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CYBERSQUATTING IN THAILAND:
THE THAI TRADEMARK ACT AND THE
UNIFORM DOMAIN NAME DISPUTE
RESOLUTION POLICY

Areeya Ratanayu†

Introduction

Imagine that a businessman buys a piece of real estate, hoping that a foreign entrepreneur wants the location badly enough to build a shopping mall. If the businessman is lucky, he should be able to make a legal profit from selling his real estate. Or imagine that an investor buys 100 shares of Gateway stock, hoping that one day its value will rise as high as Microsoft stock. He will then trade these 100 shares to someone for cash. Both are legitimate investments. However, the cyberspace world will not allow him to do the same thing if he wants to invest in domain names that are similar to someone else’s trademark or service mark. If he holds these domain names and later sells them to famous corporations, then, in the eyes of the law, he will be trading someone else’s rights and infringing upon someone else’s intellectual property rights. It cannot be denied that an important blend of network technology, law, and worldwide users is creating legal problems in the Internet arena. Wherever the Internet is used, there are legal issues. This is true even in a small developing country such as Thailand.

As it was in the United States, the Internet in Thailand was initially used by government agencies and research institutions. Not until 1995 was the Internet used commercially.¹ Currently, the Internet is available in almost every big city in Thailand, especially where universities are located.² The legal issues with domain name piracy in Thailand erupted around two years ago. The term “cybersquatter,” which refers to someone who speculatively purchases domain names with

† [author i.d.] Unless otherwise noted, translations are by the author.


² However, The Internet User Profile of Thailand (1999), which is the annual report created by the National Electronics and Computer Technology Center and National Science and Technology Development Agency, stated that 70 percent of Internet users reside in Bangkok and its metropolitan areas.
the intention of selling them for profit, was not known until May 2000. During that time, the first domain name dispute occurred in Thailand, and a claim was filed with the World Intellectual Property Organization (WIPO) Administrative Panel. In that case, the James H.W. Thompson Foundation, owner of the famous trade name Jim Thompson House, and its affiliate, the Thai Silk Co., Ltd., owner of the trademark Jim Thompson, filed a complaint with the WIPO Arbitration and Mediation Center (the Center) on May 16, 2000, asking for the transfer of the domain names jimthompsonhouse.com and jimthompsonhouse.org from a Thai individual who had registered them to the James H.W. Thompson Foundation. The Administrative Panel ruled in favor of the complainants, stating that the grounds for the complaint were valid under the Uniform Domain Name Dispute Resolution Policy (UDRP). In accordance with UDRP, the Administrative Panel found that the disputed domain names are identical or confusingly similar to the complainant's trademark, that the respondent had no right or legitimate interest in the domain names, and that the domain names were registered and being used in bad faith. The Administrative Panel ordered the transfer of the domain names on July 10, 2000.

The Jim Thompson dispute alerted Thai legal society to the cybersquatter issue. Because it is fairly inexpensive to reserve a domain name, and because the name may be perceived as more valuable than the reservation price, cybersquatters attempted to make a business out of the practice of reserving desirable names and attempting to resell them to others. In general, most Thai cybersquatters attempted to resell domain names of domestic companies only. For instance, in the Jim Thompson case, the complainant was a Thai corporation. But the case was an insufficient warning to cybersquatters. A few months after it was decided, another Thai cybersquatter,

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6 See id.
7 See id.
8 Supra note 4.
9 Telephone Interview with Katika Saisaenee, Senior webmaster, A-Times Media Co., Ltd. (Feb. xx, 2001).
Dr. Somsak Sooksripanich, was looking forward to selling domain names internationally. Later in this paper, the dispute between Dr. Somsak and Yahoo!, Inc. (Yahoo) will be discussed as a case study.¹⁰

The first part of this paper will discuss the application of the Uniform Domain Name Dispute Resolution Policy (UDRP) of the Internet Corporation for Assigned Names and Numbers (ICANN) in the cybersquatting case that took place in Thailand. Whether or not UDRP is compatible with the Thai legal system is the focus of the discussion. The second part of this paper is an analysis of the Thai Trademark Act. The analysis will consider whether Thai law is flexible enough to apply to cybersquatting cases. The third part is a discussion of UDRP and the Thai legal system. The last part of the paper will propose ways in which the Thai government can handle the cybersquatting situation. For a better understanding of the issue, consideration of the background of the cybersquatting problem is a good place to start.

I. THE DOMAIN NAME

A domain name is a hierarchically structured character string that has a referential quality and serves as an Internet address.¹¹ The Internet address or the Internet Protocol (IP) address is a string of numbers that has little or no referential quality and therefore cannot be remembered easily.¹² It is impossible for two websites to use exactly the same character string as a domain name. Therefore, a domain name system that consists of a combination of letters, symbols, and numbers was chosen as a means of remembering and locating an entity on the Internet.¹³ The IP address is also important because it is a unique set of IP numbers that corresponds to a unique domain name.¹⁴ When a user logs onto the Internet through a server, the server translates a domain name into its corresponding IP address.¹⁵

¹⁰ Dr. Somsak Sooksripanich was the respondent of other WIPO cases. They are CDL Hotels International Ltd. v DNSDEALER.COM, WIPO Case No. D2000-0958; Louis Vuitton Malletier v. Somsak Sooksripanich, WIPO Case No. D2000-0866; and Guerlain S.A.v. Somsak Sooksripanich, WIPO Case No. D2000-1496.
¹² See id.
¹⁴ For example, "wayne.edu" equals "141.217.1.15."
¹⁵ See Nathenson, supra note 3.
Because of the uniqueness of a domain name, it can act not only as an Internet address, but also as a slogan, billboard, brand name, and corporation name.16 Dana Hanamann sums up the problems that unique domain names cause:

The problem is that, as the Internet and its use has grown, so has the competition for domain names. Using common sense, many people are able to guess what a correct domain name might be when searching for products, service, or information on the [World Wide Web]. However, conflict arises because, although it may be possible for 100 million Mr. Smiths to peacefully co-exist in the world, there can be only one [www.mrsmlth.com]. Once that domain name is registered, it cannot be possessed or appropriated by another unless it is abandoned or purchased.17

A. ICANN and UDRP

The Internet Corporation for Assigned Names and Numbers is a non-profit, private-sector corporation formed by a coalition of the Internet's business, technical, academic, and user communities.18 Formed in October 1998, ICANN has been recognized by the United States and other governments as the sole designator of Internet domain names. In addition, it allocates IP address space, assigns protocol parameters, and manages the root server system.19 Currently, ICANN has a significant role in the domain name system arena because it is the primary entity through which Internet policy is established.20 Headquartered in California, ICANN is administered by a board of nineteen international directors supported by six advisory committees, and it is funded through many registries and registrars that comprise the global domain name and Internet addressing system.21 The goal of ICANN is to oversee the management tasks that require central coordination: the assignment of the Internet's unique name and number identifiers.22

In order to fulfill its goal, and realizing the need for a new way to hear and decide domain name disputes, ICANN turned to UDRP, which was originally drafted by WIPO.23 ICANN revised UDRP and

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16 See Mueller, supra note 11.
17 See Hanamann, supra note 13.
19 See id.
21 Supra note 18.
22 See id.
23 Supra note 13.
finally approved it on October 24, 1999. At the present time, any applicant for a domain name to an ICANN-accredited registrar now automatically agrees to submit to an approved arbitration process if a controversy or conflict over its domain name develops.\textsuperscript{24} So far, four dispute resolution providers are approved by ICANN. They are CPR Institute for Dispute Resolution (CPR), eResolution (eRes), the National Arbitration Forum (NAF), and WIPO. Each of the providers follows ICANN rules of procedure, and each has formulated its own supplemental rules.\textsuperscript{25} The cost of dispute resolution services varies among providers.\textsuperscript{26} The average time for reviewing a case and issuing an award is forty-five days. The time can be minimized even more because, overseen by chosen arbitrators, the process can take place entirely on line, with parties filing all communications via the Internet.\textsuperscript{27} Under this process, disputes are decided only on the basis of documents, without a hearing. Administrative panels are either a single-member panel or a three-member panel. If the complainant has elected to have the dispute decided by a single-member panel, and a respondent elects a three-member panel, then the respondent will be required to pay one-half of the three-member panel fees.\textsuperscript{28} Normally, the complainant is responsible for an initial fixed fee for a single-member panel.\textsuperscript{29}

Not all domain name disputes are filed with dispute resolution services under UDRP. Mostly, the complainant is a trademark holder who alleges that a domain name infringes on its mark.\textsuperscript{30} The complainant must allege and convince the arbitrator that:

- The domain name is identical or confusingly similar to the complainant's trademark or service mark; and
- The domain name holder has no right or legitimate interest in the domain name; and

\textsuperscript{24} \textit{Supra} note 18.
\textsuperscript{25} \textit{See} id.
\textsuperscript{26} \textit{See also} The National Arbitration Form's Supplement Rules to ICANN's Uniform Domain Name Dispute Resolution Policy, at http://www.arbforum.com/domains/domain-rules (No. 16, hearing fee: one domain name dispute with single-member panel $950, one domain name dispute with three-member panel $2,250).
\textsuperscript{27} \textit{Supra} note 18.
\textsuperscript{28} \textit{See, supra} note 26, Rule for Uniform Domain Name Dispute Resolution Policy, at Fee (a).
\textsuperscript{29} \textit{See} id.
The domain name has been registered and is being used in bad faith.\textsuperscript{31}

In addition, UDRP provides a non-exhaustive list of circumstances that are "evidence" of bad faith as follows:

- The domain name holder registered or acquired the domain name primarily for the purpose of selling it to the owner of the trademark or service mark or to a competitor of the complainant, for valuable consideration in excess of documented out-of-pocket costs; or
- The domain name was registered in order to prevent the owner of the trademark or service mark from using its mark in a domain name, provided that a domain name holder has engaged in a pattern of such conduct; or
- The domain name was registered primarily for the purpose of disrupting the business of a competitor; or
- By using the domain name, the owner has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of its website or of a product or service on its website.\textsuperscript{32}

However, the domain name holder or the respondent under UDRP has three possible affirmative defenses:

- Before any notice of the dispute, the domain name holder used, or made demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offer of goods or services; or
- The domain name holder has been commonly known by the domain name even absent a trademark or service mark; or
- The domain name holder is making a legitimate noncommercial or fair use of the domain name, without intending to profit commercially, to mislead consumers, or to tarnish the trademark or service mark at issue.\textsuperscript{33}

UDRP has been applied to disputes involving Thai parties. One of the most significant occasions is the case between Yahoo and a Thai cybersquatter, Dr. Somsak Sooksripanich. The case below shows the strengths and weaknesses of UDRP as compared to Thai trademark

\textsuperscript{32} See id.
\textsuperscript{33} See id.
law. From the facts of the case, this paper will discuss the possibility of penalizing this cybersquatter under Thai law.

B. Yahoo v. Somsak

1. Procedural History

The global Internet company Yahoo filed a complaint in October 2000 in accordance with UDRP, which was approved by ICANN. The complainant alleged that the respondent, Dr. Somsak Sooksripanich, registered a lot of domain names under several registrant names. Many of those names were slightly misspelled versions of, or affiliated with, common nouns or country names. The complainant chose the World Intellectual Property Organization Arbitration and Mediation Center (the Center) to be the dispute-resolution service provider. Therefore, the Center's Supplemental Rules for Uniform Domain Dispute Resolution Policy were also applied. In this process, the complainant was seeking to have the disputed domain names transferred to itself. Yahoo alleged that the respondent had registered domain names confusingly similar to its trademark. As a result of these activities, Internet users could mistakenly enter one of the respondent's disputed websites instead of being forwarded to Yahoo's websites. In addition, when the window containing advertisements of a third party appeared on the monitor, Internet users were likely to be misled into believing the complainant sponsored or endorsed these advertisements. The Honorable Sir Ian Barker QC of New Zealand was appointed by the Center as sole panelist to hear this case.

2. Factual Background

The complainant in this case was Yahoo, an American company with 74 million registered users. Yahoo offers Internet services, such as Internet searching and shopping, to millions of Internet users.

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35 See id. (For example, Mr. Somsak Yai, or Mr. Saetung Somkiet appear to be nicknames of Mr. Somsak Sooksripanich. However, the Panel found that it is appropriate to render the decision against multiple respondents that seem to be invented names of Mr. Somsak Sooksripanich).
36 See id. (For example, yahooforecast.com, yahoothailand.com, yahoothailand.com, and yahoocombodia.com, etc.)
37 See id.
38 See id.
39 Id.
40 Id.
41 Id.
Yahoo’s website, which provides a web directory and a search engine, was launched in 1994. The company has registered many trademarks, service marks, and domain names under the United States federal trademark law in connection with its services.\(^{43}\) Yahoo owns several trademark registrations and applications in another eighty countries as well. In the complaint, the company also alleged that it has advertised and sold merchandise bearing the Yahoo mark.\(^{44}\)

Dr. Somsak Sooksripanich, the respondent in this case, registered twenty-two disputed domain names\(^ {45}\) with Network Solutions, Inc. (NSI). Occasionally, a name such as “mrsomsaknicknameyai” or “saetungmrsmokiet” or a different company name was given to NSI as the administrative and billing contacts; however, all of the administrative contacts have the same street address in Thailand.\(^ {46}\) The complainant contended that the respondent was not and had never been a licensee of the complainant. The respondent was not and had never been otherwise authorized by the complainant to use the Yahoo mark.\(^ {47}\) Dr. Somsak was a well-known cybersquatter in Thailand, who registered domain names consisting of famous trademarks owned by others. In addition to Yahoo’s mark, Dr. Somsak had registered variations of many famous trademarks, trade names, and celebrity names as domain names.\(^ {48}\) Some owners of these domain names had filed complaints with the Center as well.\(^ {49}\)

Yahoo’s trademark counsel in Thailand sent a cease and desist letter to the respondent. The respondent replied that he would not transfer the domain names without monetary compensation and registered an additional seventy-five Yahoo-related domain names.\(^ {50}\)

\(^{42}\) Id.

\(^{43}\) Id. (For example, Registration No. 2,040,222 for the mark “Yahoo,” issued on February 25, 1997, covering computer software, International Class 42.).

\(^{44}\) See id.


\(^{46}\) Id.

\(^{47}\) Id.

\(^{48}\) Id. For example, the following brand names were registered by Mr. Somsak: Louis Vuitton, Dockers, Cerruti, Redbull, Gucci, Dunhill, R.J. Reynolds, Toyota, McDonalds, Pepsi, Coca-Cola, Lacoste, Informix, Oil of Olay, Versace, Hilton, Grammy, Guess, Cardi, Guy Laroche, Lauder, Ebay, Saks, Bertelsmann, Revlon, Sandra Bullock, and David Beckham.


\(^{50}\) Yahoo!, WIPO Case No. D2000-1461.
July 27, 2000, the respondent indicated in a telephone conversation with Yahoo’s counsel that he was willing to assign all Yahoo domain names to Yahoo.\(^{51}\) However, shortly after that conversation, the counsel found Dr. Somsak was advertising for a lawyer to represent him in negotiations for the sale of the disputed domain names.\(^{52}\) His advertisement read: “Wanted, Female lawyer: good at negotiation and sale website yahooth.com (Yahoo Thailand).”\(^{53}\) In addition, the respondent had used a Yahoo e-mail address since May 1998 and was presumably aware of the company’s stature.\(^{54}\)

3. Finding and Decision

Pursuant to § 4 (a) of UDRP,\(^{55}\) the complainant must prove that the domain names are identical or confusingly similar to a trademark or service mark in which the complainant has a right, that the respondent has no rights or legitimate interests regarding the domain names, and that the domain names were registered and are being used in bad faith.\(^{56}\) For the first element, the panel found that the disputed domain names were confusingly similar to Yahoo’s trademark because the complainant’s famous trademarks form the nongeneric part of each one of the disputed domain names.\(^{57}\) According to the facts, the panel found that the respondent did not have either licenses or permission from the complainant to use the trademark Yahoo.\(^{58}\) Therefore, the respondent did not have any legitimate rights relating to the second element. Finally, pursuant to § 4 (b) (i)-(iv),\(^{59}\) the panel found that the element regarding bad faith was demonstrated because there

\(^{51}\) Id.  
^{52} See id.  
^{53} See id.  
^{54} See id.  
^{55} UDRP Section 4 (a) (i)-(iii):  
   a. Applicable Disputes. You are required to submit to a mandatory administrative proceeding in the event that a third party (a “complainant”) asserts to the applicable Provider, in compliance with the Rules of Procedure, that your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and  
   your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and  
   you have no rights or legitimate interests in respect of the domain name; and  
   your domain name has been registered and is being used in bad faith.  
   In the administrative proceeding, the complainant must prove that each of these three elements is present.  
^{56} Yahoo, WIPO Case No. D2000-1461.  
^{57} See id.  
^{58} See id.  
^{59} Supra note 31, Section 4 (b) (i)-(iv):  
   b. Evidence of Registration and Use in Bad Faith. For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limi-
was overwhelming evidence that the respondent registered those twenty-two disputed domain names for the purpose of disrupting the business of the complainant. In addition, the respondent registered domain names in bad faith because the respondent intentionally attempted to attract Yahoo's customers to the respondent's websites and prevented Yahoo from reflecting its trademark by using the domain names. Moreover, the fact that the respondent wished to sell those disputed domain names to the complainant for profit was clear evidence of bad faith.

The panel found that Yahoo is a famous mark, and held against respondent pursuant to the above findings. Finally, the panel ordered the respondent to transfer all of the twenty-two disputed domain names to the complainant.

II. Yahoo Under Thai Trademark Law

Unlike the United States, Thailand does not have a specific provision or act such as 18 U.S.C. § 1125(d), the Anticybersquatting Consumer Protection Act (ACPA), to deal specifically with this legal issue. Conscious of the growth of e-commerce, Congress determined that mark owners needed more protection than that afforded by the

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60 Supra note 34.
61 See id.
62 See id.
63 See id. Eight decisions decided by WIPO Panels involving the Yahoo! mark have been issued in Yahoo's favor. At least six of these cases expressly found the Yahoo! mark to be famous. See also Yahoo! Inc. v. David Ashby, WIPO Case No. D2000-0241 (June 14, 2000), available at http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1461.html.
64 Supra note 34.
trademark infringement and trademark dilution laws.\textsuperscript{65} ACPA provides mark owners a new cause of action.\textsuperscript{66} ACPA's importance lies in the mechanics of the cause of action, which provide several practical benefits to mark owners pursuing cybersquatters.\textsuperscript{67} When, such as in a case of cybersquatting, Thai law does not directly address a controversy, § 4 of the Thai Civil Code allows courts to apply the most related law of cases similar in nature. In addition, the Thai Civil Procedure Code, § 134, prohibits the court from refusing to hear any case by claiming that there are no laws which apply. As of this writing, there have been no cybersquatting cases presented to a Thai court. But pursuant to these two provisions, it would be necessary for the court to hear a cybersquatting case by applying the most related law. Whenever this situation is presented to the Thai court, it will be a challenge to expand Thai law into new areas of technology.

Trademark attorneys in Thailand have been practicing in this area of law under administrative processes, such as filing trademark applications, appealing orders of the registrar, and renewing applications. Thus, it is not often that a trademark dispute is presented to the court, except in cases of passing off. For this reason, Thai courts have not had much opportunity to establish the interpretation of trademark law. Hence, the author believes that, if a case of cybersquatting is presented, the Thai court is likely to be awkward in applying trademark law. However, trademark law is the most applicable law. It is the most appropriate legal theory to apply to the case because the need to prevent public confusion with respect to trademarks is similar to the need to prevent public confusion with respect to domain names. To what extent is a famous mark such as Yahoo's protected under current Thai law?

Basically, a famous mark is protected in Thailand by two methods. The first method is remedial in nature. In the case where a mark has already been registered, any potential beneficiary or the registrar may file a petition to the Trademark Board asking for the revocation of such mark if the mark is not registrable under the Act.\textsuperscript{68} One cause


\textsuperscript{66} See id.

\textsuperscript{67} Id. at 595.

\textsuperscript{68} Trademark Act B.E. 2534, §61 (1991)(Thil.):

Any potential beneficiary or the registrar may submit a petition to the Board seeking for an order to revoke any trademark if it appears that at the time of registration the trademark was not distinctive under § 7 or was proscribed under § 8. (Pursuant to § 8 of the Act, a mark is not registrable if, for example, it is similar to state arms or crests, royal seals, official seals, or a mark is con-
of revocation is where the trademark is so similar to a trademark registered by another person that the public might be confused or misled as to the owner or origin of the marked goods. The second method of protection is preventive in nature, in that it is embodied in the registration process. The current Trademark Act of 1991 as amended by the Trademark Act of 2000 provides protection for famous marks by the stipulation in § 8(10) that a mark that is identical to a famous mark, whether registered or not, or similar to such famous mark to the extent that the public might be misled or confused as to the proprietor or origin of the goods, is not registrable. Even though protection given to trademark in Thailand relies on the principle of registration, the protection will be granted to an unregistered mark in the case of a famous mark. However, protection given to unregistered famous marks is limited to marks of the contracting party of an international convention or agreement related to trademark protection. The facts from the Yahoo case do not clearly state whether Yahoo had registered its mark in Thailand. But this paper will discuss both situations.

A. If the Yahoo Mark Were Registered in Thailand

Section 44 of the Thai Trademark Act states that “a person who is registered as the owner of a trademark shall have the exclusive rights to use it with the goods for which it is registered.” In addition, § 46 provides that “no person shall be entitled to bring legal proceedings to prevent or to recover damages for the infringement of an unregistered trademark.” These two sections are the only provisions in the Act that mention the right of the trademark owner to bring a suit under an infringement claim. However, the law has not clearly defined what the exclusive rights of a trademark owner are. Therefore, it is unclear whether the exclusive rights of the trademark owner should be extended to the right to use the mark as a domain name. Wherever the Thai Congress left the term “exclusive right” undefined, it can be

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69 See id., § 61 (4).
71 Trademark Act B.E., 2534, §8 (10) (1991) (Thil.), amended by Trademark Act (No.2) B.E.2543 (protection of a famous mark under § 8 (10) is limited to the circumstance that the owner of an unregistered famous mark seeks for a revocation of any registered trademark which is confusingly similar to that famous mark). Trademark Act B.E. 2543, §8 (10) (1991) (Thil.) “A trademark having or consisting of any of the following characteristics shall not be registrable: ... (10) A mark registered or not, which is identical with a well-known mark as prescribed by the Ministerial Notifications, or so similar thereto that the public might be confused as to the owner or origin of the goods.”
ferred that the Congress intended to let the court fill this gap. For instance, Thai Supreme Court decree number 3799/2538 ruled that a plaintiff could establish a trademark right even though the product had not been imported to Thailand yet. Therefore, the question whether the exclusive right of a trademark owner should extend to the right to use a trademark as a domain name is left to the court’s decision. Because, so far, there has been no Supreme Court precedent to establish a standard, Yahoo would be likely to struggle with this legal question if the case were filed in Thailand.

Section 4 of the Thai Trademark Act defines trademark as “a mark used or proposed to be used on or in connection with goods or services to distinguish the goods or services . . . from goods or services under another person’s trademark.” From the definition, it can be concluded that the purpose of having a trademark is to use it in connection with products or services.” Samkiet Tungkitvanich comments that a domain name should not be considered a trademark because the purpose of using a domain name differs from the purpose of using a term as a trademark. The domain name functions to locate the owner’s site on the web, but the function of a trademark is to identify the source of products or services. However, since no cybersquatting cases have been presented to the Thai courts, this legal question does not have a formal answer. But one could argue that, if the underlying concerns of the law are to protect the trademark owner, to identify the source of products or services, and to prevent the public from the likelihood of confusion, then the scope of the law should reach practices that implicate those concerns. Therefore, if Yahoo intends to use its domain name in connection with its products or services, and if there is the likelihood of confusion by Internet users, the domain name should be treated as a trademark.

However, another question remains: whether the term Yahoo is a registrable mark in the first place. Last year, Thailand’s Trademark (Thil.) amended by Trademark Act B.E. 2543 (defining “service mark” as a mark used or proposed to be used by the owner thereof on or in connection with goods or services to distinguish the services using the service mark of the owner of such service mark from services under another person’s service mark”). “Trademark” in this paper includes “service mark.”


75 Under Thai trademark law, there is no definition of likelihood of confusion. It is left to the court to apply the law depending on the circumstances. For example, Thai Supreme Court decree number 234/2540 ruled that the mark WELLCOME is confusing with the mark WELCOME; decree number 7335/2538 ruled that the mark SEAPACK, is confusing with CPAC; and decree number 1931/2536 ruled that the mark STAND UP is confusing with the mark, STANDLEY, because potential consumers of the products have low levels of understanding of English.
Act of B.E. 2534 (1991) was amended subsequent to the Uruguay Rounds relating to multinational trade. Thailand, as a World Trade Organization member, was obligated to enact new laws to make the protection of intellectual property a more efficient process. The new Act became fully effective on June 30, 2000, and contained several significant changes. One of them is to allow the registration of a juristic name without a word showing juristic status (Co., Ltd., Corp., etc). In the past, the Trademark Registration Office allowed a juristic name to be registered only if it was stylized or presented in a special manner. Under the new law, a mark bearing a non-stylized juristic name without a word to indicate juristic status can be registered. Therefore, even though the mark Yahoo is merely the name of its corporation, this is unlikely to be an issue for registrability if Yahoo files a trademark application after June 30, 2000.

In conclusion, in the situation where the Yahoo marks were registered in Thailand, if Yahoo intended to use the disputed domain names in connection with its products or services in order to identify their source, then Thai trademark law would likely extend protection to the names.

B. If the Yahoo Mark Were Not Registered in Thailand

Unlike the United States system, Thai trademark law does not include common law rights, which include the right of senior users to use unregistered marks within a specific geographical area and protections for unregistered trademark owners. Thus, trademark protections under Thai law rely on the principle of registration. Section 46 notes, "No person shall be entitled to bring legal proceedings to prevent or to recover damages for the infringement of an unregistered trademark." If this section is applied under the present situation, the mark Yahoo, which is an unregistered mark, is not likely to be protected. Yet, the section will not affect the right of the owner of an unregistered trademark to bring legal proceedings against any person for a passing-off claim. The theory of passing off under Thai law is similar to that in the United States.

76 See generally, Vipa Chuenjaipanich, Juristic Name Registration, THAILAND: IP DEVELOPMENTS Tilleke & Gibbins Newsletter, February 1998.
77 Section 46, Thai Trademark Act 2000 (B.E. 2534).
78 RESTATEMENT (THIRD) OF UNFAIR COMPETITION Chapter Two § 4:
"One is subject to liability to another under the rule stated in § 2 if, in connection with the marketing of goods or services, the actor makes a representation likely to deceive or mislead prospective purchasers by causing the mistaken belief that the actor's business is the business of the other, or that the actor is the agent, affiliate or associate of the other, or that the goods or services that the actor markets are produced, sponsored, or approved by the other."
38/2503 stated that the theory of passing off is not limited to the mis-
representation of a product’s quality, but also extends to the activity
that causes consumers to mistakenly believe the actor’s business is the
business of the other. However, in order to apply this legal theory, the
disputed mark must be used by an infringer in connection with prod-
ucts or services. Furthermore, the plaintiff in this case must demon-
strate likelihood of confusion. In other words, in most cases, an
infringer must use the mark in order to sell or offer to sell products or
services and to cause confusion to the public.\textsuperscript{79}

The facts in the present case are not clear on whether Dr. Som-
sak’s conduct constituted a passing-off action. There is no evidence to
prove whether he had sold or offered to sell products or services
which are similar to Yahoo’s products in order to cause confusion.
Moreover, there was no evidence of public confusion. The court tradи-
nitionally applies passing-off theory to a situation where an infringer
duces the public to believe that he is the trademark owner who has a
legitimate right to sell products in connection with the trademark.\textsuperscript{80} In
the present situation, Dr. Somsak did not intend to deceive the public
into believing that he was the owner of the Yahoo trademark. He
merely wanted to sell the domain names to Yahoo; he did not intend
to sell products to the public. Therefore, it cannot be clearly con-
cluded that Yahoo would have a viable passing-off claim against Dr.
Somsak.

The second analysis involves the protection granted to an unre-
istered famous mark in accordance with section 8 (10).\textsuperscript{81} The lan-
guage of this section provides that a mark is not allowed registration if
it is similar or identical to an existing famous mark. In the present
situation, Dr. Somsak did not seek for trademark registration; he was
merely a domain names holder. Therefore, Yahoo could not strike
down the domain name registration of Dr. Somsak under this
 provision.

The last analysis under Thai trademark law relates to § 63. This
 provision authorizes the registrar to revoke a trademark registration.
Any potential beneficiary may submit a petition to the Board of
Trademark Office (the Board) to cancel a trademark registration, if it
is proven that, at the time of registration, the trademark owner had no
bona fide intention to use the mark with products or services.\textsuperscript{82} Like

\textsuperscript{79} Thai Supreme Court decree number 38/2503.
\textsuperscript{80} See Vas, supra note 72 at 36.
\textsuperscript{81} Supra note 71.
\textsuperscript{82} Trademark Act § 63 (Thil.): “
\textsuperscript{ “Any interested person or the Registrar may petition the Board to cancel a
trademark registration if it is proved that at the time of registration the owner

use requirement under United States law, this section makes certain
that a trademark holder really uses the mark in connection with prod-
ucts or services.\textsuperscript{83} Another important purpose of this provision, which
relates to the present analysis, is to prevent warehousing the marks.
This practice is like cybersquatting, whose goal is to store up domain
names for resale. Therefore, Thai courts could decide cybersquatting
cases under this principle as well. Moreover, the facts from the present
case clearly show that Dr. Somsak had accumulated a number of do-
main names in bad faith. But the possibility of Yahoo prevailing in its
claim is problematic because of the legal aspect of trademark law in
Thailand. As mentioned before, most of the Thai trademark provi-
sions relate to administrative procedures within the Trademark Office,
as exemplified by § 63. That provision clearly states that a potential
beneficiary may submit a petition to the Board, not to a court, re-
questing cancellation. If the petitioner is not satisfied with the result,
he can appeal the Board's order to the court. Even though the legal
principle under § 63 seems to fit a cybersquatting case, the language of
the provision is not directly applicable to the present situation, be-
cause Dr. Somsak is not a trademark holder seeking trademark regis-
tration with the Board.

If Yahoo chooses to assert a claim under § 63, it is likely that
enforcement will remain a problem. Instead of issuing an order
against the defendant, based on a passing-off theory or an infringe-
ment theory, the court must issue an order to the Board to transfer or
cancel the trademark. And even if the court were to decide that "the
Board" in this situation is, practically speaking, Network Solutions,
the domain names registry, the problem would become one of enforc-
ing an order against a foreign corporation. Therefore, § 63 does not
appear to result in a workable outcome from the plaintiff's point of
view.

In conclusion, even though Thai courts could apply Thai trade-
mark law to a cybersquatting case, the likelihood of a plaintiff's pre-
vailing on such a claim is uncertain. Although several trademark
theories and principles of Thai law can be applied to cybersquatting

\textsuperscript{83} However, unlike the United States, Thailand does not require an applicant to estab-
lish use or assert intent to use before filing an application.
cases, some problems of interpretation of the law and legal procedure remain. First, if Yahoo would like to assert a claim under the infringement provision, the court may or may not consider a domain name as a trademark or launching a website as a trademark use. And in order to receive protection under this provision, Yahoo must register its mark in Thailand after the effective date of the amended law. Second, if Yahoo wants to seek protection without registering its mark, it is not likely to have a viable passing-off claim because Thai law requires an actual passing off of products or services and confusion to the public. Finally, even though Thai law has established a theory of bona fide use and has prohibited the warehousing of trademarks, the language of this provision may lead to procedural and enforcement problems. For these reasons, the author believes that Thai trademark law is not developed enough to handle international cybersquatting cases.

III.

UDRP AND THE THAI LEGAL SYSTEM

Because of the uncertainty of Thai domestic law in cases such as Yahoo, turning to alternative dispute resolution is the better choice. Many Thai scholars have recognized the benefits of UDRP and encouraged international intellectual property lawyers to inform their clients about it.

In Thailand, unlike the United States, ICANN and UDRP are mentioned positively. Business users of the Internet need a more time- and cost-efficient method than litigation to resolve domain name disputes. There are several reasons for Thai people to favor UDRP. First, the rule is attractive to foreign investors who seek to launch an e-commerce business in Thailand. Second, it is a sign that the Thai government is willing to adopt other forthcoming Internet regulations established by WIPO or ICANN. Third, there is jurisdiction to assert the claim. Fourth, UDRP is a uniform standard, which resolves the problem of conflicts of applicable laws. Finally, UDRP does not create serious legal issues in Thailand, as it does in the United States. For example, Professor Froomkin observes that American reliance on ICANN rather than an executive agency for regulation

85 Supra note 4.
86 Supra note 74.
87 See id.
88 See id.
89 See id.
violates fundamental values and policies designed to ensure democratic control over government.\textsuperscript{90} But UDRP was strongly praised throughout Thailand.

But no matter how good UDRP is, the Thai government should not ignore cybersquatting or let UDRP rule cyberspace. The Thai government has a responsibility to provide legal protection to its citizens by strengthening Thai laws. UDRP should have a role as an alternative dispute resolution in cases of international disputes in which jurisdiction and conflict of laws are major problems, but it should not be a substitute for Thai law. Besides, having to file a claim in English can be an expensive inconvenience,\textsuperscript{91} and Thai parties should not have to bear the burden of unnecessary expenses. Even though cybersquatting has not become a crucial legal issue in Thailand yet, the problem (not just pirating, but also misrepresentation and unfair competition) is slowly developing with the growth of the Internet.

Because Thailand is one of the signatories of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs), the general principles of Thai trademark law comply with international trademark law standards. Therefore, Thai trademark law is suited to UDRP as well. But a major flaw of UDRP should be addressed. UDRP establishes a contractual relationship between the registrar and its customers. The content of UDRP does not differ from an arbitration contract that determines the arbitrator, the choice of forum, the choice of law, and the recognition of the award. Thai arbitration law says that an arbitration agreement must be made in writing.\textsuperscript{92} So the issue here is whether the terms of use appearing on the computer screen, which contain an arbitration clause, are good enough to satisfy the writing requirement. One could argue that a printout of the terms of use should be enough to fulfill the requirement, but in practice, no one prints them out.\textsuperscript{93} Moreover, the authorized agents of Network Solutions in Thailand have never informed their customers to do so.\textsuperscript{94} The result will be similar if the international law is applied to this circumstance. Because the United States and Thailand are signatories of

\textsuperscript{90} See A. Michael Froomkin, \textit{Wrong Turn in Cyberspace: Using ICANN to Route Around the APA and the Constitution}, 50 DUKE L. J. 17 (2000).

\textsuperscript{91} E-mail from Sorapong Ounnapirak, Internet Marketing Manager, Infonova Co., Ltd., Feb. 20, 2001 (on file with author).

\textsuperscript{92} Arbitration Act, B.E. 2530, §6 (1987) (Thil.): “An arbitration agreement shall be binding upon the parties only when there is evidence thereof in writing, or there appears an agreement in an exchange of letters, telegrams, telexes, or other documents of the similar nature.”

\textsuperscript{93} Email, \textit{supra} note 91.

\textsuperscript{94} E-mail from Veerasit Rangsichainiran, technical support, Siamdomain.com, March 29, 2001 (on file with the author).
the Convention on The Recognition and Enforcement of Foreign Arbitral Awards (the New York Convention), this convention governs this case. Article II of the New York Convention requires that an arbitration agreement should be made in "writing and signed by the parties" or contained in an "exchange of letters or telegrams." If the parties fail to do so, the arbitration award may not be recognized later. This set of rules leaves open the question whether UDRP is enforceable in the first place if the parties do not exchange a tangible form of the arbitration contract. In addition, a party in Thailand could claim that click-on transactions—agreements made between a domain name registrar and a registrant—are not enforceable at all because Thailand does not have the law to validate click-on licenses yet. So far, there is neither a domestic law nor international treaty that validates a trans-national click-on license transaction. Although neither Dr. Som-sak nor other Thai respondents have raised this legal issue as a defense, this flaw should be addressed in Thai law.

IV. RECOMMENDATIONS FOR THAI LAW

A. Amendments to Trademark Law

A major problem of the Thai trademark law is the language of the law on its face. The law is narrowly applied to the registration process, and there are several unidentified terms that require judicial interpretation. Lawmakers should pay attention not only to the registration process, but also to theories of infringement. If standards of infringement are well established, the law should be able to reach cybersquatters' activities.

In order to solve the problem of cybersquatting, trademark law must recognize cybersquatting as an illegal act. There are several ways

95 United Nations Convention on The Recognition and Enforcement of Foreign Arbitral Awards, June 10, 1958, art. II §1-2, 21 U.S.T. 2517, 330 U.N.T.S.,38 (§1. "Each contracting State shall recognize an agreement in writing under which the parties undertake to submit to arbitration all or any differences which have arisen or which may arise between them in respect of a defined legal relationship, whether contractual or not, concerning a subject matter capable of settlement by arbitration. §2. The term "agreement in writing" shall include an arbitral clause in a contract or an arbitration agreement, signed by the parties or contained in an exchange of letters or telegrams.""").

96 United Nations Convention on The Recognition and Enforcement of Foreign Arbitral Awards, June 7, 1959, art. 5 (1) (a), 21 U.S.T. 2517, 330 U.N.T.S., 38: ("Recognition and enforcement of the award may be refused, at the request of the party against whom it is invoked, only if that party furnishes to the competent authority where the recognition and enforcement is sought, proof that: (a) The parties to the agreement referred to in article II were, under the law applicable to them, under some incapacity, or the said agreement is not valid under the law to which the parties have subjected it or, failing any indication thereon, under the law of the country where the award was made.""
to make the law encompass cybersquatting. The first is to clarify the term “exclusive right.” The law should define the rights of a trademark holder, and one of the rights should be the right to use a trademark as a domain name. Or the law could integrate “domain name” into the definition of trademark. (E.g., “a mark means a photograph, drawing, device, brand name, domain name, ... of an object or any one or combination thereof.”) In addition, the Thai trademark act should codify passing-off theory. The theory of passing off has been established by judicial precedents. Since the judicial precedents are considered secondary authority, the trial court need not apply these precedents if a plaintiff does not refer to them in his complaint. Therefore, lack of black letter law on passing off causes inconsistency in court decisions. The law should be written in a way that encompasses cybersquatting activities. As seen in the earlier discussion, the requirement of sale of products was not met in Yahoo’s case. To make passing-off law applicable to cybersquatters, this requirement should be relaxed. Another way to solve this problem is to recognize the sale of domain names by cybersquatters as the use of a trademark in connection with products or services. In addition, it is difficult to establish evidence of public confusion in cybersquatting cases. Therefore, this requirement under the passing-off theory should be relaxed as well.

B. Thai Dispute Resolution

Currently, the Thai government is drafting the Electronic Transaction Bill and the Digital Signature Law. After the completion of these two bills, legal transactions done via the Internet will be enforceable. Therefore, the problem concerning the validity of click-on contracts will be solved. However, the validation of click-on contracts is a separate question from arbitration contracts. Therefore, the Electronic Transaction Bill may not totally resolve the validity of arbitration contracts if the parties do not have evidence in writing. The easiest solution is to change the domain name registration process in Thailand. The government should create a regulation requiring every

97 The original definition from section 4 of the Thai Trademark Act reads: “Mark means a photograph, drawing, device, brand name, word, letter, manual signature, combination of colors, shape or configuration of an object or any one or combination thereof.”

98 The latest draft of the Electronic Transaction Bill, as approved by the House of Representatives as of September 27, 2000, § 6: “Information shall not be denied legal effect and enforceability solely on the ground that it is in the form of a data message.” Section 7: “[I]...n the case where the law requires that any transaction be made in writing or evidenced by writing or supported by a document which must be produced, if the information is generated in the form of a data message which is accessible by reading and convertible into the information usable for subsequent reference, it shall be deemed that such information is already made in writing, evidenced by writing or supported by the produced.”
registrar to inform its customer about the terms of arbitration contracts. The customer may be informed about the arbitration contract either by a tangible letter or in an electronic mail. In the case of electronic mail, the registrar should require the customer to print out the terms of use and retain a copy.

In addition, the government should encourage and provide a domain name dispute resolution service in Thailand. A Thai party, instead of filing a complaint with ICANN, should have a choice to file a complaint domestically. By having this service, a Thai party does not have to spend for expensive lawyers' fees and transaction costs for document translation. Without a language barrier, a claimant will be encouraged to seek for justice domestically. Another reason to have domestic domain name dispute resolution is to lessen the number of cases which are filed with ICANN. The cases that will go to ICANN would be those involving international parties only.

**Conclusion**

*Yahoo v. Somsak* raised awareness of intellectual property issues in the Thai legal community. In the area of intellectual property rights and cyberspace, only a few Thai lawyers have expertise, and it is time for the Thai legal system to respond to the technological developments that may inspire unexpected legal issues. Having an efficient law to cope with the cybersquatting problem is just the beginning of the battle. Many issues concerning intellectual property rights over the Internet are becoming more complicated, and Thai trademark law needs to address them now in order to move confidently into the future.