 14.

intellectual property rights may be provided. Likewise, these measures are not intended to deal with the importation of small quantities of goods.⁴⁷¹

The importer, however, receives some protection from inappropriate use of these measures. A condition for the applicant to provide a security,⁴⁷² or the right to be compensated for an injury are required.⁴⁷³ Moreover, the defendant's confidential information has to be protected.⁴⁷⁴

Nevertheless, there is fear that such measures might be corruptly enforced. One purpose of a requirement of a security is to prevent abuse.⁴⁷⁵ Furthermore, there is an anxiety that such measures may be used as a strategy to limit importation.⁴⁷⁶ In other words, they may be used to delay, or even prevent, foreign goods from competing on the domestic market.

A similar remedial measure, namely seizure on importation, is provided for in the Paris Convention (1967).⁴⁷⁷ This issue was once the subject of huge debate between developed and developing countries. The original text which mandated the seizure of counterfeit goods was eventually modified to allow members to decide whether to provide either this measure or the prohibition of importation or seizure inside the country.⁴⁷⁸

471 Article 60.

472 Article 53.

473 Article 56.

474 See TRIPs Article 57.

475 TRIPs Article 53.

476 Renoue. *op.cit.* p.236.

477 Article 9.

478 Olenick. *op.cit.* p.826.

3.5.7 CRIMINAL SANCTIONS

Criminal sanctions seem to be the most important and effective remedial measures in TRIPs.⁴⁷⁹ This may be because they are enforced directly against the infringer's right or property.⁴⁸⁰ Criminal sanctions here consist of imprisonment and monetary fines. In appropriate cases, they include seizure, forfeiture, and destruction of the infringing goods and of any materials and implements, the predominant use of which has been made in the commission of the offence.⁴⁸¹

Criminal sanctions are intended to deter and prevent any persons from committing the infringements. It is argued that such illegal activities are not a minor offence, but a particular form of economic crime that must be taken seriously and must be opposed.⁴⁸² They should be dealt with by a combination of both imprisonment and fines.⁴⁸³ This is why TRIPs requires in Article 61 that imprisonment and monetary fines are sufficient to provide a deterrent, and consistent with the level of penalties applied for crimes of a corresponding gravity. There was a likelihood that the seriousness of such infringements would be determined by comparing with the offences of theft or other monetary fraud.⁴⁸⁴ However, it was subsequently made clear that there was no

⁴⁷⁹

It seems that criminal sanctions are more preferable to civil remedies. One reason is that civil remedies are regarded as time-consuming process. Therefore, they cannot prevent infringement in proper time. See Gervais. *op.cit.* p.198.

⁴⁸⁰ See Jennings. *op.cit.* p.808. Also Gervais. *Op.cit.* p.198. Civil action is frequently regarded as a time-consuming process. As a result, it is not perceived as effective in preventing intellectual property rights' infringement.

⁴⁸¹ TRIPs Article 61.

⁴⁸² D. Brouer, "The Law to Enforce the Protection of Intellectual Property and to Combat the Piracy of Products," *Industrial Property* 12(1990) p.410.

⁴⁸³ See Jennings. *op.cit.* p.815.

⁴⁸⁴ The Basic Framework. *op.cit.* p.401.

intention to assimilate these offences into theft. The comparison was made, primarily to find out the suitable sanctions for such offences.⁴⁸⁵

Article 61 provides a mandatory punishment only in cases of wilful trade mark counterfeiting and copyright piracy,⁴⁸⁶ leaving other types of intellectual property rights infringements as 'options' for members. It seems that trade mark counterfeiting and copyright piracy are more harmful than other infringements and so are dealt with by these more effective sanctions. This is apparently true when judging from the results of such infringements. The more severe the punishment, the more it will deter such illegal activities. Nevertheless, a patent right holder might wonder why he is treated differently from a trade mark or a copyright holder. From the former's perspective, it might be more appropriate to punish all types of the infringements. Consequently, the different infringements should be dealt with by the different levels of punishments, according to their seriousness. This argument could be supported by the concept of the 'horizontal approach'.⁴⁸⁷ Thailand,⁴⁸⁸ for instance, seems to support this approach since they provide criminal sanctions for all infringements of intellectual property rights.

The additional element in criminal sanctions is that such activities should be carried out on a commercial scale. The phrase 'on a commercial scale' is rather obscure. It

⁴⁸⁵ See Committee of Experts on Measures Against counterfeiting and Piracy. *op.cit.* p.34.

⁴⁸⁶ The American court had once suggested that 'wilful' may only mean an intent to copy and not to infringe. See *United States v. Becker*, 134 F.2d 533 (2d Cir.1943) It was later construed that the concept of 'wilfulness' required for criminal copyright infringement should be "voluntary, intentional violation of a known legal duty". See *United States v. Moran*, 757 F.Supp.1046 (D.Neb.1991)

⁴⁸⁷ This approach finds that piracy is not different from a normal infringement. It is merely an act of infringement characterized by a specific aim and would be punished the same as a normal infringement. See Brouer. *op.cit.* p.410. It is noted that German jurists support this approach. See also F. Wooldridge, "The Enforcement of the TRIPs Agreement in Germany," *Intellectual Property Quarterly* 2(1997) p.240.

⁴⁸⁸ See the Copyright Act B.E.2537 Section 70, the Patent Act B.E.2522 Section 85, the Trade Marks Act B.E.2534 Section 108.

should be strictly construed since this is a criminal measure. It was once discussed whether the quantity of goods should be taken into consideration.⁴⁸⁹ It was also argued that the qualification on a commercial basis was intended to cover repeated offences.⁴⁹⁰ This phrase might be added to ensure that this measure deals primarily with the trade related aspects.

Apparently, the specific intention of the infringer is not required. To some extent, it is easier for the right holder to prove that the infringement was committed on a commercial scale, compared with an attempt to prove the specific intention of such an infringer.⁴⁹¹

⁴⁸⁹ Committee of Experts on Measures Against Counterfeiting and Piracy. *op.cit.* p.333.

⁴⁹⁰ See Brouer. *op.cit.* p.411.

⁴⁹¹ For this issue, the phrase 'for the purpose of commercial advantage or private financial gain' provided for in the American copyright law is regarded as the equivalent of "for profit". 17 U.S.C. Section 506 (a) The American court held that this phrase did not require that the offender should actually make a profit, but only that he engage in a business "to hopefully or possibly make a profit. United States v. Shabazz, 724 F.2d 1536 (11th Cir.1984)

CHAPTER 4 : INTELLECTUAL PROPERTY LAW IN THAILAND

4.1 INTRODUCTION

There has been a great deal of controversy over Thai intellectual property laws even though they are, to some extent, based on international criteria and regarded as modern. The United States of America, as well as some European countries, have complained that law enforcement and remedial measures to combat counterfeiting and piracy in Thailand are both inadequate and ineffective. For example, it was estimated that American industry lost \$70 - 100 million dollars, as a result of Thai piracy of videos, audio-cassettes, books, and computer software, in 1990 alone.⁴⁹² Therefore, the United States Trade Representative (USTR) placed Thailand on the 'priority watch list' and later, in responding to a recommendation from the President's Economic Policy Group, put Thailand on the Special 301 priority list.⁴⁹³ This step was taken on the basis that Thailand had engaged in certain intellectual property practices that created barriers to market access.⁴⁹⁴ This was the pretext for demanding restrictions on the Generalized System of Preferences (GSP) for Thailand and inevitably the reform of Thai intellectual property laws.

It is, therefore, important to find out why intellectual property law is not so effective in protecting intellectual property rights. An answer of this issue may be found when considering intellectual property law in Thailand and its historical background. Copyright law, patent law, and trade mark law, in particular, will be scrutinized

⁴⁹² Termination of Section 302 Investigation Regarding Thailand's Enforcement of Copyright Protection, 56 Fed. Reg. 67, 114 (USTR 1991)

⁴⁹³ Notice of Countries Identified as Priority Foreign Countries, 56 Fed. Reg. 20, 060 (USTR 1991)

⁴⁹⁴ Mesevage. *op.cit.* p.431.

respectively. Consequently, this Chapter will discuss the change of Thai intellectual property law, especially under international obligations. The prime result of this change, the set up of the Central Intellectual Property and International Trade Court, will also be considered.

4.2 COPYRIGHT LAW

The Royal Proclamation of the Vajirayam Library Ror.Sor.111 (1892 A.D.)⁴⁹⁵ is regarded as the first copyright law, also the first intellectual property law, in Thailand. This Proclamation was enacted during the reign of King Chulalongkorn (Rama V) of the Chakri Dynasty.⁴⁹⁶ Since the country was ruled by absolute monarchy at that period, this Proclamation was considered as a law.⁴⁹⁷ As a result, everyone had to abide by this Proclamation and, in practice, might have been punished for violating such a Proclamation, even though it provided neither civil nor criminal sanctions.

This Proclamation prohibited any person from publishing or printing the Vajirayam Vises Books without the permission of the Library Committee. The Vajirayam Library was mainly intended as the Royal Family's library.⁴⁹⁸ The other intention was to encourage Thai people to create and enjoy Thai literature.⁴⁹⁹ Accordingly, a number

⁴⁹⁵ The Royal Gazette, September 20 B.E.2435 (1892 A.D.). Ror.Sor. (*Rattanakosin Sok*) refers to the number of years which have passed since the time when the *Chakri* Dynasty reigned the country (B.E.2325). *Rattanakosin* is the formal name of 'Bangkok'.

⁴⁹⁶ 1868 - 1910 A.D.

⁴⁹⁷ See C. Hemarachata, *Some Aspects About Copyright Law* (Bangkok : Netitham Publishing, 1985) p.9.

⁴⁹⁸ Damrong Rajanubhab, Prince, *History of the National Library* reprinted for the funeral of Phra Intabanya (Bangkok : Aksorn Charoentat, 1969) p.15.

⁴⁹⁹ The Royal Proclamation of the Rewards for the Authors. The Royal Gazette, September 25 B.E.2432 (1889 A.D.).

of invaluable works were printed in the Vajirayam Vises Books. It was discovered later that some of these works had been copied and sold without prior consent of the Library Committee. After this Proclamation came into force, no single infringement was reported.⁵⁰⁰

It is apparent that, at this stage, authors and their rights were not the main focus of protection. The rights of the authors were not explicitly acknowledged in this Proclamation. Furthermore, permission from the Library Committee, rather than from the individual author, was required. This idea is supported by the fact that this law was intended to protect the literary works in the Vajirayam Vises Books only, not all literary works in the country. In other words, specific works were the aim of this protection.

Subsequently, the Ownership of Writers Act Ror.Sor. 120 was enacted in 1901.⁵⁰¹ One of the main purposes of this law was to protect economic rights of writers.⁵⁰² Therefore, this law extended the protection to all books in the country.⁵⁰³ This purpose was later extended to cover other types of literary works, such as newspapers, pamphlets, and lectures, by the Amendment of the Ownership of the Writers Act B.E.2457 (1914 A.D.).⁵⁰⁴

It has been argued that the Ownership of the Writers Act Ror.Sor.120 was influenced by the English copyright concept.⁵⁰⁵ Firstly, the Preamble of this Act referred to other countries' laws which discouraged any persons from copying or publishing any books

⁵⁰⁰ Damrong Rajanubhab. *op.cit.* p.102.

⁵⁰¹ The Annual Law Report, Part I, Vol.18, Ror.Sor.120 (1901 A.D.) p.65.

⁵⁰² The Preamble of this Act.

⁵⁰³ A book was protected when it was first published in Thailand and was first sold in Thailand. See Section 7.

⁵⁰⁴ The Annual Law Report. Vol.27, B.E.2457 (1914 A.D.), p.426.

⁵⁰⁵ See Subhapholsiri. Copyright Law (1996). *op.cit.* p.5.

without the writer's consent. Secondly, there were some significant similarities between this Act and the English laws,⁵⁰⁶ such as the term of protection. Copyright subsisted for the natural life of an author and a further seven years after his death. If such a term was shorter than forty two years, the copyright would subsist for the term of forty two years.⁵⁰⁷ In addition, it is possible that Prince Rajaburi Direkrit, highly regarded as the father of modern Thai law, introduced English laws to the Thai legal system since he completed his legal education there. The Prince himself wrote many books at that time and might have found that appropriate protection, as provided under English law, was needed.⁵⁰⁸

This was the first time that remedial measures had been provided. Under the Ownership of Writers Act Ror.Sor.120, an infringer could be ordered to pay 'appropriate' damages to the writer if he had been found to be infringing the writer's rights.⁵⁰⁹ In addition, any books which were published without the writer's consent were deemed to be the writer's property and could be forfeited.⁵¹⁰

In 1931, the Literature and Artistic Work Protection Act B.E.2474 was enacted.⁵¹¹ This Act aimed at replacing the Ownership of Writers Act Ror.Sor.120 which was considered obsolete.⁵¹² In it, the word 'copyright' was acknowledged for the first time

⁵⁰⁶ The Statute of Queen Anne 1710, c.19; the Literary Copyright Act 1842, c.45.

⁵⁰⁷ The Ownership of the Writers Act Ror.Sor.120 Section 6, and the Literary Copyright Act 1842 Section III.

⁵⁰⁸ Nitisartpaisam, Phraya, "Lecture on the Literature and Artistic Work Protection Act," in Compilation of Lectures at the Association of Samakayacham from B.E.2470 - 2474 (Bangkok : Fuengnakorn, 1931) p.598.

⁵⁰⁹ Section 16.

⁵¹⁰ *Ibid.*

⁵¹¹ The Royal Gazette, Vol. 48, June 21, 1931, p.127.

⁵¹² Nitisartpaisam. *op.cit.* p.602.

and protection was extended to cover another type of work, namely, artistic work.⁵¹³ Additionally, the Act was enacted in order to comply with international practice and to enable Thailand to become a member of the Berne Convention for the Protection of Literary and Artistic Works.⁵¹⁴

Both civil and criminal remedies were provided for in this Act. As regards civil remedies, the author was able to apply for a prohibitive order, account of profit, and other measures according to the laws of tort.⁵¹⁵ Moreover, such copies would be deemed to be the author's property.⁵¹⁶ Criminal sanctions for copyright infringement were explicitly covered in Sections 25 to 27. Sanctions provided for in this Act only extended to monetary fines.

4.2.1 THE COPYRIGHT ACT B.E.2521

The Literature and Artistic Work Protection Act B.E.2474 was in force for nearly 50 years until it was repealed by the Copyright Act B.E.2521 (1978 A.D.).⁵¹⁷ There were many reasons for introducing this Act to society. One of them, not surprisingly, was to strengthen copyright protection. Remedial measures, particularly criminal sanctions, were claimed to be too lenient and ineffective.⁵¹⁸ The only penalty, a fine not exceeding 500 Baht (12.50 Pounds), became an insignificant deterrent and resulted in many infringements.

⁵¹³ The Preamble of the Act.

⁵¹⁴ S. Ratanakorn, "The Judiciary and the Intellectual Property System in Thailand," in Regional Forum and the Judiciary and the Intellectual Property System (Geneva : WIPO, 1987) p.308.

⁵¹⁵ Section 22.

⁵¹⁶ Section 23.

⁵¹⁷ The Royal Gazette, Special issue, Vol.95, No.143, December 18, 1978, p.1.

⁵¹⁸ The reason for the enactment of the Act.

As a result, several criminal sanctions with more severe punishments were provided for in Sections 43 to 49. The minimum fine, for instance, was increased to 10,000 Baht (250 Pounds) while the maximum could amount to 100,000 Baht (2,500 Pounds).⁵¹⁹ If such infringement was committed in connection with a commercial purpose, the minimum fine was set at 20,000 Baht (500 Pounds) and the maximum of 200,000 Baht (5,000 Pounds).⁵²⁰ In addition, imprisonment was for the first time introduced into the law for infringers who committed an offence in connection with commercial purposes. The infringer could be punished by up to a year imprisonment.⁵²¹ If it was a secondary infringement, the imprisonment was reduced to a term not exceeding six months.⁵²²

Nevertheless, it is noteworthy that civil remedies were omitted from the copyright law. The author, therefore, had to seek damages, and other civil remedies, through the laws of tort. The other significant issue is that the prohibitive order was also omitted from the law and the author had to seek alternative remedies through the Civil Procedure Code.

There have been many attempts to amend the Copyright Act B.E.2521 in the last decade. The most crucial one was in 1988. Responding to pressure from the United States of America, the Royal Thai Government decided to submit the Amendment Bill to the Parliament. This turned out to be a political issue and heated debate was widespread throughout the country. The Amendment Bill was overwhelmingly opposed in society at large and many members of Parliament were reluctant to vote in favour of the bill. Finally, although it was passed by the House of Representatives, the Prime

⁵¹⁹ Section 43 para.1. If it was a secondary infringement, the amount of monetary fines were between the minimum of 5,000 Baht (125 Pounds) to the maximum of 50,000 Baht (1,250 Pounds). Section 44 para.1.

⁵²⁰ Section 43 para.2. If it was a secondary infringement, the amount of monetary fines were between the minimum of 10,000 Baht (250 Pounds) to the maximum of 100,000 Baht (2,500 Pounds). Section 44 para.2.

⁵²¹ Section 43 para.2.

⁵²² Sections 44 para.2.

Minister decided to dissolve Parliament and called an election the same day. This unanticipated incident resulted in the nullification of the bill.⁵²³

4.2.2 THE COPYRIGHT ACT B.E.2537

Most recently, the Copyright Act B.E.2521 was repealed in 1994 by the Copyright Act B.E.2537.⁵²⁴ The present law was enacted in the light of changes in both internal and external circumstances (particularly the development and expansion of the domestic and international economy and consequent trade and industry).⁵²⁵ Even though the Copyright Act B.E.2537 has repealed the Copyright Act B.E.2521, it still contains several important principles which existed in its predecessor, such as the principle of national treatment.⁵²⁶

In addition, the types of work protected under the Copyright Act B.E.2537 are rather similar to those provided for in the previous Act. They are literary, dramatic, artistic, musical, audio-visual, cinematographic, sound recording, sound and video broadcasting work, and any other work in the literary, scientific or artistic domain whatever may be the mode or form of its expression.⁵²⁷ However, the Copyright Act B.E.2537 has made a significant change regarding this issue by stipulating that

⁵²³ Macleod. U.S.Trade Pressure. *op.cit* . p.355.

⁵²⁴ The Royal Gazette, Special issue, Vol.111, No.59, December 21, 1994, p.1.

⁵²⁵ See note of the Copyright Act B.E.2537.

⁵²⁶ For example, Section 8 provides that, "The author of a work is the owner of copyright in the work of authorship subject to the following conditions : (1) in the case of unpublished work, the author must be a Thai national or reside in Thailand or be a national of or reside in a country which is a member of the Convention on the protection of copyright of which Thailand is a member provided that the residence must be at all time or most of the time spent on the creation of the work; (2) ..."

⁵²⁷ The Copyright Act B.E.2537, Section 6.

computer programs are literary works,⁵²⁸ and thereby protected under copyright law.⁵²⁹ This has ensured that Thai law conforms to TRIPs,⁵³⁰ and, at the same time, ended the chronic controversy over whether or not computer programs are protected under Thai laws.

In the past, it had been argued that computer programs were not protected under copyright law because computer programs could not be regarded as literary works; few, if any, could understand and enjoy computer language in the manner ordinary people enjoy literary works.⁵³¹ Furthermore, the issue of computer programs had not been discussed when the Copyright Act B.E.2521 was drafted, whereas other issues had been deliberately considered.⁵³² In addition, copyright law, to some extent, is regarded as criminal law since it contains punishments for persons who violate the law. Consequently, the law should be strictly interpreted;⁵³³ and since the law did not explicitly cover such matters, it should not be flexibly interpreted to protect computer programs.

⁵²⁸ The Copyright Act B.E.2537, Section 4 provides that ... 'Literary work' means any kind of literary work such as books, pamphlets, writings, printed matters, lectures, sermons, addresses, speeches, including computer programs.

...

⁵²⁹ The Copyright Act B.E.2537, Section 4 also provides that ... 'Computer program' means instructions, set of instructions or anything which are used with a computer so as to make the computer work or to generate a result no matter what the computer language is.

⁵³⁰ TRIPs Article 10(1).

⁵³¹ P. Deepadung, "Copyright and Computer Software," in Intellectual Property Law (Bangkok : Rung-Rueng Printing, 1989) p.440.

⁵³² It was argued that specialists in several branches of copyright work, excluding computer programs, were invited to express their comments on the draft of this Act. D. Subhapholsiri, In Depth of Copyright Law 2537 (Bangkok : Se-Education Public, 1995) p.28.

⁵³³ J. Pakdithanakul, "Intellectual Property Law in Thai Court," Doonlapah 40(1993) p.10.

On the other hand, others had challenged that computer programs were protected as copyright works. Some jurists argued that computer programs were protected as 'other work in the scientific domain'.⁵³⁴ Others had simply indicated that computer programs should be regarded as literary works and were thus protected by the law.⁵³⁵ This controversy did not reach a conclusion until the Copyright Act B.E.2537 was enacted.

The subject of moral rights has also been adapted in the Copyright Act B.E.2537. Previously, the Copyright Act B.E.2521 stated that

" ... In the case when the copyright has already been assigned according to paragraph 2, the author of the copyright work in this Act is still entitled to prohibit the assignee or any person from distorting, shortening, adapting or doing anything against the work to the extent that such act would cause damage to the reputation or dignity of the author".⁵³⁶

From this provision, it appeared that the author enjoyed the only type of moral rights under this law, namely, the right of integrity. It was unclear how long these rights were protected. Generally, there are three opinions relating to such terms of protection. First is the argument that moral rights should be protected perpetually. This opinion follows the concept of French law that moral rights are personal to the author;⁵³⁷ therefore, these rights should be protected indefinitely.⁵³⁸ The second opinion is that moral rights should be protected in the same way as economic rights. There is no difference

534 The Report of the Office of Juridical Council, June 23, 1985.

535 Y. Puongraj, *In Depth of Copyright Law 2537 op.cit.* p.19.

536 The Copyright Act B.E.2521 Section 15.

537 The French Copyright Statute Law No.57-298 on Literary and Artistic Property, Article 6 para. 2.

538 See S. Stewart, *International Copyright and Neighbouring Rights* (London : Butterworths, 1983) p.61.

between these two categories of rights.⁵³⁹ The last opinion suggests that moral rights are personal rights and are acknowledged primarily to protect the author's reputation. Thus, these rights relate to individual concern and should only be exercised by the author. As a result, these rights should not exist after the author's death.⁵⁴⁰

The Copyright Act B.E.2537 follows the second opinion, as above, in that it not only stipulates that the author has the right of paternity and the right of integrity, but also that:

... when the author has died, the heirs of the author are entitled to litigation for the enforcement of his right through the term of copyright protection unless otherwise agreed in writing.⁵⁴¹

The clause 'unless otherwise agreed in writing' remains ambiguous. It leads to confusion whether the term of protection for moral rights can be extended or shortened by a written agreement.⁵⁴² This clause, however, seems to relate to moral rights *per se* and should be understood to mean that the author can waive his moral rights by agreeing with other parties in writing.⁵⁴³

The introduction of performer's rights is another major change in the new copyright law. According to TRIPs, performer's rights are to be regarded as neighbouring rights (or related rights);⁵⁴⁴ and therefore Thailand has to provide them protection. Other types of neighbouring rights, namely, audio-visual work and broadcasting work had

539 This idea is acknowledged and provided in the Berne Convention Article 6 *bis* (2).

540 In Thailand, it was once argued that, since moral rights were defined as 'personal' rights, moral rights should exist only when the author was still alive. D. Subhapholsiri, *Copyright* (Bangkok : Nititham Publishing, 1992) p.81.

541 The Copyright Act B.E.2537 Section 18.

542 Subhapholsiri, *Copyright* (1996). *op.cit.* p.157.

543 Comparing with the English Copyright, Designs & Patents Act 1988, Section 87(2).

544 TRIPs Article 14(1).

already been protected under copyright law in Thailand.⁵⁴⁵ The Copyright Act B.E.2537 retains provision for the protection of audio-visual work and broadcasting work as copyright work and recognizes the performer's rights as a neighbouring right. According to the copyright Act B.E.2537, 'performer' means a performer, musician, vocalist, choreographer, dancer, or a person who acts, sings, speaks, dubs a translation or narrates or gives commentary or performs in accordance with the script or performs in any other manner.⁵⁴⁶

The performer has exclusive rights to the following acts concerning his performance

1. sound and video broadcasting or communication to the public of the performance except the sound and video broadcasting or communication to the public from a recording material which has been recorded;
2. recording a performance which has not been recorded;
3. reproducing the recorded material of a performance which has been recorded without the consent of the performer or the recorded material of the performance with the consent of the performer but for another purpose or the recorded material of a performance which falls within the exceptions of the infringement of performer's rights. ⁵⁴⁷

Another new exclusive right provided in the Copyright Act B.E.2537 is the rental right. This right is provided in accord with TRIPs.⁵⁴⁸ It gives exclusive rights to the owner of the copyright to rent the original or copies of a computer program, an audio-visual work,

⁵⁴⁵ The Copyright Act B.E.2521, Section 4.

⁵⁴⁶ Section 4.

⁵⁴⁷ The Copyright Act B.E.2537 Section 44.

⁵⁴⁸ TRIPs Article 11.

a cinematographic work, and sound recordings,⁵⁴⁹ since the benefits of copyright owners are massively decreased when such rental rights are not protected.

The Copyright Committee was first set up by the Copyright Act B.E.2537. It comprises of the permanent secretary of the Ministry of Commerce as Chairman, and members, not exceeding twelve persons, appointed by the Cabinet in which not less than six persons are appointed from representatives of associations of the owners of copyright or performers' rights and representatives of associations of the users of copyright or performers' rights.⁵⁵⁰

In general, this Committee has authority to give advice or consultation to the Minister of Commerce,⁵⁵¹ and to decide appeals against orders of the Director General of the Department of Intellectual Property relating to the amount of remuneration stipulated by the Director General.⁵⁵² The establishment of the Committee, also the selection of members of the Committee, will ensure that right owners and performers will be appropriately protected. Through their representatives, they will have the chance to express their opinions and examine the authorities' decisions. This will make the process of decision making more transparent.

Remedial measures were revised to accommodate change and promote the increasing creation of work in literary and artistic domains and other relevant fields. It was indicated that the requirement of efficient measures for copyright protection was one of the major reasons for the proclamation of the Copyright Act B.E.2537.⁵⁵³

⁵⁴⁹ The Copyright Act B.E.2537 Section 15(3).

⁵⁵⁰ The Copyright Act B.E.2537 Section 56.

⁵⁵¹ The Copyright Act B.E.2537 Section 60 (1).

⁵⁵² The Copyright Act B.E.2537 Section 60 (2). See also Sections 45 and 55.

⁵⁵³ See Note of the Copyright Act B.E.2537.

Generally, by virtue of the law, any person is prohibited from reproducing, adapting, or communicating the copyright work to public, without the consent of the copyright owner.⁵⁵⁴ Consequently, the rental right was introduced to provide protection for owners of audio-visual work, cinematographic work, sound recordings,⁵⁵⁵ and computer programs.⁵⁵⁶ Furthermore, the law provides that any of the following acts which is committed without the permission of the right owner will be deemed as the infringing act

1. making an audio-visual work, a cinematographic work, a sound recording or a sound and video broadcasting work whether of the whole or in part;
2. rebroadcasting whether of the whole or in part;
3. making a sound and video broadcasting work to be heard or seen in public by charging money or another commercial benefit.⁵⁵⁷

In addition, any of the following acts will be deemed as the infringing acts if they are committed by any person who knows or should have known that a work is made by infringing the copyright of another person

1. selling, occupying for sale, offering for sale, letting, offering for lease, selling by hire purchase or offering for hire purchase;
2. communication to public;
3. distributing in the manner which may cause damage to the owner of copyright;
4. self-importation or importation by order into the country.⁵⁵⁸

⁵⁵⁴ The Copyright Act B.E.2537 Section 27.

⁵⁵⁵ The Copyright Act B.E.2537 Section 28.

⁵⁵⁶ The Copyright Act B.E.2537 Section 30.

⁵⁵⁷ The Copyright Act B.E.2537 Section 29.

⁵⁵⁸ The Copyright Act B.E.2537 Section 31.

Several remedial measures were provided for in the Copyright Act B.E.2537. According to this Act, the Court has the authority to order an infringer to compensate the owner of copyright or performer's rights for damages.⁵⁵⁹ The judge will consider the amount of damages by taking into account the seriousness of injury, the loss of benefits, and expenses necessary for the enforcement of the right of the owner of copyright or performer's rights. Previously, the Court had the authority to order damages for the owner by virtue of the general law provided in the Civil and Commercial Code,⁵⁶⁰ which is rather broad. To some extent, the new, more specific provision will be used as guidelines for the judge in considering the appropriate amount of damages to compensate the right holder.

A new development introduced in the Copyright Act B.E.2537 is provisional measures. The law states that

In case there is an explicit evidence that a person is doing or about to do any act which is an infringement of copyright or performer's rights, the owner of the copyright or performer's rights may seek the injunction from the Court to order the person to stop or refrain from such act.⁵⁶¹

This measure does not prejudice the owner's right to claim damages.⁵⁶² In order to relieve the injury, one half of the fine paid by the infringer will be paid to the owner of the

⁵⁵⁹ The Copyright Act B.E.2537 Section 64.

⁵⁶⁰ Section 420.

⁵⁶¹ The Copyright Act B.E.2537 Section 65 para.1.

⁵⁶² The Copyright Act B.E.2537 Section 65 para.2.

copyright or performer's rights.⁵⁶³ This does not prejudice the right to bring a civil action for damages.⁵⁶⁴

Additionally, the Court is authorized to forfeit the things used for committing the offence.⁵⁶⁵ Similarly, the Court is authorized to order that all things made or imported into the country which constitutes an infringement of copyright or performer's rights and the ownership of which are still vested upon the infringer will belong to the owner of such copyright or performer's rights.⁵⁶⁶ It is noteworthy that these measures are provided in Chapter 8 : Penalties of this Act. Apparently, they may be regarded as criminal measures. Therefore, it leads to an opinion that these measures should be strictly exercised subject to the criminal concept.

For the criminal sanctions, an infringer may be inflicted with either fines or imprisonment, or both. The law states that an infringer will be inflicted with a fine from 20,000 Baht (500 Pounds) up to 200,000 Baht (5,000 Pounds).⁵⁶⁷ If such infringement is committed with the commercial purpose, the punishment will be increased to a term from six months up to four years imprisonment, or a fine from 100,000 Baht (2,500 Pounds) up to 800,000 Baht (20,000 Pounds), or both.⁵⁶⁸ Moreover, a person who commits the so called 'secondary infringement' can be inflicted with a fine from 10,000 Baht (250 Pounds) up to 100,000 Baht (2,500 Pounds).⁵⁶⁹ Where there is a

⁵⁶³ The Copyright Act B.E.2537 Section 76.

⁵⁶⁴ *Ibid* .

⁵⁶⁵ The Copyright Act B.E.2537 Section 75.

⁵⁶⁶ *Ibid* .

⁵⁶⁷ The Copyright Act B.E.2537 Section 69 para.1.

⁵⁶⁸ The Copyright Act B.E.2537 Section 69 para.2.

⁵⁶⁹ The Copyright Act B.E.2537 Section 70 para.1.

commercial purpose, the infringer will be inflicted with imprisonment for a term from three months up to two years, or a fine from 50,000 Baht (1,250 Pounds) up to 400,000 Baht (10,000 Pounds), or both.⁵⁷⁰

By providing for severe punishment, it was hoped that copyright infringement would be deterred. The concept of a 'compoundable offence' was deleted. Furthermore, the penalties are increased for a persistent offender. The recidivist will be inflicted with double the prescribed penalty for the offence he has committed if within the previous five years he has previously been convicted under this Act.⁵⁷¹

4.3 PATENT LAW

It can be argued that the idea of protecting inventors has existed in the Thai legal system for a long time.⁵⁷² Since 1956, secrets concerning industry, discoveries, and scientific inventions have been acknowledged and protected under the Penal Code B.E.2499.⁵⁷³ According to this Penal Code, a person will be found guilty of the offence of disclosure of a private secret if he discloses or uses such a secret which he has known or acquired through his duties, profession, or calling of trust.⁵⁷⁴ It was not until 1979, however, that the patent law was enacted.

⁵⁷⁰ The Copyright Act B.E.2537 Section 70 para.2.

⁵⁷¹ The Copyright Act B.E.2537 Section 73.

⁵⁷² It was claimed that the patent law was first drafted in the English language in 1913. See Department of Intellectual Property, Annual Report (Bangkok : Asorn Thai Printing, 1996) p.1.

⁵⁷³ The Royal Gazette, Special Issue, Vol.73, No.95, November 15, 1956. p.1.

⁵⁷⁴ Section 324.

4.3.1 THE PATENT ACT B.E.2522

The Patent Act B.E.2522 was enacted primarily because it was deemed expedient to grant protection for inventions and industrial designs.⁵⁷⁵ It appears that this Act, to a certain extent, conforms to the standards of the Paris Convention,⁵⁷⁶ even though Thailand is not a member of this Convention. For instance, an invention is patentable only when it is new, involves an inventive step, and is capable of industrial application.⁵⁷⁷ A patent, however, could not be granted

- "1) for food, beverages, a pharmaceutical product or pharmaceutical ingredient;
- 2) for any machine particularly made for use in agriculture;
- 3) for any variety of animal or plant or any essential biological process for the production of animals or plants;
- 4) for a scientific or mathematical rule or theory;
- 5) for a computer program;
- 6) for an invention the exploitation or publication of which would be contrary to public order or morality, public health or welfare;
- 7) for any invention prescribed in a Royal Decree".⁵⁷⁸

At present, the Patent Act B.E.2522 is still in force. However, under pressure from developed countries, this Act was amended in 1992 by the Patent Act (No.2) B.E.2535.⁵⁷⁹ This amendment made several significant changes in patent matters. Generally, such changes were made to improve the Patent Act B.E.2522. In addition, the

⁵⁷⁵ The Royal Gazette, Vol.96, No.35. Special issue. March 16, 1979. p.1.

⁵⁷⁶ The Paris Convention for the Protection of Industrial Property 1883.

⁵⁷⁷ The Patent Act B.E.2522, Section 5.

⁵⁷⁸ The Patent Act B.E.2522, Section 9.

⁵⁷⁹ The Royal Gazette, Vol.109, No.34, April 3, 1992. p.1.

law was amended to ensure that the patent law complies with international standards, particularly to the requirements of TRIPs. For example, this amendment allows certain subject matters to be patented. In the past, several subject matters such as food, beverages, pharmaceutical products or pharmaceutical ingredients were not protected under the patent law.⁵⁸⁰ The Patent Act B.E.2522 now provides that

The following inventions are not protected under the Act

1. naturally existing microorganisms and their components, animals, plants or animals and plant extracts;
2. scientific or mathematical rules or theories;
3. computer programs;
4. methods of diagnosis, treatment and care of human and animal diseases;
5. inventions contrary to public order, morality, health or welfare.⁵⁸¹

Furthermore, the term of protection has also been changed from fifteen years to twenty years.⁵⁸² In addition, compulsory licensing has been amended. Generally, the patentee can license another person to use his rights,⁵⁸³ subject to restrictions under Sections 39 and 41.⁵⁸⁴ Likewise, the patentee may notify consent that his rights are to be made available to others in the Patent Register.⁵⁸⁵ Moreover, the patentee may have to

⁵⁸⁰ The Patent Act B.E.2522 Section 9 (before the amendment).

⁵⁸¹ The Patent Act B.E.2522 Section 9.

⁵⁸² The Patent Act B.E.2522 Section 35. See TRIPs Article 33.

⁵⁸³ The Patent Act B.E.2522 Section 38.

⁵⁸⁴ Section 39 states that, in granting a license under Section 38, (1) the patentee will not stipulate any condition, restriction or compensation which will have the effect of unfairly limiting competition; (2) the patentee may not require the licensee to pay compensation for use of the patented invention after the patent has expired under Section 35. Section 41 states that patent licenses and assignments under Section 38 will be in writing and registered with the competent officer in accordance with the rules, procedures and conditions prescribed in Ministerial Regulations.

⁵⁸⁵ The Patent Act B.E.2522 Section 45.

license other persons to use his rights involuntarily. The so called 'compulsory' license can be granted in two circumstances. The first relates to the patent *per se*. Any person may apply for a license, if it is found that, after the expiration of three years from the granting of a patent or four years from the date of application,

1. the patented product is not being produced or the patented process is not being used in the country without sufficient reason; and

2. without sufficient reason, the patented products are not being sold in the country, or are being sold at unreasonably high prices or in quantities insufficient to meet domestic demand.⁵⁸⁶

The second circumstance concerns patent claims. A person may apply for a license if

1. the working of any claims contained in his patent is likely to constitute an infringement of the patent claims of another persons,

2. the granting of such a license will not unreasonably affect the use of the patentee's rights,

3. the invention of this person is of great economic importance or meets domestic demand,

4. this person cannot work his patent economically unless he is licensed.⁵⁸⁷

Additionally, the patentee may be forced to license his rights by the State. The authorities are able to use any patents which relate to activities of public utility or one essential for national defence, or for the preservation or realization of national resources or the environment or for relief of a severe shortage of food or drugs or for other public

⁵⁸⁶ The Patent Act B.E.2522 Section 46.

⁵⁸⁷ The Patent Act B.E.2522 Section 47.

benefit.⁵⁸⁸ Moreover, the authorities have power to use any patents during a state of war or emergency.⁵⁸⁹

The most controversial issue in this amendment was the establishment of the Drug Patent Board. This Board is composed of the Under-Secretary of the Ministry of Commerce, Director-General of the Department of Intellectual Property, Secretary-General of the Food and Drug Commission, Director of the Office of the Consumer Protection Board, Director-General of the Internal Trade Department, and not more than six additional members of which at least three will be appointed from the private sector.⁵⁹⁰ Its responsibilities are

1. to follow and compare the price of drugs protected by patents with the price of unpatented drugs of the same category;

2. to take action in the event there is no sale of the patented drug or the drug is sold at an unreasonably high price or the price is increased in excess of the consumer price index without sufficient reason or without sufficient reason the supply of the drug is insufficient to meet domestic public demand;

3. to submit opinions to the Council of Ministers concerning policy in respect of drug patents and patents on processes for drugs and their ingredients as well as policy and measures to promote research and development of drugs and processes for drugs and their ingredients;

4. to consider and prescribe regulations concerning the subsidizing of research and development of drugs and processes for producing drugs and their ingredients. ⁵⁹¹

⁵⁸⁸ The Patent Act B.E.2522 Section 51.

⁵⁸⁹ The Patent Act B.E.2522 Section 52.

⁵⁹⁰ The Patent Act B.E.2522 Section 55 *ter*.

⁵⁹¹ The Patent Act B.E.2522 Section 55 *quater*.

In addition, this Board has the power to notify the Central Committee on Price Fixing and Monopoly Prevention to consider action under the law on price fixing and monopoly prevention,⁵⁹² and to notify the Director-General to consider action under Section 46 *bis*.⁵⁹³

It has been argued that the setting up of this Committee is, to a certain extent, against the principle of free trade in TRIPs.⁵⁹⁴ Thai industry representatives, arguably, have been appointed as members of the Drug Patent Board. This practice, therefore, may not conform with Article 31 (l) and (j) of TRIPs mandate for judicial review or review by a neutral body.⁵⁹⁵

Provisions relating to remedial measures have also been amended to protect the patentee's exclusive rights. In case of product patent, the exclusive rights are the right to produce, use, sell, possess for sale, offer for sale and import the patented product.⁵⁹⁶ Similarly, the exclusive rights for the process patent are defined as the rights to use the patented process, to produce, use, sell, possess for sale, offer for sale and import products made by the patented process.⁵⁹⁷

These exclusive rights, however, are not applied to

1. any act for the benefit of education, research, or experimentation;

⁵⁹² The Patent Act B.E.2522 Section 55 *quinque* (1).

⁵⁹³ The Patent Act B.E.2522 Section 55 *quinque* (2).

⁵⁹⁴ For more information, see J. Kuanpoj, "Analysis of the Draft Revision of the Patent Act : A Study of Principles under TRIPs and Paris Convention," *Thammasart Law Journal* 26(1996) pp.426-457.

⁵⁹⁵ Pharmaceutical Research and Manufacturers of America, *Industry Issues International* November 26, 1996. P.3.

This information is accessed via internet.

⁵⁹⁶ The Patent Act B.E.2522 Section 36 (1).

⁵⁹⁷ The Patent Act B.E.2522 Section 36 (2).

2. production of the patented product or use of the patented process where the producer or user, in good faith, has engaged in the production or has acquired the equipment therefore prior to the date of the patent application in Thailand, Section 19*bis* not being applicable hereto;

3. any act in respect of products acquired in good faith;

4. the compounding of drugs under a physician's prescription by a professional pharmacist or medical practitioner including acts in respect thereto;

5. any act in respect of applications for drug registration, the applicant intending to produce, sell or import the patented pharmaceutical when the patent expires.⁵⁹⁸

Apart from that, any act which is committed without the permission of the patentee will be regarded as the infringement, and the patentee is able to seek for remedies. Since the definition of the infringement is not specifically provided, the provision of tort in the Civil and Commercial Code should be applied.⁵⁹⁹ This, inevitably, leads to a practical controversy. Whereas the patentee has the exclusive rights, Section 420 of the Civil and Commercial Code states that

A person who, wilfully or negligently, unlawfully injures the life, body, health, liberty, property or any right of another person, is said to commit a wrongful act and is bound to make compensation therefor.

Therefore, it is unclear whether the patentee has to prove the intention of an infringer in order to constitute his claim. There has not been any Supreme Court precedent on this issue yet.

Other remedial measures, namely damages, provisional measures, orders of confiscation and destruction, were specifically provided when the Patent Act B.E.2522

⁵⁹⁸ The Patent Act B.E.2522 Section 36 para.2.

⁵⁹⁹ The Civil and Commercial Code Section 420.

was amended. Generally, they have been enacted with similar wording to that used in the Copyright Act B.E.2537, particularly damages,⁶⁰⁰ and provisional measures.⁶⁰¹ For the order of confiscation or destruction, the judge is authorized to order that goods in the possession of the infringer which infringe the patentee's rights could be dealt with by other measures to prevent further distribution of such goods.⁶⁰²

Moreover, the patentee could be protected through criminal sanctions. These measures have been available since 1979 and were amended by the revision in 1992. The punishments of fines and imprisonment have been retained. Nevertheless, it should be noted that the term of imprisonment was decreased from a maximum of three years to two years, while monetary fines were increased from an amount not exceeding 300,000 Baht (7,500 Pounds) to 400,000 Baht (10,000 Pounds).⁶⁰³

4.4 TRADE MARK LAW

In the past, Trade Marks played an insignificant role in Thai society. It might be because Thailand is an agricultural country and Thai people, to a certain extent, have never been regarded as merchants. Even though trade has been acknowledged in this country for over seven hundred years,⁶⁰⁴ the trade marks law was only enacted in the nineteenth century.

⁶⁰⁰ The Patent Act B.E.2522 Section 77 *ter*.

⁶⁰¹ The Patent Act B.E.2522 Section 77*bis*.

⁶⁰² The Patent Act B.E.2522 Section 77*quater*.

⁶⁰³ The Patent Act B.E.2522 Section 85.

⁶⁰⁴ Trading in Thailand was first recorded in the Stone Inscription. It is believed that such the Inscription was made during the period of King Ramkhamhaeng, the Great, of the Sukhothai Dynasty (1279-1300 A.D.).

Marks on goods, it is believed, were first known in Thailand only when foreigners came to trade with Thailand.⁶⁰⁵ It was in 1910 when trade rapidly increased that the Government established the Trade Mark Registration Office in the Ministry of Agriculture. This office was moved to the Ministry of Commerce and named the Department of Commercial Registration in 1923. During that period, the Law on Trade Marks and Trade Names B.E.2457 (1914 A.D.) was enacted.

4.4.1 THE TRADE MARK ACT B.E.2474

Subsequently, the Law on Trade Marks and Trade Names B.E.2457 was repealed by the Trade Mark Act B.E.2474 (1931 A.D.).⁶⁰⁶ The aims of this Act were to protect industry and business, and to strengthen trade activity in the country.⁶⁰⁷ This Act was claimed as modern law since it was modelled on the English Trade Marks laws,⁶⁰⁸ as regards for instance, conditions of registration of trade marks. Both Thai and English law required that a trade mark must consist of or contain at least one essential particular such as a name of an individual or firm; a written signature of an individual or firm; an invented word or invented words; a word or words having no reference to the character or quality of the goods, and not being a geographical name; etc.⁶⁰⁹

This Act did not provide any specific civil remedy. It merely provided criminal sanctions which did not exceed a 1,000 Baht (25 Pounds) fine,⁶¹⁰ and the forfeiture of

⁶⁰⁵ D. Subhapholsiri, Trade Mark Law (Bangkok : Nititham Publishing, 1993) p.2.

⁶⁰⁶ The Royal Gazette, October 1, 1931.

⁶⁰⁷ The Preamble of the Act.

⁶⁰⁸ C. Chutaratkul, "Trade Marks in Thailand," World Trade Mark Symposium (Geneva:1982) p.188.

⁶⁰⁹ See the Trade Marks Act B.E.2474 Section 4, and the Act to Amend the Patents, Designs, and Trade Marks Act, 1883. (c.50, 1888) Section 64.

⁶¹⁰ Section 45.

the goods.⁶¹¹ This provision was later amended in 1961 by the Amendment of the Trade Marks Act (Number 3) B.E.2504 to increase such punishment to imprisonment not exceeding one year or a fine not exceeding 10,000 Baht (250 Pounds) or both.⁶¹²

4.4.2 THE TRADE MARK ACT B.E.2534

The Trade Mark Act B.E.2474 was repealed in 1991 by the Trade Mark Act B.E.2534.⁶¹³ The new law came into force primarily to improve trade mark protection in Thailand; the Trade Mark Act B.E.2474 being obsolete and offering inadequate protection and remedial measures for right holders. This change also aims to extend protection to other types of marks such as service marks, and certificated marks.⁶¹⁴ The main reason for this extension is to provide protection for the owners of such marks. Moreover, this ensures that the Trade Mark Act B.E.2534 complies with the provisions in TRIPs.⁶¹⁵

One significant issue which is regarded as a new issue in trade mark law is the license process. Even though rights related to trade marks have been licensed for a long time, the process was based on the general concept of contracts as contained in the Civil and Commercial Code. Arguably, this situation is inappropriate. It seems that such general provisions are too broad to use with a specific and rather complicated contract such as the license contract. These marks, to some extent, represent and indicate the origin and the quality of goods and services. Subsequently, society may be

⁶¹¹ Section 45.

⁶¹² The Royal Gazette, Vol.78, No.80, October 3, 1961. p.1084.

⁶¹³ The Royal Gazette, Vol.108, No.199, Special Issue, November 15, 1991. p.7.

⁶¹⁴ The Trade Mark Act B.E.2534 Section 4.

⁶¹⁵ TRIPs Article 15.

confused about the origin of goods and the quality of goods and services if such marks are inappropriately licensed. As a result, it is argued, specific conditions are needed to control this type of contract.

The other important issue provided for in the Trade Mark Act B.E.2534 is remedial measures. It was complained that several provisions in the Trade Mark Act B.E.2474 were obsolete and could not protect trade mark owners appropriately.⁶¹⁶ As a result, remedial measures, in particular, had to be strengthened. Consequently, trade mark law in Thailand, it was expected, would be leveled to the international standard.

Nevertheless, remedial measures in this law, to some extent, are rather different from those measures provided in the other intellectual property laws. First, there is no specific provision for damages in this Act. Therefore, the provision of tort in the Civil and Commercial Code has been applied in trade mark cases. Seemingly, this may lead to a different result for trade mark cases, compared to copyright or patent cases. However, there is no indication that the trade mark owner will receive inadequate compensation. On the contrary, the trade mark owner may be compensated more appropriately than others because the judge can exercise his discretion flexibly under the general provision of tort.

Secondly, it should be noted that remedial measures are located in the criminal part of this Act. The Trade Mark Act B.E.2534 composes of six parts and the transition provision. Subject to the criminal concept of strict interpretation, remedial measures such as orders of confiscation,⁶¹⁷ and provisional measures,⁶¹⁸ may be enforced restrictively. This may lead to differences in the enforcement of such measures.

⁶¹⁶ See the Note of the Trade Mark Act B.E.2534.

⁶¹⁷ The Trade Mark Act B.E.2534 Section 115.

⁶¹⁸ The Trade Mark Act B.E.2534 Section 116.

compared to the copyright and patent laws, even though they are provided in the similar wordings with those provisions existing in the copyright and patent laws.

For the criminal sanctions, an infringer may be inflicted with either fines, or imprisonment, or both. Previously, the punishment was regarded as lenient, and consequently as an inadequate deterrent. Therefore, the punishment has been increased to provide a stronger deterrent effect.⁶¹⁹ For instance, fines have been raised from not exceeding 20,000 Baht (500 Pounds) to not exceeding 400,000 Baht (10,000 Pounds), whereas the terms of imprisonment have been raised from not exceeding one year to not exceeding four years. The penalties for recidivists will be doubled.⁶²⁰

4.5 INTERNATIONAL OBLIGATIONS

Up until now, Thailand has been obliged to protect other countries' intellectual property rights under three international agreements. They are the Berne Convention for the protection of Literary and Artistic Works, the Treaty of Amity and Economic Relations Between the Kingdom of Thailand and the United States of America 1966, and TRIPs.

The Berne Convention was the first international convention relating to intellectual property by which Thailand has abided. Thailand became a member of this Convention in 1931,⁶²¹ by acceding to the 1908 Berlin revision and the Berne Addition Protocol of 1914. Thailand is also a signatory to the administrative part of the Paris Act 1971. In 1995, Thailand declared its accession to the Paris Act 1971 for the substantive part and the Director General of the World Intellectual Property Organization later circulated the

⁶¹⁹ The Trade Mark Act B.E.2534 Sections 108 - 111.

⁶²⁰ The Trade Mark Act B.E.2534 Section 113.

⁶²¹ The Ministry of Foreign Affairs' Proclamation of Siam Becoming a Member of the Berne Convention for the Protection of Literary and Artistic Works 1886, July 31, 1931.

notification to other members.⁶²² As a member, Thailand, generally, has to protect works copyrighted by other members of the Berne Convention.

Thailand entered into a bilateral agreement with The United States of America, entitled "The Treaty of Amity and Economic Relations Between the Kingdom of Thailand and the United States of America", in 1966.⁶²³ This Treaty was signed in Bangkok on May 29, 1966 and ratified in Washington on May 8, 1968. It contained a provision for the reciprocal protection of the two countries' copyrights.

Article V (1) ...

(2) Nationals and companies of either Party shall have within the territories of the other Party the same right as nationals and companies of that other Party in regard to patents for inventions, trade marks, trade-names, designs and copyright in literary and artistic works, upon compliance with the applicable laws and regulations, if any.

Historically, this is not the first time that Thailand has entered into a bilateral agreement with the United States of America. Thailand and the United States of America have had trade relations for nearly two hundred years. This has culminated in bilateral agreements five times. The first agreement was reached in 1833.⁶²⁴ The second one

⁶²² The Berne Notification No.167. The Berne Convention for the Protection of Literary and Artistic Works. Declaration by the Kingdom of Thailand Extending the Effects of Its Accession to the Paris Act (1971) to Articles 1 to 21 and the Appendix and Notification Concerning Article II of the Appendix. June 2, 1995.

⁶²³ This Treaty is reprinted in The Department of Treaties and Laws, the Ministry of Foreign Affairs, Treaties and Bilateral Agreements Between the Kingdom of Thailand and Other Countries and International Organizations Vol.9 (Bangkok : Srideja, 1986) pp.25-57.

⁶²⁴ The Treaty of Amity Between the United States of America and the Kingdom of Siam B.E.2376. Reprinted in the Department of Treaties and Laws, the Ministry of Foreign Affairs, Treaties and Bilateral Agreements Between the Kingdom of Thailand and Other Countries and International Organizations Vol.1 (Bangkok : Srideja, 1969). pp.153-155.

was reached in 1856.⁶²⁵ The third and the fourth were reached in 1920 and 1937 respectively.⁶²⁶

The other agreement relating to intellectual property by which Thailand has abided is TRIPs. According to this Agreement, Thailand has to protect most types of intellectual property rights, such as copyright, patent, trade mark, geographical indication, etc., which are protected by other TRIPs members. Several domestic laws, such as the Protection of the Operations of the World Trade Organization Act B.E.2537 (1994 A.D.), were enacted in order to ensure that Thailand would comply with its obligation.

The foregoing study of the historical background to Thai intellectual property law is very crucial. It reveals many significant facts such as that intellectual property laws in Thailand have been in force for a long time. Furthermore, these laws have been improved, from time to time, to raise the standard of protection to meet the requirements of various international agreements, particularly TRIPs. Accordingly, it is believed that, by the year 2000, Thailand will comply with all its obligations under TRIPs.

However, the study also shows the other side of this issue. Apparently, many countries were not satisfied with the level of protection of intellectual property in Thailand. The owners of intellectual property, they argued, were protected inappropriately. As a result, Thailand has been forced to strengthen its protective

⁶²⁵ The Treaty of Amity Between the United States of America and the Kingdom of Siam B.E.2399. Reprinted in the Department of Treaties and Laws, the Ministry of Foreign Affairs, Treaties and Bilateral Agreements Between the Kingdom of Thailand and Other Countries and International Organizations Vol.1 (Bangkok : Srideja, 1969). pp.47-55.

⁶²⁶ The Treaty of Amity Between the United States of America and the Kingdom of Siam B.E.2463. Reprinted in the Department of Treaties and Laws, the Ministry of Foreign Affairs, Treaties and Bilateral Agreements Between the Kingdom of Thailand and Other Countries and International Organizations Vol.3 (Bangkok : Srideja, 1969). pp.1-14, and the Treaty of Amity Between the United States of America and the Kingdom of Siam B.E.2480. Reprinted in the Department of Treaties and Laws, the Ministry of Foreign Affairs, Treaties and Bilateral Agreements Between the Kingdom of Thailand and Other Countries and International Organizations Vol.5 (Bangkok : Srideja, 1975). pp.1-23.

measures several times. Not surprisingly, Thai society disagreed with this analysis and regarded it as interference from other countries.

It could be argued that Thai society does not support the government in strengthening intellectual property law primarily because of a lack of knowledge about this issue. Seemingly, there are several facts that contribute to Thai society's lack of knowledge in this area. One of the major factors, arguably, is because the law is not clear. It appears that the society does not clearly understand even the purposes of the intellectual property rights protection measures.

For example, the main reason for Thailand to comply with such international obligations is to strengthen and extend the protection of the intellectual property rights to owners under other countries' laws. In addition, Thailand expects that the country, as a whole, will benefit from technology transfer, knowledge from modern inventions, and foreign investment.⁶²⁷ This will strengthen the Thai economy and, subsequently, raise the Thai standard of living and income.

However, it seems that many in Thai society do not agree with this idea. They argue that Thailand has complied with these international obligations primarily due to other reasons, not for public or private benefit. For example, it could be argued that, from history, Thailand acceded to the Berne Convention because of two significant reasons. First, it was because Thailand was forced to comply with by the bilateral agreement. There was evidence, in the Treaty of Amity between France and the Kingdom of Thailand B.E.2467, that Thailand agreed to provide domestic laws in accordance with the Berne Convention.⁶²⁸ Second, it was to demonstrate that Thai laws were as modern

⁶²⁷ See Y. Puongraj, "Arguments on Amending Intellectual Property Law : Who Gains, Who Loses," Tax Bulletin 12 (1993) PP.86-91.

⁶²⁸ Section 24 of the Treaty of Amity between France and the Kingdom of Thailand B.E.2467, February 14, 1924.

as other civilized countries' laws. This was a crucial reason since many countries, at that time, complained that Thai law was cruel and obsolete.⁶²⁹ As a result, they did not allow their citizens and subjects to be tried in Thai courts.⁶³⁰ This situation caused a lot of trouble, and Thailand was afraid that such a situation would subsequently undermine its sovereignty. Accordingly, several Thai laws were hurriedly revised and were enacted in order to acquire international acceptance.⁶³¹ These additional reasons seem to be more significant than the desires to strengthen copyright protection within the country.

Likewise, it seems that Thailand did not really intend to provide protection for American intellectual property rights. Such a protection clause was provided in the Treaty merely because it was modelled from other Treaties.⁶³² This clause was first contained in Article 12 of the Treaty of Amity Between the Kingdom of Siam and the United States of America B.E.2463,⁶³³ the third bilateral agreement between these countries. Article 12 of the Treaty stated that

The subjects or citizens of each of the High Contracting Parties shall enjoy in the territories and possessions of the other, upon fulfilment of the formalities prescribed by

⁶²⁹ See V. Mahakhun, History of Thai Law (Bangkok : Chulalongkorn University Printing, 1980) p.40.

⁶³⁰ For example, see Sections 2,3,5, and 9 of the Treaty of Amity Between the United States of America and the Kingdom of Siam B.E.2399. Reprinted in the Department of Treaties and Laws, the Ministry of Foreign Affairs, Treaties and Bilateral Agreements Between the Kingdom of Thailand and Other Countries and International Organizations Vol.1. *op cit.* pp.47-55.

⁶³¹ See P. Duke, Foreign Affairs and Thai Independence and Sovereignty (From King Rama IV until the end of the period of Marshall P.Pibulsongkram) (Bangkok : Chao Phraya Printing, 1984).

⁶³² For this argument, see P. Premssmit, Scope of Protection of Literary and Artistic Work Under Thai Law : A Case Study of Thai - US Copyright Law Issue Before the US Became Member to the Berne Convention (LL.M. Thesis, Chulalongkorn University, 1990) pp.78-79.

⁶³³ It is reprinted in the Department of Treaties and Laws, the Ministry of Foreign Affairs, Treaties and Bilateral Agreements Between the Kingdom of Thailand and Other Countries and International Organizations Vol.3 *op.cit.* pp.1-14.

law, the same protection as native subjects or citizens, or the subjects or citizens of the nation most favoured in these respects, in regard to patents, trade marks, trade names, designs, and copyright.

It is believed that this provision was modelled from Article 16 of the Treaty of Commerce and Navigation Between the United States of America and Japan 1894.⁶³⁴ Consequently, the protection of intellectual property remained in the bilateral agreement between the United States of America and Thailand. It was adapted by deleting the clauses of 'most favoured nation', 'subjects', and 'the formalities prescribed by law'.⁶³⁵

In addition, it could be argued that the main reason for Thailand acceding to TRIPs was trade. At present, Thailand has to rely on international trade and, as a result, has to follow the rules of international trade. TRIPs is known as one of the packages by which developing countries, such as Thailand, have to abide.

The fact that Thailand has not yet decided to accede to other conventions or agreements relating to intellectual property seems to support the opinion that intellectual property rights protection is not a main concern for Thailand. Apparently, it could be explained that there was no significant factor to stimulate Thailand to accede to the other conventions such as the international patent agreement. First, Thailand, like other developing countries, has felt that several measures under the Paris Convention for the

⁶³⁴ This Treaty was signed at Washington D.C. on November 22, 1894, ratification exchanged at Washington D.C. on March 21, 1895. Article XVI provided that "The citizens and subjects of each of the High Contracting Parties shall enjoy in the territories of the other the same protection as native citizens or subjects in regard to patents, trade-marks, and designs, upon fulfilment of the formalities prescribed by law".

⁶³⁵ See Article 5(2) of the Treaty of Amity Between the Kingdom of Thailand and the United States of America B.E.2509.

Protection of Industrial Property, for instance, do not respond well to its need.⁶³⁶ Up until now, Thailand has not acceded to the Paris Convention for the Protection of Industrial Property, and has consistently insisted on not becoming a member of this Convention.⁶³⁷ Second, even though Thailand has not acceded to the Paris Convention, the Patent Act B.E.2522 was drawn up following the international criteria in several areas, *inter alia*, the right of priority,⁶³⁸ etc. As a result, Thailand had never been criticized for its patent laws until the last decade.⁶³⁹

The wording of law is also ambiguous, and inevitably leads to dispute when any provisions have been interpreted. Recently, there were serious arguments, for instance, as to whether copyright work which is already protected under other countries' laws would be protected under Thai law, and by which conventions such work would be protected.

According to the Copyright Act B.E.2521, works copyrighted under other countries' laws would be protected if

(1) the work is copyrighted under the laws of a country which is a member of a convention on copyright protection of which Thailand is also a member, and if under the laws of such other country, reciprocal protection is provided for works copyrighted under the laws of other member countries.

⁶³⁶ See H. P. Kunz - Hallstein, "The Revision of the International System of Patent Protection in the Interest of the Developing Countries," *IIC* 10 (1979) p.649. Also C. Chutaratkul, "Patent Administration in Thailand," *Nitisart Journal* 13 (1983) p.71.

⁶³⁷ See B. Uwanno, "The Report on the Research of Intellectual Property Rights," *Chulalongkorn Law Journal* 15 (1994) p.59.

⁶³⁸ The Patent Act B.E.2522 Section 6.

⁶³⁹ Mesevage. *op.cit.* p.448.

(2) the work is copyrighted under the laws of an international organization of which Thailand is a member.⁶⁴⁰

This Act, nevertheless, did not specify the categories of works which would be protected, nor provide the degree of protection that would be given to such works. This Act provided only that these works would be protected subject to conditions prescribed in a Royal Decree.⁶⁴¹ Unfortunately, a Royal Decree for this issue was not enacted for decades until the United States of America claimed that Thailand had an obligation to protect American copyrights.

Regarding the question whether Thai law provides protection for works copyrighted under other countries' laws or not, there were two opinions. One was that such works were already protected, despite the absence of a Royal Decree, if the general requirement of Section 42 of the Copyright Act B.E.2521 had been satisfied. The Royal Decree merely provided the conditions to restrict the protection for works copyrighted under other countries' laws. The other opinion was that the conditions for protecting such works must be contained in the Royal Decree. This opinion was based on the fact that works copyrighted under other countries' laws were directly protected under the Literary and Artistic Work Protection Act B.E.2474, whereas the Copyright Act B.E.2521 provided that such works were protected subject to the conditions in the Royal Decree.⁶⁴² Therefore, such works were not automatically protected unless the Royal Decree was enacted and provided the conditions for such protection.⁶⁴³

⁶⁴⁰ Section 42.

⁶⁴¹ *Ibid.*

⁶⁴² S. Hunpayon, "Copyright Law and the Video Trade," Chulalongkorn Law Journal 1(1984) p.198.

⁶⁴³ J. Pakdithanakul, "International Copyright," Nitisart Journal 4(1983) p.47.

There was no solution for this dispute even though the former opinion seemed to be more plausible than the latter. Later, the Government decided to enact the Royal Decree Prescribing Conditions for the Protection of International Copyright B.E.2526 (1983 A.D.) to settle this dispute.⁶⁴⁴ This Royal Decree contained six sections. It provided definitions in Section 3, described the conditions under which international copyright would be protected in Section 4, and provided the degree of protection to be given to the international copyright in Section 5.

This Royal Decree raised another conflict of intellectual property rights protection. The word 'Convention' in Section 3 of the Royal Decree referred to the Berne Convention for the Protection of Literary and Artistic Works 1886, revised by the 1908 Berlin revision and the protocol which was completed and signed at Berne in 1914. It was clear that this definition excluded the Universal Copyright Convention.⁶⁴⁵ However, this definition led to the argument that Thailand was bound only to protect the copyright of member countries of the Berne Convention which acceded to the Berlin Act 1908 and the Berne Additional Protocol of 1914, not all member countries.⁶⁴⁶ This opinion was apparently supported by several judgments of the Supreme Court. Some of these judgments, particularly regarding protection for copyright owners in Hong Kong, indicated that such copyright was protected since the United Kingdom, including Hong Kong, adhered to the Berne Convention of the 1908, Berlin Revision in 1912, and the Berne Additional Protocol of 1914 in 1915.⁶⁴⁷

⁶⁴⁴ The Royal Gazette, Vol.100, No.15, Special Issue, February 9, 1983, p.10.

⁶⁴⁵ K. Ruechai, "The Enforcement of Foreign Copyright in Thailand," *Chulalongkorn Law Journal* 9(1984) p.7.

⁶⁴⁶ P. Deepadung, "The Principle of National Treatment and International Copyright," in *Intellectual Property Law* (Bangkok : Rung-Rueng Printing, 1989) p.365. See also Ratanakorn. *op.cit.* p.301. Pakditanakul. *International Copyright. op.cit.* p.52.

⁶⁴⁷ For example, the Supreme Court's judgments no.3895/2535, 1302/2537.

Nevertheless, this concept was strongly opposed as it is against both the law of treaties and the concept of international copyright.⁶⁴⁸ According to this concept, each Act under the Berne Convention may be regarded as independent and can be totally separated from other Acts. As a result, relationship between members (of the Berne Convention) bases upon the Act, not on the Berne Convention *per se*. This concept seems to contrast with the principle of the Berne Convention of 'the universal nature of the convention'.⁶⁴⁹ In other words, the Berne Convention indicates that every member has rights and obligations *vis-a-vis* every other member, whether or not bound by the same Act.⁶⁵⁰ Furthermore, the Berne Convention indicates that

"... but the creation of a single Union, based on the principle of the assimilation of foreigner to national, with certain minimum standards of protection, and capable, by means of revision, of meeting world change, allows recently joined countries to have international relationships with all the Union countries including those not yet bound by the most recently revised text of the Convention."⁶⁵¹

Furthermore, judgments of the Supreme Court did not explicitly insist that only member countries of the Berne Convention which acceded to the Berlin Act 1908 and the Berne Additional Protocol of 1914 would be protected. Therefore, they should not be regarded as precedents in this issue. Later, the 2526 Decree was repealed by the Royal Decree Prescribing Conditions for the Protection of International Copyright B.E.2536.⁶⁵² The latter solved this confusion by merely referring to members of the Berne

⁶⁴⁸ Subhapholsiri. Copyright (1992). *op.cit.* p.148. Also K. Ruechai, "Hong Kong Copyright," *Chulalongkorn Law Journal* 10(1985) p.85.

⁶⁴⁹ WIPO. *Guide to Berne Convention* (Geneva : WIPO 1978) p.9.

⁶⁵⁰ WIPO. *op.cit.* p.135.

⁶⁵¹ WIPO. *op.cit.* p.9.

⁶⁵² The Royal Gazette, Vol.110, No.147, Special Issue, September 27, 1993, pp.1-4.

Convention.⁶⁵³ This Decree also provided a list of ninety-five members of the Berne Convention in the Appendix. Subsequently, ten more members were added to the list by the Royal Decree Prescribing Conditions for the Protection of International Copyright (No.2) B.E.2537.⁶⁵⁴

As regards the question of protection for American intellectual property rights, it was argued that, even though this issue is provided in the American-Thai Treaty, such provision was codified in neither the Copyright Act B.E.2521 nor the Royal Decree Prescribing Conditions for the Protection of International Copyright B.E.2526.⁶⁵⁵ Therefore, this caused doubt as to whether Thailand would actually protect American copyrights in Thailand to the extent provided for by the Treaty.⁶⁵⁶ It seems that protection for copyright work which was protected under other countries' law had been denied for a long time before Thai law was made clear.

If the ambiguities and uncertainties in the law persist as it has been, it will effect the society's attitude as inevitable, and, subsequently, leads to the strong opposition to the protective scheme for intellectual property rights. In other words, there will be a loophole and it will allow the law to be challenged and freely interpreted, no matter how clear wordings of the law are, unless it is known clearly that Thailand intends to comply with

⁶⁵³ Section 4.

⁶⁵⁴ The Royal Gazette, Vol.111, No.50a, November 9, 1994, pp.51-52.

⁶⁵⁵ Ruechai. The Enforcement of Foreign Copyright in Thailand. *op.cit.* p.9.

⁶⁵⁶ See K. Prokati, "Copyright Protection in Thai Law," Nitisart Journal 13(1983) p.23. In practice, American copyright holders were able to achieve copyright protection, even before the United States of America became a member of the Berne Convention, by publishing first or simultaneously their works in a Berne member country such as Canada. This process was normally called the "back-door to Berne". American authors can also achieve protection through "the side-door", in other words, the national treatment provisions of the Universal Copyright Convention, of which the United States of America is a member, ensures Berne protection in all countries that are joint Berne - UCC signatories. See R. P. Benko, Protecting Intellectual Property Rights (Washington : American Enterprise Institute, 1987) p.6.

international rules and provides full protection to intellectual property rights. It is, therefore, important to find out why society lacks such knowledge. This will be helpful in solving the problem.

4.6 THE ATTITUDE OF THAI SOCIETY ON INTELLECTUAL PROPERTY LAW

From history, it can be argued that intellectual property law was introduced on the 'top down' basis. It was drafted and enacted in the way and when the government felt appropriate, whereas society, at that time, did not know even what it was. In other words, the society did not know about such the law, or need to learn about it. As a result, improve a knowledge relating to intellectual property is essential and must be disseminated in the appropriate way. If not, the society will not understand and will not pay attention to this issue.

This 'top down' approach is in opposition to the other approach of 'bottom up' basis. In this case, such knowledge has already existed and implemented in society. Subsequently, the law concerning this issue has been enforced merely as scope or guidelines for the society.

It is not the first time that the 'top down' approach has been practiced in Thailand, the conflict over the concept of democracy being one example. It is argued that the democratic system was introduced to Thai society by a group of persons called *Kana Ratsadorn* (The Group of People).⁶⁵⁷ Most of them were educated from western countries. From their point of view, they believed that Thailand would develop and Thai people would have better lives by changing from absolute monarchy to the democratic

⁶⁵⁷ S. Premjit, Thai History in the Democratic System (Bangkok : Fuengnakorn, 1962) p.221.

system.⁶⁵⁸ Unfortunately, society did not fully support the democratic system. Seemingly, the society did not realize the extent of this system properly primarily because society lacked knowledge relating to this system.⁶⁵⁹ As a result, even though the democratic system is regarded as the proper system, Thai society apparently lacks interest, and consequently, does not support it as it should do.

Intellectual property laws were introduced to Thai society in a similar way. They were introduced when the society *per se* did not really need them. In other words, the majority of Thai people remained the users of such rights, rather than the owners as such. Therefore, the society did not regard these rights as their private rights or their own property. Consequently, they did not pay much attention to the issue. Even today, they are still confused between copyright and patent.⁶⁶⁰ This seems to be the reason why the society does not feel that such rights should be seriously protected.⁶⁶¹

It is not surprising that these people oppose the protection scheme for intellectual property rights. They feel that they will not benefit from complying with these obligations. Some of them explicitly oppose these obligations because they believe that

⁶⁵⁸ K. Pongpanich K, The Revolution in B.E.2475 (Bangkok : Prae Pithya, 1971) pp.94-106.

⁶⁵⁹ K. Tongdhamchart, "The 1932 Revolution and the Age of Democratic Government," Chulalongkorn Law Journal Special Issue, (1980) p.229.

⁶⁶⁰ Since the word '*Likkasit*' (copyright) is a created word, many people do not understand clearly what it means. They misunderstand that this word means intellectual property right, and mix this word up with rights, intellectual property, and patent. See Copyright Law Matichon Newspapers April 4, 1995, p.31; K. Boonyakiat, "Intellectual Property Copyright," Bangkok Business Newspapers March 26, 1995, p.6. Also the advertisement in the Thai Daily News, (Sunday) March 29, 1998, p.16. This problem may occur in other countries too. In England, for instance, it is reported that almost a third of companies think their investors 'understand little' or 'not at all' the nature of their intellectual property rights. See E. Fennell, "Our Bodies Patently Lack Protection," The Times (Tuesday) December 15, 1998. P.37.

⁶⁶¹ It has been argued that royalties should not be granted when music has been played on the radio, or even in the public. Playing the music in these circumstances, to some extent, helps promoting artists. See Intellectual Property Law "Unclear" Siam Post Newspapers March 27, 1995, pp. 10,26.

their current benefits will decline soon after Thailand has provided strong protection for the owners of intellectual property rights. For example, they feel that providing strong protection to certain products, such as pharmaceutical products, will bar them from gaining a higher standard of living.⁶⁶² In other words, their quality of life will be undermined because they will not be able to afford such expensive products.⁶⁶³

Additionally, some Thai people are against intellectual property law since they feel that Thailand has been forced by the United States of America to improve its intellectual property law. It was argued by the United States of America that their citizens were not adequately and properly protected under Thai law. As a result, the United States of America decided to use Section 301 to force Thailand to provide adequate and proper protection for American intellectual property.

This impression is not good for Thai society as a whole. It is hard to deny that Thai goods have been exported primarily to the United States of America.⁶⁶⁴ In other words, Thai economic progress has to rely on the American market. Therefore, Thailand cannot ignore the American complaint.⁶⁶⁵ Despite its intention to solve the problem in the international stage, Thailand has had to revise its intellectual property laws to accord with the American requirement.

Furthermore, the situation that Thai people are still against intellectual property law will become a real obstacle to law enforcement and intellectual property rights protection in the country. This situation is very significant for Thailand since it has to

⁶⁶² See "Strong Opposition to the Patent Bill," *IP Asia* November 28, 1991. p.25.

⁶⁶³ See Y. Pattanawong, *General Information on Pharmaceutical Patent* (An academic report, the Ministry of Health, July, 1996) P.49. Also Uwanoo. *op.cit.* p.62.

⁶⁶⁴ The United States of America has been the largest export market for Thai goods since 1980s. See *Far Eastern Economic Review* July 25, 1985. p.56.

⁶⁶⁵ S. Sawetsila, *Bangkok Post* May 30, 1987. p.1.

report law enforcement and rights protection to the Council for TRIPs.⁶⁶⁶ According to the Review mechanism, the Council for TRIPs will review the implementation of TRIPs. If the Council for TRIPs is dissatisfied with the report, Thailand might be forced to revise its laws to comply with TRIPs, or even face trade sanctions.

4.7 THE CHANGE OF INTELLECTUAL PROPERTY RIGHTS PROTECTION

Thailand is aware of these significant obligations. Recently, a committee was set up to examine its law and the intellectual property system in order to ensure that, by the year 2000, Thailand will comply with its obligations under TRIPs. Subsequently, a sub-committee has been set up to undertake this task; the Sub-Committee to scrutinize the intellectual property obligations of Thailand under the Final Acts of the Uruguay Round.⁶⁶⁷ The main duties of this Sub-Committee are to scrutinize Thai obligations relating to intellectual property under the Final Acts of the Uruguay Round, to scrutinize the necessity in Thailand of revising the law and the intellectual property system in accordance with its obligations, and to report its suggestion to the Committee and the Government.⁶⁶⁸

Accordingly, several sub-committees have been appointed to examine specific issues. they are the Sub-Committee for the Patent Issue,⁶⁶⁹ the Sub-Committee for the

⁶⁶⁶ TRIPs Article 71.

⁶⁶⁷ The Order of the Permanent Secretary under the Minister of Commerce to Appoint the Sub-Committee, No.1/2537, January 10, 1994.

⁶⁶⁸ *Ibid.*

⁶⁶⁹ The Order of the Permanent Secretary under the Minister of Commerce to Appoint the Sub-Committee, No.2/2537, June 9, 1994.

Trade Marks and Geographical Indications Issue,⁶⁷⁰ the Sub-Committee for the Undisclosed Information Issue,⁶⁷¹ the Sub-Committee for the Copyright and Neighbouring Rights Issue,⁶⁷² the Sub-Committee for the Integrated Circuits Issue,⁶⁷³ the Sub-Committee for the Law Enforcement Issue,⁶⁷⁴ and the Sub-Committee for the Border Measures Issue.⁶⁷⁵

The first special Sub-Committee has power to examine the patent issues. It has considered TRIPs provisions relating to patent and Thai law, namely the Patent Act B.E.2522. Consequently, the result has been reported that, generally, Thai law has already conformed to TRIPs.⁶⁷⁶ Nevertheless, there are a few issues in TRIPs which have not been implemented yet.

The first concerns the principle of national treatment. From the report, Sections 14, 19 *bis*, and 60 *bis* of the patent Act B.E.2522 should be amended to extend the protection to nationals of TRIPs members,⁶⁷⁷ and legal persons who are domiciled or have a real

⁶⁷⁰ The Order of the Permanent Secretary under the Minister of Commerce to Appoint the Sub-Committee, No.3/2537, June 9, 1994.

⁶⁷¹ The Order of the Permanent Secretary under the Minister of Commerce to Appoint the Sub-Committee, No.4/2537, June 9, 1994.

⁶⁷² The Order of the Permanent Secretary under the Minister of Commerce to Appoint the Sub-Committee, No.5/2537, June 9, 1994.

⁶⁷³ The Order of the Permanent Secretary under the Minister of Commerce to Appoint the Sub-Committee, No.6/2537, June 9, 1994.

⁶⁷⁴ The Order of the Permanent Secretary under the Minister of Commerce to Appoint the Sub-Committee, No.7/2537, June 9, 1994.

⁶⁷⁵ The Order of the Permanent Secretary under the Minister of Commerce to Appoint the Sub-Committee, No.8/2537, June 9, 1994.

⁶⁷⁶ The Final Report of the Sub-Committee for the Patent Issue, Ministry of Commerce 0705/672, October 14, 1994, p.3.

⁶⁷⁷ See TRIPs Article 3 (1).

and effective industrial or commercial establishment in a separate customs territory Member of the World Trade Organization.⁶⁷⁸ Secondly, the provisions concerning restrictions of the exclusive rights should be amended. They should be revised,⁶⁷⁹ abolished,⁶⁸⁰ and added to,⁶⁸¹ to accord with TRIPs Article 30 and the Paris Convention Article 5 *ter*. Thirdly, the provision of compulsory licensing should also be reformed.⁶⁸² Compulsory licensing should be granted to prevent the abuses which might result from the exercise of the exclusive rights conferred by the patentee.⁶⁸³ Fourthly, Section 47 of the Patent Act B.E.2522 which refers to the exploitation of other patents should be revised to conform to TRIPs Article 31 (I). Accordingly, the wording which relates to Section 47 and is also provided in Section 49 should be deleted.⁶⁸⁴ Furthermore, the process of judicial review or other independent review, also the condition that importation will not entail forfeiture of the patent, should be added to Section 52,⁶⁸⁵ and Section 55 of the Patent Act B.E.2522 respectively.⁶⁸⁶ In addition, there is an apprehension about the provisions relating to the Drug Patent Board.⁶⁸⁷ It

⁶⁷⁸ See TRIPs footnote 1.

⁶⁷⁹ The Patent Act B.E.2522 Section 36 (2).

⁶⁸⁰ The Patent Act B.E.2522 Section 36 (4), (5).

⁶⁸¹ At present, there is no provision concerning patented devices forming part of vessels, aircraft, or land vehicles in Thai patent law.

⁶⁸² The Patent Act B.E.2522 Sections 46 and 46 *bis*.

⁶⁸³ See the Paris Convention 5 A (2).

⁶⁸⁴ Sections 49-52 of the Patent Act B.E.2522 are provided in Part V 'the Exercise of Patent Rights'. Section 49 is about compulsory licensing procedure and how to apply for a compulsory license. Some details of these issues have already been amended and provided in Section 47. Such parts of Section 49, therefore, are redundant and, according to the Sub-Committee, should be deleted.

⁶⁸⁵ See TRIPs Article 31 (i).

⁶⁸⁶ See the Paris Convention 5 A (1).

⁶⁸⁷ The Patent Act B.E.2522 Sections 55 *bis* to 55 *septo*.

seems that these provisions are inconsistent with TRIPs.⁶⁸⁸ As a result, the Sub-Committee suggested that these provisions should also be deleted.

In the Sub-Committee's report, there is also an opinion that the wording of the Patent Act B.E.2522 Section 36 (3) is so ambiguous that, subject to the interpretation, it may or may not conform to TRIPs.⁶⁸⁹ Additionally, the Sub-Committee suggested that the protection of plant varieties should be provided in the form of *sui generis* law, not in the patent law.⁶⁹⁰

The second sub-committee was appointed to scrutinize the issues of trade marks and geographical indications. It has considered these issues through several statutes, *inter alia*, the Penal Code, the Civil and Commercial Code, the Consumer's Protection Act B.E.2522, and the Trade Mark Act B.E.2534. Subsequently, the Sub-Committee concluded that there are some issues on which Thai law does not conform to TRIPs.⁶⁹¹ One of them is about the period to renew trade mark's registration. Section 56 of the Trade Mark Act B.E.2534 stipulates that a proprietor of a trade mark has to renew a registration within ninety days before the expiration of the registration, whereas the Paris Convention Article 5 *bis* allows a grace period of not less than six months for the maintenance of rights. The others concern the measures to protect geographical indications for which have not been yet provided in Thai law. First is a requirement of the legal means to prevent any use which constitutes an act of unfair competition.⁶⁹²

⁶⁸⁸ It has been argued that the owners of pharmaceutical products will be discriminated by such provisions.

⁶⁸⁹ Section 36 (3) provides that "any act in respect of products acquired in good faith".

⁶⁹⁰ The Final Report of the Sub-Committee for the Patent Issue, Ministry of Commerce 0705/672, October 14, 1994, p.6.

⁶⁹¹ The Final Report of the Sub-Committee for the Trade Marks and Geographical Indications Issue, October 19, 1994, pp.2-3.

⁶⁹² TRIPs Article 22 (2)(b).

Secondly, the protection should be applicable against a geographical indication which falsely represents that the goods originate in another territory, notwithstanding such the geographical indication is literally true.⁶⁹³ Accordingly, geographical indications for wines and spirits have not been protected yet in Thai law.⁶⁹⁴

The Sub-Committee for Undisclosed Information Issue has to consider the way to implement TRIPs Article 39.⁶⁹⁵ The study has been undertaken by considering the related laws, *inter alia*, the Civil and Commercial Code, the Penal Code, the Trade Mark Act B.E.2534, the Patent Act B.E.2522, and the Draft Copyright Act B.E..... (at that time). The study showed that the protection for such the information is apparently insufficient under Thai law.⁶⁹⁶ Subsequently, the Sub-Committee suggested that *sui generis* law should be enacted in order to provide adequate and sufficient protection for this information.⁶⁹⁷ Two significant factors should be concerned when drafting the new law, namely, the promotion of international transfer of technology,⁶⁹⁸ and the national interest.⁶⁹⁹

Accordingly, the report of the Sub-Committee for the Copyright and Related Rights Issue has been published.⁷⁰⁰ From the study, it has been found that, in general, Thai law is already in conformity with the provisions of TRIPs relating to copyright and related

⁶⁹³ TRIPs Article 22 (4).

⁶⁹⁴ See TRIPs Article 23.

⁶⁹⁵ This Article provides for protection of undisclosed information.

⁶⁹⁶ The Final Report of the Sub-Committee for the Undisclosed Information Issue, No.3.1.

⁶⁹⁷ The Final Report of the Sub-Committee for the Undisclosed Information Issue, No.3.1.

⁶⁹⁸ See TRIPs Articles 7-8.

⁶⁹⁹ The Final Report of the Sub-Committee for the Undisclosed Information Issue. *op.cit.* No.1 para.6.

⁷⁰⁰ The Final Report of the Sub-Committee for Copyright and Related Rights Issue, Ministry of Commerce 0706/745, September 9, 1994.

rights. Nevertheless, the Sub-Committee has made a few remarks on this issue. First, it should be noted that the restrictions of copyright provided in Section 32 of the Copyright Act B.E.2537 are broader than those provided in TRIPs.⁷⁰¹ Secondly, they addressed the special provisions of TRIPs regarding developing countries. Limitations on the right of translation which are provided in Sections 54-55 of the Copyright Act B.E.2537 primarily state that the exclusive right of translation will be constituted if the work has not been translated into Thai language after three years. With regard to the Berne Convention, the period should be shortened to one year since the Thai language is not in general use in one or more developed countries which are members of the Berne Convention.⁷⁰² Finally, subject to the interpretation of the Copyright Act B.E.2537 Section 61, it is unclear whether the protection will cover copyright and performer's rights of TRIPs members who are not yet parties to the Berne Convention and the Rome Convention.⁷⁰³

The protection of layout designs of integrated circuits has also been scrutinized. The Sub-Committee has made its suggestion that it is inappropriate to protect this intellectual property under either the patent law or the copyright law. Layout designs of integrated circuits should be protected under the *sui generis* law.⁷⁰⁴ Additionally, the definition and scope of protection, the ability of Thai people, the effect on an industrial sector,

⁷⁰¹ *Ibid.* No.3.1.

⁷⁰² See the Berne Convention, Appendix, Article II (3)(a).

⁷⁰³ The Final Report of the Sub-Committee for Copyright and Related Rights Issue. *op.cit.* No.3.3.

⁷⁰⁴ The Final Report of the Sub-Committee for the Integrated Circuits Issue, Ministry of Commerce 0702/207, October 18, 1994. No.2.

timing, and other countries' laws should be taken into consideration when this new law is drafted.⁷⁰⁵

According to the report of the Sub-Committee for the Law Enforcement Issue,⁷⁰⁶ most measures relating to law enforcement and remedial measures in TRIPs have already been implemented.⁷⁰⁷ This opinion is based on a study comparing TRIPs Part III with several statutes, namely, the Civil and Commercial Code, the Penal Code, the Civil Procedure Code, the Criminal Procedure Code, the Trade Mark Act B.E.2534, the Patent Act B.E.2522, the Draft Copyright Act B.E..... (at that time), and the Draft Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E..... (at that time).

The TRIPs measures with which Thai law has already complied are:

1. decisions must be made in the written form and reasons must be given (TRIPs Article 41 (3));⁷⁰⁸
2. the right of defenders to be informed in the written form (TRIPs Article 42);⁷⁰⁹
3. the right to be represented by independent legal counsel (TRIPs Article 42);⁷¹⁰
4. the provisions related to evidence (TRIPs Article 43);⁷¹¹
5. the measures concerning injunctions (TRIPs Article 44);⁷¹²

⁷⁰⁵ The Final Report of the Sub-Committee for the Integrated Circuits Issue, Ministry of Commerce 0702/207, October 18, 1994. *op.cit.* No.4.3.

⁷⁰⁶ The Final Report of the Sub-Committee for the Law Enforcement Issue, October 19, 1994. p.4.

⁷⁰⁷ The Final Report of the Sub-Committee for the Law Enforcement Issue, No.3.1.

⁷⁰⁸ The Civil Procedure Code Section 141, and the Criminal Procedure Code Section 183.

⁷⁰⁹ The Civil Procedure Code Section 173, and the Criminal Procedure Code Section 165 para.3.

⁷¹⁰ The Civil Procedure Code Section 60, and the Criminal Procedure Code Section 165.

⁷¹¹ The Civil Procedure Code Section 85, and the Criminal Procedure Code Section 226.

⁷¹² The Civil Procedure Code Sections 254,255,257.

6. the measures concerning damages (TRIPs Article 45);⁷¹³
7. the provision of a right to compensation when the applicants abuse enforcement procedures (TRIPs Article 48);⁷¹⁴
8. the order of confiscation or destruction (TRIPs Article 46);⁷¹⁵
9. the protection of undisclosed information (TRIPs Article 47);⁷¹⁶
10. The right to reveal administrative decisions by the judicial authority (TRIPs Article 41 (4));⁷¹⁷
11. the measures concerning provisional measures (TRIPs Article 50).⁷¹⁸

Additionally, the Sub-Committee insisted that Thailand has complied with its obligation regarding the issue of law enforcement and there is no need to amend Thai law for this purpose, even though there are some measures which Thailand does not provide in its law specifically. For instance, there is no explicit provision that mandatory personal appearances are not required.⁷¹⁹ Likewise, the measures to order defenders to reveal information are not provided for in Thai law.⁷²⁰ In addition, there is no specific

⁷¹³ The Civil and Commercial Code Section 420, the Patent Act B.E.2522 Section 77 *ter*, and Section 64 of the Draft Copyright Act B.E.... (at that time).

⁷¹⁴ The Civil Procedure Code Section 263.

⁷¹⁵ The Penal Code Section 35, the Patent Act B.E.2522 Section 77 *quater*, and Section 75 of the Draft Copyright Act B.E.... (at that time).

⁷¹⁶ The Civil Procedure Code Section 92, the Criminal Procedure Code Section 177, the Penal Code Section Sections 322-324, and the Patent Act B.E.2522 Section 23.

⁷¹⁷ The Trade Mark Act B.E.2534 Sections 38, 65, 75; the Patent Act B.E.2522 Section 74; and Sections 44, 54 of the Draft Copyright Act B.E.... (at that time).

⁷¹⁸ The Trade Mark Act B.E.2534 Section 116, the Patent Act B.E.2522 Section 77 *bis*, Section 65 of the Draft Copyright Act B.E.... (at that time), and Sections 24, 25 of the Draft Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.... (at that time).

⁷¹⁹ See TRIPs Article 42.

⁷²⁰ See TRIPs Article 47.

provision that exempts the officials who take action in good faith from liability to appropriate remedial measures.⁷²¹

The Sub-Committee indicated that, for the first case,⁷²² it is possible for the court to receive a deposition, since Thai law is not so strict as the common law, thereby an appearance of a witness is not required. Furthermore, the measures concerning the right of information are not regarded as compulsory. In addition, subject to Thai law, officials who act in good faith are, at present, immune from any liability. Subsequently, there is no need to amend the law for these measures. As a result, it is not expected that there will be dramatic changes in remedial measures.

The issue of border measures is also considered by the specific Sub-Committee. Similarly to the reports of several Sub-Committees, Thai law, apparently, has already conformed to TRIPs provisions relating to border measures.⁷²³ There are a few minor issues which are under consideration to be amended.⁷²⁴

4.8 THE INTELLECTUAL PROPERTY AND INTERNATIONAL TRADE COURT

The mere fact that intellectual property law has been provided in Thailand, however, will not guarantee that owners of intellectual property rights will be appropriately protected. Even though the intellectual property law has been improved from time to time, there have been criticisms of legal protection in Thailand. Arguably, law enforcement is another factor which helps to ensure adequate protection. It is believed

⁷²¹ See TRIPs Article 48.

⁷²² In case of an explicit provision that mandatory personal appearances are not required.

⁷²³ The Final Report of the Sub-Committee for the Border Measures Issue, the Ministry of Commerce 0701/S/171, October 17, 1994, p.1.

⁷²⁴ *Ibid.*

that owners of intellectual property rights will be protected adequately if the law is efficiently enforced.

Regarding this concept, Thailand has planned to strengthen its process of law enforcement. Several organizations such as the Department of Intellectual Property have been set up.⁷²⁵ The establishment of a special court to cope with intellectual property cases is the major part of this scheme. The Central Intellectual Property and International Trade Court was set up in 1996,⁷²⁶ and has operated since December 1, 1997.⁷²⁷

This court is a part of the Thai Courts System. Generally, Thai Courts of Justices are divided into three tiers. They are the Supreme Court (Dika Court), the Courts of Appeals (Uthom Court), and the Courts of First Instance.⁷²⁸ The Supreme Court is the final court of appeal in all civil and criminal cases.⁷²⁹ It consists of the President, Vice Presidents, the Secretary, and a number of Justices.⁷³⁰ Whereas there is only one Supreme Court, there are, at present, four courts in the middle level. They are the Central Court of Appeals, the Court of Appeals Region I, the Court of Appeals Region II, and the Court of Appeals Region III. They are empowered to consider most civil and criminal cases.⁷³¹

⁷²⁵ This Department is a part of the Ministry of Commerce and was established on May 3, 1992 by virtue of a Royal Decree. One of its main responsibility is to develop systems, patterns, and means to protect intellectual property properly and effectively.

⁷²⁶ It was established by the Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539, the Royal Gazette, Vol.113, No.55a, October 25, 1996. For more information, see W. Weeraworawit, "The Intellectual Property and International Trade Court," Annual Report 1996 : Department of Intellectual Property *op cit.* pp.60-69.

⁷²⁷ See "Agenda for the Inauguration Ceremony of the Central Intellectual Property and International Trade Court," in The Central Intellectual Property and International Trade Court (Bangkok : Gaingrow, 1997) p.22.

⁷²⁸ The Organizations of Justice Court Act B.E.2477 (1934) Section 2.

⁷²⁹ The Organizations of Justice Court Act B.E.2477 (1934) Section 20.

⁷³⁰ The Organizations of Justice Court Act B.E.2477 (1934) Section 8.

⁷³¹ The Organizations of Justice Court Act B.E.2477 (1934) Section 19.

Bangkok, the capital of the country, is the territorial jurisdiction of the Central Court of Appeals, while the Northern, the North Eastern, and the Southern Regions are the territorial jurisdiction of the other Courts of Appeals respectively. Each of them consists of the Chief Justice, Deputy of Chief Justices, the Secretary, and a number of judges.⁷³²

The Courts of First Instance compose of several types of courts, *inter alia* , the Changwat Courts (Provincial Courts), the Kwang Courts (the Magistrate Courts), the Civil Court, the Criminal Court, the South Bangkok Civil Court, the South Bangkok Criminal Court, the Thonburi Civil Court, and the Thonburi Criminal Court.⁷³³ The Changwat , and Kwang Courts are empowered to try all cases except specific cases, *inter alia* , labour, tax, and family cases.⁷³⁴ Each of them has territorial jurisdiction in a province where it is located.⁷³⁵ However, the Kwang Court's jurisdiction is limited to small cases.⁷³⁶ The other types of Courts of First Instance are all located in Bangkok. They are empowered to try cases, subject to either civil or criminal cases, in their territorial jurisdiction. In addition, before the establishment of the Central Intellectual Property and International Trade Court, there were three special courts which were also regarded as Courts of First Instance. They are the Labour Court, the Tax Court, and the Juvenile and Family Court. Such special courts have jurisdiction over both civil and criminal cases which relate to their special power.

⁷³² The Organizations of Justice Court Act B.E.2477 (1934) Section 8.

⁷³³ Thonburi is a part of Bangkok. It used to be the capital of Thailand during 1867-1881.

⁷³⁴ The Organizations of Justice Court Act B.E.2477 (1934) Section 16.

⁷³⁵ The Organizations of Justice Court Act B.E.2477 (1934) Section 14.

⁷³⁶ The Organizations of Justice Court Act B.E.2477 (1934) Section 15.

The Central Intellectual Property and International Trade Court is regarded as one of special courts in the Courts of First Instance. It will try all civil and criminal cases relating to intellectual property and international trade issue, no matter how severe or amount of compensation of a case is.⁷³⁷ Nevertheless, it is noteworthy that cases falling under jurisdiction of the Juvenile and Family Court will be excluded from this Court's jurisdiction.⁷³⁸

There are two explicit aims in establishing this special court. One is to speed up intellectual property trial, and the other is to try an intellectual property case efficiently.⁷³⁹ Apparently, the idea of speeding up the trial follows the worldwide concept that 'justice delayed means justice denied'. Thailand, as any other country, cannot escape from such circumstances. Therefore, it intends to tighten up the trial.⁷⁴⁰ For example, Section 27 of the Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539 states that:

The Intellectual Property and International Trade Court shall proceed with the hearing without adjournment until the hearing is over, save in the case of unavoidable necessities. After the hearing is over, the court shall promptly render a judgment or order.

⁷³⁷ The Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539 Section 7.

⁷³⁸ The Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539 Section 7 para.2.

⁷³⁹ See Note for the Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539.

⁷⁴⁰ C. Leekpai, "Message from the Prime Minister," The Central Intellectual Property and International Trade Court *op.cit.* p.7.

This provision ensures that intellectual property cases will be solved without delay. Modern and high technological communications, such as facsimile,⁷⁴¹ electronic mediums,⁷⁴² video conference,⁷⁴³ and computer,⁷⁴⁴ have been permitted in the legal process. Additionally, an appeal against a judgment or an order of this court will be directly submitted to the Supreme Court, by passing the Court of Appeal.⁷⁴⁵

The Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539 also contains several provisions which will make the trial more effective. Seemingly, the most crucial provisions are about qualification of judges and associate judges. Generally, all cases in Thailand are tried by professional judges. They have been recruited through an open competitive examination system.⁷⁴⁶ Candidates for the examination must possess the qualification of at least twenty five years of age, a law degree, have already been called to the Thai Bar, and possess at least two years of legal experience.⁷⁴⁷ An additional qualification of judges in the Intellectual Property and International Trade Court is competent knowledge of the matters relating to intellectual property and international trade.⁷⁴⁸ Associate judges are required in this court, as they are also required in other special courts. They must be

⁷⁴¹ The Rules for Intellectual Property and International Trade Cases B.E.2540 Rule 5.

⁷⁴² *Ibid.*

⁷⁴³ The Rules for Intellectual Property and International Trade Cases B.E.2540 Rule 32.

⁷⁴⁴ The Rules for Intellectual Property and International Trade Cases B.E.2540 Rule 33.

⁷⁴⁵ The Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539 Section 38.

⁷⁴⁶ The Judicial Service Act B.E.2521 (1978) Section 17.

⁷⁴⁷ The Judicial Service Act B.E.2521 (1978) Section 27.

⁷⁴⁸ The Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539 Section 14.

Thai, not less than thirty years of age, having been trained on the purposes of the Intellectual Property and International Trade Court and on the judicial duties in accordance with the rules and methods prescribed in the Ministerial Regulations, and having knowledge and expertise in intellectual property or international trade.⁷⁴⁹ It is expected that, by the specific qualification of both judges and associate judges, intellectual property cases will be tried efficiently.

The other remarkable provision which is expected to make the trial more effective is Section 30, the power to issue procedural rules of the court. The Chief Justice of this court is empowered, subject to the approval of the President of the Supreme Court, to issue Rules of the Court on proceedings and hearing of evidence in the intellectual property and international trade cases, to ensure convenience, expediency, and fairness of the proceedings.⁷⁵⁰ The present Rules of the Court have been enforced since November 28, 1997. They contain several significant rules, such as rules for proceeding according to agreed terms,⁷⁵¹ or application for the taking of evidence in advance.⁷⁵²

There have been many comments on the move of Thailand in setting up this special court. It is believed that this move will demonstrate that the owner of intellectual property rights, no matter who he is, will receive just and appropriate protection under Thai law.⁷⁵³ Similarly, it has been indicated that this move is a crucial development in the

⁷⁴⁹ The Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539 Section 15.

⁷⁵⁰ The Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539 Section 30.

⁷⁵¹ The Rules for Intellectual Property and International Trade Cases B.E.2540 Rule 4.

⁷⁵² The Rules for Intellectual Property and International Trade Cases B.E.2540 Rules 20-22.

⁷⁵³ A. Sumawong, "Message from the Chief Justice of the Central Intellectual Property and International Trade Court," The Central Intellectual Property and International Trade Court *op.cit.* p.11.

Thai Justice System,⁷⁵⁴ which will increase the confidence of both domestic and international investors; consequently, the Thai economy will be strengthened. In addition, this court has been viewed as one of the modern courts in the world. Therefore, its efficiency will be closely observed by other countries. The court's performance may be considered as an attractive model for other countries.⁷⁵⁵

Nevertheless, it should be remembered that the Intellectual Property and International Trade Court is a last resort for owners of intellectual property rights to seek protection. Therefore, it is impractical to think that the Intellectual Property and International Trade Court will solve all problems relating to intellectual property, and will provide absolute protection for the owners of intellectual property rights. They can expect certain level of protection from this court. In general, remedial measures can be sought for an infringement which is being committed, or has already been committed. In addition, with regard to provisional measures, the Central Intellectual Property and International Trade Court can protect the owners of intellectual property right even when such the rights have not yet been infringed.

⁷⁵⁴ C. Ngermuen, "Message from the Minister of Justice," The Central Intellectual Property and International Trade Court *op.cit.* p.9.

⁷⁵⁵ See G. Herrmann, "Message from the Secretary United Nations Commission on International Trade Law," The Central Intellectual Property and International Trade Court *op.cit.* p.18.

CHAPTER 5 : PROVISIONAL MEASURES IN THAI LAW

5.1 INTRODUCTION

Provisional measures are regarded as the latest remedial measures in the Thai legal system. These measures, however, can be sought only in intellectual property cases. Previously, several types of civil remedies, such as damages, orders of destruction, and criminal sanctions had been in force to protect intellectual property rights' owners, but it is only within this last decade that provisional measures have been available. These measures were first introduced in the Trade Mark Act B.E.2534 in 1991. They were later provided for in the Patent Act B.E.2522 (amended by the Patent Act (No.2) B.E.2535) and the Copyright Act B.E.2537 in 1992 and 1994 respectively.

The primary aim of provisional measures is to prolong intellectual property rights protection to cover the period when an infringement has not yet been committed. In other words, these measures allow intellectual property rights' owners to seek protection from the earliest stage, i.e. an infringement is about to occur, or in the process of occurring. As a result, intellectual property rights' owners can, in theory, prevent an infringement or prevent serious damage. It is, therefore, in some cases, preferable to seeking remedies after their rights have already been severely infringed.

Arguably, the other reason for introducing such measures into the Thai legal system is to implement TRIPs. Even though provisional measures were provided for under Thai law before agreement on TRIPs was reached, these measures were inserted into the law primarily because of TRIPs.⁷⁵⁶ Thailand, at that time, realized that agreement on TRIPs was about to be reached and Thailand would be obliged to implement this agreement.

⁷⁵⁶ Rattanasuwan S, Deputy Director General of the Department of Intellectual Property. He was interviewed at his office on May 26, 1998. (Hereinafter Interview with Rattanasuwan.)

Subsequently, several measures, including provisional measures, were added to intellectual property laws when the said laws were revised or amended.

The introduction of provisional measures into Thai law seems to show that Thailand is aware of the current situation and prepares to comply with TRIPs. Consequently, it is important for Thailand to find out whether or not its obligation (to implement TRIPs) has already fulfilled. Regarding this reason, provisional measures are selected for the study. To examine whether provisional measures in Thailand conform with TRIPs, law relating to these measures and law enforcement will be under consideration. Provisional measures will be scrutinized in three stages, namely the stage of applying for an order, the stage of granting an order, and the stage of executing an order.

5.2 PROVISIONAL MEASURES IN THAI LAW

Provisional measures are dealt with in TRIPs Article 50. According to this Article, intellectual property rights' owners are able to apply for an order :

- (a) to prevent an infringement of any intellectual property right from occurring, and in particular to prevent the entry into the channels of commerce in their jurisdiction of goods, including imported goods immediately after customs clearance;
- (b) to preserve relevant evidence in regard to the alleged infringement.

These measures exist in Thai law, however, in various statutes. Interim injunctions are provided for in intellectual property law,⁷⁵⁷ namely, the Copyright Act

⁷⁵⁷ At present, the Protection of Undisclosed Information Act B.E....., the Geographical Indications Act B.E....., and the Layout Designs of Integrated Circuits Act B.E..... have been drafted. Among them, provisions relating to interim injunctions only exist in the draft of Protection of Undisclosed Information Act B.E.....

B.E.2537,⁷⁵⁸ the Patent Act B.E.2522,⁷⁵⁹ and the trade Mark Act B.E.2534,⁷⁶⁰ whereas an order to preserve evidence in advance is contained in the Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539.⁷⁶¹ Details are also provided for in the Rules for Intellectual Property and International Trade Cases B.E.2540 (1997 A.D.).⁷⁶² In addition, these measures are available under general provisions of the Civil Procedure Code and the Criminal Procedure Code *mutatis mutandis*.⁷⁶³

Similar measures already exist in Thai law. Injunctions pending judgments are normally in force for civil cases,⁷⁶⁴ whereby a person is empowered to apply for an order to preserve evidence in advance, in both civil and criminal cases.⁷⁶⁵ Nevertheless, such injunctions can be sought only when a case has already been filed at the court. It means that these measures are available after intellectual property rights have already been infringed. Regarding the case of the order to preserve evidence in advance, the measures are rather similar. However, an applicant, in a normal case, could not seek an order to seize or attach the documents or materials that would be

⁷⁵⁸ Section 65.

⁷⁵⁹ Section 77 *bis*.

⁷⁶⁰ Section 116.

⁷⁶¹ Sections 28-29.

⁷⁶² Rules 12-22.

⁷⁶³ The Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539 Section 26.

⁷⁶⁴ The Civil Procedure Code Section 254. It is possible to apply these measures in criminal cases *mutatis mutandis*. See The Criminal Procedure Code Section 15.

⁷⁶⁵ The Civil Procedure Code Section 101, and the Criminal Procedure Code Section 237 *bis*.

adduced as evidence.⁷⁶⁶ Furthermore, in criminal cases, the witness is merely permitted to testify in advance.⁷⁶⁷

In addition, the Arrest of Seagoing Ships Act B.E.2534 provides measures to protect injured persons prior to their cases being instituted.⁷⁶⁸ A court order can be sought, in order to arrest the ship which belongs to a debtor, or which is in the possession of a debtor, with respect to the debt relating to such a ship.⁷⁶⁹ According to this law, the port authorities will be notified without delay, and such a ship will be prevented from moving off.⁷⁷⁰ Since this is a special measure, it is uncertain whether it would be explicitly applied in intellectual property cases.

As a result, it should not be difficult for judges and lawyers to understand and enforce provisional measures effectively. Nevertheless, there may be a question as to whether these measures have been adopted in a similar way to those enforced in other countries. To answer the above question, provisional measures should be examined in two aspects, namely, the law *per se* and its enforcement.

Generally, it seems that Thai law has already conformed to TRIPs. However, there are some details which are still different between Thai law and TRIPs.⁷⁷¹ The wording in the Trade Mark Act B.E.2534 Section 116, which is not the same as that of the Copyright Act

⁷⁶⁶ See the Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539 Section 29 para 1.

⁷⁶⁷ The Criminal Procedure Code Section 237 *bis*.

⁷⁶⁸ The Royal Gazette, Special Vol.108, No.196, November 11, 1991. p.1.

⁷⁶⁹ Section 4.

⁷⁷⁰ Section 11.

⁷⁷¹ The Final Report of the Sub-Committee for the Law Enforcement Issue. *op.cit.* No.4.

B.E.2537 Section 65 and the Patent Act B.E.2522 Section 77 *bis*,⁷⁷² appears to be different from TRIPs Article 50 (3).⁷⁷³ In fact, this may discriminate against Trade Mark owners and obstruct them from achieving effective protection.

Enforcement is also significant. The process of enforcement is crucial since it turns the law in statutes into an efficient form of protection in practice. Enforcement, for this purpose, could be divided into three stages, namely, applying for an order, considering an order, and executing an order. These stages, however, cannot be absolutely separated since they are linked as a circuit. If one stage fails, the whole process will probably collapse.

5.3 THE STAGE OF APPLYING FOR AN ORDER

This is the first step to access intellectual property rights protection. If intellectual property rights' owners, represented by their lawyers, realize the effectiveness of provisional measures and decide to apply for these measures, they may achieve protection even before their rights are infringed. Nevertheless, if these measures are applied for improperly, intellectual property rights' owners may be repeatedly injured, instead of achieving the said protection. A single mistake in this process could cost them dearly, since they may have to waste their time and costs when their applications are delayed and eventually dismissed. The applicants have to beware of several issues, *inter alia*, the court to which they submit their applications, and conditions which are used in applying for these measures.

⁷⁷² The Trade Mark law states that 'a person commits or is committing ...', whereas the Copyright and Patent laws prescribe 'a person commits or is about to commit ...'

⁷⁷³ This Article provides that '... the applicant's right is being infringed or that such infringement is imminent, ...'

5.3.1 THE COURT TO WHICH AN APPLICATION WILL BE SUBMITTED

The issue of the court to which the applicants submit their applications seems to have become less complicated since the Central Intellectual Property and International Trade Court was established.⁷⁷⁴ This is because intellectual property cases, both civil and criminal, fall under jurisdiction of this Court, excluding cases falling under jurisdiction of the Juvenile and Family Courts.⁷⁷⁵

Regarding territorial jurisdiction, there seems no controversy, at present, since there is only one court, the Central Intellectual Property and International Trade Court, which deals with intellectual property cases. The law provides that the Central Intellectual Property and International Trade Court and the Regional Courts will be established.⁷⁷⁶ The Central Intellectual Property and International Trade Court has jurisdiction throughout Bangkok, Samut Prakam, Samut Sakom, Nakorn Pathom, Nonthaburi, and Patum Thani provinces.⁷⁷⁷ The Regional Courts' jurisdiction will be specified in the Act to establish these Courts.⁷⁷⁸ Currently, the Regional Courts have not yet been set up, therefore, the Central Intellectual Property and International Trade Court has jurisdiction all over the country.⁷⁷⁹

⁷⁷⁴ The inauguration date of this Court was December 1, 1997.

⁷⁷⁵ The Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539 Section 7.

⁷⁷⁶ The Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539 Sections 5 and 6.

⁷⁷⁷ The Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539 Section 5 para.1. According to this provision, cases arising outside this jurisdiction may be filed with this Court too.

⁷⁷⁸ The Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539 Section 6.

⁷⁷⁹ The Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539 Section 47.

5.3.1.1 INTERIM INJUNCTIONS

There may be a question about territorial jurisdiction when the Regional Courts are established. Since there is no explicit provision concerning this issue, general principle in the Civil Procedure Code, also the Criminal Procedure Code, will be applied *mutatis mutandis*. It is noteworthy that interim injunctions could be sought in both civil and criminal cases.⁷⁸⁰

Regarding civil cases, generally, a case must be instituted with the court in which either a defendant has his domicile, or an infringement has occurred.⁷⁸¹ Literally, an applicant may not be able to submit his application to such courts since, at that time, there is no defendant and (in a case where the infringement is imminent) infringement has not yet occurred. In practice, by regarding this process as a part of the whole trial process, it is believed that the applicant could submit his application to the court with which he has to file his case later.⁷⁸² In other words, it is possible to submit the application to the court in which an infringement has occurred, or the court in which the prospective defendant has his domicile, or the court in which the infringement is about to occur. For the benefit of this process, the meaning of 'domicile' includes any place where, within two years before the date on which the case is instituted, the defendant has had a domicile in the country.⁷⁸³ It also includes any place where the defendant operates or has operated his business, in part or as a whole, in the country within two

⁷⁸⁰ See the Rules for Intellectual Property and International Trade Cases B.E.2540 Rules 12-19, 42.

⁷⁸¹ The Civil Procedure Code Section 4 (1).

⁷⁸² Thanomrod P, Deputy Chief Justice of the Civil Court. He was interviewed at his office on May 20, 1998 at 10a.m. (Hereinafter Interview with J.Thanomrod.)

⁷⁸³ The Civil Procedure Code Section 3 (2)(a).

years before the date the case has been instituted.⁷⁸⁴ If there is a representative or a person whom the defendant has contacted for business,⁷⁸⁵ the residence of such a person, on the date the case has been instituted or within two years before the case has been instituted, may be regarded as the defendant's domicile.⁷⁸⁶ In addition, the applicant may be able to submit his application to the court in which he has domicile, subject to the fact that the prospective defendant does not have his domicile in Thailand, and the infringement is not about to occur or has not occurred in this country.⁷⁸⁷

Due to the condition of a defendant's domicile, it seems that, according to Thai law, an infringer has to be identified. In other words, the applicant should know, when the application is submitted, who infringes or is about to infringe his right, even though the said infringer may not be known in detail.⁷⁸⁸ This is supported by the law, *inter alia*, regarding the conditions for the grant of interim injunctions. The court is empowered to grant such injunctions when it is found that the prospective defendant is not in a position to compensate the applicant for his damage or that it might be difficult to enforce

⁷⁸⁴ The Civil Procedure Code Section 3 (2)(b).

⁷⁸⁵ The phrase 'a person whom the defendant has contacted for business' is rather obscure. At present, there is no judgment relating to this issue. However, it seems that this phrase refers to a trade representative. See U. Fuengfung, "Civil Procedure Code," Lectures for Thai Bar Association Vol.1 (Bangkok : Krung Siam Printing Group, 1992) pp.30-32.

⁷⁸⁶ The Civil Procedure Code Section 3 (2) (b).

⁷⁸⁷ The Civil Procedure Code Section 4 *ter*.

⁷⁸⁸ It has been reported that a defendant might be identified as 'someone indicated by an arrow in a photograph'. See Warner Music Hong Kong Ltd. case, reported in IP Asia, October 31, 1994. This practice, however, could not solve the problem of the defendant's domicile.

judgment against the prospective defendant afterwards.⁷⁸⁹ These matters would be difficult to ascertain if the defendant's identity is not known.

It could be argued too that there is no need to know who the infringer is. To some extent, the aim of intellectual property law should be to protect intellectual property rights' owners from any infringement, no matter who commits it. Therefore, it may be inappropriate to bar an intellectual property right's owner from seeking protection primarily because he does not know who infringes or is about to infringe his right. In other words, it could be argued that provisional measures aim at protecting intellectual property rights' owners, not at compensating them or inflicting penalties on infringers.⁷⁹⁰ It seems possible, according to the concept of equity, that interim injunctions could be sought, notwithstanding the infringer is unidentified.⁷⁹¹

It is true that the ultimate goal of intellectual property law is to protect intellectual property rights' owners. Nevertheless, the purpose of these mechanisms, i.e. remedial measures, should also be respected.⁷⁹² Therefore, the aim of preventing someone from infringing intellectual property rights should be a prime concern.⁷⁹³ This will justify an interpretation of the law that information about the infringer as such is needed.

⁷⁸⁹ The Rules for Intellectual Property and International Trade Cases B.E.2540 Rule 13 (2).

⁷⁹⁰ See TRIPs Article 50 (1) (a).

⁷⁹¹ It has been argued that a 'roving' Anton Piller order could be sought. It is an order to be executed against anyone falling within the class of persons defined in the order. See D. Barron, "Roving Anton Piller Orders : Yet to be Born, Dead, or Alive?," *EIPR* 4(1996) p.183. The application as such, therefore, has not been required to name the defendant. In practice, the titles of 'John Doe' and 'Jane Doe' have been used, particularly in the United States of America, to represent the unidentified defendants. See, for example, *EMI Records Ltd. v. Kudhail* [1985] F.S.R. p.36.

⁷⁹² There has been a comment that the remedy should aim at achieving the rightful position under the rule, although it will not achieve the ultimate goal of the law. See *Sheet Metal Workers' International Association v. EEOC* 106 S.Ct. (1986) p.3019.

⁷⁹³ Apparently, the purpose of this measure is different from that of border measures. The former's purpose aims at the person, whereas the latter's aims at the things. The order or the warrant relating to interim injunctions could not be

The concept of the 'Anton Piller' order cannot be mentioned to support this argument since there is no strong equitable concept of injunctions in Thailand.⁷⁹⁴ Interim injunctions exist in Thai law in the form of legal remedies, in respect of the obligation under TRIPs. The provisions in TRIPs *per se* do not require members to provide the 'Anton Piller' order in their legal systems. As a result, there is no explicit evidence that, at present, the concept of the 'Anton Piller' order will be adopted.

In criminal cases, the Criminal Procedure Code will be applied *mutatis mutandis* to the issue of territorial jurisdiction. Therefore, an application will be submitted to the court in which an offence has been committed, alleged, or believed to have been committed.⁷⁹⁵ In addition, the said application could be submitted to the court in which either the accused has residence or has been arrested, or the inquiry has been conducted.⁷⁹⁶

5.3.1.2 AN ORDER TO PRESERVE EVIDENCE IN ADVANCE

According to an order to preserve evidence in advance, it seems that the terms of the Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539 Section 28 and the Civil Procedure Code Section 101 are rather similar. Therefore, the issue of territorial jurisdiction in this aspect should be applied *mutatis mutandis*. Subsequently, an application may be submitted to the court in which

delivered (to the person), unless the said person is identified. On the other hand, the order or warrant concerning border measures will be sent to the authorities.

⁷⁹⁴ It has been suggested that the general concept of equity, to some extent, exists in the Thai legal system. See S. Kraijitti, "The Comparison of the Administrative Court's Systems : The Most Appropriate Choice for Thailand," 103 Years of the Ministry of Justice (Bangkok : Ministry of Justice, 1995) P.13.

⁷⁹⁵ The Criminal Procedure Code Section 22.

⁷⁹⁶ The Criminal Procedure Code Section 22 (1).

the evidence to be testified, the person, property, or place to be examined is situated.⁷⁹⁷ It should be noted that the law, generally, requires 'the opposing party' to be summoned to the court.⁷⁹⁸ Therefore, it seems clear that the said 'opposing party' should have been identified.

Provision in criminal cases is rather different from that manifested in the Criminal Procedure Code.⁷⁹⁹ According to criminal law, a witness cannot testify before the case is instituted, unless the said witness is about to leave the country, and it will be difficult to summon him to testify afterwards.⁸⁰⁰ It is likely that the application will be submitted to the court in which the case will be instituted later.⁸⁰¹ This idea is arguably supported by the condition that the accused must be present during this process.⁸⁰²

5.3.2 THE CONDITIONS TO BE SATISFIED IN AN APPLICATION

The other aspect of which intellectual property rights' owners have to be aware are the conditions to be satisfied in an application for provisional measures.⁸⁰³ Separate consideration will be given to interim injunctions and orders to preserve evidence in advance. The general provisions for interim injunctions are stated in intellectual property law. However, these provisions merely guarantee that intellectual property rights' owners

⁷⁹⁷ The Civil Procedure Code Section 7 (3).

⁷⁹⁸ The Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539, Section 28 para.2.

⁷⁹⁹ Section 237 *bis*.

⁸⁰⁰ Section 237 *bis* para.1.

⁸⁰¹ Since there is no exceptional provision, the general provision, i.e. Section 22 is likely to be applied *mutatis mutandis*.

⁸⁰² Section 237 *bis* para.1.

⁸⁰³ These conditions are required by the law before the judge grants his order. See Rule 13 of the Rules for Intellectual Property and International Trade Cases B.E.2540.

are empowered to apply for such injunctions. The conditions are laid out in the Rules for Intellectual Property and International Trade Cases B.E.2540,⁸⁰⁴ and are used in both civil and criminal cases.⁸⁰⁵

5.3.2.1 INTERIM INJUNCTIONS

Subject to the rule, an application must contain the facts which gave rise to the cause of action and reasons sufficient for the court to believe that it is appropriate to grant such an order.⁸⁰⁶ When compared with TRIPs, it appears that an application is required to provide 'reasonably available evidence', with a sufficient degree of certainty, to prove that :

1. the applicant is the right holder
2. the applicant's right is being infringed, or the infringement is imminent.⁸⁰⁷

In light of the question whether an applicant is the rights holder or not, there seems to be less controversy in the case of registered rights such as trade marks and patents. For copyrights, however, some evidence might be required to prove this condition. The degree of certainty depends, therefore, on judicial discretion. At present, there is no precedent for this issue. It is likely that the court may require evidence of the same level as that required when a case is filed.⁸⁰⁸

Next, the applicant has to prove that his right is being infringed, or the infringement is

⁸⁰⁴ Rule 12.

⁸⁰⁵ See Rule 42.

⁸⁰⁶ Rule 12.

⁸⁰⁷ TRIPs Article 50 (3).

⁸⁰⁸ Pakditanakul J, the judge of the Court of Appeals. He gave a lecture in the training course for intellectual property law at the Judicial Training Institutes on June 8, 1998. (Hereinafter Lecture of J.Pakditanakul.)

imminent. There are several ways to prove it, such as providing pictures or samples of infringing goods.⁸⁰⁹ In addition, the law requires the statement of a person who witnessed such infringement.⁸¹⁰

There is a question as to what 'imminent' means.⁸¹¹ Literally, the copyright and patent laws require that '... a person is about to infringe the rights ...'. Therefore, the court may examine how likely it is that such an infringement is 'about' to be committed.⁸¹² The concept of 'preparation' and 'attempt' in the criminal law may be under consideration. In some cases, the mere fact of possession of infringing goods seems to be insufficient for an order to be granted.⁸¹³

It seems adequate, in some countries, to grant interim injunctions when these two elements (i.e. the applicant is the right holder, and his right is being infringed or the infringement is imminent) have already been established.⁸¹⁴ However, there is no evidence whether the court, in Thailand, would be satisfied with these elements, or require further elements, *inter alia*, the condition of reasonable likelihood of success.⁸¹⁵ Apparently, this condition concerns the degree of proof. The court might not strictly require the applicant to prove his case to the same level as the *prima facie*

⁸⁰⁹ Chantararak S, a senior lawyer of Tilleke & Gibbins, the Advocates & Solicitors. He was interviewed at his office on April 21, 1998 at 8 am. (Hereinafter Interview with Chantararak.)

⁸¹⁰ Rule 12.

⁸¹¹ It should be noted that this condition is not stated in the Trade Mark Act B.E.2534.

⁸¹² In England, there have been several cases describing this situation. For example, *Pattison v. Guilford* (1874) L.R. 18 Eq.259, *Goodhart v. Hyatt* (1883) 25 Ch.D.182.

⁸¹³ See *British United Shoe Machinery Co.Ltd. v.Simon Collier Ltd.* (1980) 25 R.P.C.567.

⁸¹⁴ For example, see *Herbert Rosenthal Jewellery Corp. v. Zale Corp.* 323 F.Supp. (S.D.N.Y 1971) 1234.

⁸¹⁵ This condition has been commented on in several countries. See *Apple Computer Inc. v. Franklin Computer Corp.* 714 F.2d. (3d Cir.1983) 1254.

case,⁸¹⁶ required in a criminal case.⁸¹⁷ The applicant, thus, may be required to prove that there is a serious case to be tried.⁸¹⁸

Regarding Thai law, it appears that the phrases '*prima facie*' case and 'a serious case to be tried' are 'borrowed' from English law, particularly from an American Cyanamid case.⁸¹⁹ In criminal case, a degree of proof required by the Criminal Procedure Code when an injured person files his own case to the court is *prima facie*.⁸²⁰ At the same time, an intellectual property rights' owner who seeks an interim injunction is required to illustrate the facts giving rise to the cause of action in the case and the reasons sufficient for the Court to believe that it is appropriate to grant an order.⁸²¹ Consequently, it seems that a degree of proof for the former is higher than the latter. This conforms with the different degree of proof between a '*prima facie*' case and 'a serious case to be tried' in English law.⁸²²

Regarding 'the reasons sufficient to believe that it is appropriate to grant the order',

⁸¹⁶ In Thailand, an injured person could institute a criminal case by himself, according to the Criminal Procedure Code Section 28 (2). In this case, a preliminary examination or a *prima facie* case is required, subject to the Criminal Procedure Code Section 162 (1).

⁸¹⁷ Deepadung P, the Assistant Judge in the Supreme Court. He was interviewed at his office on May 13, 1998 at 10 a.m. (Hereinafter Interview with J.Deepadung.)

⁸¹⁸ Ariyanantaka V, the judge in the Criminal Court working as the Central Intellectual Property and International Trade Court's judge. He was interviewed at his office on May 21, 1998 at 2pm. (Hereinafter Interview with J.Ariyanantaka.) For this meaning, for instance, see *Morning Star Co-operative Society Ltd. v. Express Newspapers Ltd.* [1979] F.S.R. 113.

⁸¹⁹ *American Cyanamid Co. v. Ethicon Ltd.* [1975] A.C.396.

⁸²⁰ Section 2 (12) States that "Preliminary examination" means the proceedings conducted by a Court with a view to finding a *prima facie* case against the accused.

⁸²¹ Rule 12 of Rules for Intellectual Property and International Trade Cases B.E.2540.

⁸²² See Parker. *op.cit.* p.661, and I. Spry, *The Principles of Equitable Remedies* (London : Sweet & Maxwell, 1990) pp.453-459.

there is no explicit provision to indicate what it means. It is up to judicial discretion and it is uncertain whether the discretion of one judge will be similar to that of others, even in the same court. The details of each case are the vital factors that might affect the court's discretion. This condition will be examined in detail in the part concerning granting the order.

In addition to the above conditions, the rule requires

a statement confirming the facts giving rise to the application, of a person who witnessed the cause of action, in order to substantiate the cause of action.⁸²³

Normally, an enquiry is the mechanism required in order to prove the fact.⁸²⁴ The so called 'affidavit' statement, to some extent, seems to be new in the Thai legal system.⁸²⁵ Up until now, it is not explicit how judges treat such statements. For instance, there are no explanations of what this statement should consist of, or of what is meant by 'a person who witnessed the cause of action'.

This issue was commented on during the meeting of the Committee set up to scrutinize the plan to establish the Intellectual Property and International Trade Court.⁸²⁶ It seems that the statement required in the Rules for Intellectual Property and International Trade Cases B.E.2540 is, in some respects, similar to the so called 'affidavit' statement which already exists in several countries.⁸²⁷ Apparently, this

⁸²³ Rule 12.

⁸²⁴ The Civil Procedure Code Section 21 (4).

⁸²⁵ "Affidavit", in English law, is a written statement in the name of a person, the deponent, who makes it and signs and swears (or affirms) to its truth before a Commissioner for Oaths. Walker. *The Oxford Companion to Law op.cit.* p.38.

⁸²⁶ The Report of the meeting of this Committee, 7/38, June 7, 1995.

⁸²⁷ *Ibid.* p.15.

statement should be submitted in written form. It is suggested that the form of a deposit of witness could be applied *mutatis mutandis* to this statement.⁸²⁸ Therefore, it should contain 1) the name of the court and the case number, 2) the date, month, year in which, and the place where, the deposition was made, 3) the name and family name of the parties, 4) the deponent's name, family name, age, address, occupation and relationship with the parties, 5) a description of the facts and/or opinions of the deponent, and 6) the signature of the deponent.⁸²⁹ Moreover, it should contain facts to substantiate the cause of action. The words 'a person who witnessed the cause of action' are so broad that they could refer to anybody, including the applicant *per se* .

5.3.2.2 AN ORDER TO PRESERVE EVIDENCE IN ADVANCE

Regarding an order to preserve evidence in advance, there are certain elements provided for in the Rules for Intellectual Property and International Trade Cases B.E.2540.⁸³⁰ These conditions are compulsory for both civil and criminal cases.⁸³¹ One concerns those facts which show the necessity for taking evidence at once.⁸³² This element and Section 28 of the Act for the Establishment of and Procedure for *Intellectual Property and International Trade Court* B.E.2539 should be considered together. According to this Section, they are facts which show that

⁸²⁸ V. Tingsamit, Law on the Intellectual Property and International Trade Court (Bangkok : Nititham Publishing Co., 1998) p.115.

⁸²⁹ Rule 30.

⁸³⁰ Rule 20.

⁸³¹ Rule 42.

⁸³² Rule 20 para.1.

the evidence on which [the applicant] may have to rely in the future will be lost or become difficult to produce, or ... the evidence on which [the applicant] intends to rely will be lost before [the applicant] can adduce it in Court or will become difficult to adduce at a later stage.⁸³³

If the case has not yet been instituted, there should be facts which show on what grounds the applicant may file the case or the case may be filed against him.⁸³⁴ This element is similar to the conditions already examined in interim injunctions. Moreover, facts which show the emergency of the situation are required in the case of emergency.⁸³⁵

This issue may be compared with Section 101 of the Civil Procedure Code. Moreover, the applicant should state that, if the other party is notified beforehand, such evidence will be damaged, lost, destroyed, or difficult to be adduced afterwards.⁸³⁶ Such a description seems to be modelled from the Anton Piller case.⁸³⁷

It is noteworthy that the purpose of this order is to preserve evidence in advance which allows intellectual property rights' owners to proceed with their cases efficiently. This purpose appears to conform to TRIPs.⁸³⁸ In respect of this purpose, the said evidence will be seized or attached for the quantity and time needed for the trial

⁸³³ Section 28.

⁸³⁴ *Ibid.*

⁸³⁵ Rule 20 para.2.

⁸³⁶ Rule 20 para.2.

⁸³⁷ *Anton Piller KG v. Manufacturing Processes Ltd.* [1976] 1 Ch.(C.A.) 55, per Lord Denning at p.61.

⁸³⁸ See TRIPs Articles 41 and 50 (1)(b).

process.⁸³⁹ In other words, this is not an order to deliver up the infringing goods.⁸⁴⁰ Furthermore, documents or materials which are required to be seized or attached as evidence, should be identified.⁸⁴¹

This concept, apparently, is not so strict in the practice of the 'Anton Piller' order. Typically, this is an order requiring a defendant to permit the search of premises and the seizure of documents.⁸⁴² In practice, the applicant could search and seize evidence relating to the infringement and within the scope of the order.⁸⁴³ It has been argued, however, that a plaintiff must not use the Anton Piller order as a means of finding out what charges he can make.⁸⁴⁴ Some means, therefore, should be devised to ensure that the plaintiff will not have *carte blanche* to search through the defendant's documents.⁸⁴⁵

5.4 THE STAGE OF GRANTING AN ORDER

Granting an order is the second stage of enforcement. This step depends primarily

⁸³⁹ Generally, the evidence will be kept until the end of the trial. However, a person who needs to use the said evidence may request the court to keep the copy or photograph of such evidence in lieu of the original. See the Civil Procedure Code Section 127 *bis*.

⁸⁴⁰ Indrambarya K, Deputy Chief Justice of the Central Intellectual Property and International Trade Court. He was interviewed at his office on June 6, 1998 at 10am. (Hereinafter Interview with J.Indrambarya.)

⁸⁴¹ According to the Civil Procedure Code Section 88 para.1, the party must submit a list of his evidence to the court before the hearing.

⁸⁴² See Sheridan. Chancery Procedure and Anton Piller Orders *op.cit.* . p.28. However, it should be noted that it is not a search warrant.

⁸⁴³ See *Columbia Pictures v. Robinson* [1986] F.S.R.367. It has been recommended, nevertheless, that a list of items seized during an execution should be handed to the defendant before their removal. See *The Future of the Anton Piller Procedure. A CLIP Seminar Report* (London : 1993) p.8.

⁸⁴⁴ See *Hytrac Conveyors Ltd. v. Conveyors International Ltd.* [1983] 1 W.L.R.44, per Lawton L.J. at p.47.

⁸⁴⁵ See *Universal Thermosensors v. Hibben* [1992] F.S.R.361.

on judicial discretion. Seemingly, intellectual property rights' owners concentrate on this stage more than the first and the final stages.⁸⁴⁶ The stage of granting an order should be examined in two aspects, *inter alia*, the process of granting an order, and the conditions for granting the said order.

5.4.1 THE PROCESS OF GRANTING AN ORDER

5.4.1.1 INTERIM INJUNCTIONS

For interim injunctions, the first step of this process is the way to grant an order. In other words, the way the court grants the order will be discussed. At present, it is suggested that a single judge is able to consider an application, and a statement to substantiate the cause of action, and subsequently, grant the order.⁸⁴⁷ This idea has been supported by the general power of the judge. Normally, a single judge is empowered to adjudicate and grant an order.⁸⁴⁸ This principle is manifested in Section 20 of the Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539.⁸⁴⁹

Additionally, the court is able to make an enquiry, if it is deemed appropriate. Subject to the general principle of the Civil procedure, which is applied *mutatis mutandis* to

⁸⁴⁶ Jitkuntivong C, a senior lawyer of Domnern Somgiat & Boonma Law Firm. He was interviewed at his office on April 23, 1998 at 4.30pm. (Hereinafter Interview with Jitkuntivong.)

⁸⁴⁷ Interview with J.Deepadung.

⁸⁴⁸ The Adjudicature Act Sections 21-22.

⁸⁴⁹ According to the Civil Procedure Code, it is believed that an injunction pending judgment can be granted by a single judge, subject to the stage of emergency. See Y. Galagam, The Handbook of the Civil Procedure Law (Bangkok : Nitibannakam, 1977) p.181, and Sataman P, The Civil Procedure Code Part IV (Bangkok : Srimuang Printing, 1981) p.74. These comments strongly support the principle that interim injunctions can be granted by a single judge.

criminal cases,⁸⁵⁰ the court can make an enquiry unless the law explicitly provides that the court must consider the said application by not making an enquiry.⁸⁵¹

Regarding interim injunctions, no such explicit restriction exists. On the contrary, it can be argued that Rule 19 implicitly supports the idea that such an enquiry is required.⁸⁵² As a result, the judge is empowered to decide whether to make an enquiry into the application for interim injunctions or not.

According to the aim of interim injunctions, the proper way of granting an order (by a single judge) seems to be without making an enquiry. Since these measures aim to protect intellectual property rights' owners as soon as possible, timing is a vital element. Delay could cause severe damage, for instance, where infringing goods are about to be circulated in the market. In addition, the statement to substantiate the cause of action is in force primarily to speed up the trial.⁸⁵³

However, it has been pointed out that such statements are rather new in the Thai legal system. At present, it is not clear whether the concept of the so called 'affidavit' statement will be totally adopted. In particular, there are no exact measures to deal with 'false' affidavit statements.⁸⁵⁴ Therefore, comments have been made on this issue that, in some cases, an enquiry is needed for the sake of justice.⁸⁵⁵

⁸⁵⁰ The Criminal Procedure Code Section 15.

⁸⁵¹ The Civil Procedure Code Section 21 (4).

⁸⁵² This Rule states that the provisions relating to *in camera* proceeding and hearing by means of video conference will be applied to this stage *mutatis mutandis*.

⁸⁵³ Interview with J.Deepadung.

⁸⁵⁴ Generally, a person who gives false witness will be punished according to the Penal Code Section 177. It is unlikely that this affidavit statement will be deemed as a witness in this sense. Up until now, it is not even clear whether a deponent will be placed on oath or not.

⁸⁵⁵ Interview with J.Ariyantaka.

Consequently, there may be another issue affecting whether the court decides to make an enquiry, that is whether this process is *ex parte*,⁸⁵⁶ or *inter parte*.⁸⁵⁷ In other words, whether the court should hear only an applicant's evidence, or should also take the other party's evidence into consideration. Literally, there is no explicit provision relating to the process of granting interim injunctions. Therefore, the provisions in the Civil Procedure Code will be applied *mutatis mutandis*.⁸⁵⁸ If there is no explicit provision that an application could be sought *ex parte*, the court is prohibited from granting such an application without giving an opportunity to the other party to oppose the said application.⁸⁵⁹ As a result, the court must give an opportunity to the prospective defendant to oppose the application before making a decision.

Apparently, this idea has been strongly opposed. It may be against the purpose of TRIPs which provides that the court should have the power to order prompt and effective provisional measures.⁸⁶⁰ The aim of interim injunctions is to prohibit or prevent the prospective defendant from committing infringing acts. These measures cannot be enforced efficiently if the said prospective defendant has been notified beforehand. Additionally, the process will be delayed while the prospective defendant is notified. In practice, it can take over fifteen days for the notification to take effect.⁸⁶¹

⁸⁵⁶ Generally, it means an application made by one party without notice to and in the absence of the other. See Walker D. *op.cit.* p.444.

⁸⁵⁷ Here, this word defines an application which the other party has to be notified.

⁸⁵⁸ Section 26 of the Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539.

⁸⁵⁹ The Civil Procedure Code Section 21 (2). This provision also applies *mutatis mutandis* to criminal cases, according to the Criminal Procedure Code Section 15.

⁸⁶⁰ TRIPs Article 50 (1).

⁸⁶¹ The Civil Procedure Code Section 79 para.2.

Moreover, it has been argued that interim injunctions, in Thai law, have been exclusively designed for intellectual property rights protection.⁸⁶² Consequently, it is argued that these measures do not fall under the Civil Procedure Code.⁸⁶³ Interim injunctions, on the contrary, may be added to the Code in due course, and will become available for every types of case, due to their effectiveness.⁸⁶⁴ Thus, it is argued that these measures should be enforced by reference to their own purpose. Since the Rules for Intellectual Property and International Trade Cases B.E.2540 merely require that the prospective defendant must be notified of the order, in cases where the court grants the order, without delay, these measures are not expected to be sought *inter parte*. Additionally, it has been suggested that, by their nature, interim injunctions as such are urgent measures, and therefore that no specific provisions are needed to indicate that these measures should be sought *ex parte*.⁸⁶⁵

When compared with TRIPs, it seems true that interim injunctions should be sought *ex parte*. TRIPs states that the court is empowered to adopt provisional measures *inaudita altera parte* where appropriate, particularly where any delay is likely to cause 'irreparable harm' to an applicant.⁸⁶⁶ The condition of 'irreparable harm' is mandatory in seeking interim injunctions.⁸⁶⁷ Thus, interim injunctions should be sought *inaudita altera parte* in accordance with TRIPs.

⁸⁶² Interview with Rattanasuwan.

⁸⁶³ Interview with J.Ariyantaka.

⁸⁶⁴ Interview with J.Indrambarya.

⁸⁶⁵ Interview with J.Ariyantaka.

⁸⁶⁶ TRIPs Article 50 (2).

⁸⁶⁷ The Rules for Intellectual Property and International Trade Cases B.E.2540 Rule 13 (2).

The best solution for this issue is to stipulate explicitly that interim injunctions should be sought *ex parte*. For instance, the Arrest of Seagoing Ships Act B.E.2534 clearly states that the order will be sought and inquired *ex parte*.⁸⁶⁸ It is not a difficult way to solve this problem since it could be simply done according to the court's rules.⁸⁶⁹ The other way is to wait for the Supreme Court's decision. This solution, however, may be uncertain and it may take some time. Nevertheless, it would still be better than leaving this issue obscure and allowing the interpretation to be made variously.

The said interpretation may cause some controversy, particularly when it has been made on the basis that interim injunctions are special measures, separate from the Civil Procedure Code. The application for interim injunctions, according to the above argument, will not be regarded as an application as provided in Section 21 of the Civil Procedure Code. However, it has been suggested that the provision concerning the court's fees will apply *mutatis mutandis* to interim injunctions.⁸⁷⁰ The issue of an enquiry is another controversy. The Rules for Intellectual property and International Trade Cases B.E.2540 state that the court has to make an enquiry when the prospective defendant requests to repeal or modify interim injunctions.⁸⁷¹ It is still ambiguous whether a single judge or the whole quorum conducts the enquiry.⁸⁷² In general, a

⁸⁶⁸ Sections 7 para.1, and 8 para.1.

⁸⁶⁹ Interview with J.Ariyanantaka.

⁸⁷⁰ It is believed that the court fees of 20 Baht (.50 Pound) is required for the issue, according to Table II (3) attached the Civil Procedure Code.

⁸⁷¹ Rule 16 para.2.

⁸⁷² According to Section 19 of the Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539, at least two judges and one associate judge will form a quorum for the adjudication.

single judge could adjudicate and grant an order.⁸⁷³ The Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539, however, provides that a single judge in the Intellectual Property and International Trade Court is empowered to conduct any proceedings or issue any orders, apart from adjudicating and passing judgment.⁸⁷⁴ The term 'adjudication' includes any process in hearing the case in chamber.⁸⁷⁵ As a result, a quorum may be required when making the enquiry, notwithstanding the single judge is still empowered to grant the order. Again, there may be some suggestions that interim injunctions are special measures, subsequently they should be conducted in a different way from that provided in the Civil Procedure Code.⁸⁷⁶ This interpretation will accept that the single judge can adjudicate the application.

5.4.1.2 AN ORDER TO PRESERVE EVIDENCE IN ADVANCE

In respect of an order to preserve evidence in advance, there is less controversy. In general, the law provides that upon receipt of the application the court has to summon the applicant, the opposing party, or the third party, before making a decision.⁸⁷⁷ In case of emergency, the law states that the applicant may file a motion to the effect so that the court may issue an order without delay.⁸⁷⁸ Even though the law does not

⁸⁷³ The Adjudicature Act Sections 21-22.

⁸⁷⁴ Section 20.

⁸⁷⁵ The Civil Procedure Code Section 1 (9).

⁸⁷⁶ Interview with J.Ariyanantaka.

⁸⁷⁷ The Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539 Section 28.

⁸⁷⁸ The Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539 Section 29.

explicitly state so, it appears that the application can be sought *ex parte*. This is because the wording is modelled from the Civil Procedure Code.⁸⁷⁹ The Supreme Court has already decided that since the law requires the court to adjudicate the application 'without delay', the court can make an enquiry on the date the application was submitted. Therefore, the court did not need to notify the other party and testify to the other party's evidence.⁸⁸⁰

It should be noted that the Civil Procedure Code provides that an order to preserve evidence in advance can be sought *ex parte* in ordinary cases, subject to the fact that the opposing party or the third party does not have his domicile in the Kingdom and has not yet come into the case.⁸⁸¹ In addition, it is noteworthy that the order to preserve evidence in advance seems to conform to TRIPs. In some cases, the said order will be sought *inter parte*, while it could be sought *ex parte* where there is a demonstrable risk of evidence being destroyed.⁸⁸²

5.4.2 THE CONDITIONS FOR GRANTING AN ORDER

5.4.2.1 INTERIM INJUNCTIONS

In the light of interim injunctions, there are four major elements in considering an application, *inter alia*,

⁸⁷⁹ See the Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539 Sections 26 and 29 para.2, and the Civil Procedure Code Section 267.

⁸⁸⁰ The Supreme Court's judgment no.61/2526 (1983). See also the Supreme Court's judgment no.1509/2514 (1971), and P. Wichitcholchai, *The Handbook of the Civil Procedure Code : Injunction Pending Judgment* (Bangkok : Gaingrow, 1995) p.87. The Central Intellectual Property and International Trade Court has already decided to follow this precedent. See the Court's order no.1/2542 (1999).

⁸⁸¹ The Civil Procedure Code Section 101 para.3.

⁸⁸² TRIPs Article 50 (1) (b), (2).

1. reasonable ground for the application and the filing of the application,⁸⁸³
2. sufficient reasons for the court to grant the said application,⁸⁸⁴
3. the condition of 'irreparable harm',⁸⁸⁵
4. the condition of 'balance of convenience',⁸⁸⁶

5.4.2.1.1 REASONABLE GROUND FOR THE APPLICATION

The first element has already been examined, in the stage of applying for interim injunctions. Subject to Rule 12, there should be grounds to substantiate the application, *inter alia* , whether an applicant is the right holder, and his right is being infringed or such infringement is imminent.⁸⁸⁷ In the case of reasonable ground for filing of the application, there is no explicit indication how the court considers this element. It is apparently up to judicial discretion and the circumstances of the individual case.

Timing to file the application is an example. If the applicant submits his application too soon, the said application may be dismissed on the basis that there is no reasonable ground for the filing of the application,⁸⁸⁸ for instance, when interim injunctions are

⁸⁸³ Rule 13 (1).

⁸⁸⁴ *Ibid* .

⁸⁸⁵ Rule 13 (2).

⁸⁸⁶ Rule 13 para.2.

⁸⁸⁷ See TRIPs Article 50 (3).

⁸⁸⁸ Tingsamit V, the Assistant Judge in the Supreme Court working as the Judge in the Central Intellectual Property and International Trade Court. He was interviewed at his office on May 27, 1998 at 13pm. (Hereinafter Interview with J. Tingsamit.)

sought to prevent the prospective defendant from circulating goods in the market, and the said goods are still abroad.⁸⁸⁹

At the same time, it can be anticipated that the application will be dismissed if protection is sought too late. For example, if the goods have already been circulated in the market, while interim injunctions are being sought. This opinion is supported by the equitable concept that delay might prejudice equity.⁸⁹⁰

5.4.2.1.2 SUFFICIENT REASON TO GRANT AN ORDER

It is apparently up to judicial discretion to decide whether there are sufficient reasons to grant the order. In other words, the judge will decide whether it is adequate to remedy the applicant by these measures. This element is so flexible that the court could dismiss any application simply on the basis that there is lack of sufficient reasons to substantiate the said applications. For instance, it may be ruled that there is insufficient reason to grant the order unless the prospective defendant is identified.⁸⁹¹ Another example is when interim injunctions have to be enforced outside the territorial jurisdiction. The judge may consider that it is hard to enforce the order, and consequently, reject the application.⁸⁹² Additionally, it seems needless to grant the order if an interim injunction is sought in the last moment before the term of the intellectual property right has expired (without renewal of the said term). This right will no longer be protected when it becomes public domain.

⁸⁸⁹ The application may be dismissed because there is no sufficient reason for the court to grant the order. The court may consider that the applicant should appropriately file the case, instead of seeking an injunction.

⁸⁹⁰ See Parker. *op.cit.* p.33.

⁸⁹¹ This issue has already been discussed above in the stage of applying for an order.

⁸⁹² For example, see Norris v. Chambers (1861) 3 De.G.F.& J.583.

As discussed above, this element is likely to be rather flexible. It is accepted that the major aim of intellectual property law is to protect intellectual property rights, and provisional measures are enforced in order to refrain others from infringing such rights. Therefore, the process of adducing evidence (to substantiate the application) should not be too restricted. This is because intellectual property rights infringement seems more complicated than other types of infringement, such as theft.⁸⁹³ Strong requirements of evidence in such a short period of time, may, on the contrary, become an obstacle for the applicant to gain access to justice.

Nevertheless, the court has to balance this situation properly. The said protection should not be easily granted since interim injunctions are regarded as draconian measures. These measures seem like criminal sanctions because they affect a person's right or liberty. In civil cases, the prospective defendant, sometimes, does not deserve to be treated as an offender. Moreover, the third party may be unnecessarily prejudiced by the broad enforcement of the said measures.

5.4.2.1.3 THE CONDITION OF 'IRREPARABLE HARM'

This is the third element to be examined. According to Rule 13 (2), the court will grant interim injunctions only if it is satisfied that damage could not be restituted by monetary measures or other forms of indemnity. In addition, interim injunctions could be sought, subject to this condition, if the prospective defendant is not in a position to compensate the applicant for his damage, or it might be difficult to enforce the judgment against the

⁸⁹³ J. Phansumrit, "Economic Crime and Effective Countermeasures Against It in Thailand," UNAFEL: Report and Resource Material Series 47(1995) p.196.

prospective defendant afterwards.⁸⁹⁴ These additional clauses, apparently, extend the scope of the concept of 'irreparable harm' in a manner that the court could provide broad protection for intellectual property rights' owners.

Arguably, the concept of 'irreparable harm' is regarded as complicated and controversial even in common law countries.⁸⁹⁵ It is, therefore, difficult for Thailand, as a civil law country, to understand this concept clearly; in particular certain legal aspects of the purpose of this condition, and the meaning of the condition as such, present difficulties.

It has been argued in many countries that the concept of 'irreparable harm' exists primarily to distinguish the difference between legal and equitable remedies.⁸⁹⁶ According to this argument, civil remedies can be sought from two sources, namely, law and equity. This idea has had a strong influence among common law countries, England in particular, for a long time.⁸⁹⁷ Historically, an injured person could only seek civil remedies in the form of damages, due to the law. Later, damages came to be regarded as inadequate remedies in several areas, *inter alia*, nuisance.⁸⁹⁸ Equity, therefore, was created in order to support legal remedies. In respect of this intention, equity has been enforced only when legal remedies, i.e. damages, are considered inadequate.⁸⁹⁹

⁸⁹⁴ The Rules for Intellectual Property and International Trade Cases B.E.2540 Rule 13 (2).

⁸⁹⁵ It has been suggested that the absence of a showing of irreparable harm is, in itself, sufficient grounds upon which to deny a preliminary injunction. See *Harris v. US* 745 F.2d.(8th Cir. 1984) 536.

⁸⁹⁶ For this argument, see, for instance, E. Gabbay, "All the King's Horses - Irreparable Harm in Trade Secret Litigation," *Fordham Law Review* 59 (1984) p.816.

⁸⁹⁷ See J. Martin, (ed.), *Hanbury & Modern Equity* (London : Sweet & Maxwell, 1993) p.6.

⁸⁹⁸ *Sevenoaks District Council v. Patullo & Vinson* [1984] Ch.211.

⁸⁹⁹ It is under the maxim that "Equity follows the law". See *Wilson v. Northampton and Banbury Function Railway Co.* (1874)9 Ch.App.275. In *London & Blackwall Ry.Co. v. Cross* (1886) 31 Ch.D.354 (C.A.), 'The very first principle of

The above idea has been greatly disputed. This is because it is based on historical reasons, subsequently, cannot underlie the use of interim injunctions at present. Even in the English legal system, the dichotomy between law and equity has been weakened.⁹⁰⁰ In current times, interim injunctions, in particular, have been regarded as legal remedies, rather than equitable ones.⁹⁰¹

Consequently, it has been argued that the concept of 'irreparable harm' is stated not for the purpose of historical reasons, but for administrative purposes. The process of considering and granting injunctions is an additional process to the normal trial, and is, thus, burdensome.⁹⁰² The said process has been argued as costly and time consuming. Therefore, a person should not be permitted to apply for an injunction easily. In other words, such a process should be applied for only when it is necessary. The condition of 'irreparable harm' has, therefore, been enforced in order to screen unnecessary applications.

Another argument concerns the legal purpose. According to this opinion, injunctions should be restrictively granted since they affect a person's rights or liberty. Whereas damages is a remedy related to the defendant's property, injunctions can be enforced upon the defendant's rights or liberty. For instance, in common law countries, a defendant who disobeys the court's order may be sanctioned for contempt of court.⁹⁰³

injunction law is that *prima facie* you do not obtain injunctions to restrain actionable wrongs, for which damages are the proper remedy', per Lindley L.J. at 369.

⁹⁰⁰ According to the Adjudicature Acts 1873 and 1875, and the Supreme Court of Judicature Act, injunctions could be sought from any court.

⁹⁰¹ TRIPs Article 50.

⁹⁰² See R. Schwartze, "The Case for Specific Performance," *Yale Law Journal* 89 (1979) p.294.

⁹⁰³ *Anton Piller KG v. Manufacturing Processes Ltd.* [1976] Ch.55, per Lord Denning at p.60.

In Thailand, as a civil law country, a defendant who refuses the court's order may be arrested and detained.⁹⁰⁴ Therefore, injunctions should not be sought easily.⁹⁰⁵

Regarding this opinion, the prospective defendant is likely to be safeguarded. It may cause the rights of intellectual property rights' owners to be infringed to a certain degree without protection. It is because the prospective defendant may be treated more severely than he should be, if the court decides to provide intellectual property rights' owners absolutely protection. The idea of providing safeguard for the prospective defendant seems to be supported by the condition of 'balance of convenience'. This may also be supported by the fact that several safeguards have been explicitly provided in provisional measures.⁹⁰⁶

Nevertheless, it is likely that the condition of 'irreparable harm' is contained in TRIPs in order to protect intellectual property rights' owners. This is the condition for the court to adopt provisional measures *inaudita altera parte*.⁹⁰⁷ This idea appears to conform to the purpose of intellectual property law and provisional measures as such.⁹⁰⁸

There is no clear evidence to show what the purpose of interim injunctions in Thailand is.⁹⁰⁹ The historical reason is unlikely to be the real purpose since there is no explicit

⁹⁰⁴ See the Civil Procedure Code Sections 259, 297, 298.

⁹⁰⁵ It has been reported that such injunctions have been opposed by several countries on the basis of human rights. See *The Future of the Anton Piller Procedure*. *op.cit.* p.1.

⁹⁰⁶ See TRIPs Article 50.

⁹⁰⁷ TRIPs Article 50 (2).

⁹⁰⁸ It has been commented that the use of preliminary injunctions in copyright reflects an intention to preserve the interests protected by the grant of copyright. See L. Mikolonis, "Preliminary Injunctions, Copyright, and the First Amendment : Does the Presumption of Irreparable Harm Infringe the Speech Interests of Copyright Defendants?," *Oregon Law Review* 65(1986) p.768.

⁹⁰⁹ The aim of interim injunctive measures has not been discussed in the meetings of the Committee to scrutinize the Plan to Establish the Intellectual Property and International Trade Court.

separation of law and equity in the Thai legal system.⁹¹⁰ If it is agreed that provisional measures have been introduced to Thai law in order to comply with TRIPs, interim injunctions may be enforced to protect intellectual property rights' owners. This is because intellectual property right's owners should be protected from the early stage and infringers should not be permitted to 'buy' such injustice by paying compensation. Moreover, the additional clauses of "... or the prospective defendant is not in a position to compensate the applicant for his damage, or it might be difficult to enforce the judgment against the prospective defendant afterwards" have been included, apparently, to further extend protection for intellectual property rights' owners. As a result, this condition, also the additional clauses, can be used as a device to indicate whether interim injunctions are appropriate remedies for intellectual property rights' owners.

However, the court has to deal with this condition carefully. The purpose of protecting private interest sometimes conflicts with the purpose of protecting public interest, *inter alia*, the principle of fair use. Seemingly, the public interest is greater, and outweighs the private one.⁹¹¹ Therefore, the condition of 'irreparable harm' should be interpreted carefully, not only to safeguard the prospective defendant, but also to protect society as a whole.

It would appear that the purpose of protecting intellectual property rights' owners could also be applied to criminal cases. This purpose is not against the general principle of criminal law,⁹¹² since the law, at this stage, merely aims to provide

⁹¹⁰ It should be noted that, in Thailand, all remedial measures have been enforced in the form of legal remedies.

⁹¹¹ See *Keep Thompson Governor Committee v. Citizens for Gallen Committee* 457 F.Supp.(D.N.H.1978) 957.

⁹¹² According to the Criminal Procedures Code Section 227 para.1, the law aims at finding out whether the offence has been committed, and an accused committed it.

intellectual property rights' owners temporary remedies. It may be burdensome for the applicant to prove his case seriously at this stage.

The meaning of 'irreparable harm' as such is also controversial. It is not explicit, at present, what it means in Thai law. Currently, this famous phrase is defined as damage which could not be restituted by monetary measures or other forms of indemnity.⁹¹³ Such a definition is still ambiguous. This may refer to a situation where the injury cannot be measured, compensated, restored, or repaired.⁹¹⁴ Furthermore, if it is accepted that one of the main purposes of interim injunctions is to preserve *status quo*, timing may be regarded as one of the crucial factors of this condition.⁹¹⁵ However, since this condition is rather new, it may be broadly interpreted and overstated like 'loss of competitive advantage worth [many thousands of dollars]',⁹¹⁶ or 'loss of customer goodwill'.⁹¹⁷ Additionally, it may go further as 'injuries that cannot be prevented by the plaintiff',⁹¹⁸ or 'there is a presumption of irreparable harm when "a likelihood of probable success on the merits" has been stated'.⁹¹⁹

⁹¹³ Rule 13 (1).

⁹¹⁴ See D. Rendleman, "The Inadequate Remedy at Law Prerequisite for an Injunction," University of Florida Law Review 33(1981) p.346.

⁹¹⁵ It has been suggested that "irreparable harm requires circumstances where the effect of the plaintiff's injury combined with the delays inherent in the administration of justice cannot be compensated for or overcome by an award of money at trial". P. Perell, "The Interlocutory Injunction and Irreparable Harm," Canadian Bar Review 68 (1989) p.558.

⁹¹⁶ *Travenol Laboratories Inc. v. Turner* (1976) 30 N.C.App.686.

⁹¹⁷ *American Can Co. v. Mansuknoni* (1982) 216 U.S.P.Q.(BNA)1094.

⁹¹⁸ See T. Spelling, Injunction and Other Extraordinary Remedies (London : Rose Publishing, 1901) p.19.

⁹¹⁹ See *Triangle Publications Inc. v. Sports Eye Inc.* 415 F.Supp. 682 (E.D.Pa.1976).

Furthermore, several phrases have been used for this condition, *inter alia*, irreparable damages, inadequacy of damages.⁹²⁰ Seemingly, these phrases have similar meanings.⁹²¹ However, there is a strong argument that such phrases may have been inappropriately interpreted.⁹²² Instead of the literal meaning that injunctions should be granted only when damages cannot be calculated, injunctions should be in force in circumstances where damages are regarded as an inappropriate remedy.⁹²³ This interpretation is likely to be more suitable in considering the application.⁹²⁴ Furthermore, it may end the conflict which occurs when 'irreparable harm' is reversely interpreted to mean that intellectual property rights' owners cannot seek injunctions if the harm is still reparable.⁹²⁵

5.4.2.1.4 THE CONDITION OF 'BALANCE OF CONVENIENCE'

This element is provided for in the Rules for Intellectual Property and International Trade Cases B.E.2540.⁹²⁶ The purpose of this condition is (for the court) to weigh the applicant's damage against the prospective defendant's burden when the court decides

⁹²⁰ J. Leubsdorf, "The Standard for Preliminary Injunctions," *Harvard Law Review* 91(1978) p.551.

⁹²¹ D. Laycock, *The Death of the Irreparable Injury Rule* (Oxford: Oxford University Press, 1991) p.8.

⁹²² *Express Newspapers Ltd. v. KEYS* [1980] I.R.L.R. 247.

⁹²³ *Smith v. Smith* (1875) L.R.20 Eq.500, ...the granting of a [mandatory] injunction did not mean that the injury could not be compensated, but that 'if it were not granted, the defendant would be allowed practically to deprive the plaintiff of the enjoyment of his property if he would give him a price for it', per Jessel M.R. at p.504.

⁹²⁴ This has been regarded as a non - hierarchical conception of remedies which permits the court to choose either damages or interim injunctions to remedy an injured person. See O. Fiss, *The Civil Rights Injunction* (Bloomington: 1978) p.91.

⁹²⁵ It has been suggested that the question of "Are damages an adequate remedy?" might be rewritten as "Is it just, in all the circumstances, that a plaintiff should be confined to his remedy in damages?". See *Evans Marshall & Co.Ltd. v. Bertola S.A.* [1973] 1 W.L.R. (C.A.) per Sachs L.J. at p.379.

⁹²⁶ Rule 13 para.2.

to grant interim injunctions. This condition has been illustrated in the famous case of the American Cyanamid case.⁹²⁷ As a result, it is up to judicial discretion to protect intellectual property rights' owners as long as the prospective defendant will not suffer more than he should.

The concept of this condition is not novel in the Thai legal system. For an injunction pending judgment, the Civil Procedure Code also provides that, in the case of emergency, the court should grant the measures which affect the parties' rights only in necessary circumstances.⁹²⁸ This concept might be applied *mutatis mutandis* in the concept of 'balance of convenience'.

The concept of 'balance of convenience' may be interpreted and enforced against the intention to protect intellectual property rights' owners. Subject to this concept, it appears that, in several circumstances, intellectual property rights' owners may not achieve absolute protection.⁹²⁹ Additionally, they may not be returned to the position that existed before the infringement was committed.

It should be noted that absolute protection, also the idea to bring an injured person back to the position he was in before such an infringement occurred, is hardly possible in practice. In theory, it seems possible to protect a person absolutely from infringement. However, when such an infringement has occurred, there is no way to bring the injured person back to his former position, or even to remedy him. Several remedial measures are needed just to satisfy the injured person. Therefore, if such remedial measures are

⁹²⁷ American Cyanamid Co. v. Ethicon Ltd. [1975] AC 396.

⁹²⁸ Section 268. This Section was amended in 1995 by the Amendment Act for the Civil Procedure Code (No.15) B.E.2538, Section 7.

⁹²⁹ This issue has been mentioned in D. Schoenbrod, "The Measure of an Injunction : A Principle to Replace Balancing the Equities and Tailoring the Remedy," *Minnesota Law Review* 72(1988) pp.627-695.

enforced to reach the ideal aim, there may be a problem in regarding the terms of enforcement. Arguably, it is not possible to achieve such an aim unless remedial measures are enforced to a very high standard.⁹³⁰ As a result, a prospective defendant will probably be overtreated and suffer more than he should.

It is true that a person must be responsible for his wrongdoing. However, the person should not be forced to accept an obligation disproportionate to his offence. If he is permitted to do so, the rights holder may be compensated more than he should be. Even though intellectual property law aims to protect intellectual property rights' owners, the concept of fairness is still available to ensure that society, as a whole, will be equally protected.⁹³¹

It seems that, according to the Rules for Intellectual Property and International Trade Cases *B.E.2540*, the court considers an application by using the 'multi-requisite' approach. This approach is described as the requirement that certain elements exist before the court grants the order.⁹³² The conditions for granting the order are mandatory. However, there is no indication that the judge has to consider such conditions in sequence. As a result, the judge may consider the condition of 'balance of convenience', for instance, at the first step. Thus, the court may not follow the exact sequence stated in the 'American Cyanamid' case, even though this case was commented on during the meeting of the Committee.⁹³³

⁹³⁰ See Schoenbrod. *op.cit.* p.678.

⁹³¹ See TRIPs Part III, Section 2, Article 42.

⁹³² See P. Carlson, "Granting an Interlocutory Injunction : What is the Test?," *Manitoba Law Journal* 12(1982) p.112.

⁹³³ The Report of the Committee Set Up to Scrutinize the Plan to Establish the Intellectual Property and International Trade Court, 8/38, June 1995, pp 15,17. This sequence has not been strictly followed in English cases too. See *Hubbard v. Pitt* [1976] QB 142 (C.A.).

5.4.2.2 AN ORDER TO PRESERVE EVIDENCE IN ADVANCE

The conditions for granting this order are not explicitly stated as are those for interim injunctions. It is likely that the court will scrutinize whether there is reasonable ground for such an application, and whether there are also sufficient reasons for the court to grant the application. It should be noted that, since the conditions are not explicitly stated, the court may use the 'multi-factor' approach in considering this application.⁹³⁴ In respect of this approach, the judge will consider all the facts he deems relevant before making his decision.

5.5 THE STAGE OF EXECUTING AN ORDER

This stage is vital for intellectual property rights' owners too. One should not assume that a plaintiff has won when he has merely achieved a judgment. In other words, he cannot claim that he has really won the case unless the order is efficiently executed.

5.5.1 INTERIM INJUNCTIONS

For interim injunctions, the order will be effective since it has been granted.⁹³⁵ The order, both civil and criminal cases, will prohibit or refrain the prospective defendant from committing the infringement. The indirect effectiveness of this order is that the order may be informed immediately to the related persons, such as the port authorities.⁹³⁶ Consequently, the applicant has to institute his case within fifteen days since interim

⁹³⁴ See Carlson. *op.cit.* p.113.

⁹³⁵ Rule 14 para.2.

⁹³⁶ It could be analogous with Sections 257 para.4 and 11 of the Civil Procedure Code and the Arrest of Seagoing Ships Act B.E.2534 respectively.

injunctions have been granted.⁹³⁷ If the case is filed within that period, the order will continue to be in force.⁹³⁸ These provisions would appear to conform to TRIPs.⁹³⁹

Normally, a court order will be effective only when the person on whom the order will be effected has been notified.⁹⁴⁰ This results in delaying the proceedings. It may prejudice the aim of interim injunctions. The law, therefore, provides that such an order binds the prospective defendant immediately, even though he has not yet been notified of the order.⁹⁴¹ This will guarantee that interim injunctions are efficiently enforced, subsequently intellectual property rights' owners are adequately protected.

The procedure for executing an order is not specifically stated, therefore, the Civil Procedure Code will be applied *mutatis mutandis*.⁹⁴² To some extent, interim injunctions share similar effectiveness to those which are executed in common law countries on the basis of contempt of court. If the prospective defendant neglects the court's order, the applicant can immediately submit an application to arrest and detain the prospective defendant until he obeys the court order.⁹⁴³ This order is sought *ex parte*.⁹⁴⁴

However, it takes time before the prospective defendant is forced to comply with the

⁹³⁷ Rule 17.

⁹³⁸ Rule 18.

⁹³⁹ See TRIPs Article 50 (6).

⁹⁴⁰ The order could also be effective when the lawyer of the said defendant is notified. See the Civil Procedure Code Section 75.

⁹⁴¹ Rule 14 para.2.

⁹⁴² Sections 259, 297-300.

⁹⁴³ Section 300. The prospective defendant may be released on bail. Moreover, he must not be detained, each time for a period exceeding six months from the date of arrest or detention.

⁹⁴⁴ Section 297.

order. In practice, these remedial measures may not be effective primarily because of inappropriate execution.⁹⁴⁵ From the start, an intellectual property rights' owner has to apply for the order to arrest and detain the prospective defendant.⁹⁴⁶ This order will be sought *ex parte*.⁹⁴⁷ It should be noted that the court cannot grant the order to arrest and detain the prospective defendant unless the said order has been sought.⁹⁴⁸ Then, the court will scrutinize the applicant's evidence. The order must not be granted unless it is certain that the prospective defendant is *bona fide* able to comply with the order but refuses to do so.⁹⁴⁹ In addition, there is no other measure to prosecute the prospective defendant.⁹⁵⁰

Subsequently, the prospective defendant will be summoned to the court.⁹⁵¹ Unless there is evidence that the prospective defendant has been legally notified, the summons has to be delivered again.⁹⁵² If the prospective defendant refuses to come to court without any appropriate reason, the court can grant a warrant to arrest him.⁹⁵³ Additionally, if he comes to court, however fails to provide any reasonable grounds why

⁹⁴⁵ Mangklatanakul P, the Baker & McKenzie's lawyer. He was interviewed on May 12, 1998 at 12pm. (Hereinafter Interview with Mangklatanakul.)

⁹⁴⁶ The Civil Procedure Code Section 297 para.1.

⁹⁴⁷ The Civil Procedure Code Sections 21 (3), 297 para.1.

⁹⁴⁸ There has been one case where the defendant came to the court, due to the summons, and was arrested under the court's order. However, the plaintiff did not request such an order. The Supreme Court decided that it was against the law. See the Supreme Court's judgment no.2523/2521 (1978).

⁹⁴⁹ The Civil Procedure Code Section 297 (1). See the Supreme Court's judgments no.1384/2510 (1967), 809/2516 (1973), and 1703/2525 (1982).

⁹⁵⁰ The Civil Procedure Code Section 297 (2).

⁹⁵¹ The Civil Procedure Code Section 298.

⁹⁵² In this case, it will waste the time in notifying the prospective defendant.

⁹⁵³ The Civil Procedure Code Section 298 para.2.

he has not been able to comply with the court's order, he may be detained.⁹⁵⁴ According to the above process, it is likely that an enquiry will be required to ascertain whether the prospective defendant should be treated under these severe measures.⁹⁵⁵

It is noteworthy that such an order can be sought only to arrest and detain the prospective defendant *per se*. An intellectual property rights' owner cannot request the court to arrest and detain other persons, even though they are regarded as conspirators.⁹⁵⁶ In practice, interim injunctions could be sought for these persons as the co-prospective defendants.

Further rules regarding interim injunctions concern safeguards for the prospective defendant. First of all, if the application is dismissed, the order will be final.⁹⁵⁷ As a result, the applicant cannot appeal such an order, neither the questions of fact nor the law.⁹⁵⁸

Moreover, the law requires that the prospective defendant must be notified, if the order is granted, without delay.⁹⁵⁹ This will guarantee that the prospective defendant is

⁹⁵⁴ *Ibid*.

⁹⁵⁵ See the Supreme Court's judgment no.560/2519 (1976).

⁹⁵⁶ The Supreme Court's judgment no.1459/2514 (1971). Even though the person had been referred to as a dependant during the enquiry, he was not the defendant as such and could not be bound directly by the judgment. Therefore, the court could not grant the order to arrest and detain him, when the defendant failed to comply with the judgment.

⁹⁵⁷ Rule 13 para.3.

⁹⁵⁸ See the Supreme Court's judgments no.407/2519 (1976), 2728/2526 (1983). However, there is no explicit provision to bar the applicant from applying for the order again. The court may dismiss it if there is no other reason to support a new application.

⁹⁵⁹ Rule 14 para.1.

informed as soon as possible. This provision apparently conforms to TRIPs.⁹⁶⁰

Since this issue is not explicitly provided, the Civil Procedure Code will be applied *mutatis mutandis*. As a result, the court officer will forward the order to the prospective defendant,⁹⁶¹ and it must be delivered as soon as possible.⁹⁶² The court officer may request the applicant, or the person whom the applicant deems appropriate, to accompany him to identify the prospective defendant.⁹⁶³ This allows the applicant to be present when the order is executed. It seems acceptable since TRIPs implicitly permits members to do so.⁹⁶⁴

The other safeguard for the prospective defendant is security. The law provides that

In cases where the court grants an application under Rule 13, taking into account any damages that the prospective defendant might incur, the court shall order the person filing the application to provide security for such damage in the amount, within the period and under the conditions, the court deems appropriate.⁹⁶⁵

The wording of this provision, however, appears to be different from that contained in the Civil Procedure Code.⁹⁶⁶ The latter states that before granting the order, the court may require the plaintiff to provide security, as the court deems appropriate, for any

⁹⁶⁰ TRIPs Article 50 (4) provides that "... the parties affected shall be given notice, without delay after the execution of the measures at the latest".

⁹⁶¹ The Civil Procedure Code Section 70.

⁹⁶² The Civil Procedure Code Section 73 para.1.

⁹⁶³ The Civil Procedure Code Section 73 para.1.

⁹⁶⁴ See TRIPs Article 50 (5). It stipulates that the applicant may be required to supply information necessary for the identification of the goods concerned by the authority that will execute the provisional measures.

⁹⁶⁵ Rule 15.

⁹⁶⁶ Section 257.

damage that the defendant might incur.⁹⁶⁷ Therefore, it seems that, in case of interim injunctions, security may be required after the order has already been granted. The phrase '... within the period ... the court deems appropriate' could be raised to support this opinion.

There is a problem when the applicant refuses to provide security. This situation could happen particularly when the applicant has already satisfied the effect of interim injunctions. Arguably, the order may provide bargaining power for the applicant when he later negotiates with the prospective defendant.⁹⁶⁸ In Thailand, it appears that the applicant will not be sanctioned for contempt of court, when he refuses to provide security. The probable way for the court to act is to revoke the order.⁹⁶⁹

Nevertheless, the above argument appears to be an exceptional case. In general, intellectual property rights' owners are likely to apply for interim injunctions in *bona fide*. When the judge examines the application and decides to require a security, he could also consider the applicant as such. If he deems it appropriate, he may specify any conditions.⁹⁷⁰

Furthermore, security may be regarded as a pre-requisite condition in granting interim injunctions.⁹⁷¹ In other words, security will be required before interim injunctions is granted. This process will be similar to that in the Civil Procedure Code.

⁹⁶⁷ Section 257 para.5.

⁹⁶⁸ Interview with Chantarasak.

⁹⁶⁹ See the Arrest Seagoing Ships Act B.E.2534 Section 8.

⁹⁷⁰ Rule 15.

⁹⁷¹ Manomai-Udom S, Senior Judge in the Central Intellectual Property and International Trade Court. He was interviewed at his office on May 21, 1998. (Hereinafter Interview with J.Manomai-Udom.)

Another safeguard is the right to revoke or modify the order. This safeguard is also stated in TRIPs.⁹⁷² After interim injunctions have been granted, the prospective defendant is empowered to file an application requesting the court to repeal or modify the said interim injunctions.⁹⁷³ If the court grants the order to repeal or modify the interim injunctions, the said order will be final.⁹⁷⁴

In addition to this privilege, the prospective defendant can also apply for compensation.⁹⁷⁵ According to the Rules for Intellectual Property and International Trade cases B.E.2540, the prospective defendant can apply for the said compensation together with an application for revoking or modifying interim injunctions, or within thirty days from the date on which the court granted the order.⁹⁷⁶ After making an enquiry, the court may order the interim injunctions' applicant to compensate the prospective defendant, to the amount the court deems appropriate.⁹⁷⁷ The court would order such compensation if the court finds that interim injunctions were granted due to the court's misunderstanding that there has been ground for taking action against the prospective defendant, or sufficient reason to grant such interim injunctions.⁹⁷⁸ Such a misunderstanding must be caused by the fault or negligence of the interim injunctions' applicant.⁹⁷⁹ In addition, the prospective defendant could seek compensation if the

⁹⁷² TRIPs Article 50 (4).

⁹⁷³ Rule 16 para.1.

⁹⁷⁴ *Ibid* .

⁹⁷⁵ According to TRIPs Article 50 (7), the court should be empowered to order the applicant to provide the prospective defendant appropriate compensation for any injury caused by provisional measures.

⁹⁷⁶ Rule 16 para.2.

⁹⁷⁷ *Ibid* .

⁹⁷⁸ *Ibid* .

⁹⁷⁹ *Ibid* .

applicant does not institute his case within fifteen days from the date on which the interim injunctions were granted, or within the period prescribed by the court.⁹⁸⁰

If the said interim injunctions' applicant fails to comply with the court order, he will be treated as a judgment debtor.⁹⁸¹ Arguably, it may be unfair for the applicant to be prosecuted at this stage.⁹⁸² If the applicant finally wins the case, he will appear to have been injured repeatedly. However, this process appears to be a mere effective safeguard for the prospective defendant since he cannot provide any evidence before the court grants interim injunctions. This compensation will remind the applicant not to apply for interim injunctions randomly. Moreover, the applicant may deserve to be sanctioned unless he applies for these measures in *bona fide*. Additionally, the court will order the applicant to compensate the prospective defendant only when interim injunctions were granted inappropriately, primarily because of the applicant's wrong. Furthermore, the said compensation may be justified, subject to the balance of hardship. It seems clear that while the prospective defendant has already suffered from interim injunctions, there is just a chance that the applicant may be injured afterwards.

Apparently, there is one more safeguard for the prospective defendant, namely, the right to appeal the order to the Supreme Court.⁹⁸³ The law merely states that the order to dismiss the application is final,⁹⁸⁴ and interim injunctions can be revoked or

⁹⁸⁰ Rule 17 para.1.

⁹⁸¹ Rule 16 para.2.

⁹⁸² The Civil Procedure Code, Section 263 para.2 stipulates that the order to compensate the defendant will be executed after the final judgment.

⁹⁸³ The Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539 Section 38.

⁹⁸⁴ Rule 13 para.3.

modified.⁹⁸⁵ However, it is not stipulated whether the prospective defendant can appeal the order or not. The Supreme Court decided in one case which was filed in *forma pauperis* that, since there was no explicit provision barring the plaintiff from appealing the court's decision, the plaintiff was empowered to appeal such an order.⁹⁸⁶ This judgment should be applied *mutatis mutandis* to this issue.⁹⁸⁷

There are two issues to be noted. First is the amount of compensation. It is still up to judicial discretion to decide this amount. Frequently, the amount set by the court has been criticized as inappropriate to the current situation.⁹⁸⁸ If compensation is decided too low, this safeguard may not be used to protect the prospective defendant properly. Secondly, several safeguards are available for the third party too. The Civil Procedure Code will be applied *mutatis mutandis*.⁹⁸⁹ As a result, the third party could request the court to repeal or modify the court order.⁹⁹⁰ Additionally, the court may order the applicant to provide security for damage.⁹⁹¹

⁹⁸⁵ Rule 16 para.1.

⁹⁸⁶ The Supreme Court's judgment no.689/2511 (1968).

⁹⁸⁷ According to the Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539, limitation for appeal is provided. Section 39 states that, in a criminal case, where the maximum penalty prescribed by law does not exceed three years imprisonment or 60,000 Baht (1,500 Pounds) fine or both, no appeal will lie against any judgment in question of fact. Section 41 states that, in a civil case, where the value of the asset or the amount in dispute on appeal does not exceed 200,000 Baht (5,000 Pounds) or does not exceed the amount prescribed in the Royal Decree, no party will appeal against a judgment with respect to the question of fact.

⁹⁸⁸ Interview with Chantarasak.

⁹⁸⁹ The Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539 Section 29 para.2, the Civil Procedure Code Section 261, and the Rules for Intellectual Property and International Trade Cases B.E.2540 Rule 18.

⁹⁹⁰ The Civil Procedure Code Section 261 para.1.

⁹⁹¹ The Civil Procedure Code Section 261 para.3.

5.5.2 AN ORDER TO PRESERVE EVIDENCE IN ADVANCE

For an order to preserve evidence in advance, the process of execution and examination of evidence has not been explicitly stated. Therefore, the provisions contained in both the Civil Procedure Code and the Criminal Procedure Code should be applied *mutatis mutandis*. There will be less controversy in general circumstances.

If the order is granted, the evidence will be examined as prescribed by the said law.⁹⁹² In cases of emergency, there will be no controversy if the court decides to examine the evidence later. In other words, the prospective defendant can be present when the evidence is examined, while documents or materials can be seized or attached when the order has been granted.⁹⁹³

If the court decides to examine the evidence soon after the order has been granted, in criminal cases there may be a question as to whether or not the prospective defendant should be present. In civil cases, it is likely that the court may examine the evidence *ex parte*. This applies the Civil Procedure Code *mutatis mutandis*.⁹⁹⁴ The evidence could be examined *ex parte* when the other party or the related party does not have domicile in the country, and the said person has not yet entered into the case.⁹⁹⁵

⁹⁹² The Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539 Section 28 para.2.

⁹⁹³ The Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539 Section 29.

⁹⁹⁴ The Civil Procedure Code Section 101.

⁹⁹⁵ The Civil Procedure Code Section 101 para.3.

Seemingly, this idea is supported by the practice that a party can request the court to submit a deposition of a witness, in lieu of examination in court.⁹⁹⁶ The law provides that the said deposition will not be accepted as evidence in the case, if the deponent fails to be present in the court in order to be cross examined.⁹⁹⁷ Nevertheless, the court may admit the said deposition as evidence corroborating other evidence, if the court deems appropriate.⁹⁹⁸

In criminal cases, on the contrary, the offender should be present during the examination of the evidence. This arises from the crucial principle of due process that the offender should be protected by the process of cross examination. Therefore, there is restricted opportunity regarding the examination of evidence while an offender is absent.⁹⁹⁹ Subject to the Criminal Procedure Code, it seems that preserving evidence in advance is not excluded by this principle. The witness can be examined before the case is instituted, on the condition that the accused is present during the examination.¹⁰⁰⁰

However, it seems clear that the process to preserve evidence in advance applies to criminal cases.¹⁰⁰¹ This process will be efficient in protecting intellectual property

⁹⁹⁶ Rule 29 para. 1.

⁹⁹⁷ Rule 29 para. 3.

⁹⁹⁸ Rule 29 para. 3.

⁹⁹⁹ Due to the Criminal Procedure Code Section 172 *bis*, an offender who has a lawyer could request to be absent, in the case where the maximum term of imprisonment does not exceed ten years. In a case where there are several offenders, some of them could be absent if the said trial does not involve him or the court deems it appropriate to conduct the trial while the said offender(s) is absent. In addition, the Civil Procedure Code Sections 33 (a) and 102 are applied *mutatis mutandis*. The offender may be expelled from the chamber for contempt, and he may be permitted not to attend the trial when the court requests another court to conduct the trial.

¹⁰⁰⁰ The Criminal Procedure Code Section 237 *bis*.

¹⁰⁰¹ Rule 42.

rights' owners, so far as this practice is not against the general safeguard for an accused or an offender in a criminal case. This idea is accepted in the Rules for Intellectual Property and International Trade Cases B.E.2540. The law states that :

If a party files a motion and the court deems appropriate in the interest of justice, the court may permit the submission of a deposition of a deponent confirming facts or opinions on the issues not directly proving guilt of the accused in lieu of bringing the deponent to testify, and the provisions for civil cases in Title I on the submission of a deposition in lieu of an oral testimony under Rules 29 to 31 shall apply *mutatis mutandis*.¹⁰⁰²

As a result, it seems that the law intends to provide strong protection for intellectual property rights' owners, subject to the principle of due process. Since there is no precedent, at present, for this issue, it is still unclear how the court will interpret this law.

The next question is how the applicant gains access to the said documents or materials. It is possible that, in case of emergency, the applicant will request the court to seize or attach the documents or materials that will be adduced as evidence.¹⁰⁰³ Therefore, it can be argued that this is a preliminary stage to preserve documents or materials which will later be adduced as evidence. In other words, the said documents or materials are not yet regarded as evidence at this stage. Subsequently, this should be deemed as the executing stage, and the court will grant an order to seize or attach the

¹⁰⁰² Rule 49.

¹⁰⁰³ The Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539 Section 29 para.1.

documents or materials. If a person who possesses the said documents or materials disobeys the order, he may be served with a warrant of arrest and detention.¹⁰⁰⁴

If these documents or materials are regarded as evidence, the court will order the said person to forward the evidence to the court.¹⁰⁰⁵ In this case, a person who does not comply with the court order will receive criminal punishment.¹⁰⁰⁶ He will be punished with imprisonment not exceeding six months or a fine not exceeding 1,000 Baht (25 Pounds), or both. In some cases, these sanctions are draconian, particularly if he is not the prospective defendant.

It is possible that a person who possesses the said documents or materials is not a prospective defendant. The Rule states that :

In cases of emergency under Section 29 of the Act, the motion shall state the facts showing the emergency situation whereby, if the other party or the party involved is to be notified beforehand, such evidence will be damaged, lost, destroyed or, due to some other reasons, difficult to be adduced at a later stage.¹⁰⁰⁷

As a result, an order to seize or attach the documents or materials can be sought against a person who is not a prospective defendant. In comparison, with regard to the process of civil execution, an order to seize or attach the debtor's property can be sought against a person who possesses such property.¹⁰⁰⁸ If he refuses to obey the order, he may be arrested and confined.

¹⁰⁰⁴ It is possible that the Civil Procedure Code Sections 254 (4) and 255 (4) (b) will be applied *mutatis mutandis*.

The term of detention must not exceed six months from the date of the arrest. Section 258 para.5.

¹⁰⁰⁵ The Civil Procedure Code Section 90 (2) and para.5.

¹⁰⁰⁶ The Penal Code Section 170.

¹⁰⁰⁷ Rule 20 para.2.

¹⁰⁰⁸ The Civil Procedure Code Section 277 para.1.

As for safeguards, it seems that security is the only safeguard for the prospective defendant.¹⁰⁰⁹ The court may consider ordering an applicant to provide security in the same criteria as discussed in the case of interim injunctions. In practice, however, the prospective defendant can be protected as much as in the case of interim injunctions. This is because Section 28 of the Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539 stipulates that, normally, the related party will be summoned to the court. Therefore, the prospective defendant can oppose the court order, or request the court to dismiss the application, as a normality. In cases of emergency, the law explicitly states that the provisions of the Civil Procedure Code are to be applied *mutatis mutandis*.¹⁰¹⁰ As a result, the prospective defendant can request the court to repeal or modify the order.¹⁰¹¹ Furthermore, he can request the court to order the applicant to compensate him, subject to certain conditions.¹⁰¹²

It should be noted, however, that the law does not require the applicant to initiate the case within a limited period of time. This requirement is stated in TRIPs.¹⁰¹³ It depends, therefore, on the purpose of this requirement. In other words, if this requirement is regarded as a safeguard for the prospective defendant, the lack of it will be crucial.¹⁰¹⁴ On the other hand, if the said requirement is regarded as a means of ensuring that the

¹⁰⁰⁹ Rule 21.

¹⁰¹⁰ The Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539 Section 29 para.2.

¹⁰¹¹ See the Civil Procedure Code Section 261.

¹⁰¹² See the Civil Procedure Code Section 263.

¹⁰¹³ Article 50 (6).

¹⁰¹⁴ It can be argued that the judge still has the general power to prescribe the condition to initiate the case.

applicant has enough time to initiate his case, the absence of this requirement seems less important.¹⁰¹⁵

¹⁰¹⁵ Arguably, the order to preserve evidence in advance has been introduced in favour of intellectual property rights' owners, rather than the prospective defendant. It has been suggested that the provisions stated in the Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539 are more effective (for the parties) than those stated in the Civil Procedure Code. For instance, the former permits the party to seek the order *ex parte*. Lecture of J.Pakditanakul.

CHAPTER 6 : THE JUDICIAL ATTITUDE ON PROVISIONAL MEASURES

6.1 INTRODUCTION

As discussed above, remedial measures in the Thai legal system seem to be influenced by TRIPs. For example, provisional measures were probably introduced into Thai law primarily because of TRIPs. These measures are rather different from those which already existed in the system. Provisional measures may be accepted later as general measures to remedy all types of infringement, subject to their effectiveness.

The efficiency of provisional measures, however, seems to be in doubt. Up until now, there have still been a number of complaints about inadequate protection for intellectual property rights in Thailand.¹⁰¹⁶ It appears that intellectual property rights' owners have not yet been protected appropriately. This will be a prime concern of the Council for TRIPs.

In fact, it seems difficult to indicate whether or not the law has already been enforced effectively. It depends perhaps on the viewpoints of persons related to this issue. The intellectual property rights' owners may feel that the protection remains insufficient, whereas the authorities, or even the society, consider that the law has already been enforced properly.¹⁰¹⁷

The actual situation of enforcement of provisional measures in Thailand, therefore, will be examined. This issue will be discussed in several aspects, such as the situation of intellectual property rights' infringement in Thailand. From the statistics, it seems that, at present, intellectual property rights' owners do not benefit from the introduction of

¹⁰¹⁶ See Economic Section, Department of State, the United States of America. 1998 Investment Climate Statement for Thailand p.6. This information can be accessed through the internet.

¹⁰¹⁷ Interview with J.Viturat.

provisional measures to Thai law. This brings to a further question of why enforcement of provisional measures in Thailand is not successful. In addition, who can improve this dissatisfied situation? And how? In this case, the study will base mainly on judges of the Central Intellectual Property and International trade Court since they play a major part in enforcing provisional measures. Judicial attitude regarding these measures, therefore, will be analysed. In addition, others' opinion will be under considered too. It is, then, expected that some fruitful results will be achieved in this study.

6.2 THE SITUATION OF INTELLECTUAL PROPERTY RIGHTS INFRINGEMENT

It is suggested that the major aim of TRIPs is to protect intellectual property rights' owners. Absolute protection, nevertheless, is unlikely to be achieved. Therefore, it is merely expected that the number of infringements should be fewer. If the trend of the said numbers is downwards, legal enforcement can be claimed, by the authorities, a success.¹⁰¹⁸

	1994	1995	1996	1997	1998
Copyright	527	292	330	637	169
Patent	16	-	2	1	-
Trade marks	770	575	476	1,032	191
Total	1,313	867	808	1,670	360

Figure 3 1. Number of cases investigated by the police.

¹⁰¹⁸ Indeed, the statistics cannot exactly show what the real situation is in Thailand. Arguably, a high number of cases may be considered, on the bright side. More cases may reflect increased awareness of this issue, increased resources devoted to this issue by police, better laws, and greater willingness to complain or to investigate. Thus, they might reflect better protection, rather than worse. It should be remembered here that the statistics are presented to reveal the fact that there are still a number of cases which the police have had to investigate.

2. The statistics in 1998 are from January to March.

	1994	1995	1996	1997	1998
Copyright	246,410	136,794	99,646	264,681	68,506
Patent	12,285	-	315	241	-
Trade marks	1,062,044	138,620	61,694	408,700	175,400
Total	1,320,739	275,414	161,655	673,622	243,906

Figure 4 1. Number of items being seized by the police.

2. The statistics in 1998 are from January to March.

These figures have been provided by the Co-ordinating Centre for Suppression of Intellectual Property Rights Violation, Department of Intellectual Property, Ministry of Commerce.¹⁰¹⁹ They illustrate the statistics for infringement of intellectual property rights in Thailand during 1994 - 1998. The figure 3 concerns the number of infringements which were investigated, while the figure 4 concerns infringing goods which were seized within the said period. It should be noted that these statistics were gathered mainly for criminal purposes. In addition, half of the cases are infringements related to trade marks, whereas there were only a few cases of patent infringement. (See the Figure 3)

This circumstance is to be expected. Firstly, because the process of infringing trade marks seems less complicated than that related to patent or copyright, counterfeit goods can be produced in mass volumes within a short period of time. Secondly, the said infringements normally concern well known marks. Consequently, these counterfeit goods can easily be circulated, even in the street. In addition, all trade marks are

¹⁰¹⁹ The major roles of this Department are co-ordinating with the relevant governmental agencies on suppression activities, and giving advice to rights holders.

directly linked to trade, while patent and copyright are only partly connected to trade. Finally, it is possible that the number of trade mark infringements is greater than the others because granted patents, in Thailand, are outnumbered by registered trade marks massively (See the figure 5).

Year	Registered trade marks	Granted patent	Total
1992	8,156	386	8,542
1993	8,147	451	8,598
1994	13,003	674	13,677
1995	12,293	782	13,075
1996	9,928	1,355	11,283
1997	8,157	1,131	9,288
Total	59,684	4,779	64,463

Figure 5 1. Number of registered trade marks and granted patent.

2. These statistics have been provided by the Department of Intellectual Property

The above statistics are unlikely to indicate a downward trend of intellectual property rights infringements. In 1997, the total number of cases was double the number of the previous year. On the other hand, the statistics do reveal the fact that intellectual property rights are still being infringed continuously.

The next figures concern the number of cases which have been instituted in the Courts of First Instance during this decade. Statistics for these cases, however, are merely from 1990 to 1994. Subsequently, they have been combined with other cases

and displayed under the title of 'miscellaneous' cases. Since then, the number of intellectual property cases has not been explicitly identified.

Year	Trade Marks		Copyright		Patent		Penal Code	
	Civil	Criminal	Civil	Criminal	Civil	Criminal	Civil	Criminal
1990	102	8	1	131	2	4	-	1,150
1991	85	16	4	147	2	3	-	1,016
1992	108	312	5	169	21	8	-	631
1993	69	561	4	253	2	13	-	341
1994	105	547	2	259	2	2	-	142
Total	469	1,444	16	959	29	30	-	3,280

Figure 6 1. The Penal Code also provides for offences relating to trade marks in Sections 273 and 274.

2. These statistics have been provided by the Ministry of Justice.

During 1995 - 1997, a number of intellectual property cases have been presented in the Courts of First Instance in Bangkok, *inter alia*, the Civil Court, the South Bangkok Civil Court, the Thonburi Civil Court, the Criminal Court, the South Bangkok Criminal Court, and the Thonburi Criminal Court. These statistics are selected on the basis that most intellectual property cases have been instituted in Bangkok. However, these statistics are incomplete, due to their collection system. They also regard intellectual property cases as miscellaneous cases (since there were just a few cases). Consequently, these cases have to be separated from the other miscellaneous cases. In addition, most of the intellectual property cases in the said courts were transferred to the

Central Intellectual Property and International Trade Court in 1997 when this court was inaugurated.

Year	the Civil Court	the South Bangkok Civil Court	the Thonburi Civil Court	The Criminal Court	The South Bangkok Criminal Court
1995	11	4	4	174	382
1996	27	17	4	431	263
1997	23	16	2	316	194

Figure 7 1. Number of cases in the Courts of Instance (1995-1997).

2. Intellectual property cases cannot be identified in the Thonburi Criminal Court.

The following Figure illustrates the number of intellectual property cases in the Central Intellectual Property and International Trade Court since it was inaugurated.

Year	Copyright		Patent		Trade Marks	
	Civil	Criminal	Civil	Criminal	Civil	Criminal
1997	-	34	-	-	4	114
1998	1	179	5	-	25	381
Total	1	213	5	-	29	495

Figure 8 1. Number of cases in the Central Intellectual Property and International Trade Court (1997-1998).

2. The Central Intellectual Property and International Trade Court was inaugurated on December 1, 1997.

3. The statistics for 1998 are from January to April.

Arguably, the above statistics cannot represent the trend of intellectual property cases in Thailand properly, due to the incomplete information. However, the figures imply that, up until now, intellectual property rights' infringements are still occurring. Moreover, intellectual property rights' owners are still submitting their cases to the courts. In other words, their rights continue to be infringed and remedies have to be sought continuously.

6.3 HAVE INTELLECTUAL PROPERTY RIGHTS' OWNERS BEEN APPROPRIATELY REMEDIED?

This is a crucial question of the study. Normally, it is difficult to indicate whether intellectual property rights' owners have been remedied appropriately (by provisional

measures) or not, since it depends on the individual's point of view. The above statistics can hardly express the situation of remedies for intellectual property rights' owners. However, it seems that provisional measures in Thailand are not so effective. This is because, at present, a few cases of the enforcement of provisional measures have been reported. Therefore, it is difficult to argue that intellectual property rights' owners have already been remedied through provisional measures (or had already been protected before the infringement was committed).

It may be challenged that provisional measures are efficient if they provide a deterrent effect, like criminal sanctions. In other words, provisional measures may deter others from infringing intellectual property rights. As a result, some may accept that intellectual property rights' owners gain appropriate remedies from provisional measures.

Nevertheless, there is no significant sign to show that provisional measures do provide a deterrent effect like criminal sanctions. Intellectual property rights have still been infringed since provisional measures came into force in 1991 (when these measures were first introduced in the trade mark law). In 1997, particularly, the number of intellectual property cases increased noticeably. In addition, the courts do not seem to intend to grant provisional measures in order to deter others from committing infringements.¹⁰²⁰ This conforms with the opinion of judges in the Central Intellectual Property and International Trade Court which rank the deterrent effect in sixth place among the eight purposes for granting provisional measures.¹⁰²¹ It may be

¹⁰²⁰ Interview with J. Viturat.

¹⁰²¹ See Table 25 in the Appendix II.

summarized that, at present, provisional measures are not significantly enforced in remedying intellectual property rights' owners.

6.4 WHY HAVE PROVISIONAL MEASURES NOT BEEN SOUGHT?

It seems that provisional measures are ineffective because the lawyers are reluctant to apply for these measures. It is, therefore, important to examine why the lawyers do not intend to take their part in the said measures. This can be regarded as a fundamental question since provisional measures may not be applied in the future, unless this problem is solved.

Is it possible that provisional measures have not been sought because the lawyers do not have any knowledge of these measures? In fact, this issue is very crucial and should have already been studied. However, no such study has yet been undertaken. It is, then, only hoped that such a study will be undertaken soon.

In fact, information concerning provisional measures already exists in society. There are several organs which circulate information relating to intellectual property law to the public. Among them is the Department of Intellectual Property, Ministry of Commerce.¹⁰²² One of the responsibilities of this Department is to promote effective use of intellectual property and technology information for the purposes of education, research, development and commercialization.¹⁰²³ This responsibility can be undertaken by educating the related persons, such as co-ordinating with educational establishments in both the Ministry of Education and Ministry of University Affairs to include intellectual property courses in the curriculum of schools and colleges.¹⁰²⁴ In

¹⁰²² This Department was inaugurated on May 3, 1992.

¹⁰²³ Department of Intellectual Property, Annual Report 1997 (Bangkok : Asorn Thai Printing, 1997) p.16.

¹⁰²⁴ Department of Intellectual Property, *op.cit.* p.28.

addition, four hundred lectures have been given nation-wide with the average participation of five hundred persons per month.¹⁰²⁵ Moreover, a series of seminars were held all over the country with special emphasis on the officials, rights owners, and users.¹⁰²⁶ Using information from lawyers, it may be assumed that the related persons have some knowledge of provisional measures.¹⁰²⁷

Indeed, lawyers play a remarkable role in applying for provisional measures. They may give advice to intellectual property rights' owners, or even change their minds, as to whether these measures should be sought. This is because they are the ones who know about litigation and decide to take action.

Normally, lawyers should know the general principles of intellectual property law.¹⁰²⁸ According to the law, a person who intends to register as a lawyer must hold a first degree in law, and must be a member of the Thai Bar Association.¹⁰²⁹ In addition, if he has never been a judge, a public prosecutor, etc., or has never practiced in a law firm for not less than one year, he must attend a compulsory course.¹⁰³⁰ As a result, this person has to learn intellectual property law in these stages. At present, intellectual property law is on most universities' curriculum, due to its importance. Furthermore, it is

¹⁰²⁵ Department of Intellectual Property. *op.cit.* p.40.

¹⁰²⁶ Department of Intellectual Property. *op.cit.* p.41.

¹⁰²⁷ Interview with Uttasart, Jitkuntivong. Also Manas-siripen P, the Director of the Training Institute, the Law Society. He was interviewed on July 26, 1998. Hereafter referred to as Interview with Manas-siripen.

¹⁰²⁸ Interview with Uttasart, Manas-siripen.

¹⁰²⁹ The Advocate Act B.E.2528 Section 35 (3). The Royal Gazette Vol.102 (special), No.129, September 19, 1985.

¹⁰³⁰ The Advocate Act B.E.2528 Section 38 para.1.

one of the subjects taught in courses for Barrister-at-law. Additionally, this subject is also provided in the training course for lawyer's trainees.¹⁰³¹

Subsequently, if it is assumed that lawyers know about intellectual property law, including provisional measures, the next question is why they are dissuaded from taking action. From the study,¹⁰³² there seem to be four remarkable reasons which make the lawyers reluctant to apply for provisional measures. They are the lack of evidence, the doubtfulness of provisional measures *per se*, the other alternative measures, and the lack of confidence in the judicial attitude. There may be other factors too that the lawyers have taken into consideration, such as the cost and time involved. These conditions, however, seem less significant and, in some cases, have been claimed merely as a pretext (for not applying for provisional measures).¹⁰³³

6.4.1 THE ABSENCE OF EVIDENCE

Some lawyers have complained that it is difficult to provide the evidence required by the court before granting provisional measures.¹⁰³⁴ Currently, due to the sophisticated technology, intellectual property rights' infringement can occur within just a short period of time, and is very hard to detect. Lawyers may possess information concerning the said infringement. However, this information is not explicit, or is even acquired through illegal channels, and cannot be presented as evidence. In order to gain evidence, the

¹⁰³¹ See Handbook for the Training Course of Lawyers, Course 14, 1997-1998 (Bangkok : 1997). In future, there is a plan that lawyers who intend to litigate their cases in the Intellectual Property and International Trade Court have to attend a special course for intellectual property law. Interview with Uttasart.

¹⁰³² This idea is mainly based on information which was acquired from lawyers and judges through interviews.

¹⁰³³ Interview with Jitkuntivong.

¹⁰³⁴ Interview with Uttasart.

lawyers sometimes have to contact infringers and purchase some illegal items from them.¹⁰³⁵ This process is rather risky.

Arguably, information concerning the infringement as such is not so difficult to acquire. It is information concerning the infringer which is difficult to obtain.¹⁰³⁶ Primarily, the intellectual property rights infringement in Thailand relates to street vendors.¹⁰³⁷ Therefore, it is difficult for lawyers to find the name and the address of the said infringer, or it may take time to gain this information. Provisional measures will, thus, be more effective, if the practice of 'John/Jane Doe' is analogous.¹⁰³⁸ In addition, there is anxiety regarding the quantity of evidence required by the court. It seems not possible to prepare, and reveal, all the evidence at this stage.¹⁰³⁹

6.4.2 THE DOUBTFULNESS OF PROVISIONAL MEASURES

Since provisional measures are rather new in the Thai legal system, they remain uncertain. Several aspects of these measures are still ambiguous. These may discourage the effectiveness of the said measures. Consequently, lawyers may decide not to apply for provisional measures.

¹⁰³⁵ Recently, there was a case that a representative of an intellectual property rights' owner gained evidence by purchasing a computer with unauthorized software from infringers. However, the Supreme Court reversed a judgment of the Central Intellectual Property and International Trade Court and dismissed the case. The Supreme Court stated that since unauthorized computer software had not been reproduced before an offer to purchase the computer, the software, then, were reproduced because the representative of the intellectual property rights' owner tempted the infringer to do so. Therefore, it was the intellectual property rights' owner who lured the infringer to commit a crime and, consequently, he could not be regarded as an injured person. See the Supreme Court's judgment no.4341/2543 (2000).

¹⁰³⁶ Interview with Uttasart.

¹⁰³⁷ Interview with Rattanasuwan.

¹⁰³⁸ Interview with Uttasart. For the discussion of John/Jane Doe practice, see Chapter 5.

¹⁰³⁹ Interview with Jitkuntivong.

For example, the purpose of Rule 17 which requires an applicant to institute his case within fifteen days from the date on which an interim injunction is granted is not clear. Seemingly, the applicant is forced to start his case within such limited time.¹⁰⁴⁰ From the lawyers' point of view, this period is rather short. They need a longer time to prepare their cases.¹⁰⁴¹ As a result, this seems to be a condition that bars intellectual property rights' owners from applying for provisional measures.

This compulsory period, nevertheless, is not required in the case of orders to preserve evidence in advance.¹⁰⁴² This issue appears to be less controversial because this measure is available for anyone who 'apprehends that the evidence on which he may have to rely in the future will be lost ...'.¹⁰⁴³ According to this provision, a prospective defendant can apply for this measure too. It is, thus, not possible to require the prospective defendant to institute his case. In addition, the order to preserve evidence in advance is sought probably because an applicant intends to litigate his case in the court. It is unnecessary, therefore, to require the applicant to file his case within a limited time.¹⁰⁴⁴

However, this assumption may not be totally true. A similar measure can be sought if the applicant merely decides to preserve his evidence in advance.¹⁰⁴⁵ Seemingly, the

¹⁰⁴⁰ Interview with Mangklatanakul.

¹⁰⁴¹ Interview with Jitkuntivong. According to TRIPs Article 50 (6), the said period of time may be extend to not to exceed 20 working days or 31 calendar days, whichever is the longer.

¹⁰⁴² See TRIPs Article 50 (6). This Article requires members to apply this compulsory period to both interim injunctions and orders to preserve evidence in advance.

¹⁰⁴³ Section 28 para.1 of the Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539.

¹⁰⁴⁴ Interview with J.Viturat.

¹⁰⁴⁵ See the Civil Procedure Code Section 101.

new measure is sought in order to seize or attach documents or materials in advance.¹⁰⁴⁶ Subject to this intention, the applicant may be in no hurry to institute his case. Then, the prospective defendant might be placed in a dissatisfactory situation, because his documents or materials have been seized or attached for a long time.¹⁰⁴⁷ Moreover, the applicant may use this measure as a device to gain access to the documents of his business rival.

The principle of provisional measures *per se* is also obscure. At present, there is an opinion that the infringement of intellectual property rights should be regarded as a civil conflict, rather than an actual crime.¹⁰⁴⁸ Therefore, criminal sanctions should be used only in serious cases, *inter alia*, infringements which relate to the public health. Arguably, interim injunctions are introduced because the other civil remedies are not so effective.¹⁰⁴⁹

This concept seems to be acceptable. It also conforms to the concept that intellectual property is private property. The owners, therefore, should protect their own rights and litigate the case by themselves. It seems that, in many countries, civil remedies have been sought more often than criminal ones.

However, it may be argued that intellectual property rights' owners, generally, apply for civil remedies because this way is easier than seeking criminal sanctions.¹⁰⁵⁰ In a criminal case, for instance, a plaintiff has to prove beyond reasonable doubt that the

¹⁰⁴⁶ Lecture of J.Pakditanakul.

¹⁰⁴⁷ However, the judge may provide conditions he deems appropriate to protect the prospective defendant. See the Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539 Section 29 para.1.

¹⁰⁴⁸ Interview with Rattanasuwan.

¹⁰⁴⁹ Interview with J.Ariyantaka.

¹⁰⁵⁰ Interview with Mangklatanakul.

right has been infringed, and an offender has committed such an infringement.¹⁰⁵¹ On the contrary, a plaintiff has to prove only what he claims in order to win his civil case and the degree of beyond reasonable doubt is hardly imposed.

6.4.3 ARE CRIMINAL SANCTIONS MORE APPROPRIATE THAN THESE MEASURES?

It seems that, according to the lawyers, criminal sanctions are preferable to civil remedies.¹⁰⁵² This suggestion is perhaps supported by the statistics shown in the above Figures. (See the Figures 5-8) Civil cases were far outnumbered by criminal cases every year. This may be because criminal sanctions are so effective when they are enforced, particularly when an infringer is punished by imprisonment.¹⁰⁵³ The infringer will be detained, while other persons may be deterred by the effect of the said punishment.

Furthermore, temporary remedies under criminal litigation may be sought more easily than those under civil ones,¹⁰⁵⁴ especially when they are sought outside Bangkok. According to the Rules for Intellectual Property and International Trade Cases B.E.2540, in a case where an application has been sought outside Bangkok, the provincial court has to dispatch the said application to the Central Intellectual Property and International Trade court without delay.¹⁰⁵⁵ Indeed, the law also states that communication between

¹⁰⁵¹ The Criminal Procedure Code Section 227 para.1.

¹⁰⁵² Interview with Jitkuntivong. There is also an opinion that, due to the copyright law, an intellectual property rights' owner is supposed to institute his criminal case to achieve compensation, from the fines. The remaining damages, therefore, will be covered through a civil litigation later. See P. Puchanavanit, Some Aspects of the Assessment of Damages in Copyright Infringement (LL.M. Thesis, Chulalongkorn University, 1988) p.85.

¹⁰⁵³ Interview with Chantarasak.

¹⁰⁵⁴ Interview with Uttasart.

¹⁰⁵⁵ Rule 44.

these courts should be conveyed via electronic medium in order to ensure expediency.¹⁰⁵⁶ It has to be accepted that this process still takes time, particularly when the court decides to make an enquiry.

On the other hand, if an intellectual property rights' owner chooses to litigate a criminal case (by not applying for provisional measures) and requests the police to investigate his case, he is able to do it at once.¹⁰⁵⁷ The police are also empowered to seize or attach any documents or materials as evidence.¹⁰⁵⁸ In addition, a prospective defendant may be arrested if he is reasonably suspected of having committed an infringement, or he has no fixed place of residence.¹⁰⁵⁹ This will bar the prospective defendant from committing an infringement.

To some extent, criminal sanctions may not be sought as easily as civil remedies. Local police may not have enough experience in investigating these complicated infringements.¹⁰⁶⁰ As a result, it is likely that the police may be reluctant to proceed with the investigation.¹⁰⁶¹ Furthermore, the police may not want to investigate the case since they feel that they are being used (by intellectual property rights' owners) merely to force the infringers to comply with intellectual property rights' owners' demands. If this

¹⁰⁵⁶ Rule 5.

¹⁰⁵⁷ Interview with Uttasart. According to the Criminal Procedure Code Section 18, the police are empowered to hold an inquiry within their territorial jurisdiction.

¹⁰⁵⁸ The Criminal Procedure Code Section 69 (1).

¹⁰⁵⁹ The Criminal Procedure Code Section 66 (1).

¹⁰⁶⁰ Chutiwongse K, "Problems of Foreign Copyright in Thailand," in Annual Report 1997 (Bangkok : Asorn Thai Printing, 1997) p.69.

¹⁰⁶¹ Interview with Uttasart.

business interest can be secured through civil remedies, the police may save their time to deal with other criminal cases.¹⁰⁶²

In addition, criminal sanctions have been sought for a long time. Lawyers are perhaps accustomed to the criminal process. In contrast, they are unfamiliar with provisional measures. Unless lawyers can be persuaded as to the clear advantages of provisional measures, it seems that they will prefer criminal sanctions to provisional measures.¹⁰⁶³

6.4.4 JUDICIAL ATTITUDE REGARDING PROVISIONAL MEASURES

The other reason that dissuades lawyers from applying for provisional measures is the judicial attitude. It seems that lawyers are not so confident whether the judge will grant provisional measures. In other words, they are afraid that the judge may restrict the use of these measures for certain cases, and subsequently a lot of evidence may be required.¹⁰⁶⁴ The lawyers, inevitably, will be under pressure (trying to win the order). As a result, they may simply refuse to seek provisional measures.

Besides, many feel that the courts do not take infringement of intellectual property rights, in both civil and criminal cases, seriously. It has been argued that the punishments are often too lenient to deter infringers.¹⁰⁶⁵ Arguably, the courts may not intend to enforce provisional measures, particularly interim injunctions which are regarded as severe, to remedy intellectual property rights' owners.

¹⁰⁶² Chutiwongse. *op.cit.* p.69.

¹⁰⁶³ Interview with Mangklatanakul.

¹⁰⁶⁴ It has been argued that public prosecutors require additional evidence since the courts seem to be strict on the cases. See Chutiwongse. *op.cit.* p.68.

¹⁰⁶⁵ See 1998 Investment Climate Statement for Thailand *op.cit.* p.6.

This is true partly because, even in society, infringements of intellectual property rights are not regarded as serious crimes, and sometimes have been listed as low priority.¹⁰⁶⁶ As a result, an infringer will not be punished severely.¹⁰⁶⁷

Although punishments have been dramatically increased, this change mainly concerns the amount of fines.¹⁰⁶⁸ This change may support the opinion that the punishment by high fines is more favourable than imprisonment.¹⁰⁶⁹ Consequently, the infringers in Thailand have rarely been imprisoned.

Additionally, the issue of seriousness may depend on the individual's viewpoint. Whereas some may feel that imprisonment is appropriate for such an infringement, others may agree that this type of punishment can be substituted by a heavy fine.¹⁰⁷⁰ The amount of fine provided in intellectual property law, at present, is regarded, by Thai society, as severe.¹⁰⁷¹

6.5 IS THERE A NEED FOR MORE PARTICIPATION FROM JUDGES?

This question, in fact, is about the role of the court in protecting intellectual property rights' owners. From the study, the court has a vital part in enforcing provisional measures. There are several issues which, up until now, depend on judicial

¹⁰⁶⁶ See Chutwongse. *op.cit.* p.68.

¹⁰⁶⁷ Interview with J.Viturat.

¹⁰⁶⁸ For example, the amount of fines has been increased from the maximum of 200,000 Baht (5,000 Pounds) to 800,000 Baht (20,000 Pounds) for copyright infringement with commercial purpose. See the Copyright Act B.E.2537 Section 69 para.2.

¹⁰⁶⁹ Interview with J.Viturat. See also S. Narkvichien, "The Sentencing Discretion in IP Cases," The IP & IT Law Forum : Special Issue 2000 Third Anniversary (December, 2000) p.325.

¹⁰⁷⁰ Interview with J.Viturat.

¹⁰⁷¹ Interview with Chantarasak.

discretion,¹⁰⁷² It is assumed that, unless provisional measures are enforced efficiently, intellectual property rights' owners will not be protected appropriately.

This study focuses on qualifications of judges, their attitudes, and their roles regarding remedial measures, particularly provisional measures. It should be noted, beforehand, that this study cannot indicate directly whether provisional measures will be effectively enforced in the future. Nevertheless, it is expected to reveal, to some extent, whether provisional measures will be utilised in a positive manner. The result of the study will, therefore, benefit intellectual property rights' owners and the society as a whole. On the one hand, it will help find flaws, if any, in these measures. Such mistakes will be amended. On the other hand, it will encourage lawyers' confidence in applying for provisional measures.

6.5.1 JUDICIAL QUALIFICATIONS

This issue is crucial since it can ensure whether these judges are suited to hearing intellectual property cases. At the same time, it will ascertain whether provisional measures will be determined appropriately and in the same way as those examined in other countries. That is why the special court is needed and specific qualifications of judges are required.

Even though the Central Intellectual Property and International Trade Court is regarded as the Court of First Instance, the judges in this court are more senior than other judges in ordinary courts in the first level. This is because this is a special court and intellectual property cases can be appealed directly to the Supreme Court.

¹⁰⁷² See Chapter 5.

Therefore, the judges in this court are as senior as those in the courts of appeals.¹⁰⁷³ Subsequently, these judges are likely to be more experienced, and understand about intellectual property issues.¹⁰⁷⁴

At present, judicial authorities are classified into nine levels.¹⁰⁷⁵ The first level is judge trainees.¹⁰⁷⁶ After judge trainees are appointed to be judges, they will work as judges in the provincial courts. This position is for levels 2 - 3.¹⁰⁷⁷ Later, they will be promoted to become judges in the Courts of First Instance in Bangkok or chief justices in the provincial courts.¹⁰⁷⁸ They stay in levels 4 - 5. After that, they will be promoted to levels 5 - 6 as judges in the Courts of Appeals,¹⁰⁷⁹ and subsequently to levels 6 - 7 as Supreme Court judges.¹⁰⁸⁰ Level 8 is for the Chief Justices in the Courts of Appeals and the Vice Presidents of the Supreme Court. The last level is for only one position, the President of the Supreme Court.¹⁰⁸¹

The study illustrates that the present judges contain high qualifications. All of them have a first degree in law and are barristers-at-law.¹⁰⁸² Furthermore, over 80 % have a

¹⁰⁷³ See the Ministry of Justice Regulation No.23 (B.E.2540) The Royal Gazette Vol.114, No.40a, August 27, 1997. p.50. However, there are many judges who work in this court, who are not as senior as the judge of the Court of Appeals. They may be selected to work in this court because of their other qualifications.

¹⁰⁷⁴ See Section 14 of the Act for Establishment and Procedure of Intellectual Property and International Trade Court B.E.2539.

¹⁰⁷⁵ The Judicial Officials Act B.E.2543 Section 13.

¹⁰⁷⁶ The Judicial Officials Act B.E.2543 Section 13 (3) (d).

¹⁰⁷⁷ The Judicial Officials Act B.E.2543 Section 13 (3) (b) (c).

¹⁰⁷⁸ The Judicial Officials Act B.E.2543 Section 13 (a).

¹⁰⁷⁹ The Judicial Officials Act B.E.2543 Section 13 (2) (a) (b).

¹⁰⁸⁰ The Judicial Officials Act B.E.2543 Section 13 (1) (b).

¹⁰⁸¹ The Judicial Officials Act B.E.2543 Section 13 (1) (a).

¹⁰⁸² The Judicial Officials Act B.E.2543 Section 27 (1), (2).

second degree in law.¹⁰⁸³ Among them, more than 70 % graduated from abroad.¹⁰⁸⁴ In addition, there are some judges who also have degrees in other fields.¹⁰⁸⁵

Statistics cannot guarantee that these judges are the experts in intellectual property law.¹⁰⁸⁶ Nevertheless, they illustrate that most of these judges have knowledge of domestic and the other countries' law or international law. As a result, they should realize the concept of the said law. This will help them to understand why domestic law is different from others.

It is the responsibility of the Judicial Training Institute to provide intellectual property information to judges. Recently, several seminars and training courses were held to ascertain whether the judges had gained knowledge of intellectual property law. (See the Figures 9-11)

Year	Number of judges attending
1984 : I	66
1984 : II	60
1985	150
1986	53
Total	329

Figure 9 Number of judges attending the seminars concerning the laws of trade marks, patent, and copyright.

¹⁰⁸³ See Table 3 in the Appendix II.

¹⁰⁸⁴ See Table 3 in the Appendix II.

¹⁰⁸⁵ See Table 3 in the Appendix II.

¹⁰⁸⁶ Since the Central Intellectual Property and International Trade Court deals with both intellectual property and international trade law, some of the judges may be experts in the latter.

Year	Number of judges attending
1988	170
1989	35
1992	30
1995	46
1996	58
1997	80
Total	419

Figure 10 Number of judges attending the seminars concerning intellectual property law.

Year	Number of judges attending
1988	60
1989	60
1990	62
1991	60
Total	242

Figure 11 Number of judges attending the training courses concerning intellectual property law.

From this study, most of the judges in the Central Intellectual Property and International Trade Court know about intellectual property law. They have studied, trained, observed, or attended intellectual property courses.¹⁰⁸⁷ Among them, a third

¹⁰⁸⁷ See Table 4 in the Appendix II.

responded that they have studied, trained, observed, or attended the said courses abroad.¹⁰⁸⁸

In addition, these judges have very good records of experience. According to the law, all of them must have legal experience before beginning a judicial career,¹⁰⁸⁹ they have to spend at least one year working as judge trainees.¹⁰⁹⁰ Even though around 40 % accepted that they had had less than two years legal experience before beginning their judicial careers,¹⁰⁹¹ these judges responded that they had already worked as judges for more than ten years.¹⁰⁹² In fact, over three quarters of the judges have had more than ten years judicial experience.¹⁰⁹³

These judges also have experience in intellectual property cases. Most of them have tried several intellectual property cases.¹⁰⁹⁴ It should be noted that the number of intellectual property cases include both civil and criminal cases. Due to the disproportion between civil and criminal cases concerning intellectual property law, it may be assumed that these judges have dealt with more criminal cases than civil ones.

According to information from the Courts of First Instance, it would appear that no one has ever dealt with provisional measures. Since this issue has been repeatedly checked from time to time, it seems to ascertain that, up until now, there has been no

¹⁰⁸⁸ See Table 5 in the Appendix II.

¹⁰⁸⁹ The Judicial Officials Act B.E.2543 Section 27 (3).

¹⁰⁹⁰ The Judicial Officials Act B.E.2543 Section 15 para. 1.

¹⁰⁹¹ See Table 7 in the Appendix II.

¹⁰⁹² These judges are respondents no.4, 7, 8, 10, 14, 15, and 18.

¹⁰⁹³ See Table 8 in the Appendix II.

¹⁰⁹⁴ See Table 9 in the Appendix II.

report of an application for provisional measures.¹⁰⁹⁵ However, there are a few judges who responded that they had dealt with provisional measures in several cases.¹⁰⁹⁶ It is possible that, due to the literal meaning, they may have misunderstood provisional measures as referring to measures under the Act of Arrest of Seagoing Ships B.E.2534.¹⁰⁹⁷

Subject to the issue of qualification, there are two aspects to be noted. One concerns gender. The other is age. The Constitution clearly states that male and female must be equal.¹⁰⁹⁸ In practice, sexual discrimination has never been reported in appointing judicial authorities. This is because judges have been recruited mainly through the process of examination.¹⁰⁹⁹ As a result, qualified persons can apply for judicial examinations, regardless of gender. Subsequently, promotion depends mainly on the experience and seniority of judges.¹¹⁰⁰

It is true that only three out of twenty two judges in the Central Intellectual Property and International Trade Court are female. However, this disproportion between male and female is not peculiar when considering the total number of male and female judges in Thailand. It appears that male judges outnumber female judges in the ratio of approximately 6 : 1. (See the Figure 12)

¹⁰⁹⁵ This was information while making a research. At present, there has been a few cases concerning this issue. For instance, see the Court's order no.1/2542 (1999).

¹⁰⁹⁶ See Table 10 in the Appendix II.

¹⁰⁹⁷ After questionnaires were collected, several judges were asked and some of them revealed that provisional measures can be understood as measures under the Act of Arrest of Seagoing Ships B.E.2534. No one insisted that they had ever dealt with provisional measures.

¹⁰⁹⁸ Section 30 para.2 of the Constitution B.E. 2540. The Royal Gazette Vol.114, no.55a, October 11,1997.

¹⁰⁹⁹ The Judicial Officials Act B.E.2543 Section 14.

¹¹⁰⁰ The Judicial Officials Act B.E.2543 Sections 20, 31.

	Male	Female	Total
Judges	1,878	395	2,273
Judge trainee	111	32	143
Total	1,989	427	2,416

Figure 12 Number of male and female judges and judge trainees (June 29, 1998).

This disproportionate ratio is not abnormal in other countries either. In England, for instance, it has been reported that the twelve law lords are all men.¹¹⁰¹ There is only one female Lord Justice of Appeal from a total of thirty five, and only seven of the ninety six High Court judges are women.¹¹⁰²

Although senior English judges agreed that this proportion should be changed, they found nothing wrong concerning the judicial selection system.¹¹⁰³ In addition, Lord Mackay, then Lord Chancellor, was reported as saying that it would be wrong to set quotas for the number of women.¹¹⁰⁴ Instead, he was prepared to encourage all applicants and treat them fairly on their merits.¹¹⁰⁵

¹¹⁰¹ See "Woolf Proposes Fast Track to Judicial Equality," *The Times* (Monday) April 14, 1997. p.6.

¹¹⁰² *Ibid.*

¹¹⁰³ *Ibid.* However, there is a proposal to create a Judicial Appointment Commission in order to change the system of choosing judges. See F. Gibb, "Public to Help in Choosing Judges," *The Times* (Tuesday) May 27, 1997. p.1. See also J. Sherman, "Labour Wants League Table of Bad Judges," *The Times* (Tuesday) May 16, 1995. p.1.

¹¹⁰⁴ F. Gibb, "Mackay Modernises Judicial Selection to Encourage Women," *The Times* (Monday) April 10, 1995. p.7.

¹¹⁰⁵ *Ibid.*

For the issue of age, the law requires that a person who applies for a judicial examination must be not less than twenty five years old.¹¹⁰⁶ After that, he can work as a judge until his retirement. In general, a civil servant retires at sixty years old.¹¹⁰⁷ The Constitution, however, prolongs the term of judicial retirement for ten more years.¹¹⁰⁸ As a result, a judge nowadays may retire at seventy years old.

This study finds that a half of the judges in this court are between forty to fifty years old,¹¹⁰⁹ whereas a third are less than forty years old.¹¹¹⁰ Only around 15 % are aged over fifty.¹¹¹¹ It can be assumed that these judges are mature enough in dealing with complicated cases like intellectual property cases. At the same time, they can work in this court for a certain period of time.¹¹¹²

Furthermore, it may be challenged that, considering their age, these judges are flexible enough to adjust themselves to sophisticated technology. This aspect is important since, generally, judges are regarded as conservative and not prepared for sudden changes.¹¹¹³ Arguably, senior judges may need more time than younger ones

¹¹⁰⁶ The Judicial Officials Act B.E.2521 Section 27 (3).

¹¹⁰⁷ The Pension Act B.E.2494 Section 13. The Royal Gazette (Special) Vol.68, No.24, April 11, 1951. p.1.

¹¹⁰⁸ Section 334 (2).

¹¹⁰⁹ See Table 2 in the Appendix II.

¹¹¹⁰ *Ibid* . Among them, the respondents nos.4,6, and 10 reveal that they have worked as a judiciary for between 10 - 20 years. Therefore, it may be assumed that they are at least 35 years old.

¹¹¹¹ See Table 2 in the Appendix II.

¹¹¹² Senior judges will be eligible to be promoted as Supreme Court judges after they are 50 years old. Indeed, it is up to other conditions too.

¹¹¹³ Many judges imply their conservative view. For instance, one supports the preservation of the traditional decoration of the court room. See S. Dhammasak, "The Structure of the Court Room According to an Academic Principle," 103 Years of the Ministry of Justice (Bangkok : Ministry of Justice, 1995) pp.4-9. Moreover, another suggests that 'conservatism has always been a feature of the law and the judicial process'. See E. Thomas, A Return to Principle in Judicial Reasoning and an Acclamation of Judicial Autonomy (Palmerston : Stylex Print, 1993) p.1.

to adapt their attitudes to different circumstances. Consequently, the present judges may be able to work efficiently from the date the court was established.

6.5.2 JUDICIAL ATTITUDE

This stage concerns the judicial attitude. It will examine how judges consider provisional measures, and intellectual property as a whole. This study is significant since it appears that there are still several aspects of provisional measures, particularly interim injunctions, which depend on judicial discretion. It is still unclear whether provisional measures will be enforced frequently, even though the judges are well informed regarding intellectual property law and provisional measures because they may be reluctant to enforce provisional measures in some cases due to their own personal attitudes. Consequently, an effective remedy through provisional measures should perhaps not be expected.

This step is beyond the point of right or wrong. It concerns an individual's opinion. It seems to depend on whether a decision is 'acceptable' or not. If there is a mistake when a judge makes his decision, the party may appeal such a decision to the higher court. It is unlikely, however, that the said party can appeal an exercise of judicial discretion which is against his desire. Unless this attitude is 'acceptable', it may discourage the appropriateness and the effectiveness of law enforcement.

Regarding their opinion as to the aim of intellectual property law, the judges consider that the most important aim is to protect intellectual property rights' owners.¹¹¹⁴ According to the study, it is also revealed that the judges are concerned about the

¹¹¹⁴ See Table 11 in the Appendix II.

creation of intellectual property rights *per se*.¹¹¹⁵ It appears that the owners of intellectual property rights, at present, are under focus of the law.¹¹¹⁶ However, it cannot be concluded that judges will protect private interest more than the public interest.

This is because their attitude was not united when they responded to the question whether 'intellectual property is private property like normal commercial property'. Merely 27 % agreed that intellectual property is private property.¹¹¹⁷ Therefore, it may be assumed that the others will not protect intellectual property to the same level as ordinary commercial property.

In fact, this seems to conform with the concept which exists in several Asian countries, as discussed in Chapter Two. The concept of 'private property' for intellectual property is unlikely to be popular among judges. This attitude may not contrast greatly with their opinion of protecting intellectual property rights' owners. This is perhaps because these judges are well educated and know the principles of intellectual property law, while they may not totally support the concept of private property. The study also illustrates that the purpose of intellectual property law to conform with other countries' laws is selected as the fifth out of seven choices.¹¹¹⁸ Therefore, the aim to protect intellectual property rights' owners may be chosen because of the influence of international obligation.

¹¹¹⁵ *Ibid* .

¹¹¹⁶ In the past, it seems that intellectual property rights' owners were not the main focus of protection. For this discussion, see Chapter 4 section Copyright. At present, according to the judges, the most important aim of intellectual property law is to protect intellectual property rights' owners. The second one is to recognize the person who creates the work.

¹¹¹⁷ See Table 31 in the Appendix II.

¹¹¹⁸ See Table 11 in the Appendix II. Some of them chose this choice as the most important aim of intellectual property law. See the questionnaires nos.8, 10, 12, and 17.

Secondly, the study shows that the judges believe that provisional measures are efficient in remedying intellectual property rights' owners.¹¹¹⁹ All of them agree with the effectiveness of provisional measures. Among them, nearly one fourth responded that they strongly agree with these measures' effectiveness. Arguably, the judges imply that they do not fully support the other remedial measures. Of the eighteen respondents, over 80 % do not agree that intellectual property rights' owners were already well protected before provisional measures came into force.¹¹²⁰ Moreover, they do not believe that the improvement of the trial, by speeding up the process, can replace provisional measures.¹¹²¹ Only 5 % agree with the speed-up trial.¹¹²² As a result, provisional measures are regarded as the most appropriate measure for protecting intellectual property rights' owners.¹¹²³ This positive attitude seems to be good news for intellectual property rights' owners.

Interestingly, criminal sanctions are placed in fourth position of the Table.¹¹²⁴ This result appears to be different from the opinions of several lawyers.¹¹²⁵ Nevertheless, it may possibly indicate that the judges view the issue of intellectual property rights infringement as a civil conflict, rather than a crime. Thus, they believe that civil remedies such as provisional measures, damages, or injunctions pending judgments are more

¹¹¹⁹ See Table 27 in the Appendix II.

¹¹²⁰ See Table 26 in the Appendix II.

¹¹²¹ See Table 28 in the Appendix II.

¹¹²² *Ibid* .

¹¹²³ See Table 12 in the Appendix II.

¹¹²⁴ *Ibid* .

¹¹²⁵ Interview with Chantarasak, Jitkuntivong, Mangklatanakul. From the lawyers' point of view, criminal sanctions are the most effective measures in remedying intellectual property rights' owners.

suitable measures in remedy intellectual property rights' owners than criminal sanctions.¹¹²⁶

Thirdly, it concerns the judges' confidence in provisional measures. In general, it seems that the judges agree that the process of enforcing provisional measures are better than the current trial procedure, both civil and criminal, in several aspects, such as in protecting intellectual property rights' owners, providing justice for society as a whole, and the process of trial. All of them concur that the owners will receive the better protection.¹¹²⁷ Among them, nearly a half believe that these measures are far better than the present procedure in protecting intellectual property rights' owners.¹¹²⁸

They also have a positive attitude that society will receive benefit from these measures. Two thirds agree with provisional measures, while the rest find no difference between these measures and the current trial procedure, in providing justice for society as a whole.¹¹²⁹ Additionally, regarding the trial process, more than 75 % view provisional measures as better than the current trial procedure, whereas the remainder saw no difference.¹¹³⁰

In the case of the protection of a prospective defendant, however, only a third recognize the benefit of provisional measures.¹¹³¹ More than 20 % of respondents disagree that provisional measures are better than current trial procedures.¹¹³² In this

¹¹²⁶ These choices are selected as the first, second, and third respectively.

¹¹²⁷ See Table 13 in the Appendix II.

¹¹²⁸ *Ibid* .

¹¹²⁹ See Table 15 in the Appendix II.

¹¹³⁰ See Table 19 in the Appendix II.

¹¹³¹ See Table 14 in the Appendix II.

¹¹³² *Ibid* .

respect, moreover, they do not find much difference between the current trial procedure and provisional measures in preventing errors from occurring during enforcement.¹¹³³ In addition, it can be argued that nearly a half do not have a positive attitude regarding provisional measures in the issues of speed or timeliness,¹¹³⁴ and costs.¹¹³⁵

Next, there is a question as to whether provisional measures will be enforced to remedy intellectual property rights' owners. According to the major aim of intellectual property law, it is likely that the judges will enforce these measures to protect intellectual property rights' owners. Furthermore, it seems that the judges will not allow intellectual property rights to be infringed. This argument is supported by the judicial opinion regarding the interpretation of the condition of balance of convenience. More than 70 % are not convinced that intellectual property rights may be allowed to be infringed if the other party's harm, caused by the protection, outweighs the damage.¹¹³⁶

Consequently, this affects the level of protection offered by provisional measures. As discussed above, the judges may not fully remedy intellectual property rights' owners, particularly when they perceive it to be against the public interest. For instance, the condition of irreparable harm is considered as the condition for limiting the use of interim injunctions.¹¹³⁷ Half of them admit that interim injunctions cannot be sought as long as the prospective defendant can compensate or the execution is not difficult.¹¹³⁸

¹¹³³ See Table 16 in the Appendix II.

¹¹³⁴ See Table 17 in the Appendix II.

¹¹³⁵ See Table 18 in the Appendix II.

¹¹³⁶ See Table 40 in the Appendix II.

¹¹³⁷ See Table 38 in the Appendix II.

¹¹³⁸ See Table 39 in the Appendix II.

It is likely that the judges will enforce provisional measures with care. All of them admit that intellectual property rights' owners are the group of persons who benefit from these measures.¹¹³⁹ In contrast, less than 40 % feel that society will benefit from provisional measures.¹¹⁴⁰ Additionally, less than a half think that domestic owners of businesses relating to intellectual property will get benefits from the said measures.¹¹⁴¹

It should be noted that over three quarters believe that foreign intellectual property rights' owners get a lot of benefits from provisional measures,¹¹⁴² whereas less than a half agree in the same degree for domestic ones.¹¹⁴³ This attitude is remarkable since it implicitly reveals that the judges do not feel that domestic intellectual property rights' owners achieve this privilege at the same level as foreign ones. To some extent, this conforms to the suggestion, as discussed in Chapter Four, that intellectual property law in Thailand has probably been amended to comply with TRIPs. Therefore, it aims to provide protection for 'foreigners'. If this is true, it may inevitably affect the way judicial discretion is exercised.

The number of both foreign and domestic intellectual property rights' owners in Thailand have been collected by the Department of Intellectual Property. However, only statistics of registered rights, namely trade marks and patents, have been gathered. There are no clear statistics for copyright owners. From the figures, it appears that the

¹¹³⁹ See Tables 20, 21 in the Appendix II.

¹¹⁴⁰ See Table 22 in the Appendix II.

¹¹⁴¹ See Table 24 in the Appendix II.

¹¹⁴² See Table 20 in the Appendix II.

¹¹⁴³ See Table 21 in the Appendix II.

number of foreign and domestic trade marks' owners are rather similar, while the domestic patents' owners are outnumbered by the foreign ones. (See the Figures 13-14)

Year	Thai	Foreign	Total
1992	4,376	3,780	8,156
1993	4,562	3,585	8,147
1994	7,101	5,902	13,003
1995	6,173	6,120	12,293
1996	4,546	5,382	9,928
1997	3,614	4,543	8,157
Total	30,372	29,312	59,684

Figure 13 Number of registered trade marks.¹¹⁴⁴

¹¹⁴⁴ See Department of Intellectual Property. *Annual Report 1997.op.cit* . p.102.

Year	Thai	Foreign	Total
1992	83	303	386
1993	92	359	451
1994	62	612	674
1995	101	681	782
1996	186	1,169	1,355
1997	198	933	1,131
Total	722	4,057	4,779

Figure 14 Number of granted patents.¹¹⁴⁵

According to these figures, judges may be reluctant to bind themselves strictly to the purpose of intellectual property law, i.e. to protect intellectual property rights' owners, when granting provisional measures. It is not because of an intense bias against foreign owners. It is possibly because judges may decide to keep private and public interests in balance. At present, concrete proof has still been required to show that Thai society would benefit from strict protection for intellectual property rights' owners. In this case, domestic owners of intellectual property rights are inevitable sacrificed and cannot achieve appropriate protection as they also expect. This idea may arguably be

¹¹⁴⁵ See Department of Intellectual Property. *Annual Report 1997*. op.cit . p.110.

supported by a result of the study that one third of judges disagree that the aim of intellectual property law may influence judicial discretion when considering applications for the said measures.¹¹⁴⁶ As a result, several elements may be considered when deciding whether or not to grant these measures.

Finally, the judicial attitude will be examined regarding the issue of conditions in granting interim injunctions. It is noteworthy that the three conditions required by law are chosen by the judges as the most appropriate conditions to be used in considering an application for interim injunctions.¹¹⁴⁷ They are the conditions of sufficient ground to apply for an order, irreparable harm, and balance of convenience. However, the sequence of these top three conditions are not the same as those stated in the law.¹¹⁴⁸ The condition of balance of convenience seems to be more significant than the condition of irreparable harm.

In addition, the condition of the amount of disputed compensation is selected as fourth place in the Table.¹¹⁴⁹ This may be because, normally, this condition has been examined in civil cases to ensure the court's jurisdiction. In general, the Kwang court can adjudicate a civil case where the amount of disputed compensation is not more than 40,000 Baht (1,000 Pounds),¹¹⁵⁰ whereas the provincial court's jurisdiction is not limited by the amount of disputed compensation. The judges may be accustomed to this condition and regard it as an appropriate condition in considering the issue.

¹¹⁴⁶ See Table 34 in the Appendix II.

¹¹⁴⁷ See Table 25 in the Appendix II.

¹¹⁴⁸ Rule 12.

¹¹⁴⁹ See Table 25 in the Appendix II.

¹¹⁵⁰ The Judicature Act Section 24 (4).

On the contrary, the judges do not pay much attention to the condition of the likelihood of success. This condition is placed second from bottom in the Table.¹¹⁵¹ In fact, this condition seems to be helpful particularly when the condition of balance of convenience is scrutinized.¹¹⁵² According to the study, this condition is probably less important when an application is examined. The judges may not want to be influenced by the anticipated result of a case.

6.5.3 THE JUDGES' QUALIFICATIONS AND THEIR ATTITUDE

The next question is whether the judges' qualifications affect their opinion regarding the issue of provisional measures. From the study, there are several significant qualifications of the judges, such as gender, age, education, and experience. It will be helpful in the future if the study can find out whether judicial attitudes are influenced by certain types of the qualifications.

According to the characteristic of gender, however, there seems to be no difference between the opinions of male and female judges. When considering the attitude of female judges, they share the only critical opinion which is rather different from the majority. They choose damages as the most appropriate measure in protecting intellectual property rights' owners.¹¹⁵³ Moreover, it appears that female judges do not recognize how significant provisional measures are.¹¹⁵⁴

¹¹⁵¹ See Table 25 in the Appendix II.

¹¹⁵² See the American Cyanamid case. Per Lord Diplock.

¹¹⁵³ There are three female judges in this Court. All of them have a second degree in law from abroad. They answered the questionnaires numbers 3, 4, and 10. They are three out of the six judges who selected damages as the most appropriate measure.

¹¹⁵⁴ They place provisional measures in the middle of Table 11 in the Appendix II.

In general, there is no clear difference in attitude among judges of different ages either. From the study, out of eighteen respondents, 33 % are judges who are under forty years old, 50 % are between forty and fifty years old, and around 15 % are over fifty years old. They share similar opinions in several issues. A notable difference concerns the question whether an applicant can apply for interim injunctions, notwithstanding that the infringer is unidentified.¹¹⁵⁵ Nearly a half of the judges disagree with this idea. All those judges who are over fifty years old are among this group.¹¹⁵⁶

The results are the same when considering the qualifications of education and experience. Those judges who share the same qualifications responded to one set of questions similarly, however, differently for the others. It should be remarked, nevertheless, that the judges with less experience share a similar attitude in considering interim injunctions.¹¹⁵⁷ They are among 40 % of judges who disagree that interim injunctions must be sought *ex parte*,¹¹⁵⁸ and nearly 50 % who agree with the reverse interpretation of irreparable harm.¹¹⁵⁹

Consequently, it is difficult to summarize whether judicial qualifications affect their attitude. This may be because their qualifications are not particularly different. All of them graduated from Universities in Thailand for their first degree, and passed the Barrister examination. During the period of judge traineeship, they attended traditional training courses. As a result, they may have similar attitudes.

¹¹⁵⁵ See Table 30 in the Appendix II.

¹¹⁵⁶ They are judges who filled the questionnaires numbers 5, 13, and 18.

¹¹⁵⁷ There are two judges who had less than five years experience before commencing a judicial career, and have worked as judges less than ten years. They are the judges who filled the questionnaires numbers 1 and 9.

¹¹⁵⁸ See Table 37 in the Appendix II.

¹¹⁵⁹ See Table 39 in the Appendix II.

6.5.4 THE JUDICIAL ROLE

The last aspect to be considered is the role of the judges in the Central Intellectual Property and International Trade Court. This is to find out the role of the judges in remedying intellectual property rights' owners. If the judges do not think that this is their major role and limit their role to protecting intellectual property rights' owners, remedial measures may not be enforced fruitfully. They may be indulgent and allow the parties to proceed with their cases. In addition, the time and cost during the trial, perhaps, will be wasted. For instance, the judges may decide to make an enquiry for an application, either *ex parte* or *inter parte*, and the process of granting provisional measures will be delayed.

Normally, the judge is empowered to seek the facts, particularly in a criminal case.¹¹⁶⁰ This idea is found in the Criminal Procedure Code. The law states that during the trial, the court may, of its own motion or upon the request of a party, take additional evidence.¹¹⁶¹ Therefore, the judge is allowed to play his role in finding the truth. In addition, the court is also empowered to demand the file of an inquiry from a public prosecutor for consideration in deciding the case, after the public prosecutor has adduced his evidence.¹¹⁶²

¹¹⁶⁰ It has been argued that the judge, especially in an acquisitorial system, will examine, evaluate, and weigh all relevant evidence in order to reach an accurate determination of the issues. See W. Pizzi, "Crime Victims in German Courtrooms: A Comparative Perspective on American Problems," Stanford Journal of International Law 32(1996) p. 44.

¹¹⁶¹ Section 228. See, for example, the Supreme Court's judgments nos. 1901/2521 (1978), 686/2523 (1980), 3122/2523 (1980).

¹¹⁶² The Criminal Procedure Code Section 175.

However, it seems that the judge is not so active in this role. Sometimes, he has been criticized for applying the concept of a civil case to a criminal one.¹¹⁶³ In civil cases, the judge seems to be indulgent and leave the parties to present the facts in the case. As a result, the role of finding the truth is limited by the judge himself.

Moreover, the judge may scale down his role because he regards himself as merely an interpreter of the code. This appears to be the result of the rigid distinction between the Legislative, Executive, and Judiciary embodied in the notion of separation of powers.¹¹⁶⁴ As a result, the judge may not exercise his discretion fruitfully (since he may be wary of encroaching on the territory of the Legislature and/or the Executive).

Additionally, the judge may limit his discretion with precedent. Even though the court is not required by law to follow a precedent, he is prone to follow decisions of the Supreme Court which contained similar facts.¹¹⁶⁵

Furthermore, the active role may be limited by worry about errors which may occur during the process. It is hard to deny that there are a few errors in the trial, no matter how careful the judges are.¹¹⁶⁶ Therefore, the judge may hesitate to initiate any action if there is a chance that the said action will cause any error. The judge may choose to

1163 See K. Na Nakorn K, The Criminal Procedure Code (Bangkok : Netitham, 1986) p.4. Also S. Likkasivattanakul, "Criminal Justice Process in Thailand : Some Aspects and Resolutions," Doolaph 43(1996) p.8.

1164 See V. Muntarbhorn, "Judicial Approach in French and English Law," Chulalongkorn Law Journal Special Issue. 1980. p.41.

1165 Interview with J.Thanomrod.

1166 It may be expected that the judges will not limit their roles in granting provisional measures primarily because of this worry. From the study, over 27 % suggest that these measures are better than the present procedure in preventing errors from occurring during enforcement. 44 % find no difference, while 22 % are still doubtful and feel that provisional measures are even worse (than the present procedure) in preventing errors from occurring during enforcement. See Table 16 in the Appendix II.

follow the routine act instead. Justice may not be denied, however it is likely that justice will be delayed.

In practice, the judge has been required to play a more active role in the trial.¹¹⁶⁷ The concept of the trial manager has been discussed, for instance, in England.¹¹⁶⁸ This means that the judge will be urged to take control over litigation. He will be empowered to set a deadline for a trial, cut short the speeches, and require the documents to be submitted on time.¹¹⁶⁹ Subsequently, the judge will determine the pace and intensity of litigation, rather than leaving the trial to the lawyers.¹¹⁷⁰ As a result, the judge has to decide how a case should be tried. In addition, the judge may be able to issue 'appropriate orders for costs' against a lawyer who delays the case.¹¹⁷¹

This change may not happen abruptly. In fact, this proposal has been opposed by some lawyers.¹¹⁷² Also, it has been argued that some judges may find the change 'bewildering'.¹¹⁷³ Nevertheless, this proposal can be regarded as a cornerstone of law enforcement. It will allow the judge to guide the trial in the appropriate direction in order to provide justice to society. In the case of intellectual property, the trial may be speeded up, and provisional measures may not be needed.

¹¹⁶⁷ For example, Lord Lane was quoted as saying that, "judges nowadays should more often stop counsel from indulging in prolixity, unnecessary questions and repetition". See "Lord Taylor's Proposals for the Civil Courts Are Wise," *The Times* (Wednesday) January 25, 1995. p.15.

¹¹⁶⁸ See F. Gibb, "Judges Told to Deliver Cheap and Fast Justice," *The Times* (Saturday) June 17, 1995. p.5.

¹¹⁶⁹ See "Lord Taylor's Proposals for the Civil Courts Are Wise" *op.cit.* p.15.

¹¹⁷⁰ See A. Zuckerman, "Keeping the Woolf from the Door," *The Times* (Monday) June 16, 1997. p.20.

¹¹⁷¹ See "Taylor Orders Lawyers to Cut the Waffle" *The Times* (Wednesday) January 25, 1995. p.1.

¹¹⁷² See F. Gibb, "Lawyers Challenge Taylor's Attempt to Speed Wheels of Justice," *The Times* (Saturday) May 13, 1995. p.11.

¹¹⁷³ See "Lord Taylor's Proposals for the Civil Courts Are Wise" *op.cit.* p.15.

For the role of a trial manager, it seems that the judges in Thailand have already been empowered to play this role.¹¹⁷⁴ The law allows the judge to settle the disputed issues to be tried and to fix the day of taking evidence.¹¹⁷⁵ If the case is adjourned, according to the request of any party, the court may order this party to pay fees to the witness and the expenses of the other parties.¹¹⁷⁶ Moreover, the court is also empowered to commission another court of the first level to carry out the proceedings, on his behalf.¹¹⁷⁷ This can be undertaken whenever the court deems appropriate and the parties so agree, to ensure that the case will be tried without delay.

It appears, from the study, that judges agree that they should play an active role. More than 80 % agree that the court has the role of maintaining justice in society.¹¹⁷⁸ This attitude will stimulate the judge to play an active role in seeking justice in these cases. Therefore, the judges' role of finding the facts in the case seems significant, rather than merely judging the case through the parties' evidence. Consequently, it may be anticipated that the judicial power will be enforced more fruitfully. For instance, the judge may summon the witness to the court when he deems appropriate.¹¹⁷⁹ In fact,

1174 See U. Nitimontn, "Some Aspects on Judicial Trial," *Doolapah* 40(1992) pp.46-64.

1175 The Civil Procedure Code Section 182 para.2.

1176 The Civil Procedure Code Section 40 para.2.

1177 The Civil Procedure Code Sections 16 para.2, 102.

1178 See Table 36 in the Appendix II.

1179 Rule 39 of the Rules for Intellectual Property and International Trade Cases B.E.2540 states that if the court deems necessary in the interest of justice for additional evidence relating to any issue in a case, including documents or materials possessed or under the care of a party, the court will, on its own motion, continue with the taking of evidence, including calling any witness already adduced to testify again.

the judges already have this power, however, they have chosen not to use it at present.¹¹⁸⁰

To be more active, a judge should not bind himself strictly to the statutes. To maintain justice in society, it is believed that both the statutes and the real meaning of justice should be taken into consideration. All the judges in the Central Intellectual Property and International Trade Court seem to accept this idea.¹¹⁸¹ This may be because these judges think that they have more roles than only interpreting the code since the statutes alone cannot maintain justice in society.¹¹⁸² This concept is not unfamiliar for them because it has been inserted in several royal speeches given to the lawyers, such as :

The law *per se* is not justice. It is merely a method to provide and to maintain justice in society. Therefore, the law must be enforced in order to maintain justice in society, not to maintain the law as such. In addition, the aim of maintaining justice in society should not be limited within the scope of the law. Morality and rationality should also be taken into consideration.¹¹⁸³

According to the above concept, judges will be able to exercise their discretion more flexibly, subject to the scope of the law. It ensures that the judge will be allowed to find a suitable device for maintaining justice in society under the law. As a result, for instance, an enquiry may be conducted if the judge deems it appropriate. This rationale may be

¹¹⁸⁰ There is an opinion that, in the case of an application for an injunction pending judgment, the judge may summon an applicant's witness (who the applicant decides not to bring to the court) as the court's witness for an enquiry. See Kalkam. *op.cit.* p.181. Sataman. *op.cit.* p.74.

¹¹⁸¹ See Table 35 in the Appendix II.

¹¹⁸² This topic is widely discussed in P. Payutto, (Phradhampidok), Law in a Buddhist way (Bangkok : Buddhadham Foundation, 1998).

¹¹⁸³ The Supreme Court, The Cerebration for the Golden Jubilee on the Reign (Bangkok : Ministry of Justice, 1996) p.71. It is a speech of His Majesty the King given to the Barristers-at-law, on October 29, 1981.

used to describe why, in the case of interim injunctions, the provision of an enquiry is not required. To some extent, the said discretion may be acceptable if it is transparent, i.e. the said discretion is reasonable and clearly explicable.¹¹⁸⁴

It seems true that this change is needed. However, it should be done carefully since the change may affect the parties' rights of litigation. Consequently, the Rules for Intellectual Property and International Trade Cases B.E.2540 were enacted, under the judicial power, partly to make the law more flexible and allow the judge to exercise his discretion appropriately.¹¹⁸⁵

This change will, perhaps, be significant in improving intellectual property law in the future. Suitable precedents can be established through this role. Subsequently, intellectual property law will be enforced appropriately. The law, namely the Rules of the Intellectual Property and International Trade Court, can also be used as guidelines. Then, an amendment of intellectual property law and the said rules, if so required in the future, can be based on practical experience. Arguably, the changes will then conform to the needs of society, which would be better than revising the law based primarily on an international concept.

This practice, i.e. the way to improve the law through the experience of society, will benefit both individuals and the public as a whole. From an individual side, it seems that intellectual property rights' owners will achieve 'enforcable' protection for their rights since such protection will be enforced in the way which is accepted in society. In this case, the authorities may hesitate less to give the protection to intellectual property

¹¹⁸⁴ See TRIPs Article 41 (3).

¹¹⁸⁵ For instance, Rule 4 of the Rules for Intellectual Property and International Trade Cases B.E.2540 states that the court, if it deems it appropriate so as to ensure convenience, expediency and fairness of the proceedings, may conduct proceedings in accordance with the parties' agreement, unless the agreed proceedings are unlawful or contrary to public order or good morals.

rights' owners since they themselves may have already agreed that such protection is required. From the public side, society will be confident and support the law since it realizes that this law is needed and will be enforced in an 'acceptable' way. It has never been ideal and will hardly be a success to enforce an 'imported' law in society, especially by ignoring the needs of society. Lack of support from society, it is believed, can easily deny the effectiveness of the law.

For the issue of provisional measures, the said active role will inevitably affect the enforcement. It is likely that the judges may support the enforcement of these measures since they regard these measures as the most appropriate ones for protecting intellectual property rights' owners. Moreover, they seem to prefer civil remedies to criminal sanctions.

Judges may have to speak out publicly about the law as an additional role. It has been suggested that making a judgment is not a judge's sole responsibility.¹¹⁸⁶ He should, outside the court, act as a law critic. By giving his shrewd opinion, the judge may initiate sound practice for provisional measures. Then, it may be expected that these measures, in the future, will be practical and appropriately enforced.

In England, for instance, judges have also been told to speak out and explain policies.¹¹⁸⁷ This, however, is not expected to be done too often. It has been argued that the judges should have a role in the evolution and development of a sound legal system in which the public can have confidence.

¹¹⁸⁶ See B. Suchiva, "A Justice Maker," *Doolapah* 42(1995) p.10. This is a suggestion made by His Majesty the King for the judiciary on the occasion of the King's Birthday, December 5, 1980.

¹¹⁸⁷ See "Judge Told to Dispel 'Aloof Image" *The Independent* April 16, 1996. p.6.

However, it appears that the judge in Thailand prefers to 'speak out' through his judgment to other channels.¹¹⁸⁸ It is unusual for a judge to express his opinion regarding specific issues in public. Moreover, the judges may be anxious about conflict between the Judiciary and the other branches of power.¹¹⁸⁹

Speaking out through a judgment is unlikely to be a good way of giving the judicial opinion to the public. Delay is a clear disadvantage. The judge has to wait for a case concerning the issue to arise for him to adjudicate. The said case may never be instituted. Furthermore, the judgments of the lower courts are not well circulated in public, unlike the Supreme Court's judgments. Therefore, the public may regard it as inconvenient to trace the judgments of each lower court by themselves.

Nevertheless, there is another route to speak out in public. The judge sometimes expresses his opinion to society through academic channels. Currently, the Central Intellectual Property and International Trade Court holds intellectual property courses for the public.¹¹⁹⁰ Also, the judges in this court frequently participate in seminars relating to intellectual property law. One significant occasion is the training course for lawyer trainees.¹¹⁹¹ This is a great opportunity for judges to persuade lawyers to be confident in the effectiveness of provisional measures.

It should be noted that this role is not to force or require lawyers to accept provisional measures. It must be up to the lawyers' discretion whether or not to apply for the said

¹¹⁸⁸ Interview with Viturat.

¹¹⁸⁹ See V. Mahakhun, "The Executive and the Judiciary: The National Security and the Rule of Law," Chulalongkorn Law Journal 4(1978) p.5.

¹¹⁹⁰ For example, the Central Intellectual Property and International Trade Court held a course of 'Intellectual Property Law under TRIPs and Law Enforcement under the Central Intellectual Property and International Trade Court' during April 20 - June 15, 1998.

¹¹⁹¹ Interview with Manas-siripen.

measures. It seems clear that they will not apply for these measures unless they are confident of the measures' effectiveness. In addition, they will hesitate to seek these measures if they feel that these measures are too complicated or too expensive.¹¹⁹²

Unfortunately, it is doubtful whether the judges in the Central Intellectual Property and International Trade court will act effectively in this role. This is because of their attitude regarding provisional measures. As discussed above, although they agree that provisional measures are the most appropriate measures for protecting intellectual property rights' owners, the judges seem not totally confident about these measures. Consequently, they may not try hard enough to establish society's confidence in provisional measures.

Besides, it seems that the country's advantage in economy and technology transfer is not regarded as a crucial condition for the judges when granting interim injunctions. In their opinion, this condition is ranked at the bottom of the Table.¹¹⁹³ Therefore, it is unlikely that the judicial decision will be swayed by this condition. To some extent, it shows that justice will not be influenced by external pressures.

It is noteworthy that the judges do not pay much attention to this condition not because they lack information on the economic situation. From the study, it illustrates that they follow world economic news.¹¹⁹⁴ They receive the said information through several media, such as television, newspapers, magazines, etc.

To sum up, if judges were active in their roles, intellectual property rights' owners might benefit from the existence of provisional measures. These measures would not be enforced merely in a passive way. In other words, the said measures might be used not

¹¹⁹² Interview with Mangklatanakul.

¹¹⁹³ See Table 25 in the Appendix II.

¹¹⁹⁴ See Table 6 in the Appendix II.

only to remedy an intellectual property rights' owner but also to protect him. This might also deter any persons from infringing intellectual property rights, as they might realize that they would not receive any benefits from illegal acts, and must obey the law. It might result in a reduction of both the number of infringements and cases.

However, there is no sign that the judges will enforce provisional measures for the purpose of deterrence. The study illustrates that they do not regard deterrence as a significant condition when considering an application for interim injunctions.¹¹⁹⁵ They rank this condition in sixth place in the Table. In addition, the judges may intend to enforce interim injunctions primarily to preserve the *status quo*.¹¹⁹⁶ Over 90 % agree that the main purpose of interim injunctions is to preserve the *status quo*. As a result, it is likely that interim injunctions will be enforced merely to limit the damage caused by the infringement, or just to abort an occurrence of the said infringement.

In Thailand, it should be noted that civil remedies are rarely enforced for the purpose of deterrence. Damages are an example. An injured person is merely compensated for his actual loss.¹¹⁹⁷ As a result, the amounts of damages decided by the court are regarded as too low,¹¹⁹⁸ particularly when compared with the plaintiff's costs.¹¹⁹⁹

¹¹⁹⁵ See Table 25 in the Appendix II.

¹¹⁹⁶ See Table 32 in the Appendix II.

¹¹⁹⁷ The Civil and Commercial Code Section 438.

¹¹⁹⁸ For example, see the Supreme Court's judgments nos.481/2526 (1983), 1399/2534 (1991).

¹¹⁹⁹ See S. Deo-isres, Assessment for Damages in Trademark Infringement (LL.M. Thesis, Chulalongkorn University, 1993) p.18.

Arguably, underlying this concept is the theory of obligation.¹²⁰⁰ An injured person, due to this concept, will not be compensated more than his actual loss.¹²⁰¹

Furthermore, the anxiety of error may outweigh the deterrent effect. The judge is unlikely to take a risk when granting provisional measures, particularly interim injunctions, without making an enquiry. Interim injunctions may even be sought *inter parte* to ensure that there is no mistake in the process. As a result, time may be wasted, and, inevitably, the deterrent effect will be diluted.

Nevertheless, judges still believe that provisional measures help decrease the number of cases reaching the court. 60 % responded to this question in a positive way.¹²⁰² The number of cases may be decreased because of other factors, apart from deterrence. For instance, a prospective defendant may be successfully refrained from committing the infringement. Thus, a further litigation is not required. In addition, provisional measures may provide bargaining power to intellectual property rights' owners. Therefore, they may reach solutions with the infringers and do not need to institute their cases. This may be the other bright side of the said measures.

¹²⁰⁰ It has been suggested that this theory is applied in several civil law countries. See Panchanavanich. *op.cit.* p.30

¹²⁰¹ In common law countries, an injured person may be compensated with exemplary damages too. See Hall. *op.cit.* p.236. The American Court, for instance, insisted that damages could be granted for remedial, as well as punitive, reason. See *Trio Process Corp. v. L.Goldstein's Sons, Inc.*, 638 F.2d 661 (3d. Cir.1980).

¹²⁰² See Table 29 in the Appendix II.

CHAPTER 7 : SUMMARY AND SUGGESTIONS

7.1 SUMMARY

This research set out to examine the impact of TRIPs on remedial measures in Thai law. Provisional measures were selected to represent all remedial measures in this study. It was expected that, in line with the aim of TRIPs, intellectual property rights' owners would be appropriately protected when provisional measures were enforced.

From the study, however, it appears to be difficult to conclude whether this hypothesis is correct or not. The statistics, at present, do not illustrate a downward trend in intellectual property rights infringements. Also, nothing indicates that intellectual property rights' owners have been efficiently protected, or remedied, by provisional measures. The fact is that a few cases concerning these measures have been reported. At this stage, it may be summarized only that intellectual property rights in Thailand are still being infringed.

This result seems disappointing. However, it is unlikely to be due to a lack of law since provisional measures in Thailand have existed in intellectual property law for a decade. From the study, TRIPs provisions concerning these measures have already been complied with. Although some minor issues involving the said measures in Thai law may have to be amended (in order to conform to TRIPs), there is no guarantee, yet, that provisional measures will be effective after such an amendment.

Therefore, it is perhaps the attitude of society concerning provisional measures, not the measures as such, which play an important element in enforcing these measures. The study implies that lawyers do not intend to apply for provisional measures, even though they recognize the existence of these measures. Apparently, lawyers do not really trust the effectiveness of provisional measures. They suggest that, today, criminal

sanctions are probably more effective than other remedial measures, including provisional measures, in protecting intellectual property rights' owners.

As a result, provisional measures may be effectively enforced only when society's attitude toward them is changed. Indeed, the law as such has to be improved. However, it seems impossible to expect that the aim of TRIPs can be achieved by merely amending, again and again, the current law.

It has been found that, nowadays, intellectual property is very significant, particularly on the international stage. This is because intellectual property, for instance sophisticated technology, relates directly to trade. Therefore, it is rather expensive, arguably, due to the process of research and development. Today, therefore, the economic value of intellectual property is a prime concern of the rights' owners.

It seems that intellectual property is now regarded as private property, rather than an asset to which everyone in the society can have access and use. Therefore, intellectual property rights' owners require strong protection for their intellectual property, at least, to a similar level as that provided for other types of property. Consequently, an attempt to strengthen intellectual property law is required.

It is hoped that the above aim will be achieved soon after the conclusion of TRIPs.¹²⁰³ The TRIPs agreement was initiated, arguably, to cope with the current situation of intellectual property rights infringement all over the world. Moral rights, for example, are not a major concern in this agreement. To some extent, TRIPs is expected to strengthen protection for intellectual property rights' owners, particularly in trade-related issues.

Although TRIPs was not expected to harmonize members' domestic laws, it inevitably requires members to provide a level of enforcement which is consistent with TRIPs

¹²⁰³ According to TRIPs Articles 65 and 66, developed countries are obliged to implement TRIPs by 1996, whereas developing countries and least-developed countries are obliged to do so by 2000 and 2005 respectively.

provisions. As a result, several measures may be required in domestic laws. Enforcement of these measures is also expected to be conducted in a manner consistent with TRIPs i.e. giving effective protection.

In Thailand, there have been several changes in intellectual property law during this decade. These changes have been carried out primarily to comply with TRIPs. Perhaps, the Royal Thai Government realized that it was not possible to oppose this global demand. It was, thus, time to accept this change in order to maintain the country's benefits. Thailand decided, therefore, to comply with its international obligations voluntarily, rather than to be forced to do so by unilateral sanctions.

These changes have been undertaken in Thailand through a 'top-down' approach. This approach is commonly used in the country, by the government, to improve the legal system. Nevertheless, the government has a duty to educate society to understand and to adjust itself to the new rules. A 'bottom-up' approach, in some respects, appears to be uncertain and time-consuming since there is no guarantee that a result can be achieved on time.

With regard to the issue of intellectual property law, it is unclear whether society has already been educated. There is no noticeable sign that society's attitude toward this issue has changed. Even now, attempts to amend intellectual property law (to comply with TRIPs) are still opposed by some groups in society. From their perspective, Thailand will not gain any benefits from this change. In contrast, arguably, Thailand has been forced to amend its intellectual property law primarily to protect 'foreigners'.

The judicial attitude has been scrutinized in earlier chapters. It seems clear that the judges in the Central Intellectual Property and International Trade Court are aware of the aims of intellectual property law. They admit that, according to intellectual property law, intellectual property rights' owners should be protected. However, the degree of

protection is a further question. It appears that the judges do not totally accept that intellectual property should be regarded as private property. In the case of provisional measures, it may be anticipated that these measures will be enforced efficiently if they are sought. From the judicial perspective, provisional measures are regarded as the most appropriate measure for protecting intellectual property rights' owners.

The study revealed no significant evidence, however, that judicial attitudes are affected by the judges' qualifications. Several elements, such as gender, age, education, and legal experience, have been examined. They do not reveal that similar groups of judges have different attitudes from others. Some differences, for instance where female judges select damages as the most appropriate measure for protecting intellectual property rights' owners, may be deemed insignificant. Consequently, it is not possible to conclude that judicial qualifications have an influence on the enforcement of provisional measures.

Nevertheless, judges' roles may be affected by their attitudes. Generally, in the case of provisional measures, the major role of the judge is to decide whether to grant these measures when they are sought. For this role, the enforcement of provisional measures may be considered primarily to protect intellectual property rights' owners. If the judge has a positive attitude toward these measures, he may undertake his role actively. As a result, these measures may be enforced effectively. Provisional measures may even be granted to deter any attempts at infringement.

On the contrary, if the judge does not consider provisional measures in a positive way, it can hardly be expected that these measures will be enforced efficiently. The judge may instead choose to be inactive and enforce the said measures in a conservative approach, i.e. to remedy an injured person after his rights have already

been infringed. Consequently, the judge may, perhaps, rely on the balance of hardship and consider that other remedial measures, *inter alia*, damages, are adequate.

The judge could play an additional role by speaking out publicly over this issue. This would allow the judge to give his opinions and recommendations concerning provisional measures in public. Furthermore, the judge would also have a chance to educate society about the said measures, and intellectual property law as a whole. Therefore, society may gain knowledge of this issue and be able to adjust itself to the new law. Moreover, lawyers may have increased confidence in these measures and become more likely to apply for them. Consequently, it may be expected that, in future, provisional measures will be improved, or amended, in a more pragmatic way. It is better to improve the law in accordance with the needs of society than to improve it purely for international obligations.

It would be beneficial if judges decided to pursue an active role. However, they do not enjoy speaking out in public frequently, due to their conservative character. If they do not have a positive attitude concerning this issue, it seems unlikely that they will come out and support provisional measures. How can a judge encourage the lawyers' confidence when even the judge himself does not trust in these measures? If the present situation continues, provisional measures may not be sought and no one will know how to improve these measures pragmatically.

Seemingly, the judges in the Central Intellectual Property and International Trade Court agree that maintaining justice in society is the ultimate goal of the legal system. Therefore, judges should not be indulgent in trials. In addition, they should not bind themselves rigidly to the statutes since the law *per se* is merely a device for achieving justice. In this case, it is likely that the judges may play an active role in protecting intellectual property rights' owners.

However, it appears that the judges are not totally confident concerning provisional measures. In some aspects, they hesitate to concur that provisional measures are better than the current trial procedures, both civil and criminal. Furthermore, it seems clear that, from their perspective, intellectual property rights' owners, particularly foreigners, are the main group who will benefit from provisional measures. This attitude will inevitably affect the enforcement of the said measures. The order may be granted, however, under restricted conditions.

To sum up, provisional measures came into force in Thailand at a time when the society did not have a positive opinion regarding the measures. It seems that, even today, this attitude has not remarkably changed. However, it is time for Thai society to realize that it has to lay aside its own self-interests, and even national pride, and to face the fact that its attitude has to change. If not, Thailand may face trade sanctions and is likely to be left out of the fierce competition in world trade. This situation would be unbearable for the whole nation. Since the law (concerning provisional measures) is a must, the government has to improve society's attitude with regard to these measures. It has to be noted that the law *per se* is not justice, and the law cannot be enforced fruitfully without support from society.

7.2 SUGGESTIONS

The study has revealed that provisional measures are not yet effective in remedying intellectual property rights' owners. There are two main reasons for this. One is the law involving the said measures *per se*, and the other is the attitude of society regarding these measures. These issues, then, have to be improved in order to ensure that intellectual property rights' owners will be appropriately remedied.

With regard to legal improvement, this seems not so difficult. At present, the aim of the improvement is just to comply with TRIPs. It appears that some issues in Thai law do not conform to TRIPs. For instance, provisional measures can only be sought to protect copyright, patents, and trade marks. These remedial measures are not applicable, at present, for other intellectual property rights, such as layout designs of integrated circuit, geographical indications, or undisclosed information. Moreover, it is unlikely that a trade mark owner in Thailand can seek interim injunctions (to protect himself) before his right is infringed. The trade mark law allows a trade mark owner to apply for interim injunctions only when his trade mark has already been infringed, or the infringement is being committed, whereas TRIPs provides that the measures may also be sought when such infringement is imminent.

Additionally, time limitations for an applicant to litigate his case after the evidence has already been preserved may be required in order to implement TRIPs Article 50 (6). It may be claimed by some that this is unnecessary; however, it would probably help to accelerate the trial by ensuring that the litigation was held within a fixed period of time.

Nevertheless, it should be kept in mind that the law is merely a device used to maintain justice in society. The law itself is not justice, particularly statutes which are created to become rules of society. These may not be supported if society considers that they are not founded on justice.

There may be a question as to whether intellectual property law in Thailand maintains justice in society or not. According to the Thai perspective, it seems that the said law is not so just since many people still oppose it. At this stage, if Thailand finds that intellectual property law cannot maintain justice in society, it has to challenge this law in the international forum. However, it may not be a good idea to disobey the rules with which Thailand has an obligation to comply. It is because an image of Thailand, from

other countries' perspectives, may possibly be ruined and these countries may hesitate to do business with Thailand, because of their lack of confidence. Above all, Thailand is likely to be retaliated against if it refuses to follow the trade rules of world society.

It may be argued that society has not yet clearly understood the concept of intellectual property law. This is a very crucial issue. Today, it seems that Thailand is still behind many countries in the rapid change of world intellectual property law. This may be a significant reason why Thailand does not fully support the change.

Apart from being amended, the law should be clarified too. The transparency of the law is equally required to make clear to related persons how the law will be enforced. This will strengthen their confidence in the said law. Arguably, provisional measures are not effectively enforced because some issues in the law are still unclear.

For instance, the issue regarding whether interim injunctions should be sought *ex parte*. It seems possible that an enquiry will be carried out *inter parte*, due to the general principle stated in the Civil Procedure Code, even though the judges in the Central Intellectual Property and International Trade Court appear to prefer an *ex parte* enquiry. An explicit provision, like Section 7 paragraph 1 in the Arrest of Seagoing Ships Act B.E.2534, should be added to the Rules of Intellectual Property and International Trade Cases B.E.2540. This would ascertain that, subject to judicial discretion, these injunctions will be sought *ex parte*.

Moreover, the content of an 'affidavit' statement should also be clarified. It could be added to the Rules of Intellectual Property and International Trade Cases B.E.2540. This would guarantee to the judge himself that the evidence was trustworthy. A further enquiry, then, would be unnecessary. This would speed up the trial, unless many further details about matters in the said statement were required. Such details should be required only for those factors which the judge would use to grant an order at this stage.

In addition, this statement should be reliable. Regarding this requirement, a punishment may be needed for persons who give false information.

Also of concern is the process for executing the judge's order. Sanctions against a person who disobeys the judge's order should be explicitly stated. As a result, provisional measures may obtain a deterrent effect in a similar manner to criminal sanctions. Moreover, provisions involving security should also be included. In cases where the judge orders an applicant to provide security after granting an interim injunction, explicit measures should be stated for cases where the applicant fails to provide such security.

The aim of law enforcement should also be clarified. This will benefit both the judge, with regard to how to enforce the law, and lawyers, with regard to realizing how the law will be enforced. This issue is important since the aim of law enforcement is not explicitly provided for in the law. Sometimes, the law may be enforced differently from its aim. For example, the aim to protect an intellectual property rights' owner may be misinterpreted, and subsequently the owner may be able to use the law to gain advantage, such as access to confidential business information, from an infringer.

Furthermore, the law should not be enforced primarily to retaliate against a person for his wrongdoing. In fact, the law should be used as a guide for a person to know what is right or wrong, or can or cannot be done, in society.¹²⁰⁴ A person should obey the law because he agrees with the reason underlying the said law, not because he fears punishment. If a person does not agree with the law and is merely afraid of legal

¹²⁰⁴ An idea of using discipline to encourage people in society to behave properly, rather than to control their behaviour, has been discussed by Payutto (Phradhampidok). See P. Payutto, Sustainable Development (Bangkok : Buddhadham Foundation, 1996) particularly in p.200.

sanctions, it is likely that he will break the law whenever he anticipates that he will not be caught.

That is why severe punishment cannot decrease the number of intellectual property rights infringements in Thailand. Criminal sanctions are severe and may provide deterrent effects at some stage. However, due to inadequate and inappropriate enforcement, many still take risks to gain their benefits (by breaking the law). Severe punishment, then, is not an appropriate element in protecting intellectual property rights' owners.

Therefore, improvement in society's attitude is crucial. According to the present situation, Thailand has to accept what is right or wrong, or can or cannot be done, in world society. What was right or wrong, or what Thailand (or other countries) could or could not do, in the past is now unimportant. Precedents are unlikely to be applicable when the situation has changed. In other words, Thailand should be mindful that it has to live with the present circumstances. Therefore, Thailand has to do the best for the present. If it addresses these issues successfully now, it will reduce problems regarding intellectual property rights protection, and the possibility of trade sanctions in the future.

7.3 PROPOSALS FOR IMPROVEMENT

Two strategies are suggested in the study in order to improve the attitude of society regarding this issue. They are a short-term strategy and a long-term one. A short-term strategy is needed to solve the present situation, while a long-term one is a must for leading society in a correct direction.

The short-term strategy is to give appropriate knowledge regarding provisional measures to related persons, *inter alia*, the judges and lawyers. This knowledge is likely to contribute enormously to the lawyers' confidence. For instance, the meaning of

'irreparable harm' and 'balance of convenience' should be clarified and this would contribute to more efficient enforcement of provisional measures. This knowledge can be provided by several organizations, such as the Department of Intellectual Property, the Law Society, and the Central Intellectual Property and International Trade Court.

Subsequently, the roles of the judge should be strengthened. By regarding provisional measures as new civil measures, judges may have to be more active in their roles. They may have to take up the role of policy maker, in order to indicate how provisional measures should be practically enforced in society. This role may be undertaken by speaking out in public. Furthermore, judges may have to strengthen their role of maintaining justice in society.

Regarding the active role, provisional measures may be enforced to deter other persons from committing infringements, rather than simply to remedy intellectual property rights' owners. The deterrent approach focusses on the protection of intellectual property rights' owners, rather than the punishment of infringers. Where a deterrent approach is adopted, an infringer should be forced only to obey the law. He should not be punished for his fault. It is expected that three major effects will be provided by the deterrent approach. First, intellectual property rights' owners will be protected from infringements as soon as possible. Secondly, the effect of this may contribute to social confidence in civil remedial measures. Finally, society will be forced to accept that intellectual property should be protected in a similar manner to other private property.

For the long-term strategy, Thai society should be educated about provisional measures, and intellectual property law as a whole. Society should be guided to the

concept of private ownership.¹²⁰⁵ It is now time for Thai society to realize that, due to global change, intellectual property is expected to be treated as private property. A person may be able to use intellectual property, subject to the owners' consent. This concept is, then, different from the one which exists in many Asian countries. Consequently, intellectual property will not be regarded as property to which any person in society can freely have access and use anymore.

Additionally, the idea of protecting intellectual property by civil measures will be applicable. It will be the intellectual property rights' owner's responsibility to protect his own interests too. As a result, provisional measures will be enforced to support criminal sanctions in remedying intellectual property rights' owners.

Finally, society may have to consider that it is not only rights holders, particularly foreigners, who benefit from the strong protection of intellectual property rights. It may be true that these owners may gain more advantage than other persons from this protection at present. However, Thai society has to accept that it will benefit from this protection too and learn how to gain advantage from the law. In other words, society should understand that this change has been carried out not only to comply with TRIPs, but also to secure economic advantage in Thai society as a whole.

¹²⁰⁵ See Microsoft (Thailand) Co.Ltd., "Microsoft Honesty Hotline," Daily News November 12, 1998. P.21.

APPENDICES

APPENDIX I

THE TRANSLATION OF QUESTIONNAIRES

PERSONAL INFORMATION

1. Gender ... male, ...female
2. Age ... less than 40 years, ... between 40-50 years, ... over 50 years.
3. Educational level
 - 3.1 Bachelor degree (please specify the institution and the year of graduation)
 - 3.2 Barrister-at-law (the year of graduation)
 - 3.3 Other education (certification, diploma, or other postgraduate degree in law, if any (please specify the institution and the year of graduation)
 - 3.4 Other education (certification, diploma, or other postgraduate degree in other field, if any (please specify the institution and the year of graduation)
4. Have you ever studied, trained, observed, or attended intellectual property courses in Thailand? Please specify.
5. Have you ever studied, trained, observed, or attended intellectual property courses abroad? Please specify.
6. Do you follow world economic news or not? ... yes, ...no. If so, please specify which media (more than 1 answer can be chosen) ... TV, ... Radio,
... Newspaper, ... Magazine, ... Journal, ... Other(s), please specify.
7. Before entering a judicial career, I have worked for .. years.
 - 7.1 Legal profession (more than 1 answer can be chosen) ... Civil servant, ... State enterprise officer, ... Lawyer, ... Lecturer, ... Other(s) please specify

7.2 Other profession, please specify ...

8. You have been a judiciary for

... less than 10 years

... between 10-20 years

... between 21-30 years

... over 30 years

9. The number of intellectual property cases you have tried

... less than 10 cases

... between 10-20 cases

... between 21-30 cases

... between 31-40 cases

... between 41-50 cases

... over 50 cases

10. The number of applications for provisional measures you have examined

... none

... less than 10 cases

... between 11-30 cases

... over 30 cases

COMMENTS ON INTELLECTUAL PROPERTY LAW

11. According to your opinion, the most important aim of intellectual property law is ...

(please put the numbers 1-7 in sequence from the most important to the least important)

... to stimulate the creation of domestic work

... to recognize the person who creates the work

... to protect intellectual property rights' owners

... to preserve indigenous culture

... to protect the whole society, for instance, in the issues of origin or quality of goods

... to devise a fair competitive system in society

... to conform with other countries' laws

12. According to your opinion, the most appropriate measure in protecting intellectual property rights' owners is .. (please put the numbers 1-7 in sequence from the most important to the least important)

... injunctions pending judgment

... damages

... orders of destruction or confiscation

... provisional measures

... border measures

... criminal sanctions

COMMENTS ON PROVISIONAL MEASURES

When comparing with the current procedure (both civil and criminal), you think provisional measures are .. (please choose 1 answer for 1 question)

(1) far better, (2) better, (3) no difference, (4) worse, (5) far worse

13. as regards protecting intellectual property rights' owners..

14. as regards protecting the prospective defendant..

15. as regards providing justice to society as a whole..

16. as regards preventing errors from occurring during enforcement ..

17. as regards the time involved..

18. as regards the cost involved..

19. as regards the process itself..

According to your opinion, how have these groups of people been affected by the change since provisional measures have been in force in Thailand? (please choose 1 answer for 1 question)

(1) got more benefits, (2) got benefits, (3) no change, (4) lost advantages, (5) lost many advantages

20. foreign intellectual property rights' owners..

21. domestic intellectual property rights' owners..

22. society as a whole..

23. domestic consumers..

24. domestic owners of business relating to intellectual property..

25. The most appropriate condition to be used in considering an application for interim injunctions is.. (please put the numbers 1-8 in sequence from the most important to the least important)

... sufficient ground apply for an order

... the advantage for Thailand in economy and technology transfer

... the amount of disputed compensation

... irreparable harm

... balance of convenience

... personal records of an infringer such as criminal records

... deterrent effect

... the likelihood of success

How do you think? (please choose 1 answer for 1 question)

(1) strongly agree, (2) agree, (3) no idea, (4) disagree, (5) strongly disagree

26. Intellectual property rights' owners were already well protected before provisional measures came into force ...

27. Provisional measures are efficient at remedying intellectual property rights' owners ...

28. Speeding up the trial could substitute provisional measures ...

29. Provisional measures help decrease the number of cases reaching court ...

30. An applicant could apply for interim injunctions, notwithstanding the infringer is unidentified ...

31. Intellectual property is private property like normal commercial property ...

32. The major aim of interim injunctions is to preserve the status quo ...

33. The purpose of interim injunctions is different from that of injunctions pending judgment ...

34. The aim of intellectual property law as such may control judicial discretion when considering applications for interim injunctions ...

35. To maintain justice in society, not only the statutes, but also the real meaning of justice should be taken into consideration ...

36. The court has the role of finding the facts in the case, rather than judging the case through the parties' evidence ...

37. The application should be sought *ex parte* ...

38. According to Rule 13 (2), 'irreparable harm' is a condition for limiting interim injunctions to be granted only in necessary cases ...

39. Rule 13 (2) could be interpreted to mean "interim injunctions could not be sought as long as the prospective defendant could compensate or the execution is not difficult" ...

40. According to Rule 13 para.2, it is accepted that intellectual property rights may be infringed (if the other party's harm, caused by the protection, outweighs the damage) ...

APPENDIX II

TABLES OF QUESTIONNAIRES

Table 1 Gender

Male	15	83.33%
Female	3	16.67%

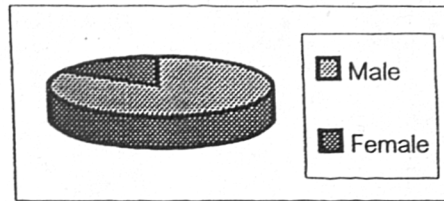


Table 2 Years of age

Less than 40	6	33.33%
Between 40-50	9	50.00%
Over 50	3	16.67%

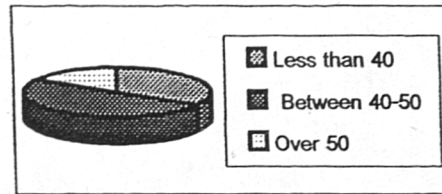


Table 3 Educational level

Bachelor degree in law	18	100.00%
Thai barrister-at-Law	18	100.00%
With other certification in law (in Thailand)	4	22.22%
With other certification in law (From abroad)	11	61.11%
With other certification in other fields	4	22.22%

Table 4 Experience from studying, training, observing, attending IP course in Thailand

Used to	17	94.44%
Never	1	5.56%

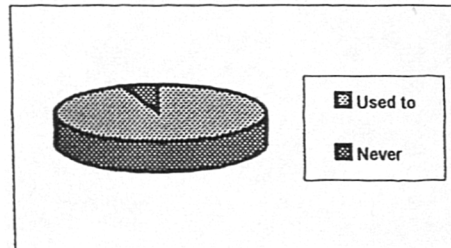


Table 5 Experience from studying, training, observing, attending IP course abroad

Used to	6	33.33%
Never	12	66.67%

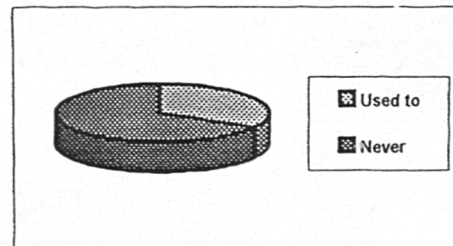


Table 6 How to access to world economic information

Television	16	88.89%
Radio	7	38.89%
Newspaper	17	94.44%
Magazine	4	22.22%
Journals	2	11.11%
Others	1	5.56%

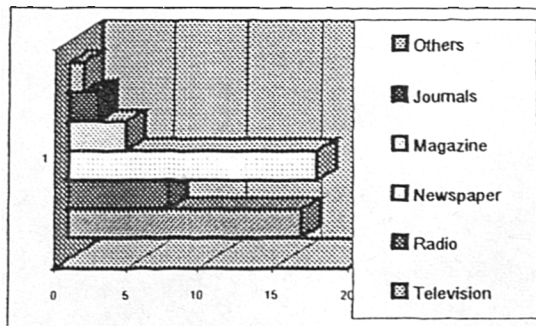


Table 7 Legal experience prior becoming a judiciary

Less than 2 years	7	38.89%
between 2 - 5 years	8	44.44%
over 5 years	3	16.67%

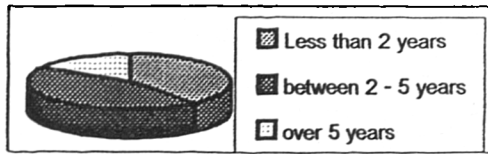


Table 8 Working experience as a Judiciary

Less than 10 years	4	22.22%
between 10 - 20 years	12	66.67%
between 21 - 30 years	1	5.56%
over 30 years	1	5.56%

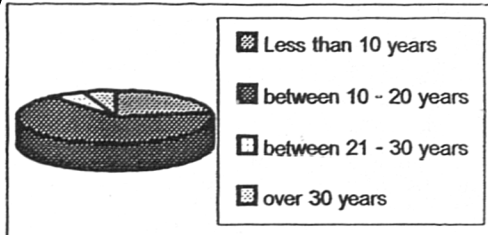


Table 9 Number of IP cases you have been tried

Less than 10 cases	4	22.22%
between 10 - 20 cases	6	33.33%
between 21 - 30 cases	1	5.56%
between 31 - 40 cases	2	11.11%
between 41 - 50 cases	0	0.00%
over 50 cases	5	27.78%

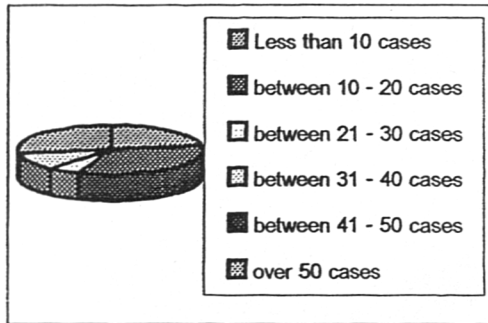


Table 10 Number of 'Provisional measures' you have been examined

Never	13	72.22%
Less than 10 cases	4	22.22%
between 10 - 30 cases	0	0.00%
Over 30 cases	1	5.56%

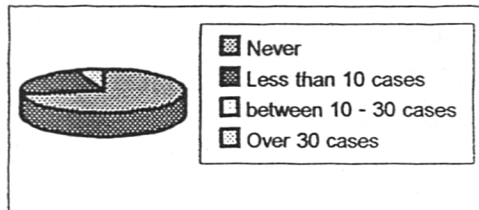


Table 11 The most important aim of IP law

	Total	Ave.	Rank
To stimulate the creation of domestic work	69	3.8	3
To recognize the person who creates the work	56	3.1	2
To protect IP rights' owners	33	1.8	1
To preserve indigenous culture	118	6.5	7
To protect the whole society	74	4.1	4
To devise a fair competitive system in society	78	4.3	6
To conform with other countries' law	76	4.2	5

Table 12 The most appropriate measure in protecting IP rights' owners

measures	Total	Ave.	Rank
Injunctions pending judgment	55	3.1	3
Damages	51	2.8	2
Orders of destruction or confiscation	77	4.3	5
Provisional measures	40	2.2	1
Border measures	84	4.7	6
Criminal sanctions	71	3.9	4

When comparing Provisional measures with the current trial procedure (both civil and criminal) in several aspects (Tables 13-19) you think Provisional measures are ...

Table 13 As regards protecting IP rights' owners

Far better	8	44.44%
Better	10	55.56%
No different	0	0.00%
Worse	0	0.00%
Far worse	0	0.00%

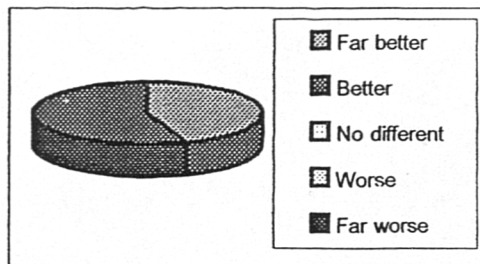


Table 14 As regards protecting the prospective defendant

Far better	1	5.56%
Better	5	27.78%
No different	8	44.44%
Worse	3	16.67%
Far worse	1	5.56%

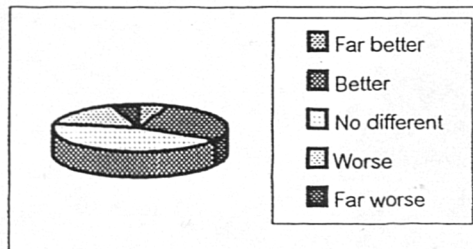


Table 15 As regards providing justice for society as a whole

Far better	4	22.22%
Better	8	44.44%
No different	6	33.33%
Worse	0	0.00%
Far worse	0	0.00%

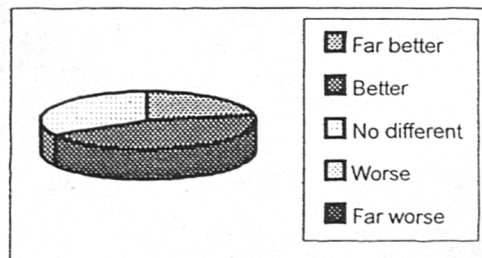


Table 16 As regards preventing errors from occurring during enforcement

Far better	0	0.00%
Better	5	27.78%
No different	8	44.44%
Worse	4	22.22%
Far worse	0	0.00%

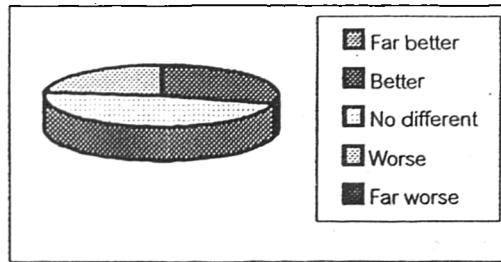


Table 17 As regards the time involved

Far better	0	0.00%
Better	10	55.56%
No different	8	44.44%
Worse	0	0.00%
Far worse	0	0.00%

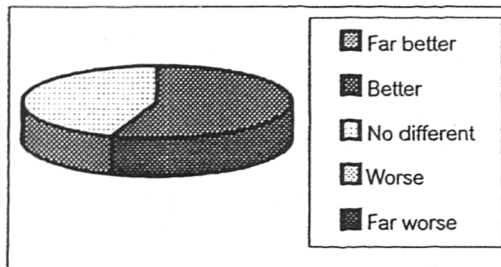


Table 18 As regards the cost involved

Far better	0	0.00%
Better	10	55.56%
No different	6	33.33%
Worse	1	5.56%
Far worse	1	5.56%

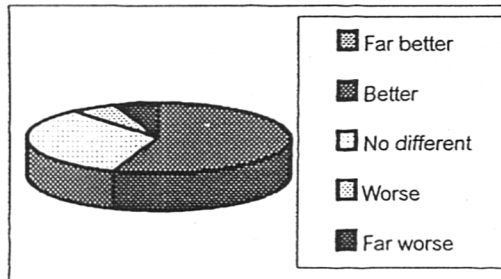
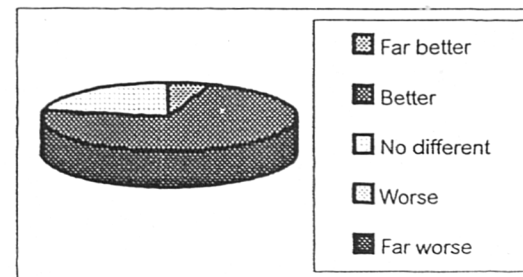


Table 19 As regards the process of trial

Far better	1	5.56%
Better	13	72.22%
No different	4	22.22%
Worse	0	0.00%
Far worse	0	0.00%



From Tables 20-24, according to your opinion, how these groups have been affected since Provisional measures have been in force,

Table 20 foreign IP rights' owners

Got many advantage	14	77.78%
Got advantage	4	22.22%
No change	0	0.00%
Lost advantage	0	0.00%
Lost many advantage	0	0.00%

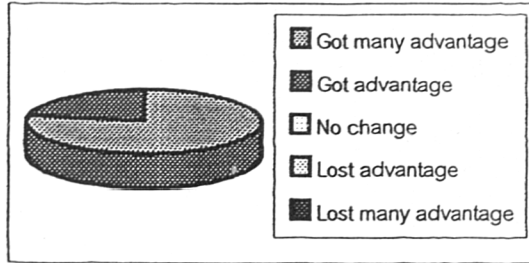


Table 21 domestic IP rights' owners

Got many advantage	8	44.44%
Got advantage	10	55.56%
No change	0	0.00%
Lost advantage	0	0.00%
Lost many advantage	0	0.00%

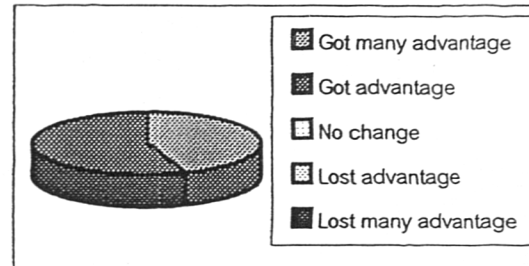


Table 22 society as a whole

Got many advantage	1	5.56%
Got advantage	6	33.33%
No change	8	44.44%
Lost advantage	3	16.67%
Lost many advantage	0	0.00%

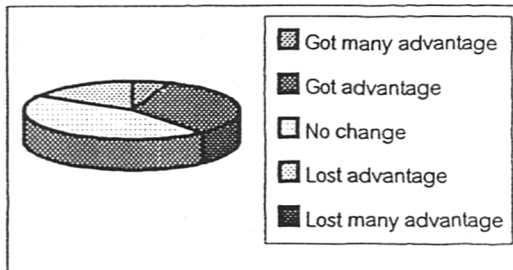


Table 23 domestic consumers

Got many advantage	1	5.56%
Got advantage	5	27.78%
No change	5	27.78%
Lost advantage	6	33.33%
Lost many advantage	1	5.56%

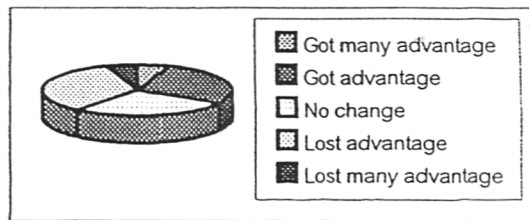


Table 24 domestic owners of business relatiy to IP

Got many advantage	1	5.56%
Got advantage	7	38.89%
No change	1	5.56%
Lost advantage	7	38.89%
Lost many advantage	2	11.11%

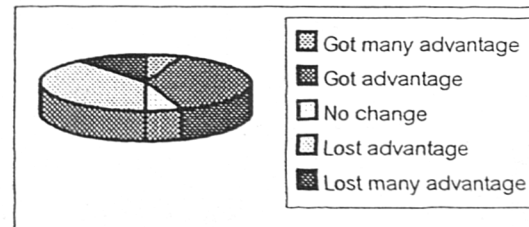


Table 25 The most appropriate condition in granting interim injunctions

	Total	Ave.	Rank
Sufficient ground to apply for the order	26	1.4	1
The advantage for Thailand in economy & technology transfer	120	6.7	8
The amount of disputed compensation	94	5.2	4
Irreparable harm	66	3.7	3
Balance of convenience	53	2.9	2
Personal's previous records	95	5.3	5
Deterrence	97	5.4	6
The likelihood of success	97	5.4	7

Table 26 IP rights' owner were already well protected before provisional measures came into force.

Strongly agree	0	0.00%
Agree	1	5.56%
No idea	2	11.11%
Disagree	15	83.33%
Strongly disagree	0	0.00%

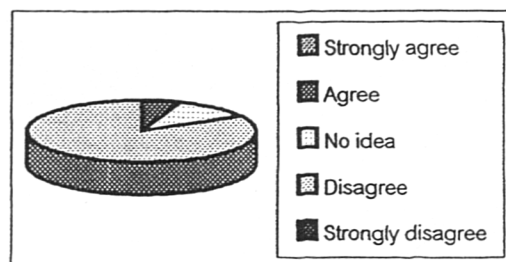


Table 27 Provisional measures are efficient at remedying IP rights' owner.

Strongly agree	4	22.22%
Agree	14	77.78%
No idea	0	0.00%
Disagree	0	0.00%
Strongly disagree	0	0.00%

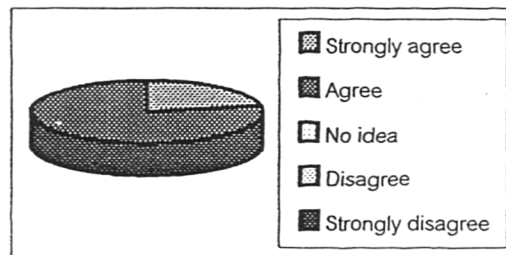


Table 28 Speeding up the trial could substitute provisional measures.

Strongly agree	0	0.00%
Agree	1	5.56%
No idea	0	0.00%
Disagree	13	72.22%
Strongly disagree	4	22.22%

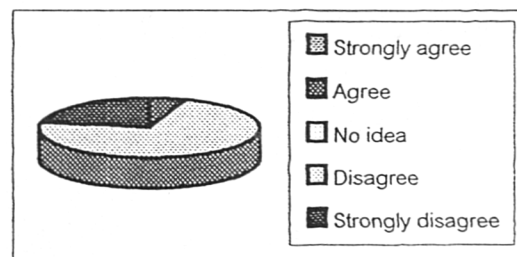


Table 29 Provisional measures help decrease the number of cases reaching the court.

Strongly agree	1	5.56%
Agree	10	55.56%
No idea	3	16.67%
Disagree	4	22.22%
Strongly disagree	0	0.00%

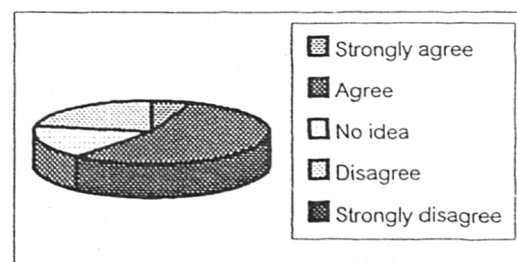


Table 30 Interim injunctions can be applied, notwithstanding the infringer is unidentified.

Strongly agree	1	5.56%
Agree	8	44.44%
No idea	0	0.00%
Disagree	6	33.33%
Strongly disagree	3	16.67%

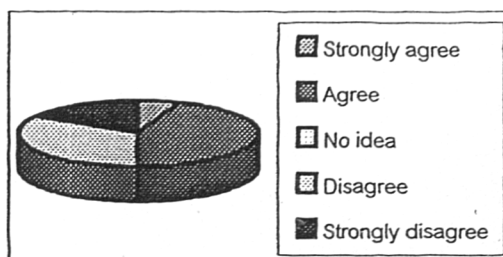
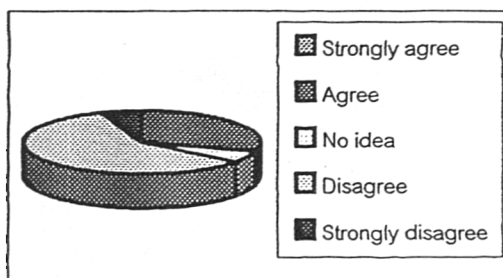


Table 31 IP is private property.

Strongly agree	0	0.00%
Agree	5	27.78%
No idea	1	5.56%
Disagree	10	55.56%
Strongly disagree	1	5.56%



Remark 1 for no response

Table 32 The major aim of interim injunctions is to preserve the *status quo*.

Strongly agree	1	5.56%
Agree	16	88.89%
No idea	0	0.00%
Disagree	1	5.56%
Strongly disagree	0	0.00%

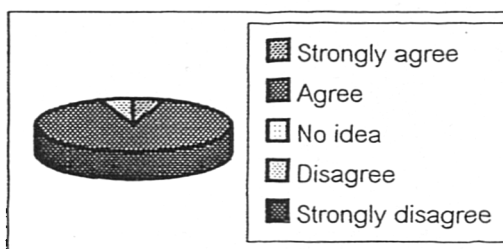


Table 33 The purpose of interim injunctions is different from that of injunctions pending judgments.

Strongly agree	1	5.56%
Agree	12	66.67%
No idea	0	0.00%
Disagree	5	27.78%
Strongly disagree	0	0.00%

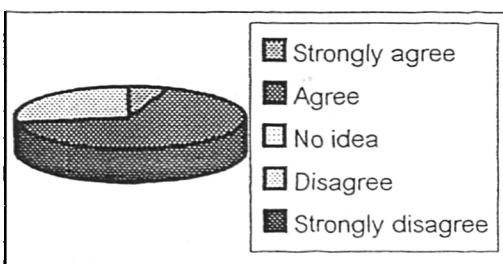


Table 34 The aim of IP law affects judicial discretion when considering interim injunctions.

Strongly agree	0	0.00%
Agree	12	66.67%
No idea	0	0.00%
Disagree	6	33.33%
Strongly disagree	0	0.00%

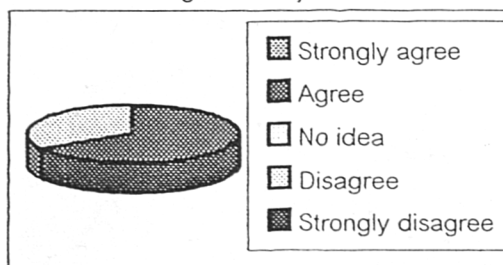


Table 35 To maintain justice in society, not only statutes, but also

the real meaning of justice should be taken into consideration.

Strongly agree	9	50.00%
Agree	9	50.00%
No idea	0	0.00%
Disagree	0	0.00%
Strongly disagree	0	0.00%

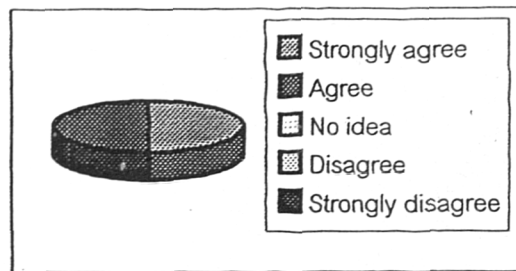


Table 36 The court has the role of finding the facts in the case,

rather than judging the case through the parties' evidence.

Strongly agree	6	33.33%
Agree	10	55.56%
No idea	0	0.00%
Disagree	2	11.11%
Strongly disagree	0	0.00%

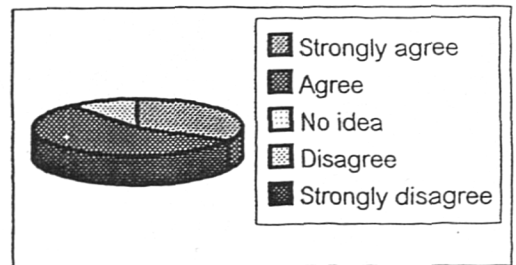


Table 37 The application should be sought *ex parte* .

Strongly agree	0	0.00%
Agree	11	61.11%
No idea	0	0.00%
Disagree	5	27.78%
Strongly disagree	2	11.11%

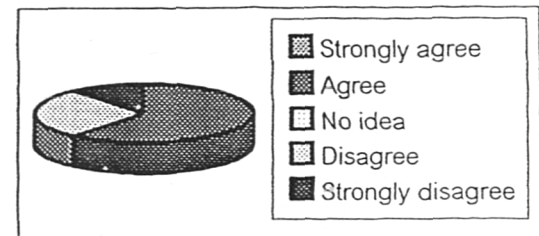


Table 38 According to Rule 13(2), irreparable harm is a condition for

limiting interim injunctions to be granted only in necessary cases.

Strongly agree	2	11.11%
Agree	11	61.11%
No idea	3	16.67%
Disagree	2	11.11%
Strongly disagree	0	0.00%

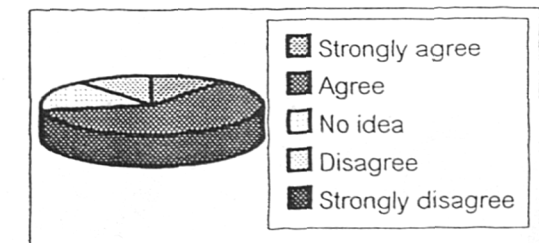


Table 39 Rule 13(2) could be interpreted to mean "interim injunctions could not be sought as long as the prospective defendant could compensate IP rights' owners, or the execution is not difficult.

Strongly agree	0	0.00%
Agree	8	44.44%
No idea	0	0.00%
Disagree	10	55.56%
Strongly disagree	0	0.00%

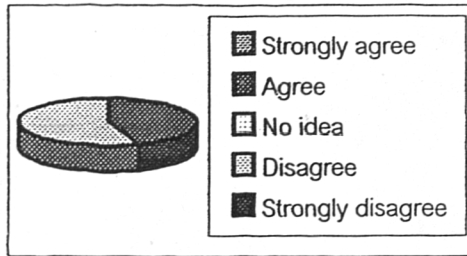
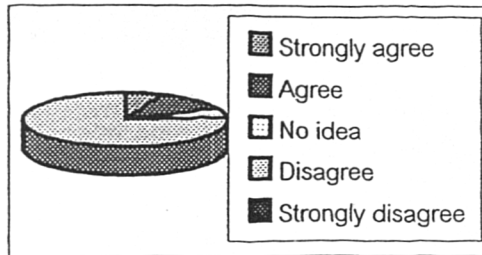


Table 40 According to Rule 13 para.2 , it is accepted that IP rights may be infringed (if the other party's harm, caused by the protection, out weighs the damage).

Strongly agree	1	5.56%
Agree	2	11.11%
No idea	1	5.56%
Disagree	13	72.22%
Strongly disagree	0	0.00%



BIBLIOGRAPHY

- Abbott, F. "The Future of the Multilateral Trading System in the Context of TRIPs," Hastings International and Comparative Law Review. 20 (1996)
- Aldonas, G. "The World Trade Organization : Revolution in International Trade Dispute Settlements," Dispute Resolution Journal. 50 (1995)
- Alford, W. To Steal a Book Is an Elegant Offense Intellectual Property Law in Chinese Civilization. California : Stanford University Press, 1995.
- Arsic, J. "Combating Trade in Counterfeit Goods, the Gatt and the EC Approaches," World Competition Law and Economic Review. 18 (1995)
- Barker, R. I. "Remedies in Intellectual Property Cases," Industrial Property. 5 (1988)
- Barron, D. R. "Roving Anton Piller Orders : Yet to Be Born, Dead, or Alive?," EIPR. 4 (1996)
- Behr, P. "Dole Joins President on GATT, Senate GOP Leader Gets 'Escape Hatch' on Trade Arbitration," Washington Post. November 24, 1994.
- Beier, F. *et al.* GATT or WIPO. IIC, 1989.
- Benko, R. Protecting Intellectual Property Rights. Washington D.C. : American Enterprise Institute, 1987.
- Bently, L. "Accounting for Profits Gained by Infringement of Copyright : When Does It End?," EIPR. 1 (1991)
- Berger, M. Taking the Fifth. Toronto : Canada Law Book Ltd., 1980.

Bhagwati, J. *et al.* Aggressive Unilateralism America's 301 Trade Policy and the World Trading System. Michigan : University of Michigan Press, 1990.

Black, H. Black's Law Dictionary. Minnesota : West Publishing Ltd., 1990.

Blakeney, M. Trade Related Aspects of Intellectual Property Rights : A Concise Guide to the TRIPs Agreement. London : Sweet & Maxwell, 1996.

Bliss, J. "GATT Dispute Settlement Reform in the Uruguay Round : Problems and Prospects," Stanford Journal of International Law. (1987)

Bogsch, A. The First Hundred Years of the Paris Convention for the Protection of Industrial Property. Industrial Property. (July/August, 1983)

Bradley, A. "Intellectual Property Rights, Investment, and Trade in Services in the Uruguay Round : Laying the Foundations," Stanford Journal of International Law. 23 (1987)

Braga, C A P. "The Economics of Intellectual Property Rights and the GATT : A View from the South," Vanderbilt Journal of Transnational Law. 22 (1989)

Brand, R. "Private Parties and GATT Dispute Resolution : Implications of the Panel Report on Section 337 of the US Tariff Act of 1930," Journal of World Trade Law. 24 (1990)

Breyer, S. "The Uneasy Case for Copyright : A Study of Copyright in Books, Photocopies, and Computer Programs," Harvard Law Review. 84 (1970)

Brouer, D. "The Law to Reinforce the Protection of Intellectual Property and to Combat the Piracy of Products," Industrial Property. 12 (1990)

Carlisle, D. T. "Protection Against Piracy - A General View," Industrial Property Vol.11 (1982)

Carlson, P. "Granting an Interlocutory Injunction : What is the Test?," Manitoba Law Journal. 12 (1982)

Central Intellectual Property and International Trade Court. A Ceremony to inaugurate The Central Intellectual Property and International Trade Court. Bangkok : Gaingrow, 1997.

Chamovitz, S. "The World Trade Organization and Social Issues," Journal of World Trade Law. 28 (1994)

Chaves, J. "The Legacy of Ts'ang Chieh : The Written Word as Magic," Oriental Art. 22 (1977)

Chirathivat, S. "Managing Thai Trade Policy to Better Access Developed Countries' Market," ASEAN Economic Bulletin. 8 (1991)

Chutaratkul, C. "Trade Marks in Thailand," World Trade Mark Symposium. Geneva : WIPO,1982.

Chutaratkul, C. "Patent Administration in Thailand," Nitisart Journal. 13 (1983)

Committee of Experts on Measures Against Counterfeiting and Piracy. WIPO Meetings. Industrial Property. 10 (1988)

Committee of Experts on the Protection Against Counterfeiting. WIPO Meetings. Industrial Property. 9 (1987)

Committee of Experts. "Audiovisual Works and Phonograms : Preparatory Document for and Report of the WIPO/UNESCO Committee of Governmental Experts," Copyright. (July/August 1986)

Communication Concept. (ed.) In Depth of the Copyright Law 2537. Bangkok : Se-Education Public Co., Ltd., 1995.

Connors, A. (ed.) Protecting Intellectual Property in Asia-Pacific. London : Dramvite Printers Ltd., 1984.

Cordray, M. L. "GATT v. WIPO," Journal of the Patent and Trade Mark Office Society. 76 (1994)

Comish, W. R. Intellectual Property. London : Sweet & Maxwell, 1989.

Comish, W.R. "The International Relations of Intellectual Property," Cambridge Law Journal. 52 (1993)

Cottier, T. "The Prospects for Intellectual Property in GATT," CMLR. 28 (1991)

Croley, S. *et al.* "WTO Dispute Procedures, Standard of Review, and Deference to National Governments," American Journal of International Law. 90 (1996)

Damrong Rajanubhab, Prince. "History of the National Library," The Funeral of Phra Intabanya. Bangkok : Aksorn Charoentat, 1969.

Damschroder, M. L. "Intellectual Property Rights and the GATT : United States Goal in the Uruguay Round," Vanderbilt Journal of Transnational Law. 21 (1988)

Davies, D. The World Trade Organization and GATT'94. Middlesex, 1995.

Davis, T. "Combating Piracy of Intellectual Property in International Markets : A Proposed Modification of the Special 301 Action," Vanderbilt Journal of Transnational Law. 24 (1991)

Deborah, H. "Out of Others' Shadows : ASEAN Moves Toward Greater Regional Cooperation in the Face of the EC and NAFTA," American University Journal of International Law and Policy. 9 (1994)

Deepadung, P. "Copyright and Computer Software," Intellectual Property Law. Bangkok : Rung-Rueng Printing, 1989.

Demaret, P. "The Metamorphoses of the GATT : From the Havana Charter to the World Trade Organization," Columbia Journal of Transnational Law. 34 (1995)

Department of Intellectual Property. Annual Report 1996. Bangkok : Asom Thai Printing, 1996.

Department of Intellectual Property. Annual Report 1997. Bangkok : Asom Thai Printing, 1997.

Dessler, D. "China's Intellectual property Protection : Prospects for Achieving International Standards," Fordham International Law Journal. 19 (1995)

Dhanjee, R.*et al.* "Trade Related Aspects of Intellectual Property Rights (TRIPs) : Objectives, Approaches and Basic Principles of the GATT and of Intellectual Property Conventions," Journal of World Trade Law. 24 (1990)

Dillons, T. "The World Trade Organization : A New Legal Order for World Trade?," Michigan Journal of International Law. 16 (1995)

- Dockray, M.*et al.* "Pillar Problems," Law Quarterly Review. 106 (1990)
- Duke, P. Foreign Affairs and Thai Independence and Sovereignty (From King Rama IV to the End of the Period of Marshall P. Pibulsongkram. Bangkok : Chao Phraya Printing, 1984.
- Earis, R. "A Broad Entry to Legal Profession," The Times. May 30, 1995.
- Edwards, G. "Copyright Law : Protection in Thailand," Harvard International Law Journal. 25 (1984)
- Emmert, F. "Intellectual Property in the Uruguay Round - Negotiating Strategies of the Western Industrialized Countries," Michigan Journal of International Law. 11 (1990)
- Feather, J. "Authors, Publishers, and Politicians : The History of Copyright and the Book Trade," EIPR. (1988)
- Fiss, O. The Civil rights Injunction. Bloomington, 1978.
- Flint, M. Practical Enforcement of Remedies in the U.K. Piracy and Counterfeiting of Industrial Property and Copyright. London : Sweet & Maxwell, 1983.
- Fuengfung, U. Civil Procedure Code. Lectures for Thai Bar Association. Bangkok : Krung Siam Printing Group, 1992.
- Fysh, M. The Action for Infringement of Intellectual Property Rights. Regional Forum and the Judiciary and the Intellectual Property System. Geneva : WIPO, 1987.
- Gabbay, E. "All the King's Horses-Irreparable Harm in Trade Secret Litigation," Fordham Law Review. Vol.52 (1984)

Gadbaw, M. R. and T. J. Richards (ed.) Intellectual Property Rights : Global Consensus. Global Conflict? Colorado : Westview Press Inc., 1988.

Gadbow, M. R. "Intellectual Property and International Trade : Merger or Marriage of Convenience?," Vanderbilt Journal of Transnational Law. 22 (1989)

Galagam, Y. The Handbook of the Civil Procedure Law. Bangkok : Nitibannakam, 1977.

Gana, R. "Has Creativity Died in the Third World? Some Implications of the Internationalization of Intellectual Property," Denver Journal of International Law and Policy. 24 (1995)

GATT. Analytical Index : Guide to GATT Law and Practice. Geneva : Bernan Association, 1994.

Gervais, D. The TRIPS Agreement : Drafting History And Analysis. London : Sweet & Maxwell, 1998.

Getlan, M. "TRIPs and the Future of Section 301 : A Comparative Study in Trade Dispute Resolution," Columbia Journal of Transnational Law. 34 (1995)

Gibb, F. "Judges Told to Deliver Cheap and Fast Justice," The Times. June 17, 1995.

Gibb, F. "Lawyers Challenge Taylor's Attempt to Speed Wheels of Justice," The Times. May 13, 1995.

Gibb, F. "Mackay Modernises Judicial Selection to Encourage Women," The Times. April 10, 1995.

Gibb, F. "Public to Help in Choosing Judges," The Times. May 27, 1997.

Golt, S. The GATT Negotiations 1986-90 : Origins, Issues & Prospects. London : Contemprint Ltd., 1988.

Grossman, G. M. and C. Shapiro "Foreign Counterfeiting of Status Goods," Quarterly Journal of Economics. 103 (1988)

Guisinger, S. "Foreign Direct Investment Flows in East and Southeast Asia," Asean Business Buletin. 8 (1991)

Gutterman, A. "The North-South Debate Regarding the Protection of Intellectual Property Rights," Wake Forrest Law Review. 28 (1993)

Hainsworth, S. "Sovereignty, Economic Integration, and the World Trade Organization," Osgoode Hall Law Journal. 33 (1995)

Hall, S. "Anton Piller Orders : A Doorstep Too Far?," EIPR. 1 (1995)

Hall, T. The Infringement of Patent for Inventions, Not Designs. Cincinnati : Robert Clarke & Co., Publishers, 1893.

Hammonds, G. "The Legal Protection of Ideas," Osgoode Hall Law Journal. 29 (1991)

Hemarachata, C. Some Aspects of Copyright Law. Bangkok : Netitham Publishing, 1985.

Henkin L. "The Mythology of Sovereignty," ASIL Newsletter. March-May, 1993.

Hettinger, E. "Justifying Intellectual Property," Philosophy & Public Affairs. 18 (1989)

Hilf, M. "The Role of National Courts in International Trade Relations," Michigan Journal of International Law. 18. (1997)

Hoffman, G. Curbing International Piracy of Intellectual Property : Policy Options for a Major Exporting Country. Washington D.C. : American Enterprise Institute, 1989.

Horlick, G. "WTO Dispute Settlement and the Dole Commission," Journal of World Trade. 29 (1995)

Hudec, R. "The GATT Legal System : A Diplomat's Jurisprudence," Journal of World Trade Law. 4 (1970)

Hudec, R. Enforcing International Trade Law : The Evolution of the Modern GATT Legal System. New Hampshire : Butterworth Legal Publishing, 1993.

Hughes, J. "The Philosophy of Intellectual Property," Georgetown Law Journal. 77 (1988)

Hunnicut, C. "The Trade Act of 1988 and the MTNs : Long-Term Planning and Reform," Georgia Journal of International and Comparative Law. 19 (1989)

Hunpayon, S. "Copyright Law and the Video Trade," Chulalongkorn Law Journal. 9 (1984)

Jackson, J. H. Restructuring the GATT System. London : Pinter Publishers Ltd., 1990.

Jackson, J. World Trade and the Law of GATT. Indianapolis : Bobbs-Merrill Inc., 1969.

Jennings, J. S. "Trademark Counterfeiting : An Unpunished Crime," Journal of Criminal Law & Criminology. 80 (1989)

Kaplan, B. An Unhurried View of Copyright. New York : Oxford University Press, 1968.

Kastenmeier, R. and D. Beier "International Trade and Intellectual Property : Promise, Risks, and Reality," Vanderbilt Journal of Transnational Law. 24 (1989)

Kasto, J. The Function and Future of the World Trade Organization : International Trade Law Between GATT and WTO. Kingston : Kall Kwik Centre, 1996.

Khansari, A. "Searching for the Perfect Solution : International Dispute Resolution and the New World Trade Organization," Hastings International and Comparative Law Review. 20 (1996)

Koebel, G. "Protection of Intellectual Property Rights in Singapore and Thailand : A Comparative Analysis," Brooklyn Journal of International Law. 13 (1987)

Kostecki, M. "Sharing Intellectual Property Between the Rich and the Poor," EIPR. 8 (1991)

Kuanpoj, J. Patent Law. Bangkok : Nititham Publishing Co., 1994.

Kuanpoj, J. "An Analysis of the Draft Revision of the Patent Act : A Study of Principles under TRIPs and Paris Convention," Thammasart Law Journal. 26 (1996)

Kunz-Hallstein, H. P. "The Revision of the International System of Patent Protection in the Interest of the Developing Countries," IJC. 10 (1979)

Kunz-Hallstein, H. P. "The United States Proposal for a GATT Agreement on Intellectual Property and the Paris Convention for the Protection of Industrial Property," Vanderbilt Journal of Transnational Law. 22 (1989)

Kuruwila, P. "Developing Countries and the GATT/WTO Dispute Settlement Mechanism," Journal of World Trade. 31 (1996)

Laycock, D. The Death of the Irreparable Injury Rule. New York : Oxford University Press, 1991.

Leebron, D. "An Overview of the Uruguay Round Results," Columbia Journal of Transnational Law. 34 (1995)

Leubsdorf, J. "The Standard for Preliminary Injunctions," Harvard Law Review. 91 (1978)

Levin, M. "What is the Meaning of Counterfeiting?" IIC. 18 (1987)

Likkasitvattanakul, S. "Criminal Justice Process in Thailand : Some Aspects and Resolutions," Doolapah. 43 (1996)

Linck, N. J. and B. P. Golob. "Patent Damages : The Basics," Journal of Law and Technology. 34 (1993)

Long, O. Law and Its Limitations in the GATT Multilateral Trade System. Dordrecht : Martinus Nijhoff Publishers, 1987.

Lowenfeld, A. "Remedies Along With Rights : Institutional Reform in the New GATT," American Journal of International Law. 88 (1994)

Machlup, F. An Economic Review of the Patent System, Study of the Subcommittee on Patents, Trade Marks and Copyrights of the Committee of the Judiciary. Washington D.C. : U.S. Government Printing Office, 1958.

Macleod, C. Inventing the Industrial Revolution : The English Patent System 1660-1800. Cambridge : Cambridge University Press, 1988.

Macleod, D. "U.S. Trade Pressure and the Developing Intellectual Property Law of Thailand, Malaysia, and Indonesia," University of British Columbia Law Review. 26 (1992)

Mahakhun, V. "The Executive and the Judiciary," Chulalongkorn Law Journal. 4 (1978)

- Mahakhun, V. History of Thai Law. Bangkok : Chulalongkorn University Printing, 1980.
- Martin, J. (ed.) Hanbury & Modern Equity. London : Sweet & Maxwell, 1993.
- Masao, T. "The New Penal Code of Siam," Yale Law Journal. 18 (1909)
- Mcdorman, T. "U.S.-Thailand Trade Disputes : Applying Section 301 to Cigarettes and Intellectual Property," Michigan Journal of International Law. 14 (1992)
- Megarry, R. "The Anatomy of Judicial Appointment : Change but not Decay," University of British Columbia Law Review. 19 (1985)
- Meng, W. "GATT and Intellectual Property Rights - The International Law Framework," Liberization of Service and Intellectual Property in the Uruguay Round of GATT. Fribourg, 1990.
- Merges, R. "Commercial Success and Patent Standards : Economic Perspectives on Innovation," California Law Review. 76 (1988)
- Mesevage, T. "The Carrot and the Stick : Protecting U.S. Intellectual Property in Developing Countries," Rutgers Computer and Technology Law Journal. 17 (1991)
- Mikolonis, L. "Preliminary Injunctions, Copyright, and the First Amendment : Does the Presumption of Irreparable Harm Infringe the Speech Interests of Copyright Defendants?," Oregon Law Review. 65 (1986)
- Ministry of Foreign Affairs. Treaties and Bilateral Agreements Between the Kingdom of Thailand and Other Countries and International Organizations. Bangkok : Srideja, 1986.
- Ministry of Justice. 103 Years of the Ministry of Justice. Bangkok : Ministry of Justice, 1995.

Muntarbhon, V. "Judicial Approach in French and English Law," Chulalongkorn Law Journal. Special Issue (1980)

Na Nakorn, K. The Criminal Procedure Code. Bangkok : Netitham, 1986.

National Consumer Council. Intellectual Property - the Consumer View of Patents, Copyright, Trade Marks and Allied Rights. London : National Consumer Council, 1991.

Nitimontree, U. "Some Aspects on Judicial Trial," Doolapah. 40 (1992)

Nitisart Phaisan, Phraya. A Compilation of Lectures at the Association of Samakayacham from B.E.2470-2474. Bangkok : Fuengnakom, 1931.

Nogues, J. "Patent and Pharmaceutical Drugs : Understanding the Pressure on Developing Countries," Journal of World Trade Law. 24 (1990)

O'Neill III, T. N. "Intellectual Property Protection in Thailand : Asia Young Tiger and America's "Growing" Concern," University of Pennsylvania Journal of International Business Law. 11 (1990)

OECD Working Papers. Dispute Settlement in the WTO. Paris : OECD, 1995.

Olenick, S. "Draft International Anticounterfeiting Code : Neo-realism as a Vehicle for Analyzing the Effect of Nonsignatories' Perceptions on the Development of an Anticounterfeiting Norm," Vanderbilt Journal of Transnational Law. 15 (1982)

Otten, A. "The Implications of the TRIPs Agreement for the Protection of Pharmaceutical Inventions," WHO Drug Information. 11 (1997)

Ough, R. The Mareva Injunction and Anton Piller Orders Practice and Precedents. London : Butterworths, 1987.

- Pakditanakul, J. "International Copyright," Doolapah. 4 (1983)
- Pakditanakul, J. "Intellectual Property Law in Thai Court," Doolapah 40 (1993)
- Parker, P. *et al.* (ed.) Snell's Equity. London : Sweet & Maxwell, 1990.
- Pattanawong, Y. General Information on Pharmaceutical Patent. Bangkok : Ministry of Health, 1996.
- Payutto, P. Law in a Buddhist Way. Bangkok : Buddhadham Foundation, 1998.
- Payutto, P. Sustainable Development. Bangkok : Buddhadham Foundation, 1996.
- Pearson, H. *et al.* Commercial Exploitation of Intellectual Property. London : Blackstone Press Ltd., 1990.
- Perell, P. "The Interlocutory Injunction and Irreparable Harm," The Canadian Bar Review. 68 (1989)
- Pescatore, P. "The GATT Dispute Settlement Mechanism : Its Present Situation and Its Prospects," Journal of World Trade Law. 27 (1993)
- Petersmann, E. *et al.* (ed.) The new GATT Round of Multilateral Trade Negotiation : Legal and Economic Problem. Deventer : Kluwer Law International, 1988.
- Phillips, J. and A. Firth Introduction to Intellectual Property Law. London : Butterworths, 1995.
- Pizzi, W. and W. Perron "Crime Victims in German Courtrooms : A Comparative Perspective on American Problems," Standford Journal of International Law. 32 (1996)

Plank, R. "An Unofficial Description of How a GATT Panel Works and Does not," Journal of International Arbitration. 4 (1987)

Pongpanich, K. The Revolution in B.E.2475. Bangkok : Prae Pithya, 1971.

Porges, A. "Introductory Note on General Agreement on Tariffs and Trade : Multilateral Trade Negotiation Final Act Embodying the Results of the Uruguay Round of Trade Negotiation," ILM. 33 (1994)

Pramoj, S. Copyright of the Author. Bangkok : Sivaporn Co.,Ltd., 1968.

Premjit, S. Thai History in the Democratic System. Bangkok : Fuengnakom, 1962.

Premssmit, P. Scope of Protection of Literary and Artistic Work Under Thai Law : A Case Study of Thai - US Copyright Law Issue Before the US Became Member to the Berne Convention. A thesis for LL.M., Chulalongkorn University, 1990.

Prokati, K. "Copyright Protection in Thai Law," Nitisart Journal. 13 (1983)

Punchanavanit, P. Some Aspects of the Assessment of Damages in Copyright Infringement. A thesis for LL.M., Chulalongkorn University, 1988.

Puongraj, Y. "Arguments on an Amendment of Intellectual Property Law : Who Gains, Who Loses?," Tax Bulletin. 143 (1993)

Ratanakorn, S. The Judiciary and the Intellectual Property System in Thailand. in Regional Forum and the Judiciary and the Intellectual Property System. Geneva : WIPO, 1987.

Reinbothe, J. *et al.* "The State of Play in Negotiations on Trips (GATT/Uruguay Round)," EIPR. 5 (1991)

Rendleman, D. "The Inadequate Remedy at Law Prerequisite for an Injunction," University of Florida Law Review. 33 (1981)

Renoue, J. C. "The Contribution of the Customs Authorities to the Fight Against Counterfeiting," Industrial Property. 5 (1988)

Resch, S. "A Necessary Evil or an Invasion of Privacy? Anton Piller Orders in Australia," Law Institute Journal. (1992)

Ricketson, S. The Berne Convention for the Protection of Literary and Artistic Works : 1886-1986. London : Sweet & Maxwell, 1987.

Ritruksa, P. Copyright. Bangkok : Vinyuchon Ltd., 1995.

Rowell, R. Counterfeiting and Forgery. London : Butterworths, 1986.

Ruechai, K. "The Enforcement of Foreign Copyright in Thailand," Chulalongkorn Law Journal. 9 (1984)

Ruechai, K. "Hong Kong Copyright," Chulalongkorn Law Journal. 10 (1985)

Rushing, F. W. and C. G. Brown. (ed.) Intellectual Property Rights in Science, Technology, and Economic Performance. Colorado : Westview Press Inc., 1990.

Sanger, D. "Senate Approves Pact to Ease Trade Curbs : A Victory for Clinton," The New York Times. December 2, 1994.

Sataman, P. The Civil Procedure Code Part IV. Bangkok : Srimuang Printing, 1981.

Schoenbrod, D. "The Measure of an Injunction : A Principle to Replace Balancing the Equities and Tailoring the Remedy," Minnesota Law Review. 72 (1988)

- Schwartz, R. "The Case for Specific Performance," Yale Law Journal. 89 (1979)
- Sharpe, R. J. Injunctions and Specific Performance. Toronto : Canada Law Book Ltd., 1983.
- Shell, R. "Trade Legalism and International Relations Theory : An Analysis of the World Trade Organization," Duke Law Journal. 44 (1995)
- Sheridan, L. A. Chancery Procedure & Anton Piller Orders. Chichester : Barry Rose Law Publishing Ltd., 1994.
- Sheridan, L. A. Injunction in General. Chichester : Barry Rose Law Publishing Ltd., 1994.
- Sherman, J. "Labour Wants League Table of Bad Judges," The Times. May 16, 1995.
- Sherwood, R. Intellectual Property and Economic Development. Colorado : Westview Press, 1990.
- Shore, C. "The Thai Copyright Case and Possible Limitations of Extraterritorial Jurisdiction in Actions Taken Under Section 301 of the Trade Act of 1974," Law & Policy in International Business. 23 (1984)
- Siebeck, W. E. Strengthening Protection of Intellectual Property in Developing Countries : A Survey of the Literature. Washington D.C. : World Bank, 1994.
- Simpson, J. A. and E. S. C. Weiner The Oxford English Dictionary. Oxford : Oxford University Press, 1995.
- Sodipo, B. Piracy and Counterfeiting : GATT, TRIPS, and Developing Countries. London : Kluwer Law International, 1997.

Spelling, T. Injunction and Other Extraordinary Remedies. London : Rose Publishing, 1901.

Spry, I. The Principles of Equitable Remedies. London : Sweet & Maxwell, 1990.

Stewart, S. International Copyright and Neighbouring Rights. London : Butterworths, 1989.

Stewart, T. The GATT Uruguay Round : A Negotiating History (1986-1992) Vol. II : Commentary. Deventer : Kluwer Law and Taxation Publishers, 1993.

Stutchbury, M. "US-Sino Spats Could Turn into Something Nasty," The Financial Review. June 21, 1996.

Subhapholsiri, D. "Some Legal Aspects on Protection of American Copyright in Thailand," Chulalongkorn Law Journal. 13 (1990)

Subhapholsiri, D. Copyright. Bangkok : Nititham Publishing Co., 1992.

Subhapholsiri, D. Trade Mark. Bangkok : Nititham Publishing Co., 1993.

Subhapholsiri, D. Copyright. Bangkok : Nititham Publishing Co., 1996.

Suchiva, B. "A Justice Maker," Doolapah. Vol.42 (1995)

Supreme Court. The Celebration for the Golden Jubilee on the Reign. Bangkok : Amarin Printing & Publishing, 1996.

Taylor, C. "The Limits of Economic Power : Section 301 and the World Trade Organization Dispute Settlement System," Vanderbilt Journal of Transnational Law. 30 (1997)

Thai Bar Association. The Administration of Justice in Thailand. Bangkok : Thai Wattana Panich Press Co., Ltd., 1969.

Thaveechaiyagam, S. "Current Developments : The Section 301 Cigarette Case Against Thailand - A Thai Perspective," Law and Policy in International Business. 21 (1990)

Thomas, E. A Return to Principle in Judicial Reasoning and an Acclamation of Judicial Autonomy. Palmerston : Stylex Print, 1993.

Thierr, A. "Piracy of Trademarks : A Matter for States," Industrial Property. 11 (1982)

Tingsamit, V. Law on the Intellectual Property and International Trade Court. Bangkok : Nititham Publishing Co., 1998.

Tongdhammachart, K. "The 1932 Revolution and the Age of Democratic Government," Chulalongkorn Law Journal. Special Issue. (1980)

Trop, T. N. and W. L. Chen. "A Bold New Awakening? The New Taiwanese Copyright Law," Journal of the Patent and Trademark Office Society. 74 (1992)

UNAFEI. Report and Resource Material Series Vol.47. Tokyo : Seishosha Co.,Ltd., 1995.

Uphoff, E. Intellectual Property and US Relations with Indonesia, Malaysia, Singapore, and Thailand. New York : Cornell Southeast Asia Program, 1991.

Uwanno, B. "The Report on the Research of Intellectual Property Rights," Chulalongkorn Law Journal. Vol.15 (1994)

Vandavelde, K. "The New Property of the Nineteenth Century : The Development of the Modern Concept of Property," Buffalo Law Review. 29 (1980)

Varga, C. The International Library of Essays in Law & Legal Theory. Hants : Dartmouth Publishing Co., Ltd., 1992.

Vaver, D. "Intellectual Property Today : Of Myths and Paradoxes," Canadian Bar Review.69 (1990)

Von Moltke, K. "The World Trade Organization : Its Implication for Sustainable Development," Journal of Environment and Development. 3 (1994)

Walk, D. The Oxford Companion to Law. Oxford : Oxford University Press, 1980.

Walker, W. "A Program to Combat Commercial Counterfeiting," Trade Mark Report. 70 (1980)

Ward, H. "Common but Differentiated Debates : Environment, Labour and the World Trade Organization," International and Comparative Law Quarterly. 45 (1996)

Wasserstrom, R. The Judicial Decision. London : Oxford University Press, 1961.

Watkins, K. Fixing the Rules : North-South Issues in International Trade and the GATT Uruguay Round. Nottingham : CIIR, 1992.

Wen, F. "The Problem of Forgeries in Chinese Painting," Artibus Asiae. 25 (1962)

White, R. "Thailand's Drug - Copying Companies Keep Prices Down, Upset Foreign Firms," Wall Street Journal. (1986)

Wichitcholchai, P. The Handbook of the Civil Procedure Code : Injunctions Pending Judgment. Bangkok : Gaingrow, 1995.

Winberg, A. "Secure Protection of Your Intellectual Property Abroad," Journal of the Patent and Trademark Office Society. 74 (1992)

Winham, G. R. The Evolution of International Trade Agreement. Toronto : University of Toronto Press 1992.

Winkler, R. J. and C. Hsu (translated) "Copyright Law of the Republic of China," Journal of the Patent and Trademark Office Society. 74 (1992)

WIPO. Committee of Experts on the Protection Against Counterfeiting : First Session PAC/CE/1/2. Geneva : WIPO, 1986.

WIPO. General Information. Geneva : WIPO, 1990.

WIPO. General Information. Geneva : WIPO, 1995.

WIPO. General Information. Geneva : WIPO, 1996.

Wooldrige, F. "The Enforcement of the TRIPs Agreement in Germany," Intellectual Property Quarterly. 2 (1997)

Young, D. *et al.* (ed.) Terrell on the Law of Patents. London : Sweet & Maxwell, 1994.

Zheng, C. "TRIPs and Intellectual Property Protection in China," EIPR. 19 (1997)

Zuckerman, A. "Keeping the Woolf from the Door," The Times. June 16, 1997.