

Time prescriptions for criminal and civil trade mark infringement actions in Thailand

As aggrieved party can take action against a trade mark infringer by filing both criminal and civil actions. Since criminal actions involve state offences that cannot be compounded, an aggrieved party cannot dismiss the criminal action by withdrawing the complaint or negotiate a settlement, as is the case (currently) with copyright infringement. In addition, a settlement agreement to not prosecute an infringer who committed a state offence is contrary to public order or good morals.

However, an aggrieved party of a copyright infringement action can receive one half of the total fine that the defendant was ordered to pay in the criminal action. In sum, an aggrieved party can recover damages from trade mark infringement only by filing a civil action with the Intellectual Property and International Trade Court (IP and IT Court).

Time prescriptions for criminal trade mark infringement actions.

In criminal cases that involves forgery of a trade mark that is registered in Thailand, the penalty is imprisonment not to exceed two years or a fine not exceeding 400,000 bahts (US\$9,860) or both. Cases involving imitation of a trade mark that is registered in Thailand carries a penalty of imprisonment not to exceed two years or a fine not exceeding 200,000 bahts (US\$4,930) or both. Anyone who brings into Thailand, sells, offers or possesses for sale products bearing a forged or imitating trade mark will be punished according to sections 108, 109 and 110 of the Trademark Act.

The time prescription for filing a criminal action with the IP and IT Court is within 10 years from the date of the offence. It is often difficult to know the actual date of the offence. In most cases, the date of offence is when the counterfeit goods are seized. Furthermore, there is no tolling provision for cases in which the infringer has fled from the jurisdiction after having been charged with a criminal complaint. The same is true for the case where the trial is suspended due to a finding that the infringer is mentally incompetent or an infringer is called to military duty after having committed the offence. The trade mark owner must file a criminal action against the infringer within 10 years from the date of the offence.

Time prescriptions for civil trade mark infringement actions prior to filing a criminal action

According to the general principles of time prescription for offences listed in section 448, paragraph 2 of the Civil and Commercial Code (CCC), if damages are claimed based on an act punishable under criminal law, in which a longer time prescription is provided, the longer time prescription applies. Although the CCC does not outline how to apply the longer time prescription, section 51 of the Criminal Procedure Code of Thailand governs the application of differing criminal and civil time prescriptions and it is the authority on filing civil cases that are related to criminal offences.

In instances where no criminal prosecution has been initiated for trade mark infringement, the rights of an aggrieved party to bring a civil action that is related to a criminal offences will be barred by the same time limitation as is provided for the criminal action. This means that the time prescription for filing a civil action is 10 years from the date of when the criminal offence occurred.

In addition, if the infringer has fled from the jurisdiction and was found by the Court to be mentally incompetent or is called into military duty, the time prescription for filing a civil action will not be tolled. If the trade mark owner does not like a civil action within 10 years from the date of the criminal offence, the trade mark owner will be precluded from bringing a civil action against the infringer.

Time prescriptions of civil trade mark infringement actions after filing a criminal action

If a criminal action is pending with the IP and IT Court, the time prescription to file a civil action will be interrupted. The time prescription of 10 years will start to run after the criminal action reaches a verdict. No matter what the criminal action is under any trial or appellate court, an aggrieved party has the right to file a civil action against an infringer at anytime.

If the IP & IT Court renders a judgment of conviction in the criminal action before a civil action is filed, an aggrieved party has 10 years from the date the judgment is pronounced to file a civil action. However, if the judgment is an acquittal and the aggrieved party has not filed a civil action within one year from the date of the offence, the aggrieved party is statutorily barred from filing the civil action.

Conclusion

When a raid to seize counterfeit goods is conducted and the civil action has not yet been filed with the IP and IT Court, the time prescription is 10 years from the date of the raid in accordance with section 51, paragraph 1 of the Criminal Procedure Code of Thailand. The time prescription for a civil action will be interrupted if the criminal action is filed with the Court. Although the time prescription for filing a civil action that is related to a criminal offence is generally 10 years, if the Court dismisses the criminal action, the time prescription for the civil action will revert to one year from the date of the offence. This is also the general time prescription for tort cases. As a precautionary matter, we recommend filing a civil action within one year from the date of the offence since the outcome of a criminal prosecution cannot be prognosticated.