

Legal Problems of Domain Name Registration in Thailand

Overview

It has been widely accepted that dot com business has grown dramatically all over the world, notwithstanding many analysts and investment experts have expressed their concerns that dot com business might not be as bright as we thought it would be, taking into account of its trading volume all over the world particularly in NASDAQ market, a major secondary market. In Thailand, dot com business has come to people's attention a great deal when MWEB (Thailand) Limited purchased website "sanook.com" in 2000 at very high price from an individual, Mr. Porameth Minsiri, a webmaster who subsequently became a millionaire and a very popular person amongst not only people dealing in dot com business but also general public. A major problem arising out of dot com business world wide including Thailand is the one relating to domain name registration especially problem of cybersquatter who takes other person's name, trademark, service mark or tradename to register in its own name whether in Generic Top Level Domain Name (gTLD) or Country Code Top Level Domain Name (cCTLd) to seek profit by selling it back to the genuine owner or otherwise. One good example of such cybersquatter problem in Thailand is the Amazing Thailand case in 1997. Other cases of cybersquatter include unauthorized registration of other famous names such as bangkokpost.com, mistine.com, S&P.com and etc.

This article broadly discusses the legal problem regarding domain name dispute in Thailand and legal obstacle in applying the current Thai Law with cybersquatter cases. According to the Manager Newspaper dated October 21, 1996, and the Bangkok Biz Newspaper dated October 2000, domain name problems in Thailand (as provided herebelow) are rapidly increasing and causing severe damage to e-business. However, most parties have not disclosed their problems and preferred to buy back the domain name instead of taking legal action against cybersquatter. The followings are examples of domain name disputes in Thailand.

- P&P Law Firm is the leading law firm in e-commerce practice. Our lawyers represented, also acting as general counsel to several e-commerce companies, representing about 75% of all e-commerce market share in Thailand. Our attorneys understand e-commerce technical terms. Many of them work with governmental authorities in drafting e-commerce legal legislation.

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The Bangkok Post Case

Bangkok Publishing Public Co., Ltd. (“Bangkokpost”), the owner of well-known English newspaper in Thailand – Bangkok Post, which has continuously used trademark “bangkokpost” with newspaper and used domain name “bangkokpost.co.th” registered with the THNIC (the Thai Accredited Domain Name Registrar for “.co.th” in Thailand), intended to file another domain name registration with Network Solutions, Inc. (NSI) for domain name “bangkokpost.com”, but found that the said domain name has already been registered by Solberg PM&P AB, a U.S. corporation. This causes Bangkokpost to use domain name “bangkokpost.net” with its website.

The Amazing Thailand Case

In 1997, Thailand had a campaign, called “*Amazing Thailand*” to attract foreigners worldwide to visit Thailand to generate benefit for the country’s economic recovery. On August 1997, a Canadian sent an e-mail to the Thai Government offering for sale of his domain names “amazingthailand.com” and “amazingthailand.org” which have been registered with NSI in the amount of US Dollar 2.3 million. However, the Thai government refused to purchase the said domain names and decided to use domain name “tourismthailand.org” instead of “amazingthailand.com”

Thaiadclick.com Case

On October 2000, a Thai cybersquatter sent an e-mail to many well-known websites in Thailand such as website “Thaiadclick.com”, etc. offering for sale of his domain names which are similar to domain names thaiadclick.com and other well-known Thai websites. He threatened the said dot com companies if the companies refused to purchase his domain names that he would use his domain names with pornography pictures to dilute value of the dot com companies’ tradenames. Finally, he was arrested and prosecuted for extortion and blackmail in accordance with the Thai Penal Code.

In light of the above, problems of domain name registration in Thailand can be classified into 2 major categories as follows:

- a) **Cybersquatter or Parasite** is a problem of domain name registration using other person’s trademark, service mark or tradename or using a mark similar to other well known mark.
- b) **Twins** is a problem of registration of trademark, service mark or tradename of the applicant in Thailand which is similar to a trademark, service mark or tradename in a foreign country but using with goods/service in different classes such as in case of bangkokpost.com.

Currently, Thailand has no “*Sui Generis Law*” directly governing domain name registration. Therefore, in case of domain name dispute, the following laws shall be applicable:

Civil Action

The Civil and Commercial Code (“CCC”)

A wrongful Act

Section 18 *If the right to the use of a name by a person entitled to it is disputed by another, or if the interest of the person entitled is injured by the fact that another uses the same name without authority, then the person entitled may demand from the other abatement of the injury. If a continuance of the injury is to be apprehended, he may apply for an injunction*

Section 69 *A juristic person has rights and duties in conformity with the provisions of law within the scope of its object as defined in the regulation or constitutive act.*

Section 70 *Subject to the foregoing section, a juristic person enjoys the same rights and is subject to the same duties as a natural person, except those which, by reason of their nature, may be enjoyed or incurred only by a natural person.*

Section 420 *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.*

Section 438 *The Court shall determine the manner and the extent of compensation according to the circumstances and the gravity of the wrongful act.*

Compensation may include restitution of the property of which the injured person has been wrongfully deprived or its value as well as damages to be granted for any injury caused.

The above principle of CCC grants right to the owners of individual names, corporate names or tradenames to prohibit other persons from using their names without authorization or to use such names as domain names in conducting business. The said provisions may be applied to the case of a cybersquatter to prohibit such cybersquatter from using another person’s individual name, corporate name or tradename. Also, a claim for damages may be initiated on the ground of tort. However, if the cybersquatter only registers the domain name and uses it as an IP address, this legal provision can not be applied.

Criminal Action

(1) *The Penal Code*

Passing-off

Section 272 *Whoever:*

(1) *uses a name, figure, artificial mark or any wording in the carrying on trade of the other person, or causes the same to appear on goods, packings, coverings, advertisements, price lists, business letters or the like in order to make the public to believe that it is the goods or trade of such other person;*

(2) *imitates a sign-board or the like so that the public are likely to believe that his trading premises are those of another person situated nearby;*

(3) *circulates or propagates the false statement in order to bring discredit to the trading premises, goods, industry or commerce of any person with a view to obtaining benefit for his trade,*

shall be punished with imprisonment not exceeding one year or fine not exceeding two thousand baht, or both.

The offense under this Section is a compoundable offence.

Section 273 *Whoever forges the registered trademark of the other person, whether it be registered within or outside the Kingdom, shall be punished with imprisonment not exceeding three years or fine not exceeding six thousand baht, or both.*

Section 274 *Whoever imitates the registered trademark of the other person, whether it be registered within or outside the Kingdom in order to make the public to believe that it is the registered trademark of such other person, shall be punished with imprisonment not exceeding one year or fine not exceeding two thousand baht, or both.*

Section 275 *Whoever brings into the Kingdom, disposes or exposes for disposal the goods bearing a name, figure, artificial mark or any wording as provided in Section 272(1), or the goods bearing the forged or imitated trademark belonging to the other person according to Section 273 or 274, shall be liable to the same punishment as provided in such Section.*

The so-called “***Passing-off***” is another alternative for the owner of the trademark or tradename to take criminal action against the cybersquatter. Under the Penal Code, the essential elements of passing off are the using of other persons’ pictures, marks or trademarks as domain names which causes confusion to the public. For example, A registers the trademark “pepsi” as a domain name by using “pepsi.com” and also uses it with the same type of goods i.e. beverage. As such, A may be found guilty on the ground of passing off under Thai law. However, this provision can not be applied to the case that A or any cybersquatter registers the domain name as only an IP address and dilute the value of the trademark without using the trademark for business.

2. Trademark Act of 1991

The Trademark Act of 1991 (“*Trademark Act*”) provides protection to all trademarks and service marks registered in Thailand. Criminal penalties are imposed on a person who falsifies a trademark and service mark of another person already registered under the Trademark Act or the person who imitates another person’s trademark or service mark registered in Thailand in order to mislead the public to believe that it is the trademark or service mark of another person. This law provides protection to any person who registers his/her own trademark, service mark with the Department of Intellectual Property. Upon the mark being registered, the mark will be protected under this law.

Section 108 Any party that falsifies a trademark, service mark, certification mark or collective mark of another person, that is already registered in the Kingdom, shall be subject to imprisonment for a term not exceeding 4 years or to a fine not exceeding Baht four hundred thousand or both.

Section 109 Any party imitating a trademark, service mark, certification mark or collective mark of another person, that has been already registered in the Kingdom, in order to mislead the public to believe that it is the trademark, service mark, certification mark or collective mark of another person, shall be subject to imprisonment for a term not exceeding two years or to a fine not exceeding Baht two hundred thousand or both.

Therefore, legal action on the ground of trademark infringement can be taken against any person who uses the trademark, service mark with goods or service for commercial profit only because in the Trademark Act, there is no legal concept of dilution.

The problem one has to deal with when applying the foregoing laws to a cybersquatter is that a domain name is not treated as a trademark when it is not actually used with goods or services which encourages cybersquatter to register other person’s trademark or service mark as domain name to seek profit and that the real name or address of cybersquatter may not be able to be traced due to many cybersquatters do not specify their real identification (in the whois database such as details of Registrant’s name, Administrative Contact, Billing Contact and/or Technical Contact) which causes difficulty in locating the cybersquatter for punishment.

Conclusion

We can say that up to now the problem of cybersquatter has rapidly increased in Thailand and the current laws are not applicable to certain cybersquatter cases. The parties, thus, prefer to resolve their disputes over domain name by contractual arrangement or arbitration online by WIPO.